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Datasheet for the decision of 5 February 2016

Case Number: T 2424/13 - 3.5.07

Application Number: 05250979.1

Publication Number: 1580896

IPC: H03M13/03, H03M13/11

Language of the proceedings: EN

Title of invention:
Encoding method and encoding apparatus

Applicant:
Sony Corporation

Headword:
Encoding method/SONY

Relevant legal provisions:
EPC R. 111(2), 103(1)(a)
RPBA Art. 11

Keyword:
Substantial procedural violation - appealed decision sufficiently reasoned (no)
Remittal to the department of first instance - (yes)
Reimbursement of appeal fee - (yes)

Decisions cited:

Catchword:

Europäisches Patentamt
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Case Number: T 2424/13 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 5 February 2016

Appellant: (Applicant)	Sony Corporation 1-7-1 Konan Minato-ku Tokyo (JP)
Representative:	D Young & Co LLP 120 Holborn London EC1N 2DY (GB)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 18 July 2013 refusing European patent application No. 05250979.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	R. Moufang
Members:	M. Rognoni
	R. de Man

Summary of Facts and Submissions

I. The appellant (applicant) appealed against the decision of the Examining Division to refuse European patent application no. 05250979.1.

II. As specified in the "Facts and Submissions", the decision of the Examining Division had been carried out on a main request and on a first and second auxiliary requests. However, the "Reasons" for the refusal dealt only with claims 1 and 5 of the main request.

III. In the statement of grounds of appeal, the appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the application documents to the main request on which the contested decision was based, or alternatively, on the basis of the first or second auxiliary request corresponding to the first and second auxiliary requests on which the decision was based. In the event that the Board was minded to agree with the Examining Division and not to set aside the contested decision based on the main request, oral proceedings were requested.

With respect to the first and second auxiliary requests the appellant furthermore observed that there was no reasoning presented in the Examining Division's decision as to why the auxiliary requests had been refused. For the appellant it was therefore not clear how to respond to the decision to refuse to grant a patent on the basis of these requests.

IV. In a communication dated 3 July 2015, the Board informed the appellant that, given the circumstances of the present case, it was inclined not to deal with any substantive issues, but to set aside the decision under

appeal, remit the case to the department of first instance and order the reimbursement of the appeal fee. Thus, the appellant was asked to specify whether it wished to maintain the request for oral proceedings only to discuss the proposed remittal of the case.

V. In reply to the Board's communication, the appellant informed the Board by letter dated 22 July 2015 that it agreed with the proposed remittal of the case to the Examining Division and declared that it did not wish for oral proceedings before the Board for the sole purpose of discussing this issue. Hence, the appellant formally withdrew the request for oral proceedings, particularly with respect to the issue of discussing the remittal of the case to the department of first instance. However, for the avoidance of doubt, the appellant maintained the request for oral proceedings before the Examining Division in the event that it intended to refuse the application.

Reasons for the Decision

1. The appeal is admissible.

2. Pursuant to Rule 111(2) EPC, decisions of the EPO open to appeal shall be reasoned. In accordance with the case law of the boards of appeal, the reasoning given in a decision open to appeal has to enable the appellants and the board of appeal to examine whether the decision was justified or not. A decision should therefore discuss in detail the facts, evidence and arguments which are essential to the decision (see "Case Law of the Boards of Appeal of the European Patent Office" 7th edition 2013, III.K.4.2.1).

3. The contested decision refers in the "Facts and Submissions" (item XI.) to a main request and first to third auxiliary requests filed with letter dated 29 March 2012. As stated in item XII. of the decision, the first auxiliary request was withdrawn during the oral proceedings of 9 May 2012 and the second and third auxiliary requests were renumbered as first and second auxiliary requests, respectively. Hence, the application documents, on which the *"decision is being carried out*", comprise a main request and first and second auxiliary requests (cf. item XII. of the decision).

3.1 In the *"Reasons"*, however, the decision deals exclusively with independent claims 1 and 5 of the main request and does not even include a cursory reference to the claims of the auxiliary requests.

3.2 Hence, although it appears from the minutes of the oral proceedings held on 9 May 2012 that the Examining Division took into account the applicant's auxiliary requests, the first instance decision does not give any reason as to why the Examining Division came to the conclusion that a patent could not be granted on the basis of the first or second auxiliary request.

4. The Examining Division's failure to deal with the first and second auxiliary requests in the decision and to provide adequate reasoning under Rule 111(2) EPC for their rejection is to be considered a substantial procedural violation and a fundamental deficiency of the first instance proceedings.

5. In these circumstances, the Board finds it appropriate to remit the case to the department of first instance pursuant to Article 11 RPBA and to order the

reimbursement of the appeal fee, which in accordance with Rule 103(1)(a) EPC is found to be equitable by reason of the procedural violation and the ensuing remittal.

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 reimbursed.

The Registrar: The Chairman:

D. Magliano R. Moufang

Decision electronically authenticated