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**D E C I S I O N**  
**of 19 November 1998**

**Case Number:** T 0345/98 - 3.4.1

**Application Number:** 92102974.0

**Publication Number:** 0504614

**IPC:** H01L 23/498

**Language of the proceedings:** EN

**Title of invention:**

Electrical connecting member and manufacturing method therefor

**Applicant:**

Canon Kabushiki Kaisha, et al

**Opponent:**

-

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 67, 71a, 86(3)

**Keyword:**

"Auxiliary requests filed during oral proceedings not admitted under Rule 71a EPC"

"Substantial procedural violation"

**Decisions cited:**

T 0153/85, T 0234/86, T 0155/88, T 0484/88, T 0079/89, T 0169/96

**Catchword:**

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Boards of Appeal

Chambres de recours

**Case Number:** T 0345/98 - 3.4.1

**D E C I S I O N**  
**of the Technical Board of Appeal 3.4.1**  
**of 19 November 1998**

**Appellants:**

Canon Kabushiki Kaisha  
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Ohta-ku  
Tokyo (JP)

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**Representative:**

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**Decision under appeal:**

**Decision of the Examining Division of the European Patent Office posted 13 November 1997 refusing European patent application No. 92 102 974.0 pursuant to Article 97(1) EPC.**

**Composition of the Board:**

**Chairman:** G. Davies  
**Members:** U. G. O. Himmler  
G. Assi

**Summary of Facts and Submissions**

I. European patent application No. 92 102 974.0 was refused by a decision of the Examining Division issued on 13 November 1997, following oral proceedings held on 3 July 1997, on the ground that the fourth auxiliary request filed during the oral proceedings, and which was the only request admitted into the proceedings out of eleven requests filed during the oral proceedings, did not involve an inventive step.

II. The applicants had been summoned to attend oral proceedings on 3 July 1997 with a letter "EPO Form 2008.1 11.95" of the Examining Division dated 24 January 1997. To this letter was attached a detailed communication comprising four sheets as well as an additional new citation D3 and giving the factual objections of the Examining Division concerning the patentability of the subject-matter of the application. On the cover sheet of the summons to oral proceedings "EPO Form 2008.1 11.95" a note was printed in bold letters

**"The final date for making written submissions and amendments (Rule 71a EPC) is  
 .....**"

and in handwriting the final date of 5 June 1997 was inserted.

III. With a letter filed on 5 June 1997 in preparation of the oral proceedings, the applicants requested the grant of a patent according to a main request with the

original claim 1 and first and second auxiliary requests with independent claims 1.

With a further letter in preparation of the oral proceedings filed on 25 June 1997, i.e. after the above-mentioned final date of 5 June 1997, the applicants filed 3 sets of claims: claims 1 to 11 as a main request, new claims 1 to 10 as the first auxiliary request and new claims 1 to 9 as the second auxiliary request. The applicants pointed out that the respective claims 1 of the respective requests fully corresponded to those filed with the letter of 5 June 1997 and that only reference numerals and correct delimitation against the closest prior art had been inserted. Moreover, each of the different requests had been completed by a set of dependent claims and independent method claims for manufacturing the device according to the respective independent apparatus claim 1.

IV. According to the minutes of the oral proceedings - page 1, second paragraph of the minutes - the first examiner expressed the Examining Division's view that according to Rule 71a EPC none of the requests filed on 25 June 1997 would be admitted into the proceedings as none of such requests appeared to lead to the grant of a patent having regard to the fact that prima facie these sets of claims comprised added subject-matter (Article 123(2) objection), did not comply with the requirement of unity of invention according to Article 82 EPC and had not been filed in time according to Rule 71a EPC, i.e. less than one week before the oral proceedings.

In reply, the applicants argued that Rule 71a EPC

concerns only submissions and not "amendments"; cf page 1, paragraph 5 of the minutes.

During the further course of the oral proceedings, the Examining Division expressed its intention - cf page 1, fourth paragraph of the minutes - not to admit into the proceedings the first and second auxiliary requests filed in time on 5 June 1997 on the basis of **Rule 86(3) EPC** (emphasis added by the Board).

The oral proceedings were interrupted "to allow the representative time to reformulate the request"; cf page 2, paragraph 3 of the minutes. After resumption of the oral proceedings, the applicants submitted a main request comprising the set of claims filed as main request with letter of 25 June 1997 and ten new auxiliary requests.

After deliberation, the chairman of the Examining Division informed the applicants that the Examining Division might decide not to accept one or more of these requests under **Rule 71a EPC** (emphasis added by the Board) and then asked the applicants to present arguments in favour of the requests. The applicants provided arguments in support of novelty, inventive step and unity of invention; in reply, the chairman summarised the Division's objections against the applicants' arguments.

After a further deliberation of the Examining Division, the chairman announced the decision to refuse the application according to Article 97(1) EPC since the subject-matter of the claims according to the fourth auxiliary request, which was the only one admitted into

the proceedings, lacked inventive step with respect to the cited prior art and the general abilities of the skilled person.

