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**Datasheet for the decision
of 8 January 2024**

Case Number: T 1823/23 - 3.3.06

Application Number: 14793312.1

Publication Number: 3044362

IPC: D06M13/11, C08G59/30,
D06M15/55, D06M23/08

Language of the proceedings: EN

Title of invention:

BROMINATED EPOXY POLYMERS AS TEXTILE-FINISHING FLAME RETARDANT
FORMULATIONS

Applicant:

Bromine Compounds Ltd.

Headword:

Flame retardant/BROMINE COMPOUNDS

Relevant legal provisions:

EPC Art. 94(3), 113(2)
EPC R. 71(3), 71(5), 103(1)(b), 140

Keyword:

Examination procedure - approval of the text by the applicant
Basis of decision - text submitted or agreed by applicant (no)

Decisions cited:

G 0001/10, J 0017/04, J 0011/18, J 0004/09, T 2081/16,
T 1003/19, T 0408/21, T 0843/03, T 0762/05, T 0265/20,
T 1869/12

Catchword:



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
Fax +49 (0)89 2399-4465

Case Number: T 1823/23 - 3.3.06

D E C I S I O N
of Technical Board of Appeal 3.3.06
of 8 January 2024

Appellant: Bromine Compounds Ltd.
(Applicant) P.O. Box 180
84101 Be'er-Sheva (IL)

Representative: Ter Meer Steinmeister & Partner
Patentanwälte mbB
Nymphenburger Straße 4
80335 München (DE)

Decision under appeal: **Decision of the Examining Division dated
13 July 2023 to grant a European patent pursuant
to Article 97(1) EPC**

Composition of the Board:

Chairman J.-M. Schwaller
Members: P. Ammendola
O. Loizou

Summary of Facts and Submissions

- I. The applicant's appeal lies from the examining division's decision dated 13 July 2023 to grant a patent on the basis of the documents indicated in the communication under Rule 71(3) EPC of 21 February 2023.
- II. The application as filed was composed of a description of 81 pages, a set of 29 claims and 3 drawing sheets 1/3, 2/3, 3/3 including figures 1 to 6.
- III. In the request for entry into the European phase, in all the communications from the examining division pursuant to Article 94(3) EPC dated respectively 29 June 2017, 14 December 2017, 28 November 2018, 5 June 2019, 24 September 2020, and in the summons to attend oral proceedings under Rule 115(1) EPC dated 12 September 2022, the drawing sheets 1/3 to 3/3 were always properly listed.
- IV. With letter dated 31 January 2023, the applicant submitted further amendments to the application documents and requested to issue a communication under Rule 71(3) EPC based on the following documents:
 - Description, pages 1 to 80 (clean version) as submitted herewith
 - Claims, numbers 1 to 16 (clean version), as submitted herewith
 - Drawings, Sheets: 1/3, 3/3 as filed with entry into the regional phase before the EPO.
- V. In a communication under Rule 71(3) EPC dated 21 February 2023, the applicant was informed that the examination division intends to grant a European patent on the basis of pages 1 to 80 of the description, filed

in electronic form on 31-01-2023 and claims 1 to 16, filed in electronic form on 31-01-2023, with pages 18, 19, 21, 80 and claims 1, 5 having been further amended by the examining division.

- VI. The applicant then filed a translation of the claims in the two other official languages and paid the fee for grant and publication.

- VII. Following the decision of the examining division dated 13 July 2023 to grant the patent in the version indicated above, the applicant appealed this decision on 29 August 2023 and requested to grant the patent on the basis of the documents identified in its letter of 31 January 2023. It also requested the reimbursement of the appeal fee.

- VIII. In its statement of grounds of appeal of 8 September 2023, the appellant put forward that the communication pursuant to Rule 71(3) EPC did not contain any drawing, nor was there any reference in said communication to the drawings or to their removal. It also observed that the case was very similar to those underlying the decisions T 1003/19 and T 408/21 and requested that the examining division's decision be set aside and a patent be granted on the basis of the documents underlying the impugned decision, additionally "including the complete set of Figures 1, 2, 3, 4, 5 and 6 as submitted on drawing sheets 1/3 to 3/3 of the original application".

