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**Datasheet for the decision  
of 15 April 2026**

**Case Number:** T 0861/25 - 3.4.02

**Application Number:** 21162268.3

**Publication Number:** 3885805

**IPC:** G02B6/02, G02B6/036, G02B6/44

**Language of the proceedings:** EN

**Title of invention:**  
REDUCED DIAMETER OPTICAL FIBER WITH IMPROVED MICROBENDING

**Applicant:**  
Corning Incorporated

**Headword:**  
Optical fiber/CORNING

**Relevant legal provisions:**  
EPC Art. 111(1), 113(1)  
EPC R. 103(1) (a)  
RPBA 2020 Art. 11

**Keyword:**

Right to be heard - examination procedure - substantial  
procedural violation (yes)

Reimbursement of appeal fee - (yes)

Appeal decision - remittal to the department of first instance  
(yes)

**Decisions cited:**

T 0951/92



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0

Case Number: T 0861/25 - 3.4.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.4.02**  
**of 15 April 2026**

**Appellant:** Corning Incorporated  
(Applicant) 1 Riverfront Plaza  
Corning, New York 14831 (US)

**Representative:** Arnold & Siedsma  
Bezuidenhoutseweg 57  
2594 AC The Hague (NL)

**Decision under appeal:** **Decision of the Examining Division of the European Patent Office posted/electronically transmitted on 14 January 2025 refusing European patent application No. 21162268.3 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** R. Bekkering  
**Members:** A. Hornung  
G. Decker

## Summary of Facts and Submissions

- I. The present appeal lies against the decision of the examining division refusing patent application No. 21 162 268.3.
- II. Claim 1 as originally filed reads as follows (numbering F1, F2 etc. added by the board):
- "(F1) A multicore optical fiber comprising:  
(F2) a first core comprising silica glass doped with an alkali metal;  
(F3) a first inner cladding surrounding the first core;  
(F4) a first outer cladding surrounding the first inner cladding and comprising a first trench region having a volume of about 30% $\Delta$ -micron<sup>2</sup> or greater;  
(F5) a second core comprising silica glass doped with an alkali metal;  
(F6) a second inner cladding surrounding the second core;  
(F7) a second outer cladding surrounding the second inner cladding and comprising a second trench region having a volume of about 30% $\Delta$ -micron<sup>2</sup> or greater; and  
(F8) a common cladding surrounding the first core and the second core,  
(F9) wherein the first core and the second core each has an effective area at 1550 nm of 100 micron<sup>2</sup> or less."*
- III. In point 3.1 of its communication pursuant to Article 94(3) EPC dated 18 April 2023 (hereinafter "C1"), the examining division identified F9 as the sole distinguishing feature of original claim 1 over document D2 (US 2013/0243381 A1) and raised an objection of lack of inventive step starting from

document D2. In point 3.1.3 of communication C1, the examining division argued as follows:

*"Even if multicore optical fibers of D2 are designed to have an effective area at 1550 nm of at least 120 micron<sup>2</sup>, the disclosure of D2 shows a number of designs wherein an effective area of the cores at 1550 nm is 'about 100 micron<sup>2</sup> or less' (e.g. down to 30 micron<sup>2</sup> by simply varying the core to core distance  $\Delta$  in Figs. 3,4; down to 'about 100 micron<sup>2</sup> or less' by varying  $R_a=a/b$  in Figs. 16,44,72, or by varying  $\Delta\%$  in Figs. 20,47,75)."*

In point 3.2 of communication C1, the examining division raised an objection of lack of inventive step concerning dependent claims 2 to 15, arguing as follows:

*"Given the closest prior art D2 ..., the additional multicore optical fibre features introduced by dependent claims 2-15 are either disclosed by D2 (e.g. claims 2,4) or are merely some of several straightforward possibilities from which the skilled person would select, in accordance with circumstances, without the exercise of inventive skill. There appears to be no surprising or synergetic effect resulting from the implementation of any of these additional features."*

IV. In reply to communication C1, the applicant filed a new set of claims where the following feature F10, corresponding to original dependent claim 15, was added at the end of claim 1:

*"(F10) wherein the first core and the second core each has a mode field diameter in a range from about*

*9 microns to about 9.5 microns at 1310 nm and in a range from about 10 microns to about 10.5 microns at 1550 nm."*

To support its opinion that the subject-matter of amended claim 1 involved an inventive step over document D2, the applicant argued as follows:

*"None of the cited art either alone or in any combination, discloses the combination of features of amended claim 1.*

*D2 (US 2013/0243381) fails to disclose the claimed mode field diameter. D2 is silent regarding mode field diameter.*

*Furthermore, the skilled person would not have modified D2 to have the same mode field diameter as claimed. The properties of an optical fiber are the result of the precise and careful balancing of the design of the fiber. The smaller effective area of the claimed fiber allows the fiber to have a reduced diameter, which advantageously allows for increased fiber count in submarine cables, for example. Furthermore, the claimed optical fiber has a sufficiently larger trench volume so that the fiber has reduced radiation loss without sacrificing mode field diameter.*

*D2 is not directed to a fiber that comprises an effective area of 100 micron<sup>2</sup> or less at 1550 nm. Instead, D2 is directed to fibers with an effective area of at least 120 micron<sup>2</sup> (see claim 1 of D2), which is outside of the claimed range.*

*The skilled person would not have been motivated to modify not only the effective area but also the mode field diameter of the optical fibers of D2".*

The applicant did not request oral proceedings.

- V. Subsequently, the examining division issued the decision under appeal. In points II.1.1 and II.1.1.1 of the decision, features F9 and F10 were identified as distinguishing over document D2. In point II.1.1.3, the examining division reiterated, *verbatim* and almost *verbatim* respectively, the reasoning already set out in points 3.1.3 and 3.2 of communication C1 as regards the absence of an inventive step based on features F9 and F10. Furthermore, in point II.2.1 of the decision, the examining division reproduced *verbatim* the applicant's arguments in support of inventive step submitted in reply to communication C1 (see point IV. above) and addressed those arguments in point II.2.2 of the decision.
- VI. The applicant (hereinafter "the appellant") lodged an appeal against the decision of the examining division. With the statement setting out the grounds of appeal, the appellant filed a new main request and auxiliary requests I to XIII. "*Without acquiescing to the merits of [the examining division's objection of lack of inventive step against claim 1 of the then sole request]*" (see statement of grounds of appeal, page 7, first paragraph), the appellant added a further feature to claim 1 of the new main request, which was based on paragraph [0031] of the application as filed.
- VII. The appellant requested as a main request that the appeal fee be reimbursed and the case be remitted to the examining division for further examination on the basis of the main request and auxiliary requests I to XIII filed with the statement setting out the grounds of appeal, or alternatively, that the appeal fee be reimbursed, the decision under appeal be set aside and a patent be granted on the basis of the main request or any one of auxiliary requests I to XIII. The

appellant further requested that oral proceedings be held if the main request was not granted.

- VIII. In support of its request for remittal of the case to the examining division and for reimbursement of the appeal fee, the appellant essentially submitted that the examining division had acted contrary to the principle of good faith when refusing the application.

### **Reasons for the Decision**

1. *Main request - remittal of the case to the examining division for further prosecution*
- 1.1 Under Article 111(1), second sentence, EPC, a board of appeal may remit the case to the department of first instance for further prosecution if the appeal is allowable. Under Article 11 RPBA, the board should not remit a case to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so. As a rule, fundamental deficiencies which are apparent in the proceedings before that department constitute such special reasons.
- 1.2 Fundamental deficiencies in the first-instance proceedings - violation of the principle of good faith
- 1.2.1 The appellant submitted that, in communication C1, the examining division had merely provided a very general indication that the subject-matter of claims 2 to 15 was either disclosed or would be selected by the skilled person without any inventive skill. In response, the appellant amended the claims and

submitted detailed arguments as to why the amended claims involved an inventive step. The examining division then issued a refusal, in which it provided for the first time substantiated reasoning as to why the amended claims lacked an inventive step. The appellant argued that issuing a refusal in examination proceedings without affording it an opportunity to respond substantively to arguments raised for the first time in the refusal amounted to a lack of good faith. In its view, the examining division should have reacted substantively to the amendments in written proceedings.

- 1.2.2 The principle of good faith (or the principle of the protection of legitimate expectations; see Case Law of the Boards of Appeal of the European Patent Office, 11th edition, 2025 (hereinafter "CLBA"), III.A.1) invoked by the appellant implies that measures taken by the EPO should not violate the reasonable expectations of parties. It requires that users of the European patent system must not suffer a disadvantage as a result of having relied on erroneous information or a misleading communication received by the EPO. It also requires the EPO to warn the applicant of any loss of right if such a warning can be expected in good faith.
- 1.2.3 None of the circumstances referred to in the preceding point applies in the present case. Rather, in accordance with the established case law of the boards of appeal, it lies within the examining division's discretion to decide whether to issue a further invitation to present comments pursuant to Article 94(3) EPC. The examining division does not exceed the limit of this discretion by refusing the application immediately, provided that the right to be heard under Article 113(1) EPC is observed.

