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Aktenzeichen / Case Number / N^o du recours : T 668/89

Anmeldenummer / Filing No / N^o de la demande : 85 900 919.3

Veröffentlichungs-Nr. / Publication No / N^o de la publication : 0 169 892

Bezeichnung der Erfindung: Phenolic Resin-Polyisocyanate Binder Systems
Title of invention: containing a phosphorus halide and use thereof
Titre de l'invention :

Klassifikation / Classification / Classement : C08G 18/54

ENTSCHEIDUNG / DECISION

vom / of / du 19 June 1990

Anmelder / Applicant / Demandeur : Ashland Oil, Inc.

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPU/EPC/CBE Article 113(1), Article 116(1), Rule 67

Schlagwort / Keyword / Mot clé : "Request of right to argue case orally not a mere request for an interview" -
"Desirability of Examining Division's seeking clarification of ambiguous requests" -
"Substantial procedural violation"

Leitsatz / Headnote / Sommaire



Case Number : T 668/89

DECISION
of the Technical Board of Appeal 3.3.3
of 19 June 1990

Appellant : Ashland Oil Inc.
5200 Paul G. Blazer, Memorial Parkway,
Dublin, Ohio 43017
U.S.A.

Representative : Hayward, Denis Edward Peter
Lloyd Wise, Tregear & Co.
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Decision under appeal : Decision of Examining Division 012
of the European Patent Office
dated 31 May 1989 refusing European
patent application No. 85 900 919.3
pursuant to Article 97(1) EPC

Composition of the Board :

Chairman : F. Antony
Members : J. Stephens-Ofner
C. Gérardin

Summary of Facts and Submissions

- I. International patent application PCT/US 85/00126 in the name of Ashland Oil Inc. was filed on 25.01.85 claiming priority from 30.01.84 (US-575 208). The international application was published on 01.08.85 under No. WO 85/03302.

On 23.09.85 the Applicant requested to proceed with the European phase of the international application, and this was done under No. 85 900 919.3.

- II. The Examining Division issued two communications pursuant to Article 96(2) EPC, the last one on 10.08.88, making various objections to the application, in substance on the grounds of lack of inventive step and lack of unity of invention.
- III. In his replies dated 14.06.88 and 30.03.89, the Applicant contended that all the objections raised by the Examining Division were unfounded. His reply dated 30.03.89 concluded with the following statement: "Reconsideration and allowance is respectfully requested and in the event that the Examiner still finds himself unable to allow the case, applicant's representative claims his right to appear and argue the case orally."
- IV. On 31.05.89 the Examining Division issued a formal decision rejecting the application under Article 97(1) EPC. In the reasons for the above decision (paragraph 1), it was stated as follows: "Issue of a decision is possible since the Applicant has had an opportunity to comment on the grounds on which the decision is based (Article 113 EPC). In the absence of a clear meaning the statement of

the Applicant in his last letter of 30.03.89, namely '... that he claims his right to appear and argue the case orally' is not considered as a request for oral proceedings under Article 116 EPC but as a request for an interview."

- V. On 31.07.89 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 02.10.89.

- VI. Apart from the substantive issues concerning the allowability of the European patent application, the subject of this appeal, the Appellant submitted that the issue of a formal decision without oral proceedings was a procedural irregularity, since it involved the denial of the applicant's right to oral proceedings. In support of the above submission, the Applicant argued that the Examining Division's interpretation of the Appellant's claim of his right to appear and argue the case orally "as a mere request for an interview" was clearly wrong, and further, that even if any doubt may have existed in the minds of the Examining Division as to the true nature of the above quoted statement, they should, on the principles set out in decision T 19/87 (unpublished), have sought clarification of it from the Applicant.
- VII. For the above reasons, the Appellant requests that his application be remitted to the Examining Division for oral proceedings, and that his appeal fee be reimbursed upon the grounds of the alleged procedural irregularity.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. The main question in this appeal is whether the sentence at the end of the Appellant's letter dated 30.03.89, that "Reconsideration and allowance is respectfully requested and in the event that the Examiner still finds himself unable to allow the case, Applicant's representative claims his right to appear and argue the case orally." constituted a request for oral proceedings for the purposes of Article 116 EPC, as distinct from a mere request for an interview, as the Examining Division had found.
3. 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 therefore leaves no room for discretion, so that if a request for oral proceedings has been made, such proceedings must always be appointed. By contrast, a request for an interview before the Examining Division does not impose any obligation upon the Examining Division to grant such a request, which may, therefore, be refused if the Examining Division considers that no useful purpose would be served by the interview (cf. Guidelines for Examination in the European Patent Office, paragraph C-VI, 6.1). If any reasonable doubt exists in the minds of the Examining Division as to the true nature of a request made to it by an Applicant, then, as was held in decision T 19/87, referred to by the Appellant, it is clearly desirable, as a matter of practice, that the Examining Division should seek clarification from the party concerned, because the right to an oral hearing provided by Article 116 EPC is an extremely important procedural

right, which the EPO should take all reasonable steps to safeguard.

4. In the present case, the operative part of the applicant's request as set out in his letter of 31.03.89 reads:-
"... Applicant's representative claims his right to appear and argue the case orally." Although a mere request for an appearance to argue matters orally could raise a degree of reasonable doubt as to the true nature of that request in relation to Article 116 EPC, and therefore require clarification (T 19/87), the expression of such a request in terms of claiming a right leaves absolutely no room for such doubt. It follows, that on any reasonable view the above claim should have been construed as a request for oral proceedings under Article 116 EPC.
5. In these circumstances, the issuing of a final decision by the Examining Division without first summoning the Appellant to oral proceedings was made in clear violation of Article 116(1) EPC. The decision under appeal is therefore void ab initio and has to be set aside. To this extent, accordingly, the appeal is allowable for the purposes of deciding the Appellant's request for reimbursement of the appeal fee under Rule 67 EPC.
6. As was stated above, the right to an oral hearing as provided for by Article 116 EPC is an extremely important right which the EPO should take all reasonable steps to safeguard. Violations of this right must, therefore, in principle, be considered as substantial violations within the meaning of Rule 67 EPC, unless the circumstances and reasons for the refusal to grant that right can be established to have been rooted in a mere error of judgement on the part of the relevant division of the EPO.

The failure in the present case of the Examining Division to hold oral proceedings was, in the Board's view, not merely such an error of judgement. The Board, therefore, finds that the said failure was a substantial procedural violation under Rule 67 EPC, justifying the request for reimbursement of the appeal fee.

Order

For these reasons, it is decided that:

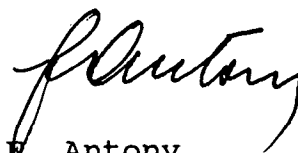
1. The decision under appeal is set aside.
2. The application is remitted to the Examining Division with the order that oral proceedings under Article 116 EPC shall take place to decide the allowability of the patent application in suit.
3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:



M. Beer



F. Antony