

**Internal distribution code:**

- (A) [ ] Publication in OJ  
(B) [ ] To Chairmen and Members  
(C) [X] To Chairmen

**D E C I S I O N**  
of 26 January 1995

**Case Number:** T 0808/94 - 3.4.2  
**Application Number:** 89109749.5  
**Publication Number:** 0386305  
**IPC:** H01M 4/00, H01M 4/38, H01M 10/34  
**Language of the proceedings:** EN

**Title of invention:**  
Alkaline storage battery and method of producing negative  
electrode thereof

**Applicant:**  
MATSUSHITA ELECTRIC INDUSTRIAL CO., LTD.

**Opponent:**  
-

**Headword:**  
Oral proceedings/MATSUSHITA

**Relevant legal provisions:**  
EPC Art. 109, 116(1)  
EPC R. 67

**Keyword:**  
"Decision to refuse issued without requested oral proceedings -  
substantial procedural violation (yes)"  
"Remittal to first instance without regard to the merits of the  
case (yes)"  
"Reimbursement of appeal fee (yes)"

**Decisions cited:**  
T 0019/87, T 0686/92, T 0647/93

**Catchword:**  
-



Case Number: T 0808/94 - 3.4.2

**D E C I S I O N**  
of the Technical Board of Appeal 3.4.2  
of 26 January 1995

**Appellant:** MATSUSHITA ELECTRIC INDUSTRIAL CO., LTD.  
1006, Oaza Kadoma  
Kadoma-shi  
Osaka-fu, 571 (JP)

**Representative:** Patentanwälte  
Leinweber & Zimmermann  
Rosental 7/II Aufg.  
D-80331 München (DE)

**Decision under appeal:** Decision of the Examining Division of the European  
Patent Office dated 21 April 1994 refusing  
European patent application No. 89 109 749.5  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** E. Turrini  
**Members:** R. Zottmann  
B. J. Schachenmann

**Summary of Facts and Submissions**

I. European patent application No. 89 109 749.5 (published as EP-A-0 386 305) was refused by decision dated 21 April 1994 of the Examining Division, because, in particular, the subject-matter defined in the independent claims was considered not novel.

II. At the beginning of the examination proceedings, the Examining Division issued a communication pursuant to Article 96(2) EPC in which the Appellant was invited to rectify deficiencies and to file his observations in reply. A letter of reply filed by the Appellant on 30 April 1992 contained such observations and a new Claim 1 and ended with a request to fix an interview in case that the Examining Division should not accept patentability of the invention. Thereafter, a consultation by telephone between a Representative of the Appellant and the Primary Examiner took place on 25 May 1992. The minutes forwarded to the Appellant indicated that an interview could informally take place in The Hague, that otherwise formal oral proceedings could be summoned in Munich and that the Appellant would provide an answer to this question. The Appellant's letter of reply filed on 16 November 1992 contained observations and amended application documents and ended with the following statement:

"In case that the Examining Division should not be prepared to grant the applied for patent on the basis of the documents on file now, even under consideration of the above argument, it is requested to conduct

**formal oral proceedings**

at the EPO in Munich."

Then, in a further consultation by telephone between a Representative of the Appellant and the Primary Examiner which took place on 29 January 1993, it was agreed to discuss the case during an interview. A Representative of the Appellant and the Primary Examiner were the participants of said interview (called "personal consultation") which took place on 26 March 1993. In reply to the observations submitted with the minutes of said interview, the Appellant filed a letter on 20 December 1993 containing observations of reply and a set of amended claims. Neither the minutes of said interview nor the letter of reply of the Appellant dealt with the requested formal oral proceedings.