Reasons for the Decision

- 1. Admissibility of the appeal
 - 1.1 For the board, the appeal is admissible since the appellant is adversely affected by the omission of the

drawings, as the granted version of the patent does not correspond to the text it had submitted in its letter of 31 January 2023. There is thus a discrepancy between the appellant's request and the examining division's decision.

- 1.2 When looking at the file history it is apparent that the original application contained the drawing sheets 1/3 to 3/3 which included Figures 1 to 6, and nowhere in the file it can be found that the figures or drawings sheets were amended, let alone withdrawn.
- 1.3 Furthermore, in all the communications pursuant to Article 94(3) EPC and in the summons to oral proceedings it was mentioned that the examination was being carried out on the basis of documents including the "Drawings, sheets 1/3-3/3 as published". For the board, a reasonable understanding of this indication is that the drawings were neither amended nor withdrawn and that they were part of the application documents on which the substantive examination was carried out.
- 1.4 The communication under Rule 71(3) EPC however referred to the description and the claims but **not** to the drawings.
- 1.5 According to Rule 71(3) EPC, first sentence: "*Before the Examining Division decides to grant the European patent, it shall inform the applicant of the text in which it intends to grant it and of the related bibliographic data.*" In the board's view, this clearly implies the need to indicate those versions of the description, claims and drawings which, after a detailed and in-depth legal and technical examination, proved to meet the requirements of the EPC. Normally the documents indicated in the communication according

to Rule 71(3) EPC should correspond to the applicant's request that the examining division intends to grant possibly modified by minor amendments (described in the "Comments" of the communication) proposed by the examining division.

- 1.6 In the present case, the documents indicated in the communication under Rule 71(3) EPC are however manifestly not in line with those resulting from the examination of the request on file, because the drawings formed part of the application as filed but were never withdrawn by the (now) appellant, and only the claims and the description were objected to by the examining division and amended by the appellant, but not the drawings.
- 1.7 When trying to clarify the intention behind an action or request, this is frequently done in the case law by identifying the "true will" of the actors in a case. This applies to the will of the applicant/appellant (e.g. J 17/04, point 11 of the Reasons; J 11/18, points 4 and 5 of the Reasons) as well as of the examining division (e.g. T 843/03, point 1 of the Reasons; T 762/05, point 1 of the Reasons; T 1869/12, headnote). Also the EBA decision G 1/10 elaborates in detail on the notion of the "true intention" behind an action performed (points 30, 31 and 44 of the grounds).
- 1.8 In the case at issue, the communication under Rule 71(3) EPC does not contain any hint that any deletion or amendment were made by the examining division to the drawing sheets. There is thus a clear discrepancy between the description referring to the Figures and the absence of any drawing sheets in the text intended for grant, which should have been remarked upon by the examining division when allegedly deleting the drawing

sheets, but apparently neither the members of the examining division nor the (now) appellant realised that the drawing sheets were missing and that the documents referred to in the communication pursuant to Rule 71(3) EPC did not correspond to those according to the appellant's request, which included the drawing sheets.

1.9 Therefore, in line with decisions T 1003/19 and T 408/21, the board concludes that the examining division did not indicate in the communication according to Rule 71(3) EPC the text it intended to grant for the following reasons:

1.9.1 The EPO is held to decide upon a European patent application only in the text submitted, or agreed, by the applicant (Article 113(2) EPC); however there was never an indication that the figures or the drawing sheets would be deleted. Such a deletion would also be contradictory to the text of the description proposed for grant, which proposed text contains on pages 30, 47, 56 and 59 references to the figures 1 to 6. Therefore, it is entirely evident that the examining division considered the figures to be part of the specification on the basis of which the patent should be granted.

1.9.2 It is furthermore common practice at the EPO to only suggest amendments which the examining division can reasonably expect the applicant to accept, for instance making a statement of the invention in the description consistent with the claims, or correcting any linguistic or other minor errors, but removing all drawing sheets including the figures that are mentioned in the description is not an amendment that can be suggested.

