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D E C I S I O N
of 10 October 1996

Case Number: T 0194/96 - 3.3.2
Application Number: 88102199.2
Publication Number: 0284754
IPC: C02F 11/08
Language of the proceedings: EN

Title of invention:
A process for treating polluted soils

Applicant:
Conor Pacific Environmental Technologies Inc.

Opponent:
-

Headword:
Polluted soil/CONOR

Relevant legal provisions:
EPC Art. 116(1), 111(1)
EPC R. 67

Keyword:
"Further oral proceedings"

Decisions cited:
T 0731/93

Catchword:
-



Case Number: T 0914/96 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 10 October 1996

Appellant: Conor Pacific Environmental Rechnologies Inc.
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Representative: Belcher, Simon James
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 16 October 1996
refusing European patent application
No. 88 102 199.2 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: P. A. M. Lançon
Members: G. J. Wassenaar
J. A. Stephens-Ofner

Summary of Facts of Submissions

I. European patent application No. 88 102 199.2 was refused by a decision of the Examining Division. The decision was taken on the basis of claims 1 to 23 filed on 11 September 1995 with a letter dated 8 September 1995. The grounds of the decision were lack of novelty. The reasoning was essentially based on the document "Nuclear active, International Journal of the AEC, No. 31 (July 1984), pages 25-32" (D10), mentioned for the first time in an observation by a third party in the meaning of Article 115(1) EPC, filed on 5 October 1994.

II. The decision was reached after a first oral proceedings which took place on 14 June 1994. At the end of these proceedings the chairman of the Examining Division informed the applicant that a patent could be granted on the basis of the claims filed during the oral proceedings.

With a letter dated 8 July 1994, the Appellant was informed that the Examining Division intended to grant a patent on the basis of the set of claims submitted during the oral proceedings.

III. Several letters with observations by a third party were filed containing references to many new documents.

In a letter dated 5 October 1994, the third party cited, amongst others, D10.

The Examining Division considered D10 to be highly pertinent and resumed the examination proceedings. An objection of lack of inventive step was raised against the claims agreed upon during the oral proceedings.

After further observations and citations of new documents by the third party the Appellant filed a new set of claims dated 8 September 1995, which formed the basis of the contested decision.

Oral proceedings were requested for the event that the application would be rejected.

With a decision dated 16 October 1995 the application was refused on the grounds of lack of novelty on the basis of D10 without performing the requested second oral proceedings.

IV. The request for further oral proceedings was considered deemed to be an abuse of procedure because, in the opinion of the Examining Division, the Appellant merely wished to prolong the examination procedure. The following reasons were given for this finding:

- (i) One of the inventors being co-author of D10, the Appellant must inevitably have been aware of its existence but kept it secret for seven years.
- (ii) The Appellant had had sufficient opportunity to amend the claims and to put forward arguments in favour of its patentability.
- (iii) The new set of claims was clearly broader than the one agreed upon during the first oral proceedings.

V. The Appellant lodged an appeal against the decision to refuse the Application. In the Statement of the Grounds of Appeal, the Appellant contested the arguments of the Examining Division and filed a new set of claims 1 to 20 as main request together with alternative claims 1 as auxiliary requests 1 to 3. In particular it was argued that D10, mentioning as author Mr Jørgen Jensen,

one of the inventors of the present patent application, concerns a study of the feasibility of mining and recovery of uranium from the Kvanefjeld Ilimaussaq intrusion in South Greenland and has nothing to do with the method of decontaminating soil polluted by organic substances as now claimed. Thus although the original applicants were aware of the content of D10, they did not deliberately conceal pertinent information about the uranium project because it was considered unrelated art. The arguments were supported by seven new documents referred to as A till G.

- IV. The Appellant requested that the decision under appeal be set aside and a patent be granted on the basis of claims 1 to 20 as main request or alternatively on the basis of a set of claims wherein claim 1 of the main request is substituted with claim 1 of one of the subsidiary requests as filed on 26 February 1996 with the Statement of Grounds.

With a telefax filed on 3 October 1996 the Appellant submitted as a further subsidiary request, that the application be remitted to the Examining Division in the event that the Board decides that there has been a procedural violation in the prosecution of the application.

Reasons for the Decision

1. The appeal is admissible
2. The right of parties to oral proceedings in examination, opposition as well as appeal proceedings is enshrined in Article 116 EPC, according to which "oral proceedings shall take place either at the instance of the European Patent Office if it considers

this to be expedient or at the request of any party to the proceedings. However, the European Patent Office may reject a request for further oral proceedings before the same department where the parties and the subject of the proceedings are the same".

It is the established case law of the Boards of Appeal that a party who requests oral proceedings is, in principle, entitled to such proceedings **as of right**. Therefore, considerations such as the speedy conduct of the proceedings or procedural economy cannot take precedence over a party's right to oral proceedings.

3. Whilst it is true that the second sentence of Article 116(1) EPC does give the European Patent Office the discretionary power to reject a request for further oral proceedings before the same department, it may do so only "where the parties and the **subject of the proceedings** are the same".

Thus, even if the Examining Division's assumptions with regard to the Appellant's alleged abuse were right, it could not be a reason to refuse a request for further oral proceedings. The only criterion is whether the subject of the proceedings was changed since the first oral proceedings.

Both the German and the French texts of the second sentence of Article 116(1) EPC refer not to the rather vague term "subject" of proceedings but to the facts or the subject-matter of the oral proceedings "... wenn die Parteien und der dem Verfahren zugrundeliegende **Sachverhalt** unverändert geblieben sind", "... devant une même instance pour autant que les parties ainsi que les **faits** de la cause soient les mêmes" (see T 0731/93, point 3 of the reasons, not published in OJ EPO).

The "subject" of the first oral proceedings in its broadest sense was the patentability of the claims then on file in view of the prior art then on file. After these oral proceedings fresh evidence has been submitted in the form of new prior art documents of which at least D10 was considered by the Examining Division to be more pertinent than the documents on file during the first oral proceedings. According to T 0731/93, if fresh evidence has been **admitted** into the proceedings, the "subject" of such proceedings in the meaning of Article 116(1) EPC can no longer be the same. In that case the fresh evidence amounted to experimental evidence and arguments (see point 5 of the reasons).

In the present case, new citations were submitted among which at least one was regarded as more pertinent than the documents on file, which could and in fact did radically change the nature of the decision. Here also, the subject of the proceedings in the meaning of Article 116 EPC can no longer be the same.

Accordingly, the Examining Division had no power to refuse the requested second oral proceedings and was wrong in law to issue its written decision without having performed such proceedings.

4. In consequence of the course of action taken by the Examining Division, the case had not yet been fully considered by the first instance. It is therefore not appropriate for the Board to continue with the appeal proceedings and consider the case on its merits. The case is to be remitted to the Examining Division for further prosecution by way of appointing the requested further oral proceedings to consider the case on the basis of all the available evidence, including the written submissions to date (Article 111(1) EPC).

5. Furthermore, since the infringement of Article 116(1) EPC constitutes a substantial procedural violation under Rule 67 EPC, and since this procedural violation is the cause of the present remittal without any decision by the Board on the merits of the case, the appeal fee should be refunded.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution with the order to appoint oral proceedings.
3. The appeal fee is refunded.

The Registrar:



P. Martorana

The Chairman:



P. A. M. Lançon

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