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**Datasheet for the decision  
of 17 July 2008**

**Case Number:** T 1422/04 - 3.4.03

**Application Number:** 99942386.6

**Publication Number:** 1048084

**IPC:** H01L 31/06

**Language of the proceedings:** EN

**Title of invention:**

Organic photosensitive optoelectronic device

**Patentee:**

THE TRUSTEES OF PRINCETON UNIVERSITY

**Opponent:**

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**Headword:**

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**Relevant legal provisions (EPC 1973):**

EPC Art. 113(2),  
EPC R. 67, 68(2), 51(4)  
RPBA Art. 11

**Keyword:**

"Substantial procedural violation (yes)"  
"Reimbursement of appeal fee (yes)"

**Decisions cited:**

T 1255/04, T 1356/05

**Catchword:**

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Case Number: T 1422/04 - 3.4.03

**D E C I S I O N**  
of the Technical Board of Appeal 3.4.03  
of 17 July 2008

**Appellant:** THE TRUSTEES OF PRINCETON UNIVERSITY  
P.O. Box 36  
Princeton, NJ 08544-0636 (US)

**Representative:** Beetz & Partner  
Steinsdorfstraße 10  
D-80538 München (DE)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 7 July 2004  
refusing European application No. 99942386.6  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** R. G. O'Connell  
**Members:** R. Q. Bekkering  
U. Tronser

## Summary of Facts and Submissions

- I. This is an appeal against the refusal of European patent application 99 942 386.6 for lack of an agreed text (Article 113(2) EPC 1973).
- II. At oral proceedings before the examining division the applicant requested grant of a patent on the basis of a main claim request or first or second auxiliary claim requests.

In a communication pursuant to Rule 51(4) EPC 1973 the applicant was informed that the examining division intended to grant a patent on the basis of the text as per the applicant's second auxiliary request on file (with an amendment by the examining division to page 47 of the description). Annexed to this communication was a brief statement of the reasons for not allowing the higher ranking main and first auxiliary requests.

In reply to this communication, the applicant stated:

*"(1) Statement of Disapproval:*

*We state herewith that we do not approve the text, and the drawings, communicated to us with the communication under Rule 51(4) EPC of 20 February 2004.*

*(2) No Suggestion of Amendments:*

*We state herewith that we do not suggest amendments to the text and drawings communicated to us with the communication under Rule 51(4) EPC of 20 February 2004.*

(3) *Request for Decision open to Appeal:*

*We request herewith to issue a decision which is open to appeal."*

The examining division reacted by issuing on 7 July 2004 a "*Decision to refuse the European patent application (Article 97(1) and Rule 51(5) EPC)*".

The reasons for the decision state:

*"Following the communication under Rule 51(4) dated 20.2.04, the Office on 24.6.04 received the applicant's express declaration of non-approval of the text proposed for grant of the European patent, but no amendments to the claims, description or drawings have been submitted. There is thus no text to serve as a basis for the grant of a European patent (Article 113(2) EPC), and the application does not therefore meet the requirements of the Convention (Article 97(1) EPC)."*

III. The appellant applicant requests that the decision under appeal be set aside and a patent granted on the basis of a main request comprising newly drafted claims or an auxiliary request corresponding to the main claim request referred to at point II above.

## Reasons for the Decision

1. The appeal is admissible.
2. Article 113(2) EPC 1973 provides that the EPO shall consider and decide upon the European patent application only in the text submitted to it, or agreed, by the applicant for the patent.
3. The applicant's three claim requests were admitted into the proceedings by the examining division and examined for compliance with the relevant formal and substantive requirements of the EPC.

In its reply to the Rule 51(4) communication the applicant (now appellant) stated his disapproval of the examining division's proposal, ie the grant of a patent on the basis of the second auxiliary request.

However, the applicant's agreement within the meaning of Article 113(2) EPC 1973 to the text of the application documents in the versions according to the main and first auxiliary requests was left unaltered.

It follows that the examining division's finding that *"there is thus no text to serve as a basis for the grant of a European patent (Article 113(2) EPC)"* was incorrect thus vitiating the factual and legal reasons given in its refusal decision.

The correct procedure to be followed by the examining division under these circumstances would have been to issue a fully reasoned decision refusing the higher ranking, viz main and first auxiliary requests pursuant

to Article 97(1) EPC 1973 (see also Guidelines EPO, C-VI, 15.4a (June 2005); Legal Advice no. 15/05 (rev. 2) (OJ EPO 2005, 357), point 1.5(b)); T 1255/04 (OJ 2005, 424)).

4. For the avoidance of doubt it is emphasised that the annex to the Rule 51(4) communication giving brief reasons why the application document's versions according to the higher ranking requests were not allowable did not constitute a decision pursuant to Article 97(1) EPC 1973. Furthermore, Rule 68(2) EPC 1973 stipulates that a decision open to appeal shall be reasoned.

As pointed out in an earlier decision (T 1356/05, reasons 2) in principle the function of the appeal proceedings is to give a judicial decision on the correctness of the contested decision of the department of first instance. A reasoned decision meeting the requirements of Rule 68(2) EPC 1973 issued by the department of first instance is thus a prerequisite for the examination of the appeal pursuant to Article 110 EPC.

This has particular relevance in the present case where the application documents according to the auxiliary request on appeal correspond to those of the main request disregarded in the decision under appeal.

5. The issue of a decision to refuse the application for the counterfactual reason of alleged lack of a text agreed by the appellant within the meaning of Article 113(2) EPC 1973 and the consequential failure to issue a reasoned decision on the main and first

auxiliary requests constitute a *substantial procedural violation* within the meaning of Rule 67 EPC 1973 and a *fundamental deficiency* within the meaning of Article 11 RPBA.

Having regard to Article 11 RPBA, the board considers it appropriate to remit the case to the department of first instance pursuant to Article 111(1) EPC 1973 for further prosecution on the basis of the main and first auxiliary requests made at oral proceedings before the examining division.

The appeal fee shall be reimbursed pursuant to Rule 67 EPC 1973, since the appeal is allowed to the extent that the decision under appeal is set aside and since reimbursement is equitable as the applicant had to file this appeal for a reasoned decision on his requests to be issued.

**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.
3. The appeal fee shall be reimbursed.

Registrar:

Chair:

S. Sanchez Chiquero

R. G. O'Connell