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File No.: T 0860/91 - 3.3.1
Application No.: 87 103 332.0
Publication No.: 0 237 007
Classification: CO7C 69/76
Title of invention: Fluoroalkane derivative and liquid crystal composition

DECISION
of 3 August 1993

Applicant: CANON KABUSHIKI KAISHA

Proprietor of the patent:

Opponent:

Headword:

EPC: Art. 167(2), Art. 113(2), Art. 114(1), Art. 97(1) and(2)
Rules 51(4), (5) and (6)
Rule 86(3)

Keyword: Discretion after Rule 51(6) EPC (No)

Decisions T 675/90; T182/88; T 166/86
J11/91/J16/91; G7, 9 and 10/91

Headnote
Catchwords



Case Number: T 0860/91 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 3 August 1993

Appellant: CANON KABUSHIKI KAISHA
30-2, 3-chome, Shimomaruko,
Ohta-ku
Tokyo (JP)

Representative: Bühling, Gerhard, Dipl.-Chem.
Patentanwaltsbüro,
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Decision under appeal: Decision of the Examining Division of the
European Patent Office dated 28 June 1991 refusing
European patent application No. 87 103 332.0
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: K.J.A. Jahn
Members: J.A. Stephens-Ofner
P.K.H. Krasa

Summary of Facts and Submissions

- I. This appeal contests the decision of the Examining Division of 28 June 1991 refusing European patent application No. 87 103 332.0 /2104 (publication No. 0 237 007), filed by Canon Kabushiki Kaisha of Tokyo, Japan.
- II. The Examining Division had issued a communication under Rule 51(4) EPC on 9 July 1990, to which the Applicant had replied on 9 November 1990, signifying his approval of the text intended to serve as the basis for the grant of the patent. Thereafter the Examining Division confirmed the receipt of the Applicant's agreement, and in the normal course, issued a communication under Rule 51(6) EPC on 26 November 1990.

On 26 February 1991, the Applicant sought to amend his application by the inclusion of a new set of claims for Spain, which State has made a reservation under Article 167(2)(a) EPC.

- III. On 28 June 1991, after having announced the imminent refusal of the application on 19 March 1991, the Examining Division refused the application in its entirety pursuant to Article 97(1) in conjunction with Article 97(2) EPC, on the basis that the request for amendment by the inclusion of a fresh set of claims for Spain made by the Applicant on 26 February 1991 had been filed too late, that is to say after the issuance of the communication under Rule 51(6) EPC. The decision was signed by a Formalities Officer acting under Rule 51(5) EPC, first sentence. The decision, which was brief in the extreme, was given on a proforma EPO document, with three lengthy appendices which were said to constitute the Reasons for the Decision. These

appendices comprised a notice from the Vice President of DG2 dated 20 September 1988, concerning the treatment of requests for amendments to application document following the dispatch of the communication pursuant to Rule 51(4), as well as certain amendments to the "Guidelines for Examination in the European Patent Office", dated 31 July 1989 and, finally, notice from the EPO dated 14 July 1989, concerning the application of Rule 58(4) EPC in opposition proceedings.

IV. The notice of appeal of 23 August 1991 contained two requests, the first (main) for the grant of the patent on the basis of the amendments sought on 26 February 1991, that is to say with the Spanish claims, the second (auxiliary), for the grant of the patent on the basis of the claims as originally approved by the Applicant after the receipt of the communication under Rule 51(4) EPC, that is to say without the Spanish claims. Finally, and irrespective of the fate of either of the above requests, the Appellant (Applicant) asked for oral proceedings, which duly took place on 3 August 1993.

V. In his Statement of Grounds of Appeal filed on 5 September 1991, the Appellant submitted four distinct strands of legal argument. However, during oral proceedings, he expressly abandoned all but one of these, which was that amendments in general, and the ones here at issue in particular, were always matters of discretion under Rule 86(3) EPC even after the issuance of the Rule 51(6) communication and, further, that such discretion needed to be exercised judicially by maintaining a balance between the EPO's interest in streamlined proceedings (leading to swift publication) on the one hand, and the frequently conflicting interests of Applicants to obtain a proper, that is to say the widest possible patent monopoly in all the Contracting States of their choice on the other hand.

In addition to the above legal submission, the Appellant also submitted a fresh objection, namely that the decision of the Examination Division was void *ab initio*, because it had not been adequately reasoned. Under this heading he argued that the three appendices to the brief and jejune proforma decision did not provide any, let alone any adequate, reasons such as were mandatory for all decisions given by all organs of the EPO.

VI. Lastly, he requested that a number of questions be referred to the Enlarged Board of Appeal pursuant to Article 112(1) EPC. These questions were, in essence, directed to the existence and therefore to the due exercise of the discretion according to Rule 86(3) EPC after the issuance of a communication under Rule 51(6) EPC, and relied on an alleged conflict between decisions T 166/86 (cf. OJ EPO 1987, 372) and T 182/88 (cf. OJ EPO 1990, 287) on the one hand, and a recent decision by this Board in case T 675/90 (cf. Headnote published in OJ EPO 12/1992) on the other hand. A further and related question was whether or not the changes in Rule 51 EPC that came into effect on 5 June 1987 had an important bearing, or any bearing at all, on the existence of the alleged conflict between the above three decisions. A final related question concerned the extent and substantiality of the changes made on the above date to Rule 51 EPC.

