



Case Number : T 19/87

D E C I S I O N
of the Technical Board of Appeal 3.4.1
of 16 April 1987

Appellant : Fujitsu Limited
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Decision under appeal : Decision of Examining Division 043
of the European Patent Office
dated 4 August 1986 refusing European
patent application No. 82 304 491.2
pursuant to Article 97(1) EPC

Composition of the Board :

Chairman : K. Lederer
Member : G.D. Paterson
Member : H. Reich

Veröffentlichung im Amtsblatt	Ja/Nein
Publication in the Official Journal	Yes/No
Publication au Journal Officiel	Oui/Non

Aktenzeichen / Case Number / N° du recours : T 19/87
Anmeldenummer / Filing No / N° de la demande : 82 304 491.2
Veröffentlichungs-Nr. / Publication No / N° de la publication : 0 103 052

Bezeichnung der Erfindung: Method for forming patterned resist layer on
Title of invention: semiconductor body
Titre de l'invention :

Klassifikation / Classification / Classement : G 03 F 7/26

ENTSCHEIDUNG / DECISION
vom / of / du 16 April 1987

Anmelder / Applicant / Demandeur : Fujitsu Limited

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Oral proceedings/FUJITSU

EPÜ / EPC / CBE Articles 113, 116, Rule 67

Kennwort / Keyword / Mot clé : "Request for 'interview as preliminary to oral proceedings'" - "Decision to refuse issued without oral proceedings . Decision void ab initio and set aside" - "Application remitted to Examining Division for oral proceedings to take place - no substantial procedural violation"

Leitsatz / Headnote / Sommaire

1. If, on the true meaning of a communication from a party, it constituted a request for oral proceedings, there is no power to issue an adverse decision without first appointing such oral proceedings.
2. A finding in a decision that there had not been a request for oral proceedings, although wrong, did not constitute either
 - (a) grounds or evidence on which the decision to refuse was based, so there was no violation of Article 113(1) EPC
 - or
 - (b) a substantial procedural violation for the purpose of Rule 67 EPC.

Summary of Facts and Submissions

I. The European patent application was filed on 25 August 1982. The Examining Division issued a communication dated 21 January 1985, pursuant to Article 96(2) EPC, in which the Appellant was invited to file his observations in reply. A letter containing observations in reply was filed by the Appellant on 31 July 1985, which ended with the statement "Should the Examiner still have any objections to the present application, it is requested that an opportunity be given to discuss these by telephone or at an interview before any adverse communication is issued". A further communication pursuant to Article 96(2) EPC was issued by the Examining Division dated 15 October 1985, again inviting the Appellant to file observations in reply, which indicated that none of the claims of the application contained inventive subject-matter, and which ended with the statement "Under these circumstances an interview does not appear to be expedient. Should the applicant, however, request oral proceedings under Article 116 EPC, such oral proceedings would be appointed". A letter dated 23 April 1986 containing observations in reply was filed by the Appellant on 25 April 1986, which ended with the following statement:

"Should the Examiner not accept the submission, I again request an interview, as a preliminary to oral proceedings, before rejection of the application".

A Decision to refuse was issued on 4 August 1986, in which it was held that "Claim 1 was not allowable on the ground of lack of inventive step", and that "there is no inventive subject-matter apparent either in the dependent claims or in the description". The Decision went on to say "Under these circumstances, the interview requested by the Applicant is not considered to be expedient. Even after the

Examining Division had informed the Applicant to that effect and pointed out the possibility of requesting oral proceedings under Article 116 EPC (communication of 15.10.85, page 2), the Applicant did not direct his request to oral proceedings, but maintained his request for an interview". The patent was therefore refused.

