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D E C I S I O N
of 10 March 1999

Case Number: T 0984/97 - 3.4.2
Application Number: 92912232.3
Publication Number: 0587708
IPC: G01J 4/00, G01N 21/23

Language of the proceedings: EN

Title of invention:

Determination of induced change of polarization state of light

Applicant:

Göttsche, Allan

Opponent:

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Headword:

-

Relevant legal provisions:

EPC Art. 96(2), 113(1)
EPC R. 67

Keyword:

"Refusal after a single communication of the Examining
Division"
"Decision including new grounds"
"Substantial procedural violation"

Decisions cited:

G 0012/91; T 0802/97

Catchword:

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Case Number: T 0984/97 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 10 March 1999

Appellant: Göttsche, Allan
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3250 Gilleleje (DK)

Representative: Hegner, Mogens
c/o Hofman-Bang & Boutard,
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 16 April 1997
refusing European patent application
No. 92 912 232.3 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: E. Turrini
Members: A. G. Klein
M. Lewenton

Summary of Facts and Submissions

- I. European patent application No. 92 912 232.3 is based on the International patent application No. PCT/DK92/00 177 (International publication No. WO 92/21 949), for which an International Preliminary Examination Report under Chapter II of the PCT, stating that the claimed subject-matter met the requirements of novelty, inventive step and industrial applicability, had been established by the European Patent Office, acting as the International Preliminary Examining Authority under Chapter II of the PCT.
- II. Upon entry of the application in the regional phase before the EPO, the Examining Division on 11 April 1995 directly issued a communication under Rule 51(4) EPC, informing the applicant of its intent to grant a European patent.
- III. In his reply dated 16 January 1996 the applicant approved the text indicated in the above communication with the exception of several amendments and corrections to be entered into the claims and the description.

In support of the proposed amendments, the applicant submitted that he had become aware of the following new prior art documents not cited in the International Search Report:

D5: US-A-4 428 017,

D6: US-A-4 998 063; and

D7: DE-A-2 017 863.

He also explained why the subject-matter of the amended claims in his view was patentable over these new citations.

IV. In a communication pursuant to Article 96(2) and Rule 51(2) EPC dated 3 May 1996, the Examining Division objected to the clarity of the claims in the sense of Article 84 EPC since they were not consistent with the description, and it further submitted that the subject-matter of the independent claim either lacked novelty in view of document D7, or did not involve an inventive step since it was distinguished from the prior art disclosed in document D5 only by features described in either of documents D6 and D7.

V. With his response dated 10 February 1997 to the above communication, the applicant filed an amended set of claims and new pages 24 and 33 of the description and set out why, in his view, these documents overcame the Examining Division's objections.

He also requested an interview, in the event the Examining Division intended to refuse the application.

VI. In a decision dated 21 March 1997, supplemented with a further decision under Rule 89 EPC, dated 16 April 1997 and correcting the earlier decision by including a copy of the claims on which it was based, the Examining Division refused the application.

In a part of the decision entitled "**Allowability of the Amendments**", inserted between a first part entitled "**Summary of Facts and Submissions**" and a third part entitled "**Reasons for the Decision**", the Examining Division stated that several amendments brought to the claims and description filed by the applicant on 10 February 1997 offended against the provisions of Article 123(2) EPC.

In the third part of the decision entitled "**Reasons for the Decision**", the Examining Division then submitted that the independent claims on the file lacked clarity in the sense of Article 84 EPC, since they were not consistent with the description **as originally filed** (as emphasised twice in the decision), and that their subject-matter was not novel in the sense of Article 54 EPC.

VII. The appellant (applicant) filed an appeal against the decision.

As his main request, he requested that the appealed decision be set aside and that the application be sent back to the Examining Division for further prosecution on the basis of the application documents proposed with his letter dated 10 February 1997.

As an auxiliary request, the appellant requested that the application be sent back to the Examining Division for further prosecution on the basis of an amended set of claims as attached to his statement of the grounds

of appeal dated 25 August 1997.

The appellant further requested reimbursement of the appeal fee.

