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**D E C I S I O N**  
**of 10 April 2001**

**Case Number:** T 1101/99 - 3.3.7

**Application Number:** 95921830.6

**Publication Number:** 0762935

**IPC:** B01J 37/02

**Language of the proceedings:** EN

**Title of invention:**

FCC CATALYST COMPRISING COATED ZEOLITE PARTICLES

**Patentee:**

Akzo Nobel N.V.

**Opponent:**

W.R. Grace & Co.-Conn.

**Headword:**

Inspection of files/AKZO

**Relevant legal provisions:**

EPC Art. 128  
EPC R. 9(3)  
PCT Art. 38(1)  
PCT R. 94

**Keyword:**

"Delegation of duties to formalities examiners - rejection of file inspection not covered"

**Decisions cited:**

T 0114/82, J 0012/85, J 0038/97

**Catchword:**

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Case Number: T 1101/99 - 3.3.7

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.7**  
**of 10 April 2001**

**Appellant:** W.R. Grace & Co.-Conn.  
(Opponent) Grace Plaza, 1114 Avenue of the Americas  
New York, N.Y. 10036 (US)

**Representative:** van Heesch, Helmut Werner  
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**Respondent:** Akzo Novel N.V.  
(Proprietor of the patent) Velperweg 76  
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**Representative:** Schalkwijk, Pieter Cornelis  
AKZO NOBEL N.V.  
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**Decision under appeal:** Decision of the formalities officer acting for  
the Opposition Division of the European Patent  
Office posted 27 September 1999 concerning  
inspection of files of European patent  
No. 0 762 935.

**Composition of the Board:**

**Chairman:** R. E. Teschemacher  
**Members:** B. J. M. Struif  
R. J. Young

## Summary of Facts and Submissions

- I. European patent no. 0 762 935 was granted in response to European patent application no. 95 921 830.6 which was a Euro-PCT-application resulting from international application no. PCT/EP95/02131. The mention of the grant of the patent was published on 15 April 1998.
- II. Notice of opposition was filed on 15 January 1999. In a letter dated 27 January 1999, the Opponent requested inspection of files in respect of documents arising from international preliminary examination. On an earlier request, he had already received a copy of the international preliminary examination report (IPER). In addition, he requested copies of all other letters submitted by the applicant and communications from the International Preliminary Examining Authority (IPEA). In particular, he mentioned the first written opinion of the IPEA under Rule 66.2 PCT and any further correspondence.
- III. As a reason for the request, the Opponent submitted that such inspection was necessary in order to establish on which substantive basis, in particular on the basis of which technical information given by the applicant, the patent had been granted. Having entered the regional phase, a Euro-PCT application was a normal European application to which Article 128 EPC applied with the consequence that inspection of the complete file was available. This was not contrary to Article 38(1) PCT, since the restriction for inspection of files in this provision no longer applied once the IPER had been established.
- IV. In a decision, dated 27 September 1999 and allowing

separate appeal, a formalities officer acting for the Opposition Division rejected the request for file inspection. The reason given was that the relevant documents were not part of the public part of the file of the European patent application accessible by file inspection under Article 128(4) EPC. Nor was file inspection available under the PCT. In the present case Rule 94 PCT as in force before 1 July 1998 applied which provision did not oblige the elected Office to allow access to the documents relating to international preliminary examination.

- V. On 25 November 1999, a notice of appeal was filed, the prescribed fee being paid on the same day. In the statement of grounds of appeal filed on 18 January 2000, the Appellant (Opponent) elaborated his submissions made in first instance proceedings.
- VI. In a communication, the Board drew the parties' attention to the fact that the Opposition Division's decision had been given by a formalities officer whose responsibility for the contested decision seemed doubtful. A decision exceeding the powers transferred might entail remittal of the case. In addition, the Board noted that the Proprietor had not been given the opportunity to comment on the rejected request.
- VII. In reply, the Respondent (Proprietor) made clear that he did not authorize inspection of the documents relating to the international preliminary examination.
- VIII. The Appellant requested that the written opinion according to Rule 66.2 PCT and the responses thereto as well as further written opinions and responses be made available for inspection. Auxiliarily, in case the

requested documents were not parts of the file of the patent, he requested that the EPO inspects the files of the IPEA according to Article 38(1) PCT and makes available the obtainable information. The Respondent abstained from submitting a request.