The main and first to third as well as the fifth to tenth auxiliary requests were not accepted on the basis of **Rule 71a(1) EPC** (emphasis added by the Board).

- V. Furthermore, also according to the decision in writing under "Summary of facts and submissions" - page 4, last paragraph to page 5, first paragraph - it is stated that, in exercising its discretion under Rule 71(a)(1) EPC, the Examining Division decided not to admit the main request and the first to third as well as the fifth to tenth auxiliary requests filed during the oral proceedings.

The minutes of the oral proceedings (cf sheet 2 of the EPO Form 2009.2) confirm that the Examination Division took the position that the Examining Division has a discretion under Rule 71a EPC whether or not to accept late-filed amendments, i.e. filed after the date indicated on "EPO Form 2008.1 11.95".

- VI. The applicants duly filed an appeal. The notice of appeal was filed on 14 January 1998 and the appeal fee was paid the same day. The grounds of appeal were filed on 13 March 1998 and the appellants requested that the decision of the Examining Division be set aside and a patent granted on the basis of a main request or a first, second or third auxiliary request. For each of these requests, the grounds of appeal included a set of documents comprising amended claims, an amended description and an amended set of drawings. The

appellants additionally requested that the appeal fee be refunded in accordance with Rule 67 EPC on the ground that the appealed decision was based on a substantial procedural violation. Finally, oral proceedings were requested in the event that neither the main request nor any of the auxiliary requests could be allowed. The appellants submitted arguments as to why, in its view, the subject-matter of the claims of the main request as well as of the auxiliary requests were allowable.

Further, the appellants submitted arguments in favour of the requested reimbursement of the appeal fee on the basis that an alleged substantial procedural violation had occurred during the oral proceedings. The essentials of this paragraph may be summarised as follows:

The appellants had drawn the Examining Division's attention to the fact that in its opinion Rule 71a(1) EPC was not applicable because it only applied to submissions. In the appellants' view, the Examining Division had exercised its discretion according to the wrong legal rule. Further the appellants were of the opinion that the approach of the Examining Division to refuse to admit all but one of the eleven requests filed in the oral proceedings on the basis of a prima facie consideration amounted to a wrongful application of Rule 71a EPC. The Division's approach would mean that an applicant would have no possibility of reacting to objections raised during oral proceedings by clarifying the claims or making amendments of a minor character. The rejection of a request on the sole ground that it was submitted late,



even if the amendments only represented minor clarifications of the claim is, in the appellants' view, not justified. In the appellants' view, the exercise of discretion to admit or refuse a new request is inadequately applied if the difference between the claim filed in time and the claim according to the new request lies in the insertion of reference numerals only.

### **Reasons for the Decision**

1. The appeal complies with the requirements of Article 106 to 108 and Rule 64 EPC and is, therefore, admissible.
  
2. It is the well-established case law of the Boards of Appeal that, in examination as well as in opposition proceedings, amendments to the text of an application or patent may be proposed in the form of main and one or more auxiliary requests (see Legal Advice 1584, OJ EPO 1984, 491; T 79/89, OJ EPO 1992, 283; T 234/86, OJ EPO 1989, 79; T 169/96 30 July 1996). An auxiliary request is a request which is contingent on the main request or any preceding auxiliary request being held to be unallowable (T 153/85, OJ EPO 1988, 1). When one or more auxiliary requests are filed in addition to the main request, the EPO is bound to these requests, and to their order. Before a decision can be made in relation to any auxiliary request, the main request and all preceding auxiliary requests must be examined and decided upon (Article 113(2) EPC; T 155/88, 14 July 1989 and T 484/88, 1 February 1989, both cited in Case

Law of the Boards of Appeal of the EPO; T 169/96 supra), so long as such preceding requests have not been withdrawn, and are therefore still pending (T 169/96 supra).

Thus, an applicant has a right to file one or more auxiliary requests in addition to a main request, and has a right to maintain all such requests (that is, not to withdraw or abandon them), even if the Examining Division indicates its view that all requests except one of those requests are inadmissible or unallowable. If the applicant does maintain such main and previous auxiliary requests in such circumstances, it is entitled to a reasoned appealable decision in respect of the rejection of each such request.

3. The regulations in the EPC governing amendments of a European patent application in proceedings before the European Patent Office are to be found in Article 123 and Rule 86 EPC which are entitled "Amendments" and "Amendment of the European patent application". Following receipt of the European search report and before receipt of the first communication from the Examining Division, the applicant may, of its own volition, amend the description, claims and drawings (Rule 86(2) EPC). After receipt of the first communication from the Examining Division, the applicant may, of its own volition, again amend once the description, claims and drawings in reply to the communication. Under Rule 86(3) EPC no further amendment may be made without the consent of the Examining Division. Whether or not that consent is given is at the discretion of the Examining Division and depends on the facts of the individual case, on the

nature of the grounds for seeking an amendment, and equally on the stage of the procedure. It is easier to secure an amendment at an earlier rather than at a later stage (cf. Singer, Lunzer edition, 123.05).

