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Datasheet for the decision of 20 September 2017

Case Number: T 1546/16 - 3.4.02

Application Number: 06826251.8

Publication Number: 1946097

IPC: G01N30/56, G01N30/60

Language of the proceedings: EN

Title of invention:
METHOD AND APPARATUS FOR PACKING CHROMATOGRAPHY COLUMNS

Applicant:
Phenomenex, Inc.

Relevant legal provisions:
RPBA Art. 11
EPC Art. 113(1)
EPC R. 103(1)(a)

Keyword:
Right to be heard - substantial procedural violation (yes)
Remittal to the department of first instance and reimbursement of the appeal fee (yes)

Decisions cited:
T 0139/87, T 0435/07, T 1060/13, T 0305/14

Europäisches Patentamt
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Beschwerdekammern
Boards of Appeal
Chambres de recours

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 1546/16 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 20 September 2017

Appellant: (Applicant)	Phenomenex, Inc. 411 Madrid Avenue Torrance, CA 90501 (US)
Representative:	Gervasi, Gemma Notarbartolo & Gervasi GmbH Bavariaring 21 80336 München (DE)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 15 February 2016 refusing European patent application No. 06826251.8 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	R. Bekkering
Members:	G. Decker
	F. J. Narganes-Quijano

Summary of Facts and Submissions

I. The appellant (applicant) lodged an appeal against the decision of the examining division refusing European patent application No. 06826251.8 (international publication No. WO 2007/050416).

II. The examining division issued a first communication under Article 94(3) EPC in which it raised the following objection (paragraph 3 of that communication):

"*However, present claims 1 to 14 contain various amendments for which no basis could be found in the application a* [sic!] *filed (Article 123(2) EPC). In order to comply with the requirements of Rule 137(4) EPC, the applicant should clearly identify all the amendments made and indicate the passages of the application as filed on which these amendments are based.*"

III. After the subsequent reply by the applicant in which it filed a set of amended claims and indicated in its view the basis for the amendments according to Article 123(2) EPC, the examining division issued a second communication pursuant to Article 94(3) EPC in which the objection was maintained and it was argued as follows (paragraphs 1 and 2 of that communication):

"*With the letter of reply dated 31 January 2012, the applicant filed an amended set of claims 1 to 15. The applicant did however not properly indicate the basis for the amendments in the application as filed, as required by Rule 137(4) EPC.*

In particular, the applicant did not indicate the basis for at least the following amendments in claim 1:
[...]

- defining the 'adjustable locking mechanism' as a 'split adjustable locking mechanism'
- deleting the technical feature of 'having a threaded adjuster interposed between the support and the piston, such that rotation of the threaded adjuster increases or decreases the force the piston exerts on the bed'"

IV. The applicant timely filed a letter of reply in which it filed a set of amended claims and indicated again in its view the basis for the amendments according to Article 123(2) EPC. As far as the two concrete objections regarding claim 1 were concerned (see point III. above), no amendments were made in the new set of claims.

V. The examining division directly issued the decision under appeal thereafter, where it argued as follows:

(a) The two above-mentioned objected amendments in claim 1 had already been introduced by the applicant with its first letter of reply and were maintained in its second letter of reply without requesting oral proceedings (Article 116 EPC); therefore, the examining division by raising in its second communication an objection under Article 123(2) EPC against these amendments respected the applicant's right to be heard pursuant to Article 113(1) EPC.

(b) As regards the amended feature "*split adjustable locking mechanism*", the passages indicated by the applicant described that the fastening mechanism may involve clam-shell or split-ring devices and also a split locking sleeve was described, but nowhere in the application as filed there was any basis to be found for the now-claimed intermediate

generalisation of having a "split adjustable locking mechanism". Consequently, said amendment contravened the requirements of Article 123(2) EPC.

(c) Also the deletion of the feature "*having a threaded adjuster interposed between the support and the piston, such that rotation of the threaded adjuster increases or decreases the force the piston exerts on the bed*" constituted added subject-matter under Article 123(2) EPC, as it was an essential technical feature of the invention; there was no indication for a person skilled in the art which would suggest that this technical feature could be omitted and it could not be seen that the threaded collet and locking sleeve would represent a threaded adjuster having the function of increasing or decreasing the force the piston exerts on the bed.

VI. With the statement setting out the grounds of appeal the appellant filed a set of amended claims according to a main (and sole) request and requested that the decision under appeal be set aside and the examination be continued on the basis of the amended claims as filed. In this context, it requested in particular that the examination department rectify its decision according to Article 109 EPC. The appellant further requested the reimbursement of the appeal fee. As an auxiliary measure, the appellant requested that oral proceedings according to Article 116(1) EPC be scheduled should the board object to the patentability of the subject-matter of the present application or should the board hold that the request to reimburse the appeal fee was not justified.

VII. The appellant’s submissions may be summarised as follows:

The examining division was to grant interlocutory revision according to Article 109 EPC since the appellant, as a reaction to the grounds of the decision under appeal, had reintroduced with the set of amended claims two features that were already present in original claim 1 of the application as filed, thereby overcoming the two objections raised by the examining division.

Furthermore, the specific objections in the decision under appeal had not previously been communicated to the appellant but were presented for the first time in the decision. The statement of the examining division in its second communication, arguing that the applicant did not indicate the basis for the amendments made, did not represent an objection to non-allowable amendments in the sense of Article 123(2) EPC. Thus, the examining division violated the appellant's right to be heard pursuant to Article 113(1) EPC and therefore committed a substantial procedural violation.

