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**Datasheet for the decision
of 27 February 2018**

Case Number: T 1922/17 - 3.2.06

Application Number: 12188076.9

Publication Number: 2545795

IPC: A41D13/005, A41D31/00, D04H1/00

Language of the proceedings: EN

Title of invention:
Method of forming adaptive insulation

Applicant:
The Boeing Company

Headword:

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

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

Decisions cited:

G 0009/91, T 1182/05, T 1997/08, T 0177/15, T 0963/02

Catchword:



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Case Number: T 1922/17 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 27 February 2018

Appellant: The Boeing Company
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Representative: Witte, Weller & Partner Patentanwälte mbB
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 15 March 2017
refusing European patent application No.
12188076.9 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman M. Harrison
Members: T. Rosenblatt
J. Hoppe

Summary of Facts and Submissions

- I. The appellant (applicant) filed an appeal against the decision of the examining division, dated 15 March 2017 refusing European patent application No. 12188076.9.

- II. In its reasoning, the examining division cited its communication dated 2 November 2015 in which it had stated that the application did not meet the requirements of the European Patent Convention and that the applicant had been informed of the reasons therein. It further stated that "The applicant filed no comments or amendments in reply to the latest communication ...".

- III. The communication dated 2 November 2015 was based on
 - the description filed with telefax on 1 April 2015, pages 1-4, 6, 8-17, 19
 - the description filed with telefax on 31 August 2015, pages 5, 5a, 7, 18
 - claims 1 and 2 filed with telefax on 30 July 2014
 - the drawings as originally filed.

- IV. In this communication of 2 November 2015, the examining division objected that the requirements of Article 84 EPC were not met because the text in the description relating to fibres was "deliberately intended to mislead the reader as to the actual scope of protection of the present application". The applicant's attention was drawn to the Guidelines for Examination (November 2014 version) F-IV 4.3 with the explanation that adaptation of the description to the amended claims had to be performed carefully in order to avoid inconsistencies between the claims and the description/drawings which could render the scope of the claims unclear. Further, the examining division stated that

any disclosure in the description and or drawings inconsistent with the amended subject-matter should normally be excised, and that reference to embodiments no longer covered by the amended claims had to be deleted, unless these embodiments could reasonably be considered useful for highlighting specifics of the amended subject-matter. It also stated that, in such a case, the fact that an embodiment was not covered by the claims had to be prominently stated.

- V. In reply to that communication, the applicant filed a new description on 1 March 2016. Subsequent to this, the examining division informed the applicant with its communication under Rule 71(3) EPC, dated 5 July 2016, that it intended to grant a patent on the basis of claims 1 and 2, filed with telefax on 30 July 2014 together with the description
- pages 1, 5, 6 and 9-12 as originally filed
 - page 2 filed with telefax on 27 January 2014
 - pages 7, 8 and 13-15 filed with telefax on 30 July 2014
 - pages 3, 4 and 16 filed with telefax on 1 March 2016 and originally filed drawings, sheets 1/8-8/8.
- The examining division noted that it had amended certain description pages to adapt the description to the claims, citing Article 84 EPC as the reason therefor.
- VI. The applicant however did not accept the amendments to the description made by the examining division. Instead, with its letter dated 4 November 2016, the applicant requested grant of a patent based on claims 1 and 2 submitted with telefax on 30 July 2014 and further requested replacement of the description proposed for grant by amended description pages 1-15.

