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D E C I S I O N
of 10 March 2004

Case Number: T 0922/02 - 3.2.3

Application Number: 93870232.1

Publication Number: 0614709

IPC: B09B 3/00, E21B 43/26
E21B 43/00

Language of the proceedings: EN

Title of invention:
In-situ remediation of contaminated soils

Applicant:
MONSANTO COMPANY

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 113(1)

Keyword:
"Right to be heard after remittal to the first instance - no"

Decisions cited:
T 0892/92, T 0120/96

Catchword:
-



Case Number: T 0922/02 - 3.2.3

D E C I S I O N
of the Technical Board of Appeal 3.2.3
of 10 March 2004

Appellant:
(Applicant)

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Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 18 December 2001
refusing European application No. 93870232.1
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: C. T. Wilson
Members: U. Krause
J. P. B. Seitz

Summary of Facts and Submissions

- I. The appeal contests the decision of the Examining Division dated 18 December 2001 to refuse European patent application No. 93 870 232.1 for lack of novelty in view of document DE-A-4 112 893.

- II. The appealed decision is the second decision taken by the Examining Division with respect to this application. In appeal proceedings following a first refusal dated 3 April 1998 for lack of clarity of the claims the Board decided, with its decision T 876/98 dated 16 August 2001, that the amended claims submitted by telecopy on 29 January 2001 met the requirement of clarity, and remitted the case to the first instance for further prosecution. Thereafter the appealed decision was taken without any intervening communication with the Applicant.

- III. The Applicant (hereinafter denoted Appellant) filed the notice of appeal on 18 February 2002 and paid the appeal fee on the same day. The statement of the grounds of appeal was received on 16 April 2002 and included two further sets of claims according to auxiliary requests I and II.

- IV. The Appellant requests to set aside the decision under appeal and to grant a patent on the basis of the claims of the main request or of auxiliary requests I or II. Further, reimbursement of the appeal fee and, should the Board decide to remit the case to the first instance, a possibility of responding to at least one further official communication is requested.

The Appellant points out that, since the novelty objection was raised in the appealed decision for the first time, it has not been given an opportunity to present its comments on this issue and, therefore, has been deprived of its right to be heard under Article 113 EPC. Any objections raised so far during the examination before the first and second instances related to the problem of clarity which was finally resolved by amendment of the claims. Even if particular comments made by the Examining Division were considered to touch upon the issue of novelty, those comments concern the original claims, rather than the amended claims underlying the appealed decision. Further, the Examining Division could not simply presuppose that the Appellant was not willing to limit the claims if necessary, since the Appellant clearly demonstrated its willingness to introduce appropriate limitations by having filed the amended claims of the main request.

Further arguments of the Appellant relate to potential substantive differences between the invention and the subject-matter disclosed in document DE-A-4 112 893.

Reasons for the Decision

1. The appeal complies with the provisions of Articles 106 to 108 EPC and of Rules 1(1) and 64 EPC and is, therefore, admissible.
2. The main objection raised by the Appellant against the appealed decision concerns a violation of the right to be heard as stipulated in Article 113(1) EPC. In fact, the right to be heard is a fundamental provision

governing all proceedings before the EPO, and its violation would not only warrant the reimbursement of the appeal fee, as requested by the Appellant, but also the remittal to the first instance according to Article 111(1) EPC and Article 10 RPBA. It will, therefore, have to be determined whether the right to be heard was observed, before proceeding to the question whether the decision on novelty was justified on its merits.

3. Article 113(1) EPC provides that the decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. In the present case the appealed decision was based on a lack of novelty with respect to document DE-A-4 112 893. Therefore, the provisions of Article 113(1) EPC require that, before taking a decision on novelty which adversely affects the Appellant, the Appellant was notified, before taking the final decision, of this novelty objection and invited, as often as necessary (Article 96(2) EPC), to present its comments thereon.

