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Anmeldenummer / Filing No / N° de la demande : 81 900 967.1  
Veröffentlichungs-Nr. / Publication No / N° de la publication : 0 050 129  
Bezeichnung der Erfindung:  
Title of invention: Monoclonal antibody  
Titre de l'invention :  
Klassifikation / Classification / Classement : C12 P1/00

INTERLOCUTORY DECISION  
vom / of / du 23 September 1987

Anmelder / Applicant / Demandeur : Secher, D.S., Burke, D.C.

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Oral proceedings/SECHER

EPU / EPC / CBE Article 116

Kennwort / Keyword / Mot clé : "Oral proceedings - Reservation of right to request is not a request"

Leitsatz / Headnote / Sommaire

- I. The statement "I reserve my right to request oral proceedings under Article 116 EPC" is not in itself an actual request for oral proceedings.
- II. The right of a party to have oral proceedings under Article 116 EPC is dependent upon such party filing a request for oral proceedings. In the absence of such a request, a party has no right to such proceedings, and the EPO can issue a decision - whether adverse or not - without appointing such proceedings.

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Chambres de recours



Case Number : T 299/86

**I N T E R L O C U T A R Y   D E C I S I O N**  
of the Technical Board of Appeal 3.3.2  
of 23 September 1987

**Appellant :** Secher, David Stanley  
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**Representative :** Votier, Sidney David  
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**Decision under appeal :** Decision of Examining Division 023  
of the European Patent Office  
dated 25 March 1986 refusing European  
patent application No. 81 900 967.1  
pursuant to Article 97(1) EPC

**Composition of the Board :**

**Chairman :** P. Lançon

**Members :** G. D. Paterson

G. Szabo

## Summary of Facts and Submissions

- I. European PCT application No. 81 900 967.1 was filed with an international filing date of 13 April 1981. After examination, the application was refused by a Decision of the Examining Division dated 25 March 1986. The history of the examination of the application prior to refusal, so far as relevant to this Decision, is set out below.
  
- II. In reply to a first communication from the Examining Division dated 1 September 1982, the Appellant filed amended claims and submitted that they were allowable. In a second communication, dated 9 May 1983, objections were raised under Articles 54, 84 and 123 EPC. The Appellant, through his representative, filed in reply further amended claims for the purpose of clarification, contested the objections raised, and stated "If the Examiner is contemplating refusing the application I request an opportunity to discuss the case personally with the Examiner". In a third communication dated 28 March 1984, some objections were maintained under Articles 54, 56 and 123 EPC, and it was stated "If the Applicant thinks a personal consultation necessary, the Examiner is ready to appoint it". In reply, the Appellant's representative contested the objections, and stated "If the Examining Division is contemplating refusing the application I would be grateful if the Primary Examiner could telephone me to arrange a mutually convenient time for a personal discussion of the case". In a fourth communication dated 27 December 1984, objections to specified claims were maintained under Articles 84 and 123 EPC, and an objection under Article 83 EPC was raised for the first time. In reply to the fourth communication upon the request of the Appellant, an interview between the Primary Examiner and

the representative was arranged and took place on 21 August 1985, and a report entitled "Result of consultation" was issued on 9 September 1985, which stated, inter alia, that specified claims were not allowable under Article 83 EPC.

Furthermore, in a letter dated 25 October 1985 the Appellant's representative contested in detail the outstanding objections under Articles 83, 84 and 123 EPC. The letter ended with the statement:-

"In the event, however, that the Examining Division is minded to refuse the application, I reserve my right to request oral proceedings under Article 116 EPC. If, however, the Examining Division refuses the application for failure of the description to comply with Article 83 on the ground only that the experiment described therein is not identically repeatable, the applicant would consider putting this question forward in an appeal, for a decision of the Technical Board of Appeal or the Enlarged Board of Appeal, without passing through the stage of oral proceedings".

III. A Decision to refuse was issued by the Examining Division on 25 March 1986. The Decision referred to the passage quoted above, and stated in paragraph 1 of the Reasons for the Decision, "With respect to the kind of requests as ... above ... the Examiners were internally instructed to disregard them and they were told that such a request does not alone prevent a direct refusal of the application".

In the substantive part of the Decision the application was held not to be allowable because

(i) Claims 1 to 7 were not allowable under Article 84 EPC;

(ii) the procedure on page 7 is not repeatable and is thus contrary to Article 83 EPC.

The application was therefore rejected under Article 97 EPC.

IV. The Appellant filed a Notice of Appeal on 24 May 1986 and paid the appeal fee, and filed a statement of grounds of appeal (dated 25 July 1986) on 26 July 1986 requesting that the Decision of the Examining Division be set aside. The first ground of appeal was:

"The Appellants are entitled as of right to oral proceedings before the Examining Division under Article 116 EPC and this right has been denied".

In support of this contention, the Appellant referred to the passage of the letter dated 25 October 1985 quoted in paragraph II above, and submitted that its meaning was abundantly clear. It had been clear to the Appellants that the Examining Division was not likely to alter its view on the objection raised under Article 83 EPC, and that oral proceedings on that point alone would be fruitless, but it had been felt that oral proceedings might be helpful if the application was to be refused, inter alia, on the basis of the outstanding Article 84 and 123 EPC objections. It was submitted that the request for oral proceedings was clear in indicating that oral proceedings were not requested if the only ground of rejection was the Article 83 EPC "repeatability" ground; and that since this had not been the case, oral proceedings should have been appointed.

