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D E C I S I O N
of 8 July 1999

Case Number: T 1066/96 - 3.4.2

Application Number: 91104573.0

Publication Number: 0448123

IPC: G02B 26/10

Language of the proceedings: EN

Title of invention:
Scanning optical device

Applicant:
Canon Kabushiki Kaisha

Opponent:
-

Headword:
-

Relevant legal provisions:

EPC Art. 97(1), 113(1)
EPC R. 51(5), 67, 86(3)

Keyword:

"Basis of decisions - opportunity to comment (no): intention to exercise discretion under R. 86(3) EPC negatively not communicated before refusal"

"Substantial procedural violation (yes)"

Decisions cited:

G 0007/93, T 0946/96

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: T 1066/96 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 8 July 1999

Appellant: Canon Kabushiki Kaisha
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Tokyo (JP)

Representative: Tiedtke, Harro, Dipl.-Ing.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 6 August 1996
refusing European patent application
No. 91 104 573.0 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: E. Turrini
Members: S. V. Steinbrener
B. J. Schachenmann

Summary of Facts and Submissions

- I. The appellant lodged an appeal against the decision of the Examining Division refusing European patent application No. 91 104 573.0 (publication No. EP-A-0 448 123) under Article 97(1) EPC.

The Examining Division based its decision on the fact that the appellant filed further amended claims 1 and 2 within the period which was given to the appellant at the end of oral proceedings before the first instance in order to "state his approval of the text of the application as annexed to the minutes of the oral proceedings and to file fair copies of the amended documents, so that as the next step the communication under Rule 51(6) EPC can be issued" (see the minutes of said oral proceedings).

The Examining Division held that at this stage of the proceedings no consent can be given, under Rule 86(3) EPC, to the filing of still further amended claims which amendments were not occasioned by Rule 88 EPC.

As can be seen from the file, the impugned decision was issued by the Examining Division without any further oral or written communication after having received the appellant's letter of 15 March 1996 containing the newly amended claims and detailed reasons for said further amendments.

- II. In the statement of grounds of appeal, the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the

amended documents as submitted with the letter of 15 March 1996. As an auxiliary measure, oral proceedings were requested for the event that the patent was not to be maintained as requested on the basis of the written submissions.

- III. In a phone call dated 2 July 1999, the appellant was informed by the Board that the impugned decision seemed to offend against Article 113(1) EPC, and the Board was therefore considering remittal of the case to the department of first instance because of a substantial procedural violation.

The appellant declared its consent to withdraw the auxiliary request for oral proceedings if the case was to be remitted.

- IV. The appellant's arguments, insofar as they are relevant to the present decision, may be summarised as follows:

Since not all of the amendments suggested by the Examining Division in a communication under Rule 51(4) EPC were acceptable for the appellant, further amendments were discussed and finally agreed upon. The appellant's approval of the amended documents was then declared so that the issue of a communication under Rule 51(6) EPC was expected. However, due to a change of mind of the Examining Division, the appellant was summoned to attend oral proceedings instead. At said oral proceedings, a set of claims considered allowable by the Examining Division was submitted by the appellant, the set containing in particular independent claims 1 and 2 prepared by the appellant's representative during the oral proceedings.

This means that the applicant itself, a company domiciled in Japan, had no possibility to comment on these claims. Therefore, the representative did not state his approval during the oral proceedings so that the procedure was continued in writing. When the representative informed the applicant about the result of the oral proceedings, it became apparent that the wording of the claims might be misunderstood by a skilled person so that further clarifications were required. However, the application was refused by the Examining Division in reaction to the appellant's letter requesting such further clarifications, and the appellant thus was no longer allowed to file claims deviating from those prepared at the oral proceedings.

Bearing in mind that only one official communication had been issued before the communication under Rule 51(4) EPC, this procedure does not seem to be fair and does not correspond to the usual conduct of proceedings before the EPO.

Reasons for the Decision

1. Admissibility of appeal

The appeal complies with the provisions mentioned in Rule 65 EPC and is therefore admissible.

2. Amendments filed after disapproval of the text notified under Rule 51(4) EPC

2.1 In the present case, the appellant (applicant) had not

given its approval of the text notified under Rule 51(4) EPC, but proposed further amendments to the application documents within the period set in the 51(4)-communication. After a somewhat involved discussion of said further amendments which were first accepted and then rejected by the Examining Division until a "final" version was agreed upon during oral proceedings considered expedient by the Examining Division, the latter exercised its discretion under Rule 86(3) EPC not to admit further amendments to claims 1 and 2 after said oral proceedings.

- 2.2 Pursuant to Rule 51(5) EPC, the Examining Division has the discretion not to consent under Rule 86(3) EPC to amendments proposed by the applicant within the period set by the communication under Rule 51(4) EPC. However, in that case, Rule 51(5) EPC explicitly provides that "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."

These provisions have to be seen in the light of the general regulation of Article 113(1) EPC pursuant to which "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".

- 2.3 Therefore, in exercising its discretion under Rule 86(3) EPC in a negative way, an Examining Division may only refuse an application if before issuing a decision it has informed the applicant about the fact that the further amendments requested will not be

admitted and about the reasons for not admitting said amendments, thereby taking due account of the applicant's reasons for such late filing of further amendments. If the applicant maintains its request and its counterarguments are not considered convincing by the Examining Division, the application has to be refused under Article 97(1) EPC since it contains no claims to which the applicant has agreed. This procedure is also set out in the Guidelines for Examination in the European Patent Office, Part C, June 1995 (see C-VI, 15.1.3, referring to C-VI, 4.6 et seq., in particular 4.12).

In this context, it is clear that further amendments cannot be excluded wholesale in advance, but the discretion under Rule 86(3) EPC has to be exercised on a case-by-case basis balancing the EPO's and the applicant's interests against one another (see decision G 7/93 of the Enlarged Board of Appeal, OJ EPO 1994, 775; point 2.5 of the reasons).

3. *Substantial procedural violation*

3.1 In the present case, the Board cannot retrieve any trace in the file that the appellant had been informed in a reasoned communication about the imminent rejection under Rule 86(3) EPC of the further amendments to claims 1 and 2. Rather it appears that the Examining Division more or less decided on the spot not to consent to the further amendments requested and refused the application. The reasons for the negative exercise of the Examining Division's discretion were first communicated to the appellant in the reasons of the impugned decision.

3.2 As has been pointed out above, this conduct of the proceedings involves a substantial procedural violation since Article 113(1) EPC in general and Rule 51(5) EPC in particular must also be complied with in the case of a refusal under Rule 86(3) EPC, irrespective of how cumbersome the proceedings may have been beforehand (see decision T 946/96, not published in OJ EPO; point 2 of the reasons).

4. *Remittal of the case to the first instance and reimbursement of the appeal fee*

4.1 In view of the procedural violation and in order to allow the appellant to argue its case before two instances, the Board without any comment as to the merits of the impugned decision makes use of its discretion under Article 111(1) EPC to remit the case to the Examining Division for further prosecution.

4.2 If no consent is to be given under Rule 86(3) EPC to the late amendments requested, it will be necessary to communicate the Examining Division's intention and the reasons on which the intention is based to the appellant and to reconsider the appellant's observations on this intention before issuing any decision.

In accordance with G 7/93 (*supra*), the Division's discretion under Rule 86(3) EPC should be exercised so that a fair balance of interests is achieved, whereby an overall converging tendency of the procedure should not be ignored in the Board's view.

4.3 Under the circumstances of the present case, the Board

considers the requirements of Rule 67 EPC to be met and, accordingly, the appeal fee shall be reimbursed.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. The reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

P. Martorana

E. Turrini