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Case Number : T 283/88 - 3.3.2



D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 7 September 1988

Appellant : ABBOTT LABORATORIES
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USA

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Decision under appeal : Decision of Examining Division 023
of the European Patent Office
dated 28 September 1987 refusing
European patent application
No. 81 301 323.2 pursuant to
Article 97(1) EPC

Composition of the Board :

Chairman : P. Lançon
Members : E. Persson
U. Kinkeldey



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Aktenzeichen / Case Number / N° du recours : T 283/88 - 3.3.2

Anmeldenummer / Filing No / N° de la demande : 81 301 323.2

Veröffentlichungs-Nr. / Publication No / N° de la publication : 0 037 687

Bezeichnung der Erfindung: Recombinant deoxyribonucleid acid which codes for
Title of invention: plasminogen activator and method of making
Titre de l'invention : plasminogen activator protein therefrom

Klassifikation / Classification / Classement : C12N 15/00

ENTSCHEIDUNG / DECISION

vom / of / du 7 September 1988

Anmelder / Applicant / Demandeur : ABBOT LABORATORIES

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Oral proceedings/ABBOTT

EPU/EPC/CBE Article 116, Rule 67

Schlagwort / Keyword / Mot clé : "Oral proceedings - Suggestion that probably
there should be an Oral Proceeding - Decision
to Refuse issued without Oral Proceedings -
Decision void ab initio and set aside".
"Reimbursement of appeal fee"

Leitsatz / Headnote / Sommaire

Summary of Facts and Submissions

- I. European patent application 81 301 323.2 concerning a recombinant plasmid was filed on 27 March 1981. The Examining Division issued three communications pursuant to Article 96(2) EPC, the last one on 14 November 1984, making various objections to the application, inter alia under Article 83 EPC and as to the formulation of the claims in the application. By letter of 14 March 1985 the applicant responded to the last mentioned communication. It was concluded in the letter "that there would be little point in further exchange of written communications but that probably there should be an oral proceeding so that the applicant could take these matters to appeal as soon as possible". On 6 December 1985 the Examining Division issued a further communication maintaining its view that the claims were not meeting the requirements of the EPC. By letter of 1 August 1986 the applicant maintained his opposite view on this point and suggested that possibly a way of making progress would be for the applicant's attorney kindly to be granted an interview with the Chairman of the Examining Division.

- II. On 28 September 1987 the Examining Division issued a decision refusing the application according to Article 97(1) EPC. The grounds for the refusal were, inter alia, that the claims were lacking clarity as required under Article 84 EPC in conjunction with Rules 27(1)(d) and 29(1) EPC. In the reasons for the decision the suggestion of the applicant for an interview with the Chairman of the Examining Division was mentioned. However, this request was not allowed, "because the Examining Division can only act as a whole and because this request is not a formal request according to Article 116(1), first

sentence, with respect to the issues raised in the communication of 06.12.1985."

- III. On 25 November 1987 the applicant filed a notice of appeal against the decision of the Examining Division and paid the appeal fee. A statement of the grounds of appeal was filed on 27 January 1988.
- IV. The appellant submits that the decision of the Examining Division was "wrongly given" in view of the fact that the Examining Division had ignored the request made for oral proceedings. By letter of 29 April 1988 the appellant is further referring to the decision of Technical Board of Appeal 3.4.1 of 16 April 1987 in case T 19/87 concerning the obligation under Article 116 EPC to let oral proceedings take place if such proceedings have been requested before issuing a final decision.
- V. The appellant requests that the application be remitted to the Examining Division for oral proceedings to take place as soon as possible. Furthermore, the reimbursement of the appeal fee is requested.

Reasons for the Decision

- 1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
- 2. According to Article 116(1) EPC, oral proceedings shall take place either at the instance of the European Patent Office if it considers this to be expedient or at the request of any party to the proceedings. This provision is mandatory and leaves no room for discretion. If a request for oral proceedings has been made, such proceedings must therefore be appointed. This is in contrast to a request

for an interview before the Examining Division, in which case the Examining Division may refuse such a request if it considers that no useful purpose would be served by such a discussion (cf. Guidelines for Examination in the European Patent Office, paragraph C-VI, 6.1). As pointed out in the decision in case T 19/87, referred to by the appellant, if there is any doubt in any particular case as to whether or not oral proceedings have been requested, it is clearly desirable as a matter of practice that clarification should be sought from the party concerned.

3. Even if, as stated above, the Examining Division was formerly entitled to refuse the request made for an interview, the reasons given in the decision under appeal for not allowing such an interview are very formalistic and do indeed not correspond to the spirit of the Guidelines on this point.

4. Furthermore, in refusing the request for an interview the Examining Division clearly overlooked the suggestion previously made in the letter of 14 March 1985 for oral proceedings. Although the word "request" was not used in this letter, the "suggestion" must in the circumstances be construed as a request for oral proceedings within the meaning of Article 116(1) EPC. There was no reason to believe that the appellant had dropped this request by his subsequent asking for an interview, particularly not in the case the request for an interview should be refused. It was after all quite clear that the appellant was desperately trying to get an opportunity to discuss orally with the Examining Division the controversial issues of the formulation of the claims in the application and the Examining Division should, in the Board's view, at least have checked with the appellant whether his former suggestion for oral proceedings was still maintained.

5. In these circumstances the issuing of a final decision without first summoning the appellant to oral proceedings was in violation of Article 116(1) EPC and the decision under appeal is therefore void ab initio. Consequently, it has to be set aside.

6. The right to an oral hearing as provided for by Article 116 EPC is a very important procedural right. Any violation of this right must therefore, in principle, be considered as a substantial procedural violation within the meaning of Rule 67 EPC. The failure in the present case of the Examining Division to provide for oral proceedings was, in the Board's view, not an error of judgement but rather due to negligence on the part of the Examining Division. The failure in question has therefore to be deemed as a substantial procedural violation under Rule 67 EPC. The request for reimbursement of the appeal fee is therefore justified.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.

2. The application is remitted to the Examining Division with the order that oral proceedings under Article 116 EPC shall take place before the Examining Division decides whether to grant or refuse the present patent application.

3. Reimbursement of the appeal fee is ordered.

The Registrar:

J. Ruckerl

The Chairman:

P. Lançon