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**D E C I S I O N**  
**of 10 November 1999**

**Case Number:** T 1022/98 - 3.3.5

**Application Number:** 94303548.5

**Publication Number:** 0625492

**IPC:** C04B 35/48

**Language of the proceedings:** EN

**Title of invention:**

Dielectric ceramic material and method for making

**Applicant:**

TDK Corporation

**Opponent:**

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**Headword:**

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**Relevant legal provisions:**

EPC Art. 113(1)

EPC R. 67

**Keyword:**

"Refusal for lack of novelty despite announcement that  
examination was deferred"

"Violation of right to be heard - yes"

"Reimbursement of appeal fee - yes"

**Decisions cited:**

T 0951/92

**Catchword:**

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Boards of Appeal

Chambres de recours

**Case Number:** T 1022/98 - 3.3.5

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.5**  
**of 10 November 1999**

**Appellant:**

TDK Corporation  
13-1, Nihonbashi 1-chome  
Chuo-ku  
Tokyo  
JAPON

**Representative:**

Feakins, Graham Allan  
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**Decision under appeal:**

**Decision of the Examining Division of the  
European Patent Office posted 26 May 1998  
refusing European patent application  
No. 94 303 548.5 pursuant to Article 97(1) EPC.**

**Composition of the Board:**

**Chairman:** R. K. Spangenberg  
**Members:** M. B. Günzel  
M. M. Eberhard

## Summary of Facts and Submissions

- I. The appeal is from the decision of the Examining Division dated 26 May 1998 refusing European patent application No. 94 303 548.5 for lack of novelty.
- II. Prior to issuing said decision the Examining Division had, in a first communication, raised a novelty and inventive step objection. In a second communication, additionally to restating a novelty and inventive step objection, the amendments made by the Appellant were objected to under Article 123(2) and 84 EPC. In response the Appellant again filed amended claims. Should rejection of the application on any ground be envisaged the Appellant reserved its right to oral proceedings.

In a third communication the Examining Division pointed out that the last filed amendments introduced new subject-matter within the meaning of Article 123(2) EPC. The further discussion of novelty and inventive step was said to be deferred until the Article 123(2) EPC objection had been overcome. It was further pointed out that the wording used by the Appellant that it reserved its right to oral proceedings was not usually interpreted as a request for oral proceedings.

- III. In response the Appellant again filed amended claims, expressed its opinion that the objection under Article 123(2) had now been removed and that the examination of novelty and inventive step of the claimed invention could now be performed.

IV. As the next step the Examining Division issued the decision under appeal to refuse the application. The claims on file were said not to infringe Article 123(2) EPC, but were found not to relate to novel subject-matter.

V. On 24 July 1998 the Appellant lodged an appeal against this decision.

The Appellant submitted that the Examining Division was wrong in refusing the application without giving the Appellant the opportunity of arguing its case at oral proceedings. Moreover, in its last communication before the application was refused, the Examining Division had pointed out that discussion of novelty and inventive step was deferred until the objections under Article 123(2) EPC raised in said communication had been overcome. Thus the Appellant could have expected a telephone call or a further communication before a decision to refuse the application on the ground of lack of novelty or inventive step was taken. In all of the responses filed by the Appellant to the communications from the Examining Division the Appellant had made bona fide attempts to deal with the objections raised. As an auxiliary request, if on reconsideration of the history of prosecution of this application in the light of the current claims the Board would come to the conclusion that the Examining Division was correct in its refusal of the application, an amended set of claims was filed.

VI. The Board issued a communication informing the Appellant of its provisional opinion concerning the procedural issues raised and asked the Appellant to

clarify its requests in this respect.

- VII. In reply the Appellant requested that the case be remitted to the Examining Division and that the appeal fee be reimbursed.

### **Reasons for the Decision**

1. The decision under appeal has to be set aside. By refusing the application for lack of novelty without previously giving the Appellant a further opportunity to comment on this issue, with respect to the claims filed in response to the Examining Division's last communication, the Examining Division violated the Appellant's right to be heard within the meaning of Article 113(1) EPC, because in said last communication the Examining Division had expressly informed the Appellant that discussion on novelty and inventive step was deferred until the Article 123(2) objection had been overcome. The Appellant therefore was entitled to assume that it would still be given an opportunity to comment on these issues, should the Examining Division regard the objections under Article 123(2) EPC as having been removed, but still regard the amended claims as not being novel and/or inventive. It could not anticipate immediate refusal on the ground of lack of novelty or inventive step of the application on the basis of the set of claims filed after the Examining Division's last communication.

In the Board's judgement, Article 113(1) EPC is intended to ensure that before a decision refusing an

application for non-compliance with a requirement of the EPC is issued, the applicant has been clearly informed by the EPO so that he knows in advance of the decision both that the application may be refused as well as the essential legal and factual reasons on which such decision is based, (see also T 951/92 (OJ EPO 1996, 53, point 3(v)). Thus, the applicant's right to be heard is not only violated if the reasons on which refusal is based have not previously been communicated to the applicant as to their substance but also if, in the circumstances of the case under consideration, the applicant could not be aware that a decision based on such grounds was to be expected at all at the point in time when the decision was taken. Such is the case here. The refusal of the application for lack of novelty by the Examining Division's decision dated 26 May 1998 came as a surprise to the Appellant, because of the Examining Division's announcement in its last communication that discussion of novelty and inventive step was deferred.

It is therefore irrelevant in the present case whether or not the grounds for lack of novelty given in the decision under appeal are as to their substance the same as the ones already raised in the previous communications against the claims then on file. It is also irrelevant whether or not the Appellant's additional complaint that the Examining Division should have appointed oral proceedings before taking a decision is correct.

2. It follows from the above that not only must the appeal be allowed but that it is also equitable to reimburse the appeal fee by reason of a substantial procedural

violation having occurred within the meaning of 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 first instance for further prosecution.
3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

S. Hue

R. Spangenberg