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D E C I S I O N
of 6 December 1995

Case Number: T 0798/95 - 3.3.1

Application Number: 93306211.9

Publication Number: 0582481

IPC: C07C 401/00

Language of the proceedings: EN

Title of invention:
Preparation of 19-nor-vitamin D compounds

Applicant:
WISCONSIN ALUMINI RESEARCH FOUNDATION

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. -
EPC R. 51(6), 67, 86(3), 88

Keyword:
"Request for amendment (R. 86(3) EPC) filed after the completion of the proceedings - substantial procedural violation (no)"

Decisions cited:
G 0012/91, G 0007/93

Catchword:
A request for amendment under Rule 86(3) EPC filed after the completion of the proceedings up to grant before an Examining Division is to be disregarded even if the filing of the request and the completion of the proceedings occur on the same date.



Case Number: T 0798/95 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 6 December 1995

Appellant:

WISCONSIN ALUMINI RESEARCH FOUNDATION
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Representative:

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Decision under appeal:

Decision of the Examining Division of the European
Patent Office dated 31 August 1995 granting a
European patent pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: A. J. Nuss
Members: W. Moser
R. K. Spangenberg

Summary of Facts and Submissions

- I. On 31 March 1995, the Formalities Officer on behalf of the Examining Division (Rule 9(3) EPC) issued a communication under Rule 51(6) EPC, inviting the Appellant (Applicant) to pay the fees for grant and printing and to file translations of the claims within a non-extendable period of three months from notification of the communication.
- II. In a letter dated 20 June 1995, received by the EPO on 21 June 1995, the Appellant requested correction under Rule 88 EPC of claim 9.

Within the period set by the Examining Division, the Appellant further paid the fees for grant and printing and filed the translations of the claims.
- III. On 28 July 1995, the Examining Division gave its consent to the correction under Rule 88 EPC requested by the Appellant after despatch of the communication under Rule 51(6) EPC.
- IV. The decision to grant a European patent (EPO Form 2006) was handed over to the EPO postal service on 25 August 1995 and notified on 31 August 1995.
- V. On 25 August 1995, at 6.47 p.m., the Appellant filed a request for amendment of the application under Rule 86(3) EPC by telefax. The Appellant asked the Examining Division to replace pages 1 and 26 of the application with amended copies of these pages.
- VI. With letter dated 6 September 1995, the EPO informed the Appellant that, on 25 August 1995, the decision to grant a European patent was handed over to the EPO postal

service and that, therefore, the requested amendments could not be taken into consideration.

VII. On 13 September 1995, the Appellant lodged an appeal against the decision of the Examining Division to grant the patent and paid the prescribed fee at the same time. A written statement setting out the grounds of appeal was filed together with the notice of appeal.

VIII. In an annex to the summons to attend oral proceedings, dated 16 October 1995, the Board informed the Appellant of its provisional opinion that, based on the findings of the Enlarged Board of Appeal in decision G 12/91 (OJ EPO 1994, 285), his request for amendment of the application under Rule 86(3) EPC was filed after the proceedings before the Examining Division had been completed and that it appeared therefore that no substantial procedural violation pursuant to Rule 67 EPC had occurred in the proceedings before the Examining Division.

IX. The Appellant replied by a telefax dated 1 November 1995.

X. In the written submissions and during oral proceedings held on 6 December 1995, the Appellant argued essentially as follows:

- He (the Appellant) was adversely affected by the decision under appeal because the amendments to the claims and description requested had not been made.

- Because the Examining Division had been able on 25 August 1995 to hand over the decision to grant to the postal services, it had equally been competent to decide on the allowability of amendments to the application.

- According to decision G 7/93 of the Enlarged Board of Appeal (OJ EPO 1994, 775), it was possible to amend an application (at the discretion of the Examining Division) at any time until issue of a decision to grant the patent. Since for the present application the decision to grant was issued on 31 August 1995, the request for amendments received by the EPO on 25 August 1995 had been made in due time and should have been considered.

- The reliance on decision G 12/91 (supra) was misplaced because this decision had been modified by the more recent decision G 7/93 (supra).