## **Reasons for the decision**

### *Main request*

1. The Appellant's request is based on Article 128 EPC. Also the reasons for the request make clear that the request is not directed to the IPEA but to the EPO acting, after grant of the patent, outside its PCT functions. Hence, the provisions of the EPC apply. Accordingly, the decision under appeal was not given by the IPEA but by the Opposition Division with which opposition proceedings are pending (*Singer/Stauder*, 2nd ed., Köln 2000, Art. 128 EPC, pt. 14). The Opposition Division's decision, although not terminating proceedings, is subject to appeal (Article 106(1) and (3) EPC). The appeal fulfils the formal requirements and is, therefore, admissible.
2. The decision under appeal exceeds the competence of a formalities officer.
  - 2.1 The Notice of the Vice-President of Directorate-General 2 of the EPO concerning the entrustment to formalities officers of certain duties normally the responsibility of the Opposition Divisions of the EPO entrusts formalities officers with the duty of "granting of inspection of files in cases covered by Article 128(2) to (4) EPC" (Notice dated 28 April 1999, pt. 13, OJ EPO 1999, 506).

- 2.2 The term "granting of inspection" defines apparently only a positive decision, whereas in the decision under appeal the request for inspection was rejected.
- 2.3 There is no justification for giving the above delegation of duties an interpretation beyond its wording covering also the rejection of file inspection. This would be contrary to the terminology used elsewhere in the list of delegated duties. Where a delegation is intended to comprise a positive as well as a negative decision, this is made clear in the wording used. For example, pt. 12 delegates "decisions as to applications under Article 122(4) EPC ..." (see also pts. 6, 19, 20 and 21). Consistently, pt. 13 could be expected to read *decisions on requests for inspections of files* if it were intended also to comprise a negative decision. In addition, the purpose of the delegation speaks against an interpretation beyond its wording. Inspection of files is in the vast majority of cases a routine task, since the files of published applications are open to inspection without restriction with the consequence that inspection normally can be given without examining the individual circumstances of the case. Rule 9(3) EPC allowing the delegation of duties serves the purpose of relieving Examining and Opposition Divisions of duties not calling for legal or technical expertise. As illustrated by the situation in the present case, rejection of a request for inspection of files requires examination of the circumstances of the individual case and possibly interpretation of the relevant provisions or evaluation of conflicting interests. Such cases typically fall outside the scope of Rule 9(3) EPC restricting delegation to duties involving no technical or legal difficulties. As far as decision J 38/97

(dated 22 June 1999, not published in OJ EP0, Reasons, pt. 2) may be understood differently it has to be noted that the decision is concerned with a different problem. It does not deal with the extent of delegation of the duties of the Opposition Division in its full composition (Article 19(2) EPC) to the formalities officer on the basis of Rule 9(3) EPC but rather with the question of the entitlement of a DG 2 Director to decide on a matter within the responsibility of the Opposition Division.

3. Pursuant to Article 10 of the Rules of Procedure of the Boards of Appeal, a Board shall normally remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings. This principle applies to a decision of the formalities officer exceeding the powers transferred on the basis of Rule 9(3) EPC (T 114/82, OJ EPO 1983, 323). In the absence of any comments of the parties on this possible conduct of proceedings mentioned in the Board's communication, the Board makes use of the possibility of remitting the case pursuant to Article 111(1) EPC.
  
4. In accordance with established case law, it amounts to a substantial procedural violation if a decision is taken by a formalities officer who was not competent to decide (See the decisions cited in Case Law of the Boards of Appeal of the EPO, 3d. ed. 1998, VII.D.15.4.6, p. 518 of the English version). Considering that the Appellant has not obtained a review in substance of the decision under appeal, reimbursement of the appeal fee in accordance with Rule 67 EPC appears equitable.



*Auxiliary request*

5. As far as the auxiliary request can be understood to relate to a subject different from the main request, there is no decision under appeal which has dealt with such subject. To this extent the request cannot be subject of these appeal proceedings (Article 106(1) EPC; cf J 12/85, OJ EPO 1986, 155).

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division for further prosecution.
3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

C. Eickhoff

R. Teschemacher