With reference to the passage quoted in paragraph III above from paragraph 1 of the Reasons for the Decision, the Appellant submitted that he was unaware of the "internal instructions" referred to, that such instructions constituted grounds or evidence germane to the Decision not to appoint oral proceedings and that the refusal to appoint oral proceedings constituted a substantial procedural violation for the purpose of Rule 67 EPC.

Finally, the Appellant requested oral proceedings in respect of the appeal, such request being made unconditionally subject to withdrawal of the request if the Board of Appeal should find in the Appellant's favour in the appeal on the basis of the written submissions.

- V. In a communication dated 15 June 1987, it was stated that in the Board's present view the letter dated 25 October 1985 on its true interpretation did not contain a request for oral proceedings for reasons there set out, and invited the Appellant's observations on this substantive point and also on the future course of procedure in the appeal. In his reply dated 13 July 1987, the Appellant made no observations on this substantive point, but withdrew his request for oral proceedings in respect only of that part of the appeal relating to the denial of the Appellant's right to oral proceedings before the Examining Division.

#### Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is admissible. As the Appellant has withdrawn his request for oral proceedings in relation to the first ground of appeal, the Board has decided to issue an interlocutory decision in respect of this ground only.

2. In the Board's view the right to oral proceedings provided to a party to proceedings before the EPO by Article 116 EPC is a very important procedural right. The wording of the first sentence of Article 116 EPC makes it clear that, whether or not the EPO considers it to be expedient, a party is entitled to oral proceedings upon request; and such request may be made at any time. However, the right of a party to have oral proceedings is dependent upon such party filing a request for such proceedings: in the absence of such a request, a party has no right to such proceedings, and the EPO can issue a decision, whether adverse or not, without appointing such proceedings.
3. The right of a party to request oral proceedings under Article 116 EPC is, of course, in no way affected by the fact that such party may have also requested and/or attended an interview with the Examiner.
4. In the present case, as set out in paragraph I above, the Appellant requested an interview with the Examiner, and attended such an interview. Following this interview, the Appellant's representative wrote the letter dated 25 October 1985, including its last paragraph which is quoted in paragraph II above. The correctness of the Appellant's contention that he was entitled as of right to have oral proceedings before the Examining Division before the Decision to Refuse was issued, depends upon whether or not the quoted paragraph contains a request for oral proceedings under Article 116 EPC, when such paragraph is properly interpreted in its context; that is, in the context of the remainder of that letter and of the previous correspondence also referred to in paragraph II above.

In the Board's view, the statement in the first sentence of the paragraph - "I reserve my right to request oral proceedings" - can be properly interpreted in its context as a statement by the representative that it should not be implied from the previous history of the case, including in particular the interview, that he is no longer interested in having oral proceedings, or that he has abandoned his right to request oral proceedings. Furthermore, the wording of the second sentence of the paragraph rather confirms that the Appellant has not yet decided whether to request oral proceedings. However, there is a clear distinction between actually "making" a request for oral proceedings" and "reserving the right to make a request for oral proceedings". The statement "I reserve my right to request oral proceedings under Article 116 EPC" is not in itself an actual request for oral proceedings. In the judgement of the Board, the wording of such paragraph cannot be construed as containing a " request for oral proceedings" such as to create a legal right under Article 116 EPC for the Appellant to have oral proceedings appointed.

5. If there is any doubt in any particular case as to whether or not oral proceedings have been requested, it is clearly desirable as a matter of practice that clarification should be sought from the party concerned.

In the Board's view, in normal circumstances there is little point in a party "reserving his right" to request oral proceedings, in view of the fact that under Article 116 EPC he is entitled to make such a request at any time. However, unless and until he has actually filed such a request, he runs the risk that an adverse decision may be issued without the appointment of such proceedings, if it is otherwise appropriate to do so.

A request for oral proceedings may be withdrawn at any time, so if there is a possibility that oral proceedings will be required, it is clearly safer from a party's point of view to make such a request at an early stage. Withdrawal of a request should clearly be made as early as possible and well in advance of the appointed day.

If, as in the present case, a party has in mind to request oral proceedings only if certain points are taken against him, the party should make a request for oral proceedings (and not just "reserve the right" to make such a request) and at the same time state clearly the exact circumstances in which he does request oral proceedings.

6. For the reasons set out above, the Board will reject this ground of appeal. Accordingly, the Appellant's submissions in relation to Rule 67 EPC do not need to be considered in detail, because the Board has no power to order reimbursement of an appeal under Rule 67 EPC unless the appeal is allowed. However, the Board does consider that the reasons which were expressed in paragraph 1 of the Reasons for the Decision and are quoted in paragraph III above were in fact quite inadequate as legal justification for not appointing oral proceedings. The question whether a "request for oral proceedings" has been made must be decided in each case on the individual facts of that case, in the manner previously discussed. This question was considered in another case by another Board in Decision T 19/87 "Oral proceedings/Fujitsu" dated 11 June 1987, to be reported.
7. Examination of the remainder of the grounds of appeal will now proceed.

**Order****For these reasons, it is decided that**

The ground of appeal set out in paragraph 1.4(i) of the statement of grounds of appeal, dated 25 July 1986, is rejected.

**The Registrar****The Chairman**