- III. In its decision to refuse the application the Examining Division stated with regard to the first consultation by telephone on 25 May 1992 (in I.5): "The applicant was given the opportunity to formally request Oral Proceedings under Article 116." Moreover, the second consultation by telephone and the interview were mentioned (in I.7. and 8.). However, nothing was said with regard to the Appellant's request for formal oral proceedings. Instead, paragraph (II.1.) headed "Right to be heard (Article 113(2))", the Examining Division stated: "No Oral Proceedings under Article 116(2) are pending.".
- IV. The Appellant lodged an appeal against this decision.
- V. The Appellant requested that the decision be set aside, that a patent be granted on the basis of enclosed new claims, that, auxiliarily, oral proceedings take place and that the appeal fee be refunded.
- VI. As to the latter request, the Appellant put forward the following arguments: An auxiliary request for formal oral proceedings had been submitted and never been

withdrawn. Nevertheless, the Examining Division refused the application without conducting said oral proceedings. Due to the violation of Article 116 EPC, the proceedings suffer from a substantial procedural violation according to Rule 67 EPC.

### Reasons for the Decision

1. The appeal is admissible.
2. No withdrawal or modification of the request for formal oral proceedings submitted with the letter dated 16 November 1992 can be found in the file. Moreover, the notifications of the Examining Division during the period between said request and the appealed decision did not contain any statement dealing with said request.  
  
The Examining Division, in the appealed decision, stated that no oral proceedings under Article 116(2) EPC were pending. However, paragraph 2 of said Article refers to oral proceedings before the **Receiving Section** rather than before the Examining Division. If it is assumed that the Examining Division intended to refer to a pending **request** for oral proceedings before the **Examining Division** (according to Article 116 EPC, paragraphs 1 and 3), said statement would be contradictory to the facts.
3. By "formal oral proceedings", as requested by the Appellant in case of a decision adverse to him, unambiguously oral proceedings within the meaning of Article 116 EPC were meant. This was, apparently, also the opinion of the Examining Division, since it clearly distinguished between an informal interview and formal oral proceedings, see point II. Informal interviews

(also called "personal consultation") and/or informal consultations by telephone which are carried out by the Primary Examiner alone cannot replace duly requested oral proceedings under Article 116 EPC, which shall take place before all members of the Examining Division (Article 18(2) EPC), see also Guidelines E III 1. and 2.

4. In the Board's view, the right to oral proceedings under Article 116 EPC is a very important procedural right which the EPO must take all reasonable steps to safeguard (cf. T 0019/87, OJ EPO 1988, 268). In the circumstances of the present case there was a clear request for oral proceedings under Article 116(1) EPC which was never withdrawn by the Appellant. The Examining Division thus had no power to issue its decision without first summoning the Appellant to oral proceedings. The case, therefore, has to be remitted to the Examining Division in order that oral proceedings should take place prior to deciding on the application.
5. The Examining Division ignored a clear request for oral proceedings by the Applicant which, in the Board's view, amounts to a substantial procedural violation (cf. T 0686/92, para. 4). Such substantial procedural violation also occurred as the Examining Division did not make use of the possibility of granting interlocutory revision under Article 109 EPC, after the mistake had been pointed out in the grounds of appeal (see decision T 0647/93, to be published).
6. Since the case has therefore to be remitted to the Examining Division for further prosecution the Appellant's request to grant a patent has not to be decided at this stage of the proceedings (see decision T 0019/87, OJ EPO 1988, 268, headnote I. and paragraph 3).

The Examining Division will have to undertake further prosecution on the basis of the claims filed with the grounds of appeal. Said prosecution consists in this case inter alia of the appointment of oral proceedings under Article 116 EPC (unless the Appellant withdraws his request for such proceedings) and in due course of taking of a new decision.

7. The Board deems it equitable to order reimbursement of the appeal fee by reason of the substantial procedural violation referred to above and by reason of the allowability of the appeal (Rule 67 EPC).
  
8. The auxiliary request of the Appellant for oral proceedings before the Board of Appeal is meaningless, since the case is remitted to the first instance for further prosecution. It remains the possibility of an appeal against the (new) decision to be taken by the first instance including the right to oral proceedings before the Board.

### **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 for further prosecution.
  
3. Reimbursement of the appeal fee is ordered.

The Registrar:

P. Martorana

The Chairman:

E. Turrini

