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D E C I S I O N
of 3 February 1998

Case Number: T 0121/95 - 3.4.1

Application Number: 90915796.8

Publication Number: 0552145

IPC: G09B 9/00

Language of the proceedings: EN

Title of invention:
Training method and articles therefor

Applicant:
Ward, David, Robert

Opponent:
-

Headword:
Training method and articles therefor/WARD, DAVID

Relevant legal provisions:
EPC Art. 113(1), 113(2)
EPC R. 67

Keyword:
"Auxiliary request - right to be heard before the issue of an
adverse decision - yes"
"Procedural violation - yes"
"Refund of appeal fee - no"

Decisions cited:
G 0004/92, J 0020/85, J 0003/90, T 0951/92, T 0234/86

Catchword:
-



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Boards of Appeal

Chambres de recours

Case Number: T 0121/95 - 3.4.1

D E C I S I O N
of the Technical Board of Appeal 3.4.1
of 3 February 1998

Appellant: Ward, David, Robert
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Representative: Eder, Ephry
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Decision under appeal: Decision of the Examining Division of the
European Patent Office dated 5 October 1994
refusing European patent application
No. 90 915 796.8 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: G. Davies
Members: R. K. Shukla
U. G. O. Himmeler

Summary of Facts and Submissions

- I. European patent application No. 90 915 796.8 relating to a training method and articles therefor was refused in a decision of the Examining Division, dated 5 October 1994.

During the proceedings before the Examining Division, the applicant, in response to a communication from the Examining Division, filed on 30 May 1994 claims 1 to 15, claim 15 having the following wording :

Claim 15:

"Material intended specifically for use in a training method according to any one of claims 1 to 10, or intended specifically for use as the chemical material of a self-contained movable supply that is to form part of a combination according to any one of claims 11 to 14, the said material providing a gaseous emission comprising ethylene, or butane, or a chlorinated or fluorinated hydrocarbon, e.g. chloroform."

In a further communication dated 27 June 1994, the Examining Division informed the applicant that, whereas claims 1 to 14 were considered to be allowable, the subject-matter of claim 15 was not new within the meaning of Article 54(1) and (2) EPC, since the wording "intended specifically for use..." was not a technical feature and did not therefore limit the claimed subject-matter.

In its response dated 30 June 1994, the applicant maintained claim 15 unamended and made submissions in support of the patentability of claim 15.

In a telephone consultation, which took place 16 August 1994, with the representative of the applicant, the Examining Division reiterated its objection to claim 15. As can be seen from the minutes of the consultation, an amended wording for claim 15 was proposed by the applicant, and it was apparently agreed that the amended claim 15 should form the basis of an auxiliary request, whereas claims 1 to 15 filed earlier with the letter dated 30 May 1994 formed the basis of the main request, and that a decision be taken on the basis of these main and auxiliary requests.

The above result of the consultation was subsequently confirmed in a communication from the Examining Division dated 23 August 1994.

Claim 15 of the auxiliary request contains the following amendments in relation to claim 15 of the main request:

"Material *when sold* for use ... (the remaining wording as in claim 15 of the main request).

- II. The Examining Division refused the application on the ground that claim 15 of each of the main and the auxiliary requests is not new in the sense of Article 54(1) and (2) EPC.
- III. The applicant lodged an appeal against the above decision, paid the appeal fee and filed the statement of the grounds of appeal all on 5 December 1994. In the statement of grounds, the applicant, while accepting the finding of the Examining Division in respect of claim 15 according to the main request, contested the finding that claim 15 according to the auxiliary request is not new, and requested that the decision be cancelled in respect of the auxiliary request.

In the statement of grounds, the applicant requested that the appeal fee should be refunded, since the issue of the decision had been peremptory and without sufficient warning, and since the Examining Division did not provide any reasoned arguments such as those set out in paragraphs 7 to 9 of the decision to counter the arguments and prior decisions previously cited by the applicant.