- VII. On 28 November 2016 a member of the examining division called the applicant by telephone. Afterwards, with a communication dated 8 December 2016, the examining division stated that the application did not meet the requirements of the EPC "for the reasons given in the enclosed copy of the result of consultation by telephone on 28 November 2016". A copy of the result of the telephone consultation was annexed to the communication dated 8 December 2016. In this copy it was stated that "The Examining Division does not approve the proposed amendments to the description filed on 04-11-2016" and that "As per the applicant's request the next step will be the issuance of an appealable decision." The examining division additionally noted that "There is currently a request for oral proceedings on file. The applicant is invited to either confirm or withdraw this request."
- VIII. The applicant withdrew its request for oral proceedings on 24 February 2017 and requested that a decision be taken "on the basis of the documents on file". Subsequently the examining division issued the decision under appeal on 15 March 2017.
- IX. With its grounds of appeal, the appellant requested that the decision of the examining division dated 15 March 2017 be set aside, and that issuance of a communication under Rule 71(3) EPC be ordered in accordance with the main request as submitted with the grounds of appeal or alternatively according to any of the 1st, 2nd, 3rd or 4th auxiliary requests. As an auxiliary measure, oral proceedings were requested.
- X. With its communication under Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA) dated 4 December 2017, the Board gave its preliminary view

concerning an apparent failure by the examining division to provide adequate reasoning in the appealed decision in accordance with Rule 111(2) EPC having regard to the documents which were on file at the time of refusing the application. The Board also stated its intention to remit the case to the examining division because of this.

- XI. With letter dated 10 January 2018 the appellant withdrew its request for oral proceedings and requested remittal of the case to the examining division.

Reasons for the Decision

1. **Necessity to provide adequate reasoning in a decision**
- 1.1 Rule 111(2) EPC embodies the general principle of law that appealable decisions must be reasoned. It states inter alia: "Decisions of the European Patent Office which are open to appeal shall be reasoned". The function of appeal proceedings is to give a judicial decision upon the correctness of a separate earlier decision (G 9/91, OJ 1993, 408, reasons 18; T 1182/05, reasons 3). The reasoning given in a decision open to appeal has to enable appellants and the Boards of Appeal to examine whether the decision was justified or not. In other words, it is not up to the Board or the appellant to speculate as to what might be the intended meaning behind the reasoning. A reasoned decision meeting the requirements of Rule 111(2) EPC is accordingly also a prerequisite for the examination of the appeal (see also T 1182/05, reasons 3).

A failure to provide adequate reasoning in a decision in accordance with Rule 111(2) EPC is to be considered a substantial procedural violation justifying the reimbursement of the fee for appeal (see e.g. Case Law Book, 8th edition IV.E.8.4.4).

- 1.2 After the withdrawal of the request for oral proceedings, the examining division issued a decision, noting that the applicant had requested a decision according to the state of the file.

Nevertheless a request for a decision on the state of the file cannot be construed as a waiver of the right to a reasoned decision, because the content and rationale of Rule 111(2) EPC, to enable appellants and the Boards of Appeal to examine whether the appealed decision was justified, also applies to this procedural constellation.

2. **Requirements for adequate reasoning**

- 2.1 It is the consistent case law of the Boards of Appeal that a "reasoned" decision should deal with all important issues of dispute and therefore must include considerations in respect of the factual aspects of the case to enable the Board to assess, on the basis of the reasoning given in the decision under appeal, whether the conclusion drawn in the appealed decision was justified or not. In particular, final decisions have to take account of documents received in response to EPO communications (see also T 1997/08, reasons 4.4) which can be comments and/or requests. These requirements are not fulfilled in the present case.

2.2 The reasoning in the decision under appeal does not state any specific objections justifying the refusal of the application.

Instead the decision mentions the communication dated 2 November 2015 by stating that the applicant had been informed of the reasons why the application does not meet the requirements of the EPC therein. The communication dated 2 November 2015 had been reasoned as regards the amendments in the description made by the applicant, but this reasoning was based on description pages 1-4, 6, 8-17 and 19 submitted by the applicant on 1 April 2015, as well as pages 5, 5a, 7 and 18 submitted on 31 August 2015. Thus, this communication did not take into account the latest amendments in the description made by the applicant with its letter dated 4 November 2016 which included pages 1 to 15 and did not only contain minor amendments compared to the former versions.

