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**Datasheet for the decision
of 20 December 2024**

Case Number: T 1588/22 - 3.3.02

Application Number: 14716913.0

Publication Number: 2986679

IPC: C09D7/61, C09D7/48, C09D7/65,
C09D7/40, C09D5/34

Language of the proceedings: EN

Title of invention:

COMPOSITION FOR THE THERMAL INSULATION OF BUILDING WALL
SURFACES AND APPLICATION PROCESS THEREOF

Applicant:

Fantini, Stefania

Headword:

Relevant legal provisions:

EPC R. 103(1) (a)
EPC Art. 111(1), 113(1)
RPBA 2020 Art. 11

Keyword:

Substantial procedural violation

Decisions cited:

G 0002/97, J 0003/24

Catchword:

Principle of the protection of legitimate expectations not observed by the examining division (see points 1.3 to 1.5 of the Reasons)



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0

Case Number: T 1588/22 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 20 December 2024

Appellant: Fantini, Stefania
(Applicant) Bluna
Via Frua 24
20146 Milano (IT)

Representative: Cammareri, Emanuele
Bresner Cammareri Intellectual Property-BCIP
Via Aurelio Saffi, 23
20123 Milano (IT)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 5 January 2022
refusing European patent application No.
14716913.0 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman M. O. Müller
Members: S. Bertrand
M. Blasi

Summary of Facts and Submissions

- I. The appeal by the applicant ("appellant") lies from the decision of the examining division to refuse European patent application No. 14 716 913.0 ("patent application"). The decision under appeal deals with the set of claims filed on 24 November 2021, which was the sole claim request to be decided upon.
- II. In the impugned decision, the examining division's conclusions included that claim 1 of the claim request comprised subject-matter extending beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC.
- III. In the statement of grounds of appeal, the appellant contested the examining division's decision.
- IV. The appellant was summoned to attend oral proceedings by videoconference on 21 November 2024.
- V. By letter dated 5 November 2024, the appellant requested as its main request a remittal of the case to the examining division and a reimbursement of the appeal fee for reason of a substantial procedural violation. The appellant also submitted claim sets of three auxiliary requests.
- VI. Oral proceedings were cancelled.
- VII. The appellant's requests relevant to the decision are that the decision under appeal be set aside, the case be remitted to the examining division for further prosecution and the appeal fee be reimbursed.

VIII. The appellant's case relevant to the present decision is summarised below.

Reasons for the Decision

1. *Substantial procedural violation - Remittal - Article 111 EPC, Article 11 RPBA - Reimbursement of the appeal fee - Rule 103(1)(a) EPC*

1.1 In line with the established case law of the boards, the principle of the protection of legitimate expectations (also referred to as the principle of good faith) applies in proceedings pursuant to the EPC. Its application to procedures before the EPO implies that measures taken by the EPO should not violate the reasonable expectations of parties to such proceedings (see decision G 2/97, OJ EPO 1999, 123, Reasons 1). It requires that communications addressed to applicants be clear and unambiguous, i.e. drafted in such a way as to rule out misunderstandings on the part of a reasonable addressee (see also decision J 3/24, Reasons 3.2.2).

1.2 The history of the case before the examining division can be summarised as follows.

- On 27 July 2021, the examining division issued a communication and raised an objection under Article 123(2) EPC against the subject-matter of claim 1 of the claim request then under consideration. The last paragraph of the communication (point 1.4) reads as follows:
"The applicant may choose to amend the claim set as previously proposed by the examining division (see

the text intended for grant dated 01.06.2021) and thereby lead to the grant of the present application. They may also choose to submit further arguments along with a new claim set satisfying the requirements of EPC. In the latter case the applicant is kindly reminded that the examination procedure would continue with oral proceedings for the sake of efficiency and better communication."