The applicant also submitted first further and second further auxiliary requests with the statement of grounds, based respectively on revised claims 15. Claim 15 of the second further auxiliary request contains the wording which the Examining Division considered to be patentable in its decision (see paragraph 10.1 of the decision).

IV. The Board, after having examined the appeal only in connection with the applicant's request in the statement of the grounds of appeal for refund of the appeal fee having regard to an alleged substantial procedural violation, informed the applicant's representative that the Board intended to set aside the decision under appeal because the decision had been issued in contravention of the requirement of Article 113(1) EPC, and asked him to indicate whether he wished the application to be further prosecuted before the Examining Division or before the Board.

V. In its reply, dated 24 February 1997, the applicant requested that the Board proceed with the consideration of the allowability of:

- claim 15 filed on 30 May 1994 (main request)
- the auxiliary request of 16 August 1994

- the first further auxiliary request of paragraph 8 of the statement of grounds filed on 5 December 1994
- the second further auxiliary request of paragraph 9 of the statement of grounds filed on 5 December 1994.

The request for the refund of the appeal fee having regard to the alleged substantial procedural violation was reiterated by the applicant.

VI. Following the examination of the above requests, the Board informed the applicant that claims 15 of the main request, auxiliary request and first further auxiliary request, respectively, were not allowable, and that the patentability of claim 15 of the second further auxiliary request was not at issue in the present appeal, since according to the decision under appeal, this claim was patentable. With regard to the reimbursement of the appeal fee, the Board stated that pursuant to Rule 67 EPC, the reimbursement has to be ordered where inter alia the Board deems an appeal to be allowable, and that in the event that the main and auxiliary requests forming the basis of the decision under appeal were not allowed, then the appeal would not be deemed to have been allowed, and consequently, the appeal fee would not be refunded.

VII. In a reply dated 10 July 1997 to the above communication, the applicant requested that the application be allowed to proceed to grant in accordance with the second further auxiliary request, namely with:

Description: pages 1, 4 to 11 as originally filed
pages 2, 3, and 3a as filed with the
letter dated 30 May 1994

Claims: claims 1 to 13 as filed with the letter dated 30 May 1994
claims 14 and 15 filed with the letter dated 10 July 1997

Drawings: Sheet 1/1 as originally filed.

Claims 14 and 15 filed with the letter dated 10 July 1997 correspond respectively to claim 14 filed with the letter dated 30 May 1994, and claim 15 as set out in paragraph 9 of the statement of grounds of appeal.

With regard to the Board's observations in respect of the refund of the appeal fee, it was submitted by the applicant that the underlying principle of Rule 67 EPC is that "reimbursement is equitable by reason of a substantial procedural violation", and that, since the Board accepted that a substantial procedural violation had occurred, it would be unconscionable, unjust and wholly inequitable if the appeal fee were not now to be refunded.

VIII. Claim 15 filed with the letter dated 10 July 1997 has the following wording :

"Use of a material in a training method according to any one of claims 1 to 10, or as the chemical material of a self-contained movable supply that is to form part of a combination according to any one of claims 11 to 14, the said material providing a gaseous emission comprising ethylene, or butane, or a chlorinated or fluorinated hydrocarbon, e.g. chloroform."

Reasons for the Decision

1. The appeal is admissible.
2. Claim 15 filed with the letter dated 10 July 1997 has the same wording as the one considered to be patentable by the Examining Division in paragraph 10.1 of the decision under appeal. Thus, the patentability of the claims 1 to 15 as identified above in paragraph VII is not an issue in the present appeal, so that the application with these claims can proceed to grant.

The only issue to be decided in the present appeal is, therefore, that of refund of the appeal fee having regard to an alleged substantial procedural violation.

Procedural violation

- 3.1 Article 113(1) EPC states that the decisions of the European Patent Office "may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments." This provision of Article 113(1) EPC has been recognised in a number of previous decisions of boards of appeal as being of fundamental importance for ensuring a fair procedure between the EPO and parties conducting proceedings before it (see in particular G 4/92, OJ EPO 1994, 149; J 20/85, OJ EPO 1987; J 3/90, OJ EPO 1991, 550) and reflects the generally recognised principle of procedural law that a party to proceedings has a "right to be heard" before an adverse decision is issued.

