

Publication in the Official Journal Yes /

File Number: T 675/90 - 3.3.1
Application No.: 86 100 544.5
Publication No.: G 191 313
Title of invention: 6-Thioxanthine derivatives

Classification: C07D 473/22

DECISION
of 24 June 1992

Applicant: Euro-Celtique S.A.

Headword: Separate set of claims/EURO-CELLTIQUE

EPC Article 114(1) and Rules 51(6), 67 and 86(3)

Keyword: "Separate set of claims filed after issue of communication pursuant to Rule 51(6) EPC (rejected)"

Headnote

Headnote follows



Case Number : T 675/90 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 24 June 1992

Appellant : Euro-Celtique S.A.
122 Boulevard de la Petrusse
Luxemburg (LU)

Representative : Eisenführ, Speiser & Partner
Martinistrasse 24
W - 2800 Bremen 1 (DE)

Decision under appeal : Decision of Examining Division of the European
Patent Office dated 17 May 1990 refusing European
patent application No. 86 100 544.5 pursuant to
Article 97(1) EPC.

Composition of the Board :

Chairman : K.J.A. Jahn
Members : J.A. Stephens-Ofner
R.W. Andrews

Summary of Facts and Submissions

- I. This appeal, filed on 21 July 1990, contests the decision of the Examining Division of 17 May 1990 refusing application No. 86 100 544.5 (publication No. 0 191 313) by Euro-Celtique S.A. of Luxembourg.

- II. The Examining Division had issued a notice under Rule 51(4) EPC on 26 April 1989, to which the applicant had replied on 10 August 1989 agreeing to the proposed text on which the grant was to be based. Thereafter the Examining Division confirmed receipt of the applicant's agreement and, in the normal course issued a communication under Rule 51(6) EPC on 18 August 1989.

By letter dated 26 September 1989 the applicant submitted a new set of claims for Austria. The Examining Division regarded these as being unacceptable as having been filed too late: that is to say after issuance of the communication under Rule 51(6) EPC.

The Applicant then attempted to persuade the Examining Division, both in writing and by a number of telephone conversations, to accept the text with the inclusion of the new claims for Austria.

- III. As is stated in the Summary of Facts and Submissions of the contested decision, the applicant wrote to the Examining Division on 17 November 1989, making it clear that he wished to argue for the grant of the patent with the new Austrian claims by way of main request, or in the alternative, and by way of auxiliary request, for the grant of the patent based on the claims in their original form. The contested decision recites that on 27 March 1990 the applicant telephoned the Formalities Officer and made clear that he wished to proceed on these twin bases, and

more particularly, with his main request, in order to provoke a decision upon the allowability of the new claims that were filed after the Rule 51(6) EPC communication.

In its decision the Examining Division held that:

- (i) there was no requirement in the EPC that amendments after a communication under Rule 51(6) EPC should be admissible;
- (ii) that the discretion conferred upon the Examining Division by Rule 86(3) EPC "should not be applied" after the Rule 51(6) stage;

Accordingly, the Examining Division held that there was no agreed text on the basis of which a patent could be granted in accordance with Article 97(2) EPC, and in consequence rejected the application, pursuant to Article 97(1) EPC.

- IV. The Appellant has submitted two requests: the main one for the grant of the patent on the basis of the new set of Austrian claims as filed by him on 26 September 1989, and the auxiliary request for the grant of a patent in the form originally agreed by him in reply to the communication under Rule 51(4) EPC. The Appellant also contends that the contested decision was based on a substantial procedural violation, justifying a refund of the appeal fee (Article 104 and Rule 67 EPC).

Reasons for the Decision

1. The appeal is admissible.

2. The first issue that falls to be decided is the allowability of the main request. This in turn hinges on whether or not the discretion under Rule 86(3) to allow amendments, extends to amendments proposed after the Rule 51(6) stage. Although the contested decision did not pose and answer the question in quite such a clear manner, formulating its finding as follows: "the Examining Division is however of the opinion that the discretion allowed it by Rule 86(3) should not be applied after the Office has acknowledged the applicant's agreement to the text proposed in the communication under Rule 51(6)", the Board is satisfied that the Examining Division did in fact have the existence of the discretion in mind, rather than the mere question of whether it should or should not be applied after the Rule 51(6) EPC stage.

3. The Appellant submits that if amendments of the type here at issue are allowable even at, or just after, the Rule 51(4) stage, thereby giving rise to a delay in the granting procedure, then such amendments proposed still later, namely after the Rule 51(6) communication has been issued, should also be allowable for the reason that: "it is not notable that this delay is any different after the issuance of the communication under Rule 51(6) EPC". (See page 8, para. 2 of the Statement of Grounds of Appeal). The Appellant also submits that the entire basis of the European Patent Office's existence is its function to grant patents on inventions, i.e. to give to an applicant what he is legally entitled to have, in exchange for the publication of his invention. Procedural requirements, he goes on to submit, are therefore subordinate to this "raison d'être" of the European Patent Office (page 9 of the Statement of Grounds of Appeal, first paragraph). In other words, since the EPO's function is to grant patents, procedural delays should either be generally disregarded and, in particular, if amendments filed very late i.e. at

or after the Rule 51(4) stage are still allowable, then amendments filed even later, i.e. after the Rule 51(6) stage, should likewise be allowable.