Reasons for the Decision

1. The appeal is admissible.
2. The first issue to be decided is whether the Formalities Officer had the power to issue the decision under

appeal, and the related issue of whether the decision was adequately reasoned.

The task of issuing decisions of the kind here under appeal had been validly delegated to the Formalities Officers by the Vice President of DG2: see notices of 15 June 1984 (OJ EPO, 1984, 317 and 319) as revised and supplemented by a notice of 1 February 1989 (OJ EPO 1987, 178).

The decision under appeal, which was short in the extreme, gave as its reason that "the Applicant had already given his binding approval to the text intended to serve as the basis for the grant."

This reason, short though it be, is in the Board's judgment adequate in the circumstances of this case.

3. The next issue that falls to be decided is the allowability of the main request. This in turn hinges upon the existence of the discretion under Rule 86(3) EPC after the issuance of the Rule 51(6) EPC communication, for clearly if no discretion exists then the question of its exercise becomes irrelevant. At the outset of the oral proceedings the Board indicated its preliminary intention to follow its earlier decision in case T 675/90 (Headnote published in OJ EPO 12/1992), in which it held that such discretion no longer existed after the issuance of a communication under the above rule. After having been given an opportunity to study the text of this decision (during an adjournment), the Appellant submitted that the above decision was wrong in law and relied, in particular, on two earlier cases namely T 166/86 (cf. OJ EPO 1987, 372) and T 182/88 (cf. OJ EPO 1990, 287), both of which concerned the nature and manner of the exercise of the discretion that Rule 86(3) EPC provided after the issue of a

communication under Rule 51(4) EPC in the form it stood promulgated before the amendment of Rule 51 as a whole on 5 June 1987, (coming into force on the 1 September 1987). The earlier of the above decisions was clearly based on the unamended Rules, and whilst decision T 182/88 was given after their amendment, the facts upon which it relied preceded that date, and was therefore clearly also based on the unamended Rule. Nevertheless, the Appellant argued that the amendments of the Rule amounted to no more than a mere elaboration and, in particular, that old Rule 51(4) contained all the elements of new Rule 51(4) in conjunction with Rule 51(6) with the consequence that as matter of law there was no difference of substance at all between the two sets of Rules.

4. The old Rules 51(4) and 51(5) read as follows:

"(4)" 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 shall request him to pay within three months the fees for grant and printing and to file a translation of the claims in the two official languages of the European Patent Office other than the language of the proceedings or, where the latter has been changed, other than the initial language of the proceedings. If the applicant has communicated his disapproval of the patent being granted on the basis of this text within that period, the communication of the Examining Division shall be deemed not to have been made, and the examination shall be resumed.

(5) The communication of the Examining Division under paragraph 4 shall indicate the designated

contracting States which require a translation pursuant to Article 65, paragraph 1.

- * Amended by decision of the Administrative Council of 20 October 1977 which entered into force on 1 February 1978 (OJ 1978, page 12 et seq.)"

There was, at that time, no Rule that corresponded to new Rule 51(6).

The Rules amended by the Decision of the Administrative Council of 5 June 1987 and under which this appeal has to be decided read as follows:

Rule 51(4): "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 shall request him to indicate, within a period to be set by it which may not be less than two months or more than four months, his approval of the text notified. The period shall be extended once by a maximum of two months provided the applicant so requests before it expires."

Rule 51(5): "If the applicant fails to communicate his approval within the period according to paragraph 4, the European patent application shall be refused. If within this period the applicant proposes amendments to the claims, description or drawings to which the Examining Division does not consent under Rule 86, paragraph 3, the Examining Division shall, before taking a decision, request the applicant to submit his observations within a period it shall specify and shall state its reasons for so doing."

Rule 51(6): "If it is established that the applicant approves the texts in which the Examining Division, taking account of any proposed amendments (Rule 86,

paragraph 3), intends to grant the European patent, it shall invite him to pay, within a non-extendable period to be set by it which may not be less than two months or more than three months, the fees for grant and printing and shall also invite him to file within the same period a translation of the claims in the two official languages of the European Patent Office other than the language of proceedings or where the latter has been changed, other than the initial language of the proceedings."