As the communication dated 2 November 2015 is not based on the latest request of the applicant, particularly with regard to the amended description filed on 4 November 2016, the reference to this communication cannot be accepted as sufficient reasoning underlying the appealed decision.

2.3 In the appealed decision the examining division further states that the "applicant had not filed comments or amendments in reply to the latest communication". This wording however does not provide a clear and precise reference to any reasoning in the "latest communication". But even if this were interpreted as being an implicit reference to the reasoning in the communication dated 8 December 2016, which at that stage was the "latest" communication on file, this

would mean that the appealed decision referred to two different communications: the communication dated 2 November 2015 and the communication dated 8 December 2016 each dealing with different amendments of the description. Hence the Board would still have had to examine both communications each dealing with different amendments in the description, for facts, arguments and provisions to ascertain which reasons might have justified the refusal of the application. This would leave it to the Board to speculate as to which reasons would still apply to the request on file at the time the decision was taken. This is found to be at odds with the principle that, for a decision to be reasoned according to Rule 111(2) EPC, it must be self-contained (T 177/15, reasons 4, 5; T 963/02, reasons 2.1).

Moreover, a decision that is merely reasoned by reference to a preceding communication only provides sufficient reasoning if the communication itself fulfils the conditions of Rule 111(2) EPC (see e.g. T 963/02, reasons 2.1). This is not the case here because it is not possible to derive specific reasoning either from the communication dated 8 December 2016 itself or from the copy annexed to it, in which the results of the telephone call made by one of the examiners on 28 November 2016 was minuted.

In the communication dated 8 December 2016 itself no specific objections were addressed at all. In the annexed copy that minuted the telephone call it is merely stated that "The Examining Division does not approve the proposed amendments to the description filed on 04-11-2016". Thus, even though the examining division apparently addressed the amendments of 4 November 2016 in the telephone call on 28 November

2016 (n.b. the appellant has not disputed this), no information as to the specific objections (facts, arguments or provisions) is given in the annexed copy dated 8 December 2016.

- 2.4 Sufficient reasoning for the appealed decision also cannot be found in the communication dated 5 July 2016. First of all, no specific reference to this communication has been made in the decision under appeal. It is neither mentioned explicitly nor is it implied by the reference to the "latest communication" which at that stage had not been the communication dated 5 July 2016 but that dated 8 December 2016. More importantly, this communication did not take into account the amendments that had been made by the applicant in the meantime with its letter dated 4 November 2016.

3. **Substantial procedural violation**

- 3.1 Even though the Board recognises that the examining division spent time and effort, on several occasions, to make clear to the appellant which amendments to the description were not acceptable in order to bring the description into consistency with the amended claims, the failure to provide adequate reasoning in the decision in accordance with Rule 111(2) EPC results, however, in a substantial procedural violation.

The Board cannot examine the appealed decision without speculating if the reasons given in the communication dated 2 November 2015 relating to the description dated 1 April 2015 and 31 August 2015 also apply in some way to the description pages filed on 4 November 2016 that were filed to replace former descriptions. As stated by the

Board in its communication under Article 15(1) RPBA (see item 3.1 thereof), and notwithstanding the Board's own comments made under item 3.2 of that same communication, the Board is not even in a position to know whether the decision was ultimately based on a failure to meet the requirements of Article 84 EPC as had been the case with earlier amendments (and, if so, for what reasons precisely) or indeed whether possibly some other aspect had led to the refusal.

Thus, insufficient reasoning is present in the decision under appeal since there is no reasoning based on the latest version of the description which was on file. This therefore constitutes a substantial procedural violation.

- 3.2 Due to the foregoing, and as no special reason is apparent to do otherwise, the case is to be remitted to the examining division for further prosecution (Article 11 RPBA).
- 3.3 Further, by reason of the procedural violation, it is equitable to reimburse the appeal fee (Rule 103(1)a) EPC).

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 is reimbursed.

The Registrar:

The Chairman:



M. H. A. Patin

M. Harrison

Decision electronically authenticated