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**Datasheet for the decision
of 19 September 2024**

Case Number: T 0289/23 - 3.5.07

Application Number: 19710182.7

Publication Number: 3752928

IPC: G06F16/29, G06Q50/16,
G06Q50/14, G06Q50/30

Language of the proceedings: EN

Title of invention:

A method and an apparatus for searching or comparing sites using routes or route lengths between sites and places within a transportation system

Applicant:

Malewicz, Grzegorz

Relevant legal provisions:

EPC Art. 18(2), 114(1)
EPC R. 103(1)(a), 113(1), 113(2), 115(2)
RPBA 2020 Art. 11, 15(3)

Keyword:

Remittal to the department of first instance - (yes)
Reimbursement of appeal fee - (yes)
Substantial procedural violation - missing signature (yes)

Decisions cited:

G 0012/91, J 0007/82, J 0016/17, T 1093/05, T 1170/05,
T 0990/06, T 2076/11, T 0572/19, T 0989/19, T 2348/19



Beschwerdekammern
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Case Number: T 0289/23 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 19 September 2024

Appellant: Malewicz, Grzegorz
(Applicant) Alabastrowa 56
25-753 Kielce (PL)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 3 January 2023
refusing European patent application
No. 19710182.7 pursuant to Article 97(2) EPC**

Composition of the Board:

Chair J. Geschwind
Members: M. Jaedicke
C. Barel-Faucheux
R. de Man
E. Mille

Summary of Facts and Submissions

- I. The appellant (applicant) appealed against the examining division's decision refusing European patent application No. 19710182.7.
- II. In the case at hand the examining division decided to enlarge itself by a legally qualified examiner in accordance with Article 18(2) EPC (see decision by the examining division dated 12 July 2022 on EPO Form 2939).
- III. According to the minutes, oral proceedings were held on 15 December 2022 in the absence of the appellant and in the presence of all four members of the enlarged examining division. At the end of the oral proceedings the decision was announced (see EPO Form 2009.1 and 2009.2 - in the electronic file with a date of 2 January 2023; points 10 and 11 of the "Summary of Facts and Submissions" of the decision under appeal).
- IV. The examining division decided that the subject-matter of independent claim 1 of the sole request lacked inventive step over a notoriously known general-purpose computer system.
- V. The decision under appeal was electronically authenticated on 22 December 2022 by the three technically qualified examiners, i.e. the Chair, the first examiner and the second examiner (see electronic authentication of the decision on Form 2048.2, reproduced below with anonymisation), but not by the legally qualified member of the examining division.



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Application No.:

EP19710182

Decision of the Examining Division

The examining division has decided:

The European patent application is refused on the basis of Article 97(2) EPC. The reason for the decision are attached (Form(s) 2916).

Electronically authenticated

22.12.2022

Date

[Redacted signature]

Chairperson

[Redacted signature]

1st examiner

[Redacted signature]

2nd examiner



VI. However, the name of the legally qualified member is mentioned on sheet 2 of EPO Form 2007 of the decision (reproduced below with anonymisation).

Date 03.01.2023

Sheet 2

Application No.: 19 710 182.7

Examining Division:

Chairman:
2nd Examiner:
1st Examiner:
Legal Member:

██████████
██████████
██████████
██████████



Abily, Yolande
Formalities Officer
Tel. No.: +31 70 340-4386

Branch at The Hague

Enclosure(s): 9 page/s reasons (Form 2916)
Form 2019

to EPO postal service: 22.12.22

Registered letter
EPO Form 2007 07.1917R

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22.12.2022

VII. In his statement of grounds of appeal, the appellant requested the following:

- "1. The Decision of the Defendant dated 2023.01.03, concerning a patent application EP19710182.7, of not allowing the claims as amended on 2021.09.08, is revoked.
2. The claims as amended on 2021.09.08, concerning a patent application EP19710182.7, are allowed.
3. The Defendant pays the cost of the Appeal.