4. The Board finds little sympathy with this line of reasoning. Although it is true that a vital function of the European Patent Office is indeed to grant patents, it, as well as the Boards of Appeal, are also directly and indirectly enjoined by Articles 97, 111(1) and 114(1) EPC, to have full regard to the interests of the general public by ensuring that granted patents do comply with the relevant provisions of the EPC.

5. It is therefore clear that the Examining Division, as well as the Boards of Appeal must have due regard to the general public interest in the sense of ensuring that invalid patents are not granted, and also that the public knows, and knows in good time, (i.e. after publication of the grant) what commercial activities the patent will stop or hinder them from pursuing. In the Board's view the procedure provided for in Rule 51(1-4) EPC is designed to ensure in a speedy manner that patent applications and any patents granted upon them do comply with the relevant provisions of the Convention. After a communication under this part of the Rule and any amendment proposed in reply to it, Rule 86(3) however, still allows the Examining Division discretion, which has to be judicially exercised, to consider one more proposal for amendments. Throughout this entire stage of the examining procedure, the EPO's aim is to balance the need for speedy grant against the commercial damage that would be inflicted upon the public by the existence of invalid patents, and it is this balance that forms the basis of the discretion conferred upon the Examining Division under Rule 86(3). The balance that the Appellant alleges to exist between the EPO's administrative convenience on the one hand, and an

applicant's interest in obtaining a speedy grant, is therefore not the proper basis for the exercise of the Office's discretion under Rule 86(3). In this respect the Appellant's submission (page 8, last paragraph of the Statement of Grounds of Appeal), that his interest is obviously more important than the Office's own administrative convenience, is therefore wholly irrelevant to the main issue in this appeal.

6. In the Board's judgment, the function of the communication sent out under Rule 51(6) EPC is to draw the amendment procedure at the examination stage to a firm and final conclusion, so as to enable the public to obtain knowledge of the scope of legally prohibited activities as soon as possible i.e. upon the publication of the grant of the patent. Accordingly, the Board finds as a matter of law that discretion under Rule 86(3) EPC to consider amendments does not extend to amendments proposed after the Rule 51(6) EPC stage. Nor can the Board accept the Appellant's argument that procedural delays should always be subordinated to the EPO's function, which he alleges to be its sole or main function ("raison d'être"), to grant patents. The Board also disagrees with the narrower proposition espoused by the Appellant, namely that if delays in proposing amendments up to and after the Rule 51(4) stage are allowable (cf. T 166/86 OJ EPO 1987, 372), then they should also be allowable after the later, Rule 51(6) stage of the examination procedure.
7. The Board, has, of its own motion (Article 114(1) EPC), also considered the possible relevance of an unpleaded ground, namely the correction of errors under Rule 88 EPC, but finds that in the present case neither the mistake, nor its correction, could by any stretch of the imagination be regarded as obvious.

Accordingly, the Board finds that the Examining Division was right in disallowing the applicant's main request.

8. The question still remains whether they were also right in holding that this finding automatically led to the refusal of the application under Article 97(1) EPC, on the ground that there was no agreed text under Article 97(2) EPC. The answer to this question clearly depends on whether or not the applicant's auxiliary request for a grant in the text originally approved by his letter of 9 August 1989, in response to Rule 51(4) EPC communication, that is to say without the separate claims for Austria, had ever been abandoned. If it had not, then it would clearly have been incumbent upon the Examining Division to consider the allowability of the application for patent grant on that basis, and if it was minded to refuse it, to give good and valid reasons for doing so.

Having examined the documents on file, and considered the Appellant's submissions in this respect, the Board finds that the auxiliary request had not, at any relevant stage, been abandoned. Since the allowability of that auxiliary request is clearly beyond dispute, the Board has no alternative but to allow the appeal insofar as it based on that request.

9. Turning to the last and consequential issue of the refund of the appeal fee, the above finding that the auxiliary request had not been withdrawn means that the Examining Division had either disregarded or overlooked it. In the Board's view however, this omission of a clearly allowable request does not amount to a procedural violation substantial enough within the terms of Rule 67 EPC to warrant a refund of the appeal fee.

Order

For these reasons, it is decided that:

1. The Examining Division's decision is set aside.
2. The main request is refused.
3. The case is remitted to the Examining Division with the order to grant the patent on the basis of the text communicated to the Applicant (Rule 51(4) EPC) on 26 April 1989 and subsequently approved by him (auxiliary request).
4. The request for the refund of the appeal fee is refused.

The Registrar:


E. Gorgaier

The Chairman:


H.J.A. Jahn