4. Rule 71a EPC is relevant to the procedural phase **prior** to oral proceedings; this follows clearly from the title of Rule 71a: "**Preparation** of oral proceedings" (emphasis added by the Board). Rule 71a(1) EPC obliges *inter alia* the Examining Division to draw the attention of the parties **in advance** of oral proceedings, when issuing the summons thereto, to the points which in its opinion need to be discussed for the purposes of the decision to be taken. At the same time a final date for making written submissions in preparation for the oral proceedings is fixed and, pursuant to Rule 71a(2), the parties may be invited to submit documents which meet the requirements of the Convention, including amendments to the description, claims and drawings. Indeed, in the present case, the Rule 71a communication of the Examining Division drew the attention of the applicants to the essential substantive questions and invited them to submit submissions and amendments.

New facts and evidence presented after the expiry of the time limit set with the communication according to Rule 71a(1) EPC need not be considered, unless admitted on the grounds that the subject of the proceedings has changed (Rule 71a(1), fourth sentence, EPC). This provision applies *mutatis mutandis* to amendments submitted after that date (Rule 71a(2), second sentence).

Thus, whereas Rule 86 EPC applies generally to the procedure after the search report has been drawn up, Rule 71a EPC is, in particular, applicable as regards the admissibility of written submissions or amended documents of the application within the time limit fixed according to the first paragraph of the rule. Thereafter, only Rule 86 EPC is applicable for the admissibility of amended documents as this rule applies generally to amendments of the European patent application. It should be noted that Rule 86 EPC has the function of preventing the procedure continuing indefinitely as a result of the applicant continually filing amended documents. On the other hand, the purpose of Rule 71a EPC is to avoid the Examining or Opposition Division being surprised by submissions or documents filed at the last moment before the oral proceedings.

5. Consequently, the Examining Division applied the wrong Rule of the EPC when not admitting the main request and the first to third as well as the fifth to tenth auxiliary requests filed during the oral proceedings. Such a wrong application of a regulation of the EPC constitutes a substantial procedural violation which justifies the reimbursement of the appeal fee and the remittal of the case to the Examining Division for further prosecution.
  
6. According to Rule 86(3) EPC, the admissibility of any main or auxiliary request which is filed after the reply to the first communication from the Examining Division is a matter within the discretion of the Examining Division. Such discretion must be exercised lawfully having regard to the relevant circumstances.

In a case such as the present, where the Examining Division had interrupted the oral proceedings in order to allow the applicants to reformulate their requests, i.e. to amend the text of the claims, it is difficult to imagine any circumstances in which it would be lawful for the Examining Division to admit one particular request, i.e. the fourth auxiliary request, and to deny the admissibility of all the other requests without giving any legal reasons for this particular selection. On the contrary, the choice made is completely arbitrary.

Under "II. Reasons for the decision", No. 4 , the Examining Division came to the conclusion that a *prima facie* consideration of the main request and the first to third as well as the fifth to tenth auxiliary requests revealed substantial deficiencies in these requests concerning added subject-matter (Article 123(2) EPC) and lack of unity of invention (Article 82 EPC). Therefore, these deficiencies "*render these requests inadmissible*"; cf page 13, paragraph 3 of the decision. In the Board's view, Article 123(2) and Article 82 EPC refer to substantive law and not to procedural regulations under which a request could be "*inadmissible*". However, from the point of view of substantive law an admissible claim might be found "not allowable".

The Board notes that the Examining Division had *de facto* admitted all eleven requests by carrying out, at least on a "*prima facie*" basis, a substantive examination for the main request and the first to third auxiliary requests (cf "II. Reasons for the decision",

No. 4.1) as well as for the fifth to tenth auxiliary request ("II. Reasons for the decision", No. 4.2). Such a substantive examination, which dealt extensively with the arguments put forward by the applicants in favour of substantive patentability (cf "II. Reasons for the decision", No. 4.3 and 4.4), is in clear contradiction to the conclusion that the requests are "inadmissible".

7. In view of the foregoing, the Board admits into the proceedings the main and the three auxiliary requests filed with the statement setting out the grounds of appeal.

However, as the applicants have a right to a "full" substantive examination by two instances, the Board comes to the conclusion that the decision under appeal must be set aside and makes use of its power under Article 111(1) EPC to remit the case to the first instance for further prosecution of the application. In these circumstances, oral proceedings before the Board are superfluous.

8. Furthermore, the Board considers that, in view of the substantial procedural violation (see points 4. and 5. above), it is equitable to refund the appeal fee, as provided for under 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 department of the first instance for further prosecution.
3. The appeal fee shall be reimbursed.

The Registrar:

The Chairman:

M. Beer

G. Davies