4. The Defendant pays 1,000,000 EUR to the Appellant.
5. Any employment of [...] [the Chair] with the Defendant is terminated, and [...] [the Chair] is barred from holding any employment with the Defendant for five years."

VIII. In a communication under Article 15(1) RPBA accompanying the summons to oral proceedings, the board informed the appellant that it interpreted points 1 to 3 of the appellant's above-mentioned requests as follows: the appellant requests that (1) the contested decision be set aside, (2) a patent be granted on the basis of the claims of the sole substantive request filed on 8 September 2021 and (3) the appeal fee be reimbursed.

The board also expressed its provisional opinion that the contested decision suffered from a substantial procedural violation since the signature of the legal member of the examining division was missing. Consequently, the decision under appeal had to be set aside, the case had to be remitted to the examining division and the appeal fee had to be reimbursed in full. Furthermore, the board informed the appellant of its preliminary opinion that it was not competent to decide on the appellant's requests 4 and 5 in accordance with point VII. above.

IX. By letter of 11 July 2024 in reply to the board's communication, the appellant submitted arguments in completely inappropriate and rude language.

The appellant did not agree to the case being remitted to the department of first instance. Remittal would place an undue burden on the appellant. Based on "the

written record of the case", there was a "reasonable fear" that the examining division would "try to cheat the Appellant, so as to cover up how the Examining Division already cheated the Appellant". In addition, the appellant would be "forced to exert effort to process the 'further prosecution'". For example, the appellant might be "forced to read and check" how one member of the examining division was "trying to cheat the Appellant again".

The appellant maintained all his requests, asked the board to perform its obligation under Articles 12 and 15 RPBA "to consider the evidence and the arguments presented in the Statement of Grounds" and informed the board that he would not be attending the oral proceedings.

- X. At the end of the oral proceedings, held as scheduled in the appellant's absence, the Chair announced the board's decision.

Reasons for the Decision

1. The appellant having been duly summoned to the oral proceedings, these were held in his absence (Rule 115(2) EPC). The appellant was treated as relying only on his written case (Article 15(3) RPBA).
2. According to Rule 113(1) EPC, decisions from the European Patent Office "shall be signed by, and state the name of, the employee responsible".
3. In the case at hand, the appellant did not complain in the appeal proceedings about the absence of the legally qualified examiner's signature. However, according to Article 114(1) EPC, "the European Patent Office shall

examine the facts of its own motion" and "shall not be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought".

Therefore the board examines of its own motion whether there was a substantial procedural violation within the meaning of Rule 103(1)(a) EPC during the first-instance proceedings (see e.g. J 7/82, Reasons 6; T 989/19, Reasons 2), in particular with regard to essential requirements of the first-instance decision.

4. In line with decision T 990/06, Reasons 2.2 and 2.4, the Guidelines for Examination in the European Patent Office (2023), C-VIII, 7 state the following regarding decisions taken by an enlarged examining division:

- *"Once the examining division has been enlarged, communications or decisions must be signed by all four members of the examining division."*
- *"Where an examining division has been enlarged pursuant to Art. 18(2) but the case is decided in a three-member composition, there should be clear evidence in the public file that a decision to set aside enlargement was taken by the division in its four-member composition prior to the final decision."*

Therefore, if enlargement is considered no longer necessary, the examining division will set it aside. This decision is not separately appealable.

The applicant is informed about the setting aside of the enlargement in the communication accompanying and/or the annex to the summons or the decision following the setting aside of the enlargement."

5. There is no evidence on file, for example in the minutes of the oral proceedings held on 15 December 2022, that a decision to set aside enlargement of the examining division was taken by that division in its four-member composition prior to announcing the final decision in the oral proceedings. In fact, the minutes of the oral proceedings contain only the following sentence: "The requests and arguments on file were discussed by the examining division". Hence, based on the public evidence on file, it can only be concluded that the decision to refuse the application, now under appeal, was taken by the examining division in its enlarged composition (see G 12/91, Reasons 2).

Furthermore, the non-public Form 2701 for interlocutory revision was signed by all four members of the examining division, i.e. by the legal member as well. This seems to confirm that the decision under appeal was indeed taken by the examining division in its enlarged composition.