4. Concerning such a notification reference is made, in points "14" and "6" of the appealed decision, to earlier statements made by the Examining Division during the first instance proceedings before interruption by the earlier appeal proceedings, and by the Appeal Board during the earlier appeal proceedings. The Board wishes to emphasise that, irrespective of whether or not the statements in question refer to the same novelty objection, the provisions of Article 113(1) are only complied with, in a case where the decision is taken after remittal for further prosecution, if the

notification and invitation is made after the remittal, typically by announcing the resumption of the proceedings, setting out the objections, if any, and asking the Appellant whether or not it wishes, within a fixed period of time, to present its comments or modify its request(s). Otherwise any final decision would come as a surprise to the Appellant, which is contrary to the principle of good faith and fair hearing established by Article 113(1) EPC. The Board follows in this respect the jurisprudence developed in decisions T 892/92 (OJ 1994, 664, see point 2.1 of the reasons) and T 120/96 (not published, see "Case Law" 4th edition, VII.C.2.4), for opposition procedures, which however is equally applicable to examination procedures because the right to be heard is an essential procedural principle governing both procedures.

It is evident that if, as in the present case, the appealed decision is taken immediately after remittal to the first instance, without any intervening communication informing the Appellant of the novelty objection based on document DE-A-4 112 893, the provisions of Article 113(1) are not complied with.

5. Furthermore, it is observed that the earlier statements made by the Examining Division and by the Appeal Board referred to in points "14" and "6" of the appealed decision do not clearly relate to a novelty objection based on document DE-A-4 112 893.

In point "14" of the appealed decision a quotation from item 2 of the reasons for the Examining Division's first decision to refuse the application was made. Since this decision terminated the proceedings before

the first instance at that time no opportunity was provided for the Appellant to comment on the findings in item 2. Furthermore, item 2 mentioned some features common to claim 1 and to document DE-A-4 112 893 but has to be seen in combination with the following item 3 where it was made clear that "desired effects" defined in claim 1 were not derivable from this document, and "effect no. 3" was raising a clarity objection because the claim lacked information, in the form of essential features, as to how this effect should be achieved. Thus, the statements in item 2 formed the basis for a clarity objection leading to the first decision of the Examining Division. A corresponding objection was raised in the consultation by telephone dated 15 October 1997 (see points 1.3 and 1.4) and in point 2 of the communication dated 23 May 1997, to which the appealed decision made reference in point "6" of the reasons. It is, therefore, evident that no clear novelty objection based on document DE-A-4 112 893 was made during the examination before the first instance, and that the Appellant had neither a reason nor an opportunity to comment on such an objection.

In point "6" of the appealed decision reference was made to item 4 of the communication dated 14 November 2000 issued by the Board of Appeal during the earlier appeal proceedings. In this paragraph the Board commented on some features defined in claim 1 and their relation to document DE-A-4 112 893 without, however, drawing any conclusions as to novelty. Since the Board did not have to, and in fact indicated in the following item 5 that it did not wish to, decide on the issue of novelty, the comments in item 4 could not be understood by the Appellant as an invitation to present its

comments on novelty. In any case, the obligation to give the Appellant an opportunity to comment on grounds forming the basis of an adversely affecting decision relates to the proceedings which are eventually terminated by such a decision, in this case to the proceedings before the first instance, and cannot be transferred to the separate appeal proceedings.

6. For the reasons set out in above points 4 and 5 it is concluded that the Appellant did not have an opportunity to present its comments on the grounds for refusal of the application, either after the remittal of the case to the first instance, as necessary, or at any time before interruption of the proceedings before the first instance by the first appeal proceedings. Thus, the first instance proceedings terminating in the appealed decision were not in conformity with the provisions of Article 113(1) EPC, constituting a substantial procedural violation within the meaning of Rule 67 EPC. Therefore, the appeal must be allowed to the extent that the appealed decision is set aside. Further, since the appeal was clearly motivated by this substantial procedural violation, the reimbursement of the appeal fee is considered equitable.

7. Regarding the further prosecution of the application the Board has decided, as foreseen by Article 10 PRBA, to exercise its power under Article 111(1) EPC and to remit the application once more to the first instance for substantive examination as to novelty and inventive step in order to give the Appellant the opportunity to have these issues considered by two instances.

The Board wishes to point out that due attention should be paid, during the further prosecution before the first instance, to the principles of a fair procedure and the right to be heard, in order to avoid any further lengthening of the examination. In particular, it will have to be ensured that the Appellant is given an opportunity of establishing its requests and of commenting on any relevant grounds with regard to the issues of novelty and inventive step, as requested.

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:

A. Counillon

C. T. Wilson