Also, according to decision T 951/92, OJ EPO 1996, 53, in the context of examination procedure, the word "ground" in Article 113(1) does not refer merely to a

ground of objection in the narrow sense of a requirement of the EPC, but should be interpreted as referring to the essential reasoning, both legal and factual, which leads to the refusal of the application (emphasis added).

It is the established case law of the boards of appeal that, in proceedings before an opposition division, the patentee is entitled to an appealable decision in respect of all the unallowable requests before a decision to grant a patent on the basis of a lower-ranking allowable request is taken. Such a practice ensures that the patentee is not deprived of a decision by the appeal board on any of the requests considered to be unallowable by the opposition division (see T 234/86, OJ EPO 1989, 79; point 5.6).

The above principles also apply to proceedings before an examining division, so that all the requests must be examined in their turn for patentability in compliance with Article 113(2).

In the present case, both the main and auxiliary requests were examined for patentability and were decided upon in compliance with Article 113(2), so that the refusal of the application on the basis of the auxiliary request was an essential part of the decision.

As can be seen from the wording of claims 15 of the main and auxiliary requests forming the basis of the decision, whereas the former is concerned with "Material intended specifically for use...", the latter has been amended so as to relate to "Material *when sold* for use ... (the remaining wording is as in claim 15 of the main request). Thus the latter claim 15 does not contain simply minor clarifying amendments or

amendments of an editorial nature, but amendments requiring reasoned arguments, such as those advanced in the decision in paragraph 7.2, as to why the amended wording did not limit the scope of the claim or why the claimed subject-matter was considered to lack novelty. In the minutes of the telephone consultation mentioned above, there is no record of any discussion regarding the patentability of the amended wording of claim 15, in accordance with Article 54(1) and (2) EPC, so that the factual and legal reasoning against the patentability of the auxiliary request were presented for the first time in the decision and the applicant had no opportunity to present its comments prior to the issue of the decision.

In the present case, therefore, the issue of the decision refusing the auxiliary request was contrary to the provisions of Article 113(1) EPC, and constituted a substantial procedural violation.

3.2 Refund of the appeal fee

According to Rule 67 EPC, the reimbursement of an appeal fee is to be ordered if the following conditions are fulfilled:

1. where the board of appeal deems an appeal to be allowable; and
2. if such reimbursement is equitable by reason of a substantial procedural violation.

Thus, contrary to the submission of the applicant (see paragraph VII above), it is also a prerequisite for the refund of the appeal fee that the appeal is deemed to be allowed. In the present case, the decision under appeal is based on claims 15 of the main and auxiliary requests filed on 30 May 1994 and 16 August 1994,

respectively. These requests along with the first and second further auxiliary requests were submitted for consideration by the applicant in the present appeal. The main and the auxiliary requests forming the basis of the decision under appeal were considered to be not allowable by the Board and the Board's decision to allow the application to proceed to grant has been taken on the basis of a new auxiliary request (second further auxiliary request) submitted with the grounds of appeal. Under these circumstances, although a substantial procedural violation occurred during the proceedings before the first instance, since the appeal was not allowable on the substantive issues forming the basis of the decision under appeal, it would be contrary to the requirements of Rule 67 EPC to refund the appeal fee.

The applicant was given the opportunity to have the case remitted to the first instance for further prosecution of the application on the basis of the requests submitted with the grounds of appeal, and had the applicant availed himself of this opportunity, then the appeal would have been deemed to be allowed and it would have been also equitable to refund the appeal fee having regard to the substantial procedural violation. However, since the appeal was not successful on the substantive issues forming the basis of the decision under appeal, in the Board's judgement, it is not equitable to refund the appeal fee.

Order

For these reasons it is decided that:

1. The decision of the Examining Division is set aside.
2. The case is remitted to the department of the first instance with the order to grant a patent with the text and drawings as specified in paragraph VII above.

The Registrar:

The Chairman:

M. Beer

G. Davies