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**Datasheet for the decision
of 13 March 2023**

Case Number: T 1456/22 - 3.4.01
Application Number: 16763200.9
Publication Number: 3345016
IPC: G01S17/10, G01S13/22, G01S15/10
Language of the proceedings: EN

Title of invention:

REMOTE SENSING BY PERIODICALLY INHIBITED PULSE SIGNALS

Applicant:

Kerber, Thierry

Headword:

Delay of grant / Kerber

Relevant legal provisions:

EPC Art. 111(1), 113(1)
EPC R. 11(3), 103(1)(a)
RPBA 2020 Art. 11

Keyword:

Substantial procedural violation - violation of the right to
be heard (yes) - higher-ranking request overlooked (yes)
Reimbursement of appeal fee (yes)
Remittal to the department of first instance (yes)



Beschwerdekammern

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Case Number: T 1456/22 - 3.4.01

D E C I S I O N
of Technical Board of Appeal 3.4.01
of 13 March 2023

Appellant: Kerber, Thierry
(Patent Proprietor) 75014 Paris (FR)

Representative: Kerber, Thierry
65, rue de la Tombe Issoire
75014 Paris (FR)

Decision under appeal:

Composition of the Board:

Chairman P. Scriven
Members: A. Medeiros Gaspar
D. Rogers

Summary of Facts and Submissions

- I. The appellant sought to defer a decision on grant, as it wished to wait until the UPC system was in effect, which would then give it the option of requesting the grant of a unitary patent ("UP"). The Examining Division did not defer grant and made a decision, dated 5 November 2021, granting the patent. It is against this decision that the appellant appeals.
- II. The appellant requests that the decision under appeal be set aside, that the case be remitted to the Examining Division for further consideration of its request to defer grant, and the reimbursement of the appeal fee due to a substantial procedural violation.
- III. In a communication, the Board expressed its preliminary opinion (Article 17(2) RPBA 2020). The relevant sections of that communication read:

5. *In a letter dated 15 October 2021, the appellant made a request to the Examining Division that: "...the patent granting be postponed until the entry into force of the UPC Agreement...". It set out various reasons why it was making such a request. This can be considered to be the appellant's main request before the Examining Division. The auxiliary request of the appellant was set out in the last paragraph of its 15 October 2021 letter, "Only if the present deferment request is*

refused, the Applicant requests that a European patent be granted anyway...".

6. *The Formalities Officer of the Examining Division responded to this request in a letter dated 28 October 2021. This rejected the request to postpone the patent granting until the entry into force of the UPC Agreement. The request was rejected because there was no certainty as regards the date on which the new Unitary Patent system would start. In addition the request for unitary effect for the patent application was not accepted as a UP could only be requested for a European patent granted on or after the entry into force of the UPC Agreement.*

7. *In a letter dated 2 November 2021, the appellant noted that the Examining Division's 28 October 2021 letter did not have the form of a decision and was signed by a Formalities Officer rather than the Examining Division. The appellant therefore "...respectfully applies for an effective EPO decision on his grant deferment request for having a least a chance to file an appeal upon Art. 106(1) EPC, if need be...".*

8. *A few days later, on 5 November 2021, the Examining Division issued a decision to grant a European patent. This decision made no reference to the appellant's request to defer grant.*

9. *The duties of an Examining Division that can be entrusted to a Formalities Officer are set out in the decisions of the President of the EPO dated 12 December 2013 (OJ January 2014, A6), 23 November 2015 (OJ December 2015, A104) and 14 June 2020 (OJ June 2020, A80). The power to make a decision whether or not to defer grant does not appear in these decisions of the President. Thus the letter of the Formalities Officer dated 28 October 2021, to the extent it is a decision, was made ultra vires.*

10. *The Examining Division's decision to grant of 5 November 2021 contains no reference whatsoever to the appellant's request to defer grant. It is difficult to avoid the impression that the Examining Division was entirely unaware of the deferral request and its rejection by the Formalities Officer. Nevertheless, it is an implicit rejection of this request that is entirely unreasoned.*

11. *The Board considers the ultra vires action of the Formalities Officer, and the failure to provide any reasoning in the grant decision as to why the appellant's main request for deferment was refused, to be a substantial procedural violation.*

12. *The Board is thus presently minded to set aside the decision under appeal, to reimburse the appeal fee, and to remit the*

case to the Examining Division for further prosecution.

- IV. In reply to this communication, the appellant expressed its agreement with the preliminary opinion of the Board and proposed that a decision on the violation of the right to be heard under Article 113(1) EPC be taken.

Reasons for the Decision

1. After further consideration, the Board sees no reason to depart from its preliminary opinion.
2. The communication of 28 October 2021 set out why the request for delay could not be allowed. It was not a decision, but nevertheless, in sending it, the Formalities Officer acted beyond the powers entrusted under Rule 11(3) EPC (OJ January 2014, A6; OJ December 2015, A104). A communication of this nature should have been sent by the Examining Division itself, setting a clear date for the applicant to respond (Article 113(1) EPC).
3. The fact that the decision to grant overlooked the higher-ranking request for deferment was a further procedural violation, namely a further breach of the applicant's right to be heard under Article 113(1) EPC.
4. Given the causal relationship between the procedural violations and the need to appeal, special reasons exist justifying remittal of the case to the Examining Division for further prosecution, along with grounds

for reimbursing the appeal fee (Article 111(1) EPC and Rule 103(1) (a) EPC, Article 11 RPBA 2020).

5. The appellant's and the Examining Division's attention is called to the recent decisions of the President of the EPO concerning the forthcoming introduction of the unitary patent (OJ November 2022, A102, A104, A105).

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 Chair:



D. Meyfarth

P. Scriven

Decision electronically authenticated