- 5.1 Rule 113(1) EPC stipulates that "[a]ny decisions [...] from the European Patent Office shall be signed by, and state the name of, the employee responsible". Rule 113(2) EPC provides that an EPO seal can replace the signature where a document (i.e. the decision) is produced automatically by a computer.

In recent years, the EPO has implemented a mechanism to electronically authenticate decisions and other

documents relevant to the decision-making process. An electronic authentication by a member of the examining division has the consequence that the member's name will appear on the relevant form together with an indication that the decision has been electronically authenticated (see Notice from the EPO dated 27 March 2020 concerning the electronic authentication of decisions and other documents relevant to the decision-making process, OJ EPO 2020, A37).

5.2 According to established case law (see decision J 16/17, Reasons 2.3; decision T 989/19, Reasons 3 to 6), the requirements codified in Rule 113(1) EPC are *"not just a mere formality but an essential procedural step in the decision-taking process. The name and the signature serve to identify the decision's authors and express that they unconditionally assume responsibility for its content. The requirement laid down in Rule 113(1) EPC is aimed at preventing arbitrariness and abuse and ensuring that it can be verified that the competent body has taken the decision. It therefore constitutes an embodiment of the rule of law. As a consequence, a violation of the requirement pursuant to Rule 113(1) EPC amounts to a substantial procedural violation and renders the decision erroneous (see T 2076/11, Reasons 4 and 5; T 1093/05, OJ EPO 2008, 430, Reasons 6)."* Eventually, these requirements are to be met for each relevant procedural step, including the written decision.

5.3 If a member of the department of first instance who participated in the oral proceedings before that department is unable to act at the time the written decision is to be issued, for example due to death or to a relatively long-lasting illness, one of the other members may sign on behalf of the incapacitated member.

However, in such a situation, a written explanation as to why one member is signing on behalf of another must be provided (see T 1170/05, Reasons 2.4; T 2076/11, Reasons 3; T 989/19, Reasons 5; and T 2348/19, Reasons 1.3).

- 5.4 In the case at hand the requirement pursuant to Rule 113(1) EPC was contravened since the decision was not electronically signed by all four members of the enlarged examining division: the signature of the legal member is missing. Moreover, there is no indication that the legal member was for some reason unable to act at the time the written decision was to be issued, and in any event none of the other members has signed or authenticated the decision on their behalf.

In view of this, a substantial procedural violation of the requirements of Rule 113(1) EPC has occurred.

- 5.5 The appellant demanded that the board nevertheless examine the merits of his appeal, essentially because immediate remittal might result in the application being refused a second time for the same reasons.

Although the board understands the appellant's concern that an immediate remittal may lead to a second refusal and a second appeal with no progress being made, the board takes the view that the appellant's individual interest in a speedy conclusion of the examination proceedings cannot outweigh the fundamental general interest of parties and the public alike to place their trust in the integrity of the EPO's decision-making processes (see T 572/19, Reasons 14).

- 5.6 Hence the decision under appeal (i.e. the decision to refuse the current patent application) is to be set

aside and the case is to be remitted for further prosecution by the examining division (Article 11 RPBA).

6. *Reimbursement of the appeal fee under Rule 103 EPC*

6.1 Under Rule 103(1)(a) EPC, the appeal fee is to be reimbursed if the appeal is allowable and if such reimbursement is equitable by reason of a substantial procedural violation.

6.2 Since the decision under appeal is to be set aside, the appeal is allowable. Moreover, full reimbursement of the appeal fee under Rule 103(1)(a) EPC is also equitable since the substantial procedural violation is the reason for the immediate remittal.

7. *Appellant's third, fourth and fifth requests*

The board of appeal, as a review instance, is not competent to decide on the appellant's fourth and fifth requests, nor on the third request to the extent that it exceeds the cost of the appeal fee.

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 in full.

The Registrar:

The Chair:



S. Lichtenvort

J. Geschwind

Decision electronically authenticated