- 1.2.4 In the present case, and in the absence of a request for oral proceedings by the appellant, the examining division was therefore not prevented, on the basis of the principle of good faith, from issuing an immediate refusal following the appellant's reply to communication C1. It is, however, a separate question whether the examining division was precluded from doing so by the requirements of the right to be heard.
- 1.2.5 The board notes that it is not detrimental to the appellant's case that no explicit objection based on an alleged violation of the right to be heard was raised. It is sufficient that the appellant sets out the relevant factual circumstances. It is for the board to determine the legal consequences arising therefrom on the basis of those facts (*da mihi factum, dabo tibi ius*).
- 1.3 Fundamental deficiencies in the first-instance proceedings - violation of the right to be heard
  - 1.3.1 To comply with a party's right to be heard under Article 113(1) EPC, a decision may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. "Grounds or evidence" under Article 113(1) EPC are to be understood as meaning the essential legal and factual reasoning on which the decision is based (see CLBA, III.B.2.4.2, and the references cited there). An applicant must be informed of the essential legal and factual reasons on which the finding of non-compliance is based, so that they know in advance of the decision both that the application may be refused and why it may be refused, and so that they may have a proper opportunity to comment upon such reasons and/or to propose amendments so as to avoid refusal of the

application (see e.g. T 951/92, OJ EPO 1996, 53, Headnote I).

- 1.3.2 In response to communication C1, the appellant filed a new set of claims, in which it added to claim 1 the additional feature F10 taken from original dependent claim 15. In addition, it submitted detailed arguments as to why this new claim 1 met the requirements of inventive step over document D2 (see point IV. above).
- 1.3.3 Where a decision is issued immediately after receipt of the appellant's reply, the essential legal and factual reasons for the refusal must already have been set out in the preceding communication. This was not the case here, as the examining division merely relied on a general assertion that all additional features introduced by dependent claims 2 to 15 were obvious and lacked any surprising or synergistic effect (see point III. above). To satisfy the requirement of setting out the essential legal and factual reasoning, the examining division would have had to examine specifically the added feature on its own merits and to explain why, in combination with the other claim features, it did not involve an inventive step.
- 1.3.4 Incidentally, the board notes that in the decision under appeal the examining division did not adequately address the appellant's argument that the mode field diameter and the effective area were, to some extent, independent (*"The skilled person would not have been motivated to modify not only the effective area but also the mode field diameter of the optical fibers of D2"*). The examining division's mere statement that *"[t]he effective area is unambiguously related to a corresponding mode field diameter D by elementary relation  $A=(\pi/4)D^2$ "* (decision under appeal,

point II.2.2, second paragraph) does not explain why the appellant's view concerning the relative independence of these parameters was considered incorrect. This failure to properly consider the appellant's submissions also constitutes a violation of Article 113(1) EPC (see CLBA, III.B.2.5.2, III.B.2.5.4 and III.K.3.4.2).

1.3.5 Accordingly, as an appropriate response to the filing of a new set of claims by the appellant, the examining division would have had to either issue a further communication under Article 94(3) EPC or summon to oral proceedings of its own motion.

1.4 As a consequence of the violation of the appellant's right to be heard, the case is remitted to the examining division for further prosecution on the basis of the main request and auxiliary requests I to XIII filed with the statement setting out the grounds of appeal (Articles 111(1) EPC, 11 RPBA).

## 2. *Reimbursement of the appeal fee*

2.1 Under Rule 101(3) (a) EPC, the appeal fee is to be reimbursed where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation.

2.2 As established in point 1.3 above, the examining division violated the appellant's right to be heard under Article 113(1) EPC. This constitutes a substantial procedural violation within the meaning of Rule 101(3) (a) EPC. By reason of this procedural violation, the reimbursement of the appeal fee is considered to be equitable.

## 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 on the basis of the main request and auxiliary requests I to XIII.
3. The appeal fee is reimbursed.

The Registrar:

The Chairman:



L. Gabor

R. Bekkering

Decision electronically authenticated