- On 4 November 2021, the communication issued on 4 July 2021 was resent to the appellant since the communication dated 27 July 2021 had not been received by the appellant.
- On 6 November 2021, the appellant filed a reply to the communication and a new set of claims.
- On 24 November 2021, the appellant filed a new set of claims identical to the set of claims filed on 6 November 2021.
- On 29 November 2021, the appellant filed an enquiry as to when the EPO would deliver the next communication.
- On 7 December 2021, the examining division issued a communication in response to the appellant's enquiry and stated that it would supply a communication within two months.
- On 5 January 2022, the examining division issued a decision refusing the application based on the claims filed on 24 November 2021 (point I.11 of the decision).

1.3 The examining division's announcement in its communication of 27 July 2021 (resent to the appellant on 4 November 2021), that the appellant *"may also choose to submit further arguments along with a new claim set satisfying the requirements of EPC. In the latter case the applicant is kindly reminded that the examination procedure would continue with oral proceedings for the sake of efficiency and better communication"* appears nonsensical or at least misleading in the given circumstances. The only way for the appellant to make sense of the examining division's statement was to assume that this statement actually meant to refer to a situation where a new claim set was filed that would NOT meet the requirements of the EPC, in which case the proceedings would be continued with the holding of oral proceedings.

This created the legitimate expectation on the appellant's part that, after having filed a new set of claims on 6 November 2021 (refiled on 24 November 2021), these claims would either be found allowable or oral proceedings would be held and that, in the latter case, the appellant would have the opportunity to provide, during the oral proceedings, submissions on the allowability of the set of claims filed on 6 November 2021 (refiled on 24 November 2021). In the same way, the examining division's communication of 7 December 2021 created the legitimate expectation that the appellant would have the opportunity to receive a communication or at least a summons to oral proceedings in response to the set of claims filed on 6 November 2021 (refiled on 24 November 2021).

In view of the communication of 27 July 2021, the appellant could not have expected as the next action of the examining division that a decision refusing the

patent application would be issued. This is exacerbated by the communication of 7 December 2021 informing that the examining division would "*supply a communication within 2 months*".

It follows that instant issuance of the decision of the examining division refusing the application was a surprise for the appellant.

Thus, the principle of the protection of legitimate expectations has not been observed in the case at hand.

1.4 In its decision (point II. 12), the examining division stated:

"Issue of a decision is possible since the applicant did not request in any of their responses, including the last one received on 24.11.2021, oral proceedings in view of Article 116(2) EPC [sic]. Additionally, all the objections mentioned in this refusal had already been communicated to the applicant more than once, where they had a chance to provide counter-arguments or submit amendments in order to overcome said objections. Hence, the applicant's right to be heard in view of Article 113 EPC is respected."

The board does not agree. Even if the appellant had not submitted any request for oral proceedings, for the reasons set out above, the examining division had created the legitimate expectation that rather than a decision to refuse the application, the next step would be either oral proceedings, arranged by the examining division of its own motion in accordance with Article 116(1) EPC as considered expedient, or a further communication.

In view of these legitimate expectations, the appellant had to assume that it would be given a further opportunity to provide counterarguments or submit amendments prior to any decision to refuse its application.

- 1.5 Issuance of the decision refusing the patent application without holding oral proceedings or issuing a further communication as announced had thus the effect of depriving the appellant of any such further possibility to provide comments.

Consequently, the appellant's right to be heard has been violated (Article 113(1) EPC). The examining division's decision to refuse the application thus constitutes a substantial procedural violation.

2. For this reason, the decision under appeal is to be set aside without further consideration of the appeal case as to its merits, and the case is to be remitted to the examining division for further prosecution (Article 11 RPBA and Article 111(1) EPC).
3. Moreover, as the board deems the appeal to be allowable and in view of the substantial procedural violation having occurred, the board considers reimbursement of the appeal fee equitable. Thus, the appeal fee is to be reimbursed in accordance with Rule 103(1) (a) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.
3. The appeal fee is reimbursed.

The Registrar:

The Chairman:



U. Bultmann

M. O. Müller

Decision electronically authenticated