1.9.3 It is also good standard practice at the EPO to include every amendment suggested by the examining division not only in the text on the basis of which the patent is to be granted, but also to explain the amendments in the communication according to Rule 71(3) EPC. In this respect, a special field is provided at the bottom of page 1 of Form 2004C in which the amendments proposed by the examining division are to be indicated and explained. In the present case, this field was used by the examining division to indicate that pages 18, 19, 21, 80 of the description and claims 1 to 5 had been amended, but the deletion of the drawing sheets is not mentioned. Hence, there is no indication that the examining division intended to include such deletion to the application documents submitted by the applicant.

1.9.4 In view of the history summarised above, it can only be concluded that the examining division had no reason or intention to delete the drawing sheets from the list of documents intended for grant. The board therefore concludes that neither the documents referred to in Form 2004C nor the documents submitted as the text intended to grant with the communication according to Rule 71(3) EPC corresponded to the text in which the examining division intended to grant the European patent.

1.9.5 The examining division therefore did not communicate the text that it intended to grant. Following T 2081/16 (point 1.4.5 of the Reasons), T 408/21 (point 1.12 of the Reasons) and T 1003/19 (point 2.4.5 of the Reasons), Rule 71(5) EPC correspondingly does not apply, as in the step preceding the deemed approval the applicant has to be informed of the text in which the examining division intends to grant the patent according to Rule 71(3) EPC. Although the (then)

applicant received a Rule 71(3) EPC communication, the documents indicated were not those which the examining division intended to grant.

- 1.9.6 The present board is aware of decision T 265/20, in which the competent board did not follow the approach in the above cited decisions T 408/21, T 1003/19 and T 2081/16 without considering it necessary to refer a question to the Enlarged Board of Appeal. The present case is however distinguished from said decision not least in the fact that, as outlined above, the board could identify convincing reasons why the examining division's true intention was not reflected by the text of the Rule 71(3) EPC communication, whereas the board in case T 265/20 was not in a position to draw such a conclusion for "the case at hand" (point 2.11 of the Reasons).

This board considers that the detailed reasons given in T 1003/19, T 2081/16 and T 408/21 are fully convincing and lead to a result that prevents the patent applicant from being seriously prejudiced by the absence of a possibility to request corrections under Rule 140 EPC (see G 1/10, points 8 to 12 of the Reasons). Therefore, the Board sees no need for and refrains from its own referral to the Enlarged Board.

- 1.10 As the text on the basis of which the patent was granted was not in accordance with the appellant's request, the appellant is adversely affected by the decision under Article 97(1) EPC. With all other requirements pursuant to Rule 101(1) EPC being met, the board concludes that the appeal is admissible.

2. Allowability of the appeal

2.1 A decision to grant a patent pursuant to Article 97(1) EPC which is based on an application in a text which was neither submitted nor agreed to by the appellant, as is the case here, does not comply with Article 113(2) EPC.

2.2 The decision under appeal is therefore to be set aside.

3. Reimbursement of the appeal fee

3.1 Rule 103(1)a) EPC provides for a refund of the appeal fee where an appeal is allowable and the reimbursement is equitable by reason of a substantial procedural violation.

3.2 In the case at issue the reimbursement of the appeal fee is not held equitable since the applicant made no use of opportunities to participate in the initial proceedings (J 4/09, Reasons 4), as the error made by the examining division was introduced already in February 2023 into the communication under Rule 71(3) EPC, and the applicant could and should have noticed it when checking the text of the communication under Rule 71(3) EPC, because the fact that no published drawing sheets existed should have alerted it and should have prompted a double check.

3.3 The fact that a narrow interpretation of Rule 71(3) and (5) EPC as proposed by the present board allows for an appeal to be treated as admissible should however not be misinterpreted as an invitation to neglect the applicant's duty to carefully check the documents submitted in the text intended for grant sent with the

communication under Rule 71(3) EPC. The request for reimbursement of the appeal fee is therefore rejected.

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 with the order to grant a patent on the basis of the following documents:
 - Pages 1 to 80 of the description, according to the text intended for grant submitted with the communication under Rule 71(3) EPC of 21 February 2023
 - Claims 1 to 16, according to the text intended for grant submitted with the communication under Rule 71(3) EPC of 21 February 2023
 - Drawing sheets 1/3 to 3/3, as originally filed.
3. The request for reimbursement of the appeal fee is rejected.

The Registrar:

The Chairman:



A. Pinna

J.-M. Schwaller

Decision electronically authenticated