5. It is clear to the Board that whilst there may well be a number of shared legal elements and requirements between the two sets of sub-rules, this doesn't mean that the Rules governing the Applicant's freedom to amend his application have, for all practical purposes, remained similar or even identical. In other words the mere presence of certain common components or "bricks" does not mean that the legal concept or "house" that they constitute had not changed. On the contrary, it is the Board's position that the earlier tacit approval of the Applicant of the text in which the patent was intended to be granted had been superseded by a clear requirement for his express approval. Failure to give such approval will lead to the refusal of the application under Rule 51(5) (new version) which, significantly, also gives the Applicant a final opportunity, in case he did not so consent, to propose amendments, the allowability of which will fall to be decided under the discretion conferred upon the Examining Division by Rule 86(3) EPC. Once such express approval had been established (see first sentence Rule 51(6) EPC), the issuance of a communication under the above sub-rule sets in train a sequence of automatic and merely administrative steps, which will guarantee the earliest possible publication of the patent application, in line with the EPO's declared policy of streamlining proceedings, and, also

in conformity with the interest of the general public to know, at the earliest possible moment, the likely scope of activities which may be legally prohibited by a European patent. The wording of Rule 51(6) EPC, in referring to the discretion under Rule 86(3) EPC, clearly refers to that discretion as existing only at the Rule 51(5) stage - and not thereafter. Indeed, Rule 51(6) does not either expressly or by implication admit of any refusal to grant at any stage subsequent to a communication issued under it, and for this additional reason, there can be no question at all of the existence, let alone the exercise, of any discretion under Rule 86(3) after this stage.

It is therefore clear that the old Rules governing amendments have not only been elaborated but completely changed by placing the burden of express approval of the text squarely upon the shoulders of the Applicant at the Rule 51(4) stage and no later.

6. As was stated in the earlier decision of this Board in case T 675/90 (paragraph 6 of the reasons), the function of the communication sent out under Rule 51(6) EPC is to draw the amendment procedure of the examination stage to a firm and final conclusion, so as to enable the public to ascertain the scope of legally prohibited activities as soon as possible, that is to say upon the publication of the grant of the patent. Accordingly, the Board found (in that case) as a matter of law, that the discretion conferred by Rule 86(3) EPC did not extend to amendments proposed after the Rule 51 (sixth stage).

The Appellants admission that the decisions of other Boards in cases T 182/88 and T 166/86 were in clear conflict with the above earlier finding of this Board, is entirely sound in fact but not in law, since, as has been explained above, these cases applied the law as it

stood promulgated under unamended Rule 51 EPC which law, as this Board now finds, has been changed to such an extent as to render any argument based on an analogy between the effect of the two sets of requirements, and consequently of the relevance here of the above cited two cases, wholly untenable.

7. The Appellant also referred to cases J 11/91 (cf. OJ EPO 1993 1-2) and J 16/91 (cf. OJ EPO 1993 1-2) in support of his submission that even up to the very point of the grant of the patent it was possible to ask for, and therefore to obtain amendments. The Board wishes to observe that both cases were concerned only with divisional applications under Rule 25 EPC in conjunction with their allowability under Rule 51(4) EPC. Any observations made in these two decisions as to the allowability of the amendments proposed after the Rule 51(6) stage were clearly *obiter*, and even if they were not, in this Board's view they are wholly misconceived for, interpreted literally they would permit amendments to be made, for example, one day before the proposed publication date.
8. For all the above reasons, the Board sees no reason to depart from the *ratio decidendi* of its earlier decision in case T 675/90, and accordingly again holds that the discretion to allow amendments under Rule 86(3) no longer exists after the issuance of a Rule 51(6) communication. In consequence, the Examining Division's decision refusing the application under Rule 51(5) was correct on its merits with the consequence that the Appellant's main request is refused.
9. The last question that falls to be decided is the Appellant's request for a reference to the Enlarged Board under Article 112(1) EPC, the relevant part of which reads as follows:

"... the Board of Appeal shall, during the proceedings on a case and either of its own motion or following a request from a party to the appeal, refer any question to the Enlarged Board of Appeal if it considers that a decision is required for the above purposes. If the Board of Appeal rejects the request it shall give reasons in its final decision;"

It is thus clear that a reference to the Enlarged Board is a matter of discretion for a Board, and whilst it is clear that the point of law that had been argued in this case is an important one, it is equally evident that on the proper interpretation of the old and new set of the sub-rules governing amendments, for the reasons already stated, that point or question of law can be answered, as had been done by this Board in case T 675/90, and, accordingly, a decision on this point by the Enlarged Board is not required.

The conflict between the two decisions relied upon by the Appellant and the above decision is, in the Board's view, irrelevant for the reasons already stated.

For all the above reasons, the Appellant's request for referral to the Enlarged Board is rejected.

10. The Appellant's auxiliary request for the grant of the patent without the claims for Spain is clearly allowable.

Order

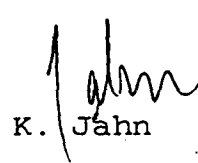
For these reasons, it is decided that:

1. The decision under appeal set aside.
2. The case is remitted to the Examining Division with the order to grant the patent on the basis of the auxiliary request.
3. The request for a reference to the Enlarged Board of Appeal is rejected.

The Registrar:


E. Gorgmaier

The Chairman:


K. Jahn