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**Datasheet for the decision
of 26 July 2012**

Case Number: T 1540/11 - 3.3.10

Application Number: 03076151.4

Publication Number: 1358892

IPC: A61L 15/18

Language of the proceedings: EN

Title of invention:

Absorbing agent composition, absorbent material, and absorbent product containing absorbent material

Applicant:

NIPPON SHOKUBAI CO., LTD.

Headword:

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Relevant legal provisions:

EPC Art. 113(2)
EPC R. 137(3)

Keyword:

"Correct exercise of discretion by the Examining Division under Rule 137(3) EPC"

Decisions cited:

T 1064/04, G 0007/93

Catchword:

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Case Number: T 1540/11 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 26 July 2012

Appellant: NIPPON SHOKUBAI CO., LTD.
(Applicant) 1-1, Koraibashi 4-chome
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Osaka-shi, Osaka 541 (JP)

Representative: Müller - Hoffmann & Partner
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 24 January 2011
refusing European patent application
No. 03076151.4 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: P. Gryczka
Members: J. Mercey
D. S. Rogers

Summary of Facts and Submissions

- I. The present appeal lies from the decision of the Examining Division to refuse European patent application No. 03076151.4.

- II. The Examining Division, pursuant to Rule 137(3) EPC, refused to admit into the proceedings a main and an auxiliary request filed with letter dated 11 March 2010 and received after a communication under Rule 71(3) EPC informing the Applicant of the text in which it was intended to grant a patent. Thus there was no agreed text (Article 113(2) EPC) and the application was refused under Article 97(2) EPC.

- III. Together with the Grounds of Appeal dated 23 May 2011, the Applicant (the Appellant) requested that a patent be granted upon the basis of a main request, or alternatively, upon the basis of an auxiliary request. The main request consisted of claims 1 to 7, and was identical to the main request filed with letter dated 11 March 2010. The auxiliary request consisted of claims 1 to 29, claim 1 of which was identical to claim 1 of the auxiliary request filed with letter dated 11 March 2010, consisting of 31 claims.

- IV. In its summons, the Board informed the Appellant that the sole issue to be discussed during the oral proceedings was whether the Examining Division had properly made use of its discretion under Rule 137(3) EPC by not admitting the requests filed with letter dated 11 March 2010 into the proceedings, and indicated that its preliminary opinion was that the Examining Division had indeed correctly used its discretion.

V. The Examining Division indicated in its decision that the Applicant had had sufficient opportunity to amend its case and sufficient time to prepare for the oral proceedings held before the Division on 28 September 2009 ("the First Oral Proceedings"). At the end of the First Oral Proceedings, the Examining Division announced that it intended to grant a patent on the basis of the main request filed during said proceedings. Claim 1 of each of the later two sets of claims received with letter dated 11 March 2010, and after a communication under Rule 71(3) EPC, differed *inter alia* from claim 1 on the basis of which the Examining Division intended to grant a patent in that the feature "wherein the absorbent resin is formed by heating [....] particles having a diameter smaller than 106 µm" was omitted, said feature having been previously added in order to overcome an objection under Article 83 EPC. The amendments proposed were, hence, substantive amendments which called into question the outcome of the earlier procedure. The conditions for accepting late amendments defined in the decision G 7/93 were, therefore, not met. The Examining Division took into account both the right of the Applicant to a valid patent and the interest of the EPO in bringing the examination to a close, and after a further communication summoning to oral proceedings, which were held on 20 December 2010 ("the Second Oral Proceedings"), it decided not to admit either of the sets of claims according to the main and first auxiliary request filed with letter dated 11 March 2010 into the proceedings.

- VI. In its letter dated 26 June 2012, the Appellant argued that the Examining Division was not precluded from reopening examination proceedings up to the moment at which the decision was handed over to the internal postal service, and cited the Guidelines for Examination in the EPO, C-VI, 14.4. It further argued that the discretion of the Examining Division should have been exercised taking into consideration all relevant factors, including the right of the Appellant to a patent which is legally valid in all of the designated states. The application related to a complex invention, which justified the filing of the new sets of claims and remittal to the first instance. Since the Appellant could not file further divisional applications, the sets of claims filed after the communication under Rule 71(3) EPC were its last possibility to obtain a valid patent for the invention.
- VII. In response to the summons of the Board to oral proceedings to be held on 26 July 2012, the Appellant withdrew its request for oral proceedings and requested a decision based on the state of the file.
- VIII. With letter dated 24 July 2012, the Appellant confirmed its request that the decision should be set aside and a patent be granted according to the main or auxiliary request filed with letter dated 23 May 2011.
- IX. At the end of the oral proceedings, which were held in the absence of the Appellant, the decision of the Board was announced.

Reasons for the Decision

1. Although the admissibility of the appeal is questionable since the statement of the grounds for appeal does not challenge the reasons for refusing the application given in the decision under appeal, it is not necessary to decide on this issue since the appeal is not allowable.

Main request

2. The decision under appeal deals solely with the refusal under Rule 137(3) EPC of the Examining Division to admit into the proceedings the two requests received after issuance of the communication under Rule 71(3) EPC. The main request filed with this appeal is identical to the main request not admitted by the Examining Division. Thus, the question to be decided is whether this refusal of the main request was based on an appropriate exercise of the discretion given in this respect to the Examining Division under Rule 137(3) EPC.
3. Guidance on the principles to be applied can be derived from the Enlarged Board of Appeal decision G 7/93 (OJ EPO 1994, 775), as summarised in decision T 1064/04 (not published in OJ EPO):
 - (a) Until the issue of a decision to grant the patent, the examining division has a discretion under Rule 137(3) EPC whether or not to allow the amendment of the application at a late stage (G 7/93, point 2.1).