- G 7/93 (supra) was directly concerned with the issues at stake in the present case, i.e. the deadline by which amendments may be made (at the discretion of the Examining Division) after issue of the Rule 51(6) EPC communication. By way of contrast, G 12/91 (supra) was more concerned with procedure during opposition proceedings.

- In decision G 12/91 (supra), there was no discussion of the exact time at which proceedings were completed, only reference to the date on which proceedings ended. Thus, the Examining Division had still been responsible for the application on Friday 25 August 1995. Furthermore, it followed from decision G 12/91 (supra) and general EPO practice (cf. Notice of 26 May 1992 from the President of the EPO concerning the filing of patent applications and other documents) that the Examining Division had been responsible for the application all day on Friday 25 August 1995.

- For all deadlines set by the EPO, action had to be taken before midnight on the day on which the deadline expired. Thus, the submission of the request for amendments at 6.47 p.m. on Friday 25 August 1995 had been in time and the decision not to consider it represented a substantial procedural violation.

XI. The Appellant requested that the decision under appeal be set aside and that the case be remitted to the Examining Division with the order to consider the amendments submitted on 25 August 1995 at 6.47 p.m. He furthermore requested a reimbursement of the appeal fee.

Reasons for the Decision

1. The appeal is admissible.
2. In decisions G 12/91 and G 7/93 (supra) completely different questions of law have been answered by the Enlarged Board of Appeal. Consequently, the Appellant's objection that decision G 12/91 has been modified by the more recent decision G 7/93 is unfounded. Furthermore and contrary to the opinion expressed by the Appellant, decision G 12/91 is equally concerned with the decision-making process within an Examining Division.
3. On 25 August 1995, no period set by the EPO was running or expired at midnight. As a matter of fact, the decision to grant the European patent in suit was taken after the non-extendable period under Rule 51(6) EPC had elapsed. Consequently, the Board cannot accept the Appellant's argument that a deadline set by the EPO expired on Friday 25 August 1995 at midnight and that,

as a result, the submission of the request for amendment at 6.47 p.m. on that date had been in time.

4. According to decision G 12/91 (supra), the decision-making process following written proceedings is completed on the date the decision to be notified is handed over to the EPO postal service by the decision-taking department's formalities section. This event clearly marks the point in time up to which the parties can expect account to be taken of any further submission they might make (cf. point 9.2 of the Reasons). However, when a decision is handed over by the formalities section to the EPO postal service for notification, it is taken from the file and is removed from the power of the department that issued it (cf. point 9.3 of the Reasons). This moment marks the completion of the proceedings before the decision-making department. Once proceedings have been completed, the decision-making department can no longer amend its decision. It must disregard any fresh matter the parties may submit to the EPO thereafter.

5. On 25 August 1995, the decision to grant the European patent in suit was handed over by the formalities section of the Examining Division to the EPO postal service for notification during the official working time of the EPO. Thus, the proceedings before the Examining Division were completed not later than at the end of the official working time on that date. Thereafter, the Examining Division could no longer amend its decision. The Appellant's submissions that the Examining Division had been responsible for the application all day on Friday 25 August 1995 and that it was possible to amend the application until issue of the decision are therefore not correct.

6. The request for amendment of the application under Rule 86(3) EPC was filed on 25 August 1995 at 6.47 p.m., i.e. after the completion of the proceedings before the Examining Division (cf. point 5 supra). From this it follows that the Examining Division was not competent to consider this request. Consequently, the fact that this request has not been considered by the Examining Division does not represent a substantial procedural violation within the meaning of Rule 67 EPC.
7. Because no substantial procedural violation has occurred in the proceedings before the Examining Division, the appeal has to be dismissed.
8. Since the appeal is not deemed to be allowable, the reimbursement of the appeal fee cannot be ordered under Rule 67 EPC.

Order

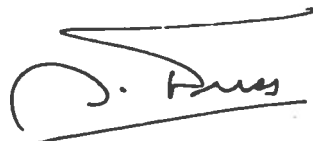
For these reasons it is decided that:

The appeal is dismissed.

The Registrar:


E. Görgmaier

The Chairman:


A. Nuss