II. By a letter dated 12 September 1986 the Appellant pointed out that he had requested oral proceedings in the last paragraph of his letter dated 23 April 1986, which he quoted, and he therefore asked that the Decision to Refuse be withdrawn or ignored. The Appellant filed a Notice of Appeal on the same day, in which he requested interlocutory revision under Article 109 EPC, and he also simultaneously filed a statement of grounds of appeal. In this statement it was submitted that a request for oral proceedings had quite clearly been made in the letter dated 23 April 1986, and that the Decision to Refuse was therefore either void ab initio or should be set aside. It was also submitted that the issuance of the Decision without oral proceedings had been a substantial procedural violation, and that the appeal fee should be reimbursed.

III. On 2 October 1986 the Appellant was informed by telephone that the Decision to Refuse would not be rectified under Article 109 EPC, and he was advised to file a statement of grounds of appeal on the substantive aspects of the Decision. The Appellant filed a supplementary statement of grounds of appeal on 15 December 1986 in which he further submitted:

(A) that the procedural ground for issuing the Decision to Refuse without appointing oral proceedings was a ground on which the Appellant should have had an opportunity to present his comments before the Decision was issued, pursuant to Article 113(1) EPC, and that since such an

opportunity to comment had not been given, the Decision lacks a basis under Article 113(1) EPC, and for this reason also should be declared void ab initio or set aside. Furthermore, there was no basis for the Board of Appeal to consider the substantive issues raised in the Decision.

(B) In the alternative, that the Decision is wrong on the substantive issues, for various reasons which the Appellant has set out in detail.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC, and is therefore admissible.
2. The main question is whether or not the sentence at the end of the letter from the Appellant dated 23 April 1986, when considered in its context as set out in paragraph I above, constituted a request for oral proceedings for the purpose of Article 116 EPC. In the Board's judgement the true meaning of that sentence is that it contained two requests, namely a request for an interview and a request for oral proceedings.
3. A request for an interview is clearly not, by itself, a request for oral proceedings. Equally clearly, if the Examining Division receives a request for an interview, there is no obligation upon the Examining Division to grant such a request. The practice is set out in the "Guidelines for Examination in the European Patent Office" at paragraph C.VI 6.1, as follows: "If the applicant or his representative requests an interview, the request should be granted unless the examiner believes that no useful purpose would be served by such a discussion". In the present case the examiner had expressed his belief that "an interview

does not appear to be expedient" in the communication dated 15 October 1985. So when the Appellant repeated his request for an interview in his letter dated 23 April 1986, he must have been aware that such request might not be granted. In the Board's view, the request in that letter for "an interview as a preliminary to oral proceedings", can only be construed as both a request for an interview (which might or might not be granted), and a request for oral proceedings. In this circumstance, in accordance with Article 116 EPC, it is therefore mandatory that "oral proceedings shall take place", before the Examining Division. The Examining Division had no power to issue its Decision without first summoning the Appellant to oral proceedings, and the Decision is therefore void ab initio. The appeal is allowed, and the application must be remitted to the Examining Division in order that oral proceedings should take place, in accordance with the request which has already been made, prior to the Examining Division making its decision on the application.

4. As to the Appellant's submission that the Decision was issued in violation of Article 113(1) EPC, this depends upon whether or not the Decision to Refuse was "based on grounds or evidence" on which the Appellant had not had an opportunity to present his comments. The Decision to Refuse was based on the ground of lack of inventive step, and upon evidence relevant to that ground. In the Board's judgment, the finding in such Decision that there had not been a request for oral proceedings, although wrong, did not constitute either "grounds" or "evidence" on which the decision to refuse the European patent application was based. Thus there was no violation of Article 113(1) EPC.
5. As the appeal has been allowed, the Appellant's request for reimbursement of the appeal fee under Rule 67 EPC must be considered.

In the Board's view, the right to an oral hearing which is provided by Article 116 EPC is a very important procedural right. In the present case the last sentence of the Appellant's letter dated 23 April 1986 should on any reasonable view have raised the possibility that oral proceedings were being requested. 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.


~~Nevertheless, in the present case the Examining Division~~ held in its