- (b) The examining division is required to exercise its discretion considering all relevant factors, in particular the applicant's interest in obtaining a patent which is valid in all designated states, and the EPO's interest in bringing examination to a close, and must balance these against one another (G 7/93, points 2.2 and 2.3).

- (c) Allowing a request for amendment at a late stage of the examination proceedings during which the applicant has already had at least one opportunity to amend the application, and after the examining division has already completed substantive examination thereof, will be an exception and not the rule (G 7/93, point 2.3).

- (d) It is not the function of a board of appeal to review all the facts of the case as if it were in the place of the first instance department in order to decide whether or not it would have exercised the discretion in the same way. Rather, a board of appeal should only overrule a first instance exercise of discretion if it comes to the conclusion either that the first instance department has not exercised its discretion correctly as set out in (b) above, or has exercised its discretion in an unreasonable way, and thus exceeded the proper limits of its discretion (G 7/93, point 2.6).

4. In the present case, the proceedings before the Examining Division involved two communications according to Article 94(3) EPC, after each of which the Appellant filed amended claims, a detailed summons to

attend the First Oral Proceedings, in response to which new claims were presented to the Examining Division, and a Second Oral Proceedings before it, during which a new main request was filed. At the end of the First Oral Proceedings, the Examining Division intended to grant a patent on the basis of claims 1 to 18 of the main request filed during said proceedings and a description adapted thereto. This was confirmed in a communication under Rule 71(3) EPC dated 2 November 2009. From this sequence of events, the Board concludes that the Appellant had several opportunities to amend the application and it did so, and that the substantive examination had been completed by the Examining Division.

5. The purpose of oral proceedings should be to settle as far as possible all outstanding questions relevant to the decision. A late stage of the examination proceedings had thus been reached at the end of the First Oral Proceedings, and any amendments thereafter were to be considered under the principles derivable from decision G 7/93 as set out in point 3 above.

6. As stated in the decision under appeal, the Examining Division exercised its discretion under Rule 137(3) EPC to refuse to allow into the proceedings the main request filed after the communication under Rule 71(3) EPC because this would have required re-opening of the examination proceedings in relation to matters already thoroughly discussed during these proceedings.

The Examining Division explained in its decision that the claims of the main request which the Appellant sought to introduce into the proceedings omitted *inter*

alia one feature which had been added previously to claim 1 in order to overcome objection under Article 83 EPC. The Board agrees with the Examining Division that the amendments proposed are substantive, in the sense that they call into question the outcome of the First Oral Proceedings and, if taken into account, would have necessitated a substantive re-examination of the application and thus a delay in the closure of the examination procedure.

In addition, the validity of the claims upon which the Examining Division intended to grant a patent following the First Oral Proceedings, as mentioned in the communication under Rule 71(3) EPC, had never been called into question by the Appellant.

Thus, the Examining Division took into consideration the Appellant's interest in obtaining a valid patent and the EPO's interest in bringing the examination to a close. The Board concludes that the Examining Division has, hence, followed the principles set out in G 7/93 as explained in paragraph (b) above, and considered all relevant factors as defined in G 7/93 in its decision not to admit the new main request.

7. The Board concludes, therefore, that the Examining Division exercised its discretion under Rule 137(3) EPC in a reasonable manner by not admitting the set of claims of the main request filed with letter dated 11 March 2010 into the proceedings.
8. The Appellant argued that the present application was very complex, not only due to its subject-matter, but also since it was a divisional application (of

EP 96306263), and because together with the summons to the First Oral Proceedings, the Examining Division introduced 32 additional documents which had been cited in the opposition proceedings concerning the parent application. Further divisional applications could no longer be filed, such that the Appellant had no further option other than the present proceedings to obtain a valid patent. For these reasons the present case was an exceptional situation in which reopening of the examination proceedings by the Examining Division was justified.

9. The Board is of the view that the complexity of the case rather supports the decision of the Examining Division not to admit a request at a very late stage of proceedings, which had already involved two communications of the Examining Division and oral proceedings before it. In fact, admitting the set of claims put before it at that late stage would have led, in view of the complexity of the case, to re-starting the examination on complex substantive issues, with the consequence of unduly lengthening the proceedings.

Auxiliary request

10. The decision of the Examining Division not to admit into the proceedings the auxiliary request filed with letter dated 11 March 2010 received after issuance of the communication under Rule 71(3) EPC was also based on the fact that substantive amendments had been made to claim 1 thereof (see point V above). The Board holds that the Examining Division correctly used its discretion in not admitting the auxiliary request into

the proceedings, for the same reasons given above for the main request.

11. Claim 1 of the present auxiliary request is identical to claim 1 of the auxiliary request (see point III above) which the Examining Division refused to admit. The Board thus exercises its discretion under Rule 137(3) EPC to not admit this request into the proceedings for the same reasons given by the Examining Division in the contested decision for not admitting the very similar auxiliary request filed before it.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

C. Rodríguez Rodríguez

P. Gryczka