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**Datasheet for the decision
of 14 November 2008**

Case Number: T 0408/08 - 3.2.04

Application Number: 03742555.0

Publication Number: 1476007

IPC: A01D 34/00

Language of the proceedings: EN

Title of invention:
Ecological lawnmower

Applicant:
MA.RI.NA Systems S.r.l.

Headword:
-

Relevant legal provisions:
RPBA Art. 11

Relevant legal provisions (EPC 1973):
EPC Art. 113(1)
EPC R. 67

Keyword:
"Right to be heard"
"New prior art cited by the examining division during oral proceedings"
"Substantial procedural violation (yes)"
"Remittal (yes)"

Decisions cited:
T 0951/97, T 0376/98

Catchword:
-



Case Number: T 0408/08 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 14 November 2008

Appellant: MA.RI.NA Systems S.r.l.
(Applicant) Via F. Baracca 3
I-24034 Cisano Bergamasco (IT)

Representative: Riccardi, Sergio
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 12 October 2007
refusing European application No. 03742555.0
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: M. Ceyte
Members: A. de Vries
C. Heath

Summary of Facts and Submissions

I. The Appellant lodged an appeal, received at the EPO on 11 December 2007, against the decision of the Examining Division notified 12 October 2007, refusing the European patent application no. 03 742 555.0 filed as international patent application PCT/EP03/01691, and simultaneously paid the appeal fee. The grounds of appeal were submitted 4 February 2008.

II. The Examining Division held that the application did not meet the requirements of Articles 52(1) and 56 EPC having regard to the following documents

D1: US-A-4 870 811

D2: EP-A-1 107 074

A copy of D2, cited by the primary examiner during oral proceedings held 27 September 2007 before the examining division, was attached to the decision.

III. In a telephone consultation with the rapporteur on 15 October 2008 the appellant indicated that at the oral proceedings before the examining division D2 was briefly presented to him during the discussion of a proposed claim combination. No copy was provided at the time, nor were the proceedings adjourned at this point. He did however retrieve the document immediately after the proceedings. He was informed of the Board's preliminary opinion that the examining division in basing its decision on the new document for which he was not given sufficient opportunity to comment may have violated his right to be heard under Article 113(1) EPC. Should this be so, it would be necessary to consider remittal of the case with reimbursement of the appeal fee (Article 11 RPBA), without prejudice to the

merits of the case. The appellant stated that he had no objections against such a course of action.

- IV. The Appellant requests that the decision under appeal be set aside, and, with the grounds of appeal submits a set of claims.

As a subsidiary request, he requests oral proceedings.

Reasons for the Decision

1. The appeal is admissible.
2. *Substantial Procedural Violation*
 - 2.1 Article 113(1) EPC (in its 1973 version applicable at the time of oral proceedings and issuance of the written decision) enshrines a party's right to be heard (as explicit in the heading of the same Article in its 2000 version). Thus "decisions ... may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments". Where, for example, a new document is first cited by the examining division in oral proceedings, this basic procedural right will have been observed if the applicant is given an adequate amount of time to study the document and present comments, see e.g. T 0951/97 (OJ EPO 1998, 440) or T 0376/98. This is analogous to the procedure set out in the Guidelines for Examination in the EPO, E-III, 8.6, final paragraph of page III-7, when pertinent new facts or evidence are admitted during opposition oral proceedings.

2.2 The decision, in the section headed "2. Article 56 EPC" of the reasons, on page 3, argues lack of inventive step of the two main differences i) and ii) over D1 in reference to D2 : "it is apparent from paragraph [0016] of EP-A-1 107 074 - cited by the primary examiner during oral proceedings, a copy of which is annexed to the present decision - that a standard method of producing tubular pipes and conduits is by means of cold-drawing through a circular die". D2, and specifically paragraph [0016], is thus cited in the decision as evidence of the fact that drawing tubular pipes (of the frame) is standard.

2.3 The minutes of the oral proceedings, see section 3, fifth and sixth paragraphs, state that D2 was cited in the context of a discussion of a proposed claim combination:

"[the applicant] proposes the combination of claims 1 and 3 including an appropriate drawing die.

The first member of the examining division explains that such an appropriate drawing die is already known from EP-A-1 107 074".

Inspection of the file confirms that this document had not been mentioned previously in the procedure.

The minutes do not record an adjournment of the proceedings or any other opportunity afforded the appellant-applicant to study D2 and present comments. In the telephone consultation of 15 October 2008 with the rapporteur the appellant-applicant confirms that he was neither provided with a copy nor that the proceedings were adjourned (only after the proceedings did he retrieve D2 from the internet to ascertain its contents).

- 2.4 The fact that at the oral proceedings the appellant-applicant was not given an opportunity to present his comments on D2, which is relied upon as evidence of lack of inventive step in the decision, can but lead the Board to conclude that the appellant-applicant's right to be heard under Article 113(1) EPC was violated.
- 2.5 A comparison of the minutes and the decision further reveals a change in the facts and evidence relied on by the division in its reasoning regarding inventive step. The minutes, see section 3, first paragraph, indicate that the difference over the closest prior art of D1 of making a frame from drawn steel was considered well-known procedure ("the first member argues that the fact that stainless steel is unpainted and that the frame is made from drawn steel is a well known procedure in the state of the art") without citing any particular further prior art. In contrast, the decision, in the passage mentioned above relies on a specific, hitherto unmentioned paragraph of D2 to demonstrate that it is standard to cold-draw tubular pipes from a circular die. The examining division appears to acknowledge this shift in that it considers it appropriate to now provide a copy to the appellant-applicant by annexing a copy of D2 to the decision, see page 2 of the cover sheet (EPO Form 2007) under "enclosures". The fact that the decision thus now relies on new evidence, in the form of paragraph [0016] of D2, where neither that passage, nor in fact D2, had played a role before, compounds the examining division's violation of the right to be heard. It is in no way mitigated by the belated provision of a copy of D2 with the decision.

2.6 As the decision is fundamentally flawed in its non-observance of a fundamental procedural right the Board is compelled to set it aside without any consideration of the merits of the appeal.

3. *Remittal and reimbursement of the appeal fee*

3.1 According to Article 11 of the Rules of Procedure of the Boards of Appeal of the EPO (RPBA) in their current version, see OJ EPO 2007, 536, "[a] Board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise". As the violation of a party's basic right to be heard in the Board's view represents a fundamental deficiency, and, moreover, no special reasons to decide otherwise are apparent, the Board decides to remit the case to the department of first instance. Such remittal shall be without prejudice to the merits of the case. Examination should then proceed by affording the appellant-applicant an opportunity to comment on D2.

3.2 By reason of the substantial procedural violation the Board also finds it equitable to reimburse the appeal fee according to the provision of Rule 67 EPC 1973.

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 first instance for further prosecution.
3. The appeal fee is to be reimbursed.

The Registrar

The Chairman

G. Magouliotis

M. Ceyte