VIII. By EPO Form 2701 of 20 June 2016, the examining division ordered that the decision under appeal would not be rectified and that the case was to be referred to the Board of Appeal without delay.

Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rule 99 EPC and is therefore admissible.

2. *Substantial procedural violation*

2.1 According to the principle of the right to be heard pursuant to Article 113(1) EPC, the decision of the examining division must be based on grounds on which the applicant has had an opportunity to present comments. The requirements of Article 113(1) EPC cannot be considered to be met if the factual basis is not sufficiently given in the preceding communication(s) so that the applicant has to speculate about the examining division's assessment and thus is not put in the position to properly defend its rights (see T 435/07, points 2.1, 2.6 of the Reasons). Consequently, only if a preceding communication pursuant to Article 94(3) EPC sets out the essential legal and factual reasoning to support a finding that a requirement of the EPC has not been met, can a decision based on such a finding be issued without contravening Article 113(1) EPC (see T 305/14, point 2.3 of the Reasons).

2.2 The board does not agree with the appellant's assertion that the examining division's remarks in its second communication did not represent an objection to non-allowable amendments in the sense of Article 123(2) EPC. When reading the second communication in connection with the precedent communication where the examining division objected to an infringement of Article 123(2) EPC and linked it directly with the requirements of Rule 137(4) EPC, it becomes sufficiently clear that the examining division, when pointing in its second communication (only) to Rule 137(4) EPC, raised at the same time an objection under Article 123(2) EPC. Indeed, the appellant itself in its reply to the second communication addressed the objections under the headline "*Basis for the amendments, Art.123(2) EPC*".

2.3 However, the board holds that the examining division's objection in its second communication cannot be considered to set out the essential legal and factual reasoning that the requirements of Article 123(2) EPC have not been met.

2.3.1 The examining division contented itself with pointing out the concrete amendments that constituted added subject-matter and citing the pertinent provisions of the European Patent Convention and its Implementing Regulations that were thereby infringed. The appellant thus was not clearly informed in the communication why the examining division was of the opinion that the objected amendments contained subject-matter which extended beyond the content of the application as filed. The statement was put forward in an abstract way only, without the necessary logical chain linking the given statement and the particular technical facts of the case.

2.3.2 Rather, it was only with the impugned decision that the appellant learnt about the technical considerations behind the objections made in the second communication. The examining division stated there for the first time that it considered the objected amended feature "*split adjustable locking mechanism*" to be an impermissible intermediate generalisation. The same applies to the deleted technical feature "*having a threaded adjuster interposed between the support and the piston, such that rotation of the threaded adjuster increases or decreases the force the piston exerts on the bed*", as the examining division explained for the first time in its decision that it could not be seen that the threaded collet and locking sleeve would represent a threaded adjuster having the function of increasing or decreasing the force the piston exerts on the bed.

2.4 As a result, because the appellant learnt about the essential reasoning for the first time in the impugned decision, it did not have an opportunity to present its comments with respect to that reasoning, contrary to the requirements of Article 113(1) EPC. This constitutes a substantial procedural violation.

3. *No rectification by the examining division*

3.1 Without having impact on the outcome of the case at hand, the board notes that, apart from the procedural violation considered above and as far as the substantive issues are concerned, the examining division was not incorrect in not rectifying its decision.

3.2 Only in the event that the appeal is objectively to be considered as admissible and well-founded, is the first instance department obliged to grant interlocutory revision according to Article 109(1) EPC. An appeal by an applicant for a European patent is to be considered, as far as the substantive issues are concerned, well-founded within the meaning of Article 109(1) EPC if the main request of the appeal includes amendments which clearly meet the objections on which the refusal of the application has been based as indicated by the examining division (see T 139/87, OJ EPO 1990, 68, point 4 of the Reasons; T 1060/13, point 4.1 of the Reasons).

3.3 However, amended claim 1 as filed with the statement setting out the grounds of appeal reads "*… and having a threaded adjuster interposed between the **column** and the piston, …*", whereas claim 1 as originally filed reads "*… and having a threaded adjuster interposed between the **support** and the piston, …*" (emphasis added). Under

these circumstances the appellant's amendment does not fully meet the examining division's objection.

4. *Remittal*

4.1 The appellant did not file an express request to remit the case to the department of first instance for further prosecution. However, the appellant explicitly requested "*to continue examination of the present patent application on the basis of the claims as filed*" (see statement of ground of appeals, page 2, first paragraph) and that the examining division grant interlocutory revision. Thus, it becomes sufficiently clear that also in the case of non-rectification by the examining division it is the appellant's main request that the examining division continue substantive examination of the patent application. As a consequence, the board considers the appellant's implicit main request in the just mentioned case that the decision under appeal be set aside and the case be remitted to the department of first instance for further prosecution.

4.2 Since a substantial procedural violation took place, based on the appellant's main request the case is remitted to the first instance for further prosecution without an analysis of the appealed decision in its substantive aspects, nor a decision on the claim requests of the appellant on file (Article 11 RPBA).

5. *Reimbursement of the appeal fee*

In view of the foregoing, the appeal is successful to the extent that the decision under appeal is set aside. Moreover, as a consequence of the substantial procedural violation the applicant was only able to

have its right to be heard restored by filing the appeal. In view of this the board considers the reimbursement of the appeal fee as equitable (Rule 103(1)(a) EPC).

6. *Request for oral proceedings*

Since the board allows the appellant's higher-ranking requests, there is no need to appoint oral proceedings, which were only requested on an auxiliary basis in the present case.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance for further prosecution.

3. The appeal fee is to be reimbursed.

The Registrar: The Chairman:

M. Kiehl R. Bekkering

Decision electronically authenticated