The set of claims in accordance with appellant's main request comprises 10 claims, of which claims 1 and 3, the only independent claims, read as follows:

"1. A method of determining induced change of polarization state of light in a polarization element comprising:

- a) transmitting unpolarized light from a light source at the one end of an optical transmitter waveguide means (21) to polarizer means (31) at the other end;
- b) polarizing the unpolarized light by the polarizer means (31);
- c) transmitting the polarized light through the polarization element (41, 41A, 41B) using at least one reflective optical element (51, 51A, 51B, 61);
- d) analyzing the transmitted polarized light from the polarization element by an analyzer means (32);
and
- e) transmitting the analyzed polarized light from the one end of an optical receiver waveguide means (22) to a light detector at the other end;

said optical transmitter waveguide means (21) and said optical receiver waveguide means (22) being substantially parallel;

wherein

- f) the unpolarized light while being polarized by the polarizer means (31), the polarized light while being analyzed by the analyser means (32), or both, are non-collimated;
- g) the light from said other end of the optical transmitter waveguide means (21) is reflected in the light path between the polarizer means (31) and the analyzer means (32) by the at least one reflective optical element (51, 51A, 51B, 61) so as to focus the reflected polarized light onto said one end of the optical receiver waveguide means (22);
- h) the analyzed light exits the analyzer means (32) from the same side or parallel sides of the polarization element (41, 41A) as the polarized light enters the polarizer means (31); and
- i) the polarizer means (31) is located directly adjacent to the optical transmitter waveguide means (21) and the analyzer means (32) is located directly adjacent to the optical receiver waveguide means (22)."

"3. A sensor device for determining induced change of polarization state of light in a polarization element comprising:

- a) a polarizer means (31) for polarizing unpolarized light emitted from the one end of an optical transmitter waveguide means (21) transmitting unpolarized light from a light source to the polarizer means (31);
- b) a polarization element (41) comprising a suitable polarization active material in which an induced anisotropy in its index of refraction changes the polarization state of said polarized light polarized by the polarizer means (31);
- c) at least one reflective optical element (51, 51A, 51B, 61) for reflecting said polarized light transmitted through the polarization element (41);
and
- d) an analyzer means (32) for analyzing said polarized light reflected by the at least one reflective optical element; said analyzer means positioned at one end of an optical receiver waveguide means (22) transmitting the analyzed light from the analyzer means (32) to detection means; said optical transmitter waveguide means (21) and said optical receiver waveguide means (22) being substantially parallel;

wherein

- e) the at least one reflective optical element (51, 51A, 51B, 61) is arranged to focus light transmitted through the polarizer means (31) from said one end of the optical transmission waveguide means (21) through the analyzer means (32) onto said one end of the optical receiver waveguide means (22);

- f) the analyzed light exits the analyzer means (32) from the same side or parallel sides of the polarization element (41, 41A) as the polarized light enters the polarizer means (31); and

- g) the polarizer means (31) is located directly adjacent to the optical transmitter waveguide means (21) and the analyzer means (32) is located directly adjacent to the optical receiver waveguide means (22)."

VIII. In support of his requests, the appellant provided detailed arguments in favour of the allowability of the claims in accordance with his main and auxiliary requests.

With respect of his request for reimbursement of the appeal fee he also submitted that his filing of amended application documents with his letter dated 10 February 1997 and his discussion of the merits of the claimed subject-matter in view of the prior art documents D5, D6 and D7 amounted to a *bona fide* attempt to deal with the Examining Division's objections. Accordingly, he

could legitimately have expected to be warned e.g. by a telephone conversation or a communication of the Examining Division's intent to refuse the application, in conformity with the instructions set down in the Guidelines for Examination in the EPO (see Guidelines C-VI, 4.3).

The Examining Division in the appellant's view also offended against the requirement of Article 113(1) EPC that decisions of the EPO be based only on grounds or evidence on which the parties concerned have had an opportunity to present their comments. The appellant in particular should have been given the opportunity to present his comments on the Examining Division's refusal to consider that the features added to the independent claims as amended with appellant's response dated 10 February 1997 actually provided novelty of the claimed subject-matter.

The appellant also submitted that he telephoned the primary examiner of the Examining Division two or three weeks after dispatch of his letter dated 10 February 1997, to ask if further amendments were considered necessary. The primary examiner indicated that he had already decided to recommend refusal of the application and that the interview requested by the appellant in the above letter was not granted. Had the appellant wanted an interview, he should have requested oral proceedings.

Reasons for the Decision

1. The appeal is admissible.

2. *Refusal of the application after one communication pursuant to Article 96(2) and Rule 51(2) EPC only*

According to Article 96(2) EPC the Examining Division shall invite the applicant as often as necessary to file his observations. When applying this provision to determine in a specific case whether an applicant should be given a further opportunity to present comments or amendments before refusing an application after a single official communication, the established practice of the Examining Divisions as set out in particular in the Guidelines for Examination in the European Patent Office is to warn the applicant who had made a *bona fide* attempt to deal with the Examining Division's objections, e.g. by a telephone conversation or by a short further written action, that the application will be refused unless he can produce further more convincing arguments or makes appropriate amendments within a specified time limit. Only when the applicant has not made any real effort to deal with the objections raised in the first communication, should the Examining Division consider immediate refusal of the application, this however being an exceptional case (see Guidelines C-VI, 4.3). The Board sees no reason to question this established practice.

In the present case, it is noticed that the Examining Division in its only substantive communication pursuant to Article 96(2) and Rule 51(2) EPC dated 3 May 1996, on the one hand objected to the clarity of the claims in the sense of Article 84 EPC, on the ground that the feature of independent claims 1 and 3, according to which the reflected light was focussed onto the fibre, conflicted with a number of embodiments of the description. Incidentally the Board in this respect notices that the objected feature of the independent claims was already included in the independent claims on the basis of which the Examining Division initially intended to grant a patent, before the examination was resumed, following the appellant's filing of new prior art documents and amended claims on 16 January 1996 (see the communication under Rule 51(4) EPC dated 11 April 1995).

On the other hand, the Examining Division in its only substantive communication contested the novelty and inventive step of the subject-matter of independent claims 1 and 3.

The appellant in his response dated 10 February 1997 filed an amended set of claims, together with amended pages 24 and 33 of the description.

He also explained in detail, over eight densely typed pages of comments, why the amendments brought to the description and claims overcame the Examining Division's earlier objections.

This reply must in the Board's view, be considered to constitute a *bona fide* attempt to deal with these objections.

The Examining Division in its decision stated that "in view of the fact that the matters at issue are of a principal nature, and also considering the course of the procedure to date, an interview is not considered appropriate", without further explanations (see point 7 of the decision). In the Board's view, however, the established practice of warning the applicant before refusing an application after a first substantive communication is certainly not limited to case in which the matters at issue are only of secondary importance. Neither could the Board recognise any exceptional circumstances in the present case, which would have justified departing from the above established practice.

Quite on the contrary, the fact that the International Search Report, although not established by the EPO, had failed to cite the apparently highly relevant documents D5, D6 and D7, which the appellant drew to the Examining Division's attention of its own motion, and the Examining Division's apparent change of mind as to the question of the clarity of the claims under Article 84 EPC, in the Board's opinion could have justified particular attentions towards the appellant in the further handling of the application.

The appellant in his statement of the grounds of appeal indicated that he actually phoned the primary examiner

of the Examining Division two or three weeks after his filing of the response of 10 February 1997, to ask for the status of the case and whether further amendments were considered necessary. The examiner informed him that he had already decided to recommend refusal of the application and that an interview was not granted. Had the appellant wanted an interview he should have requested oral proceedings.

The Board has no reason to question the truth of the appellant's statement and there are no minutes of the conversation which could provide evidence that the appellant actually misinterpreted the information given to him by the primary examiner.

The primary examiner's answer in the Board's opinion cannot be equated to a last warning to the appellant before the actual refusal of the application, since the examiner clearly expressed that the decision at that stage was already final, and that it was too late, even for oral proceedings. Incidentally, the information given by the primary examiner - apparently as early as three to four weeks before the decision dated 21 March 1987 and six to seven weeks before the corrective decision of 16 April 1987 - was clearly wrong. The decision-making process following written proceedings is indeed only completed on the date when the decision to be notified is handed over to the EPO postal service by the decision-taking department's formalities section, not on the date the primary examiner decides to recommend refusal of an application to the Examining Division (see decision of the Enlarged Board of Appeal

G 12/91, OJ EPO, 1994, 285).

Accordingly, the immediate refusal of the application without any prior warning to the appellant in the Board's opinion constituted a substantial procedural violation within the meaning of Rule 67 EPC in view of Article 96(2) EPC.

3. *Basis of the decision*

3.1 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 (see Article 113(1) EPC).

3.2 In addition to the grounds of lack of clarity and novelty already evoked in its only substantive communication, the Examining Division in the impugned decision also for the first time objected to the compliance of the amendments, brought to the claims and description in response to the latter communication, with the requirements of Article 123(2) EPC. The objections under Article 123(2) EPC were set out in a portion of the decision entitled "**Allowability of the Amendments**" inserted between the "**Summary of Facts and Submissions**" and the "**Reasons for the Decision**", probably to suggest that the new objections against the allowability of the amendments were not actually to be considered as grounds on which the decision was based in the sense of Article 113(1) EPC.

In the Board's opinion, if a decision of the EPO

includes several grounds supported by respective arguments and evidence, it is of fundamental importance that the decision as a whole meets the mandatory requirements of Article 113(1) EPC. Leaving it up to the deciding body to suggest which of the grounds were to be considered as the basis of the decision and which were not - and did not therefore need to comply with the requirements of Article 113(1) EPC - can only lead to legal uncertainty and confusion of the parties, for instance with respect of the question of which objections the appellant should actually overcome with his appeal to benefit from an interlocutory revision in the sense of Article 109 EPC (see also the decision T 802/97, not published in the OJ EPO).

Not informing an applicant before the refusal of his application of a major non-conformity with the requirements of the Convention also deprives him of an opportunity, in case he could have agreed to the objection, of amending his application in a way which possibly might also have overcome the remaining objections, thus avoiding both the refusal and a later appeal.

Moreover, the question of the allowability under Article 123(2) EPC of the amendments brought to the claims and the description actually was a central issue of the decision, which also influenced - and tainted - the Examining Division's handling of the remaining objections against the clarity of the claims and the novelty of their subject-matter.

Concerning clarity, the amendments brought by the appellant to the description precisely aimed at overcoming the Examining Division's objection in the only substantive communication that the description was not consistent with the claims then on file.

The appealed decision however does not deal with the question of whether the so amended description is consistent with the claims, but it simply reiterates the objections already made in the communication on the basis of a not yet amended version of the description, to conclude that lack of clarity results from an alleged inconsistency between the claims and "the description **as originally filed**" (emphasised twice in the decision, see paragraph 11). Obviously, the question of the clarity of the claims and of their support by the description should be decided on the basis of the documents of the application in the version in which grant is requested, not by comparing the valid claims with any earlier version of the description.

With respect to the objection of lack of novelty raised in the decision under appeal against independent claims 1 and 3, it is noticed that the added feature, according to which the polarizer means and analyzer means are located "directly" adjacent the transmitter and the receiver waveguide means, is first considered in the decision to offend against the provisions of Article 123(2) EPC as meaning that no air gap exists between the respective components (see paragraph 9.2 of the decision). Turning then to the question of the novelty of the subject-matter of the claims in view of the contents of document D7, the Examining Division on the contrary ignores the allegedly inadmissible limitation, to reiterate its reasoning in the earlier communication, to the effect that the feature is anticipated by the known presence of an air gap between the components (see point 12.2.2 of the decision).

Thus, in the Board's opinion, the questions of the proper interpretation, and of the admissibility, of the amendments brought by the appellant to the claims and description in response to the Examining Division's only substantive communication are central issues of the decision under appeal. That the appellant had no opportunity to comment on them constitutes a further substantial procedural violation within the meaning of Rule 67 EPC, in view of Article 113(1) EPC.

4. *Further prosecution*

In accordance with Article 10 of the Rules of Procedure of the Boards of Appeal, a Board shall remit a case to

the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise.

Several fundamental deficiencies are indeed apparent in the present case (see points 2 and 3 above).

The appellant as his main request himself requested that the application be sent back to the Examining Division for further prosecution, which the Board also deems appropriate in the present circumstances.

The appeal thus being deemed allowable, and reimbursement of the appeal fee being further considered equitable by reason of substantial procedural violations, such reimbursement as requested further by the appellant, shall be ordered in accordance with Rule 67 EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution on the basis of the application documents filed with letter dated 10 February 1997.
3. Reimbursement of the appeal fee is ordered.

The Registrar: The Chairman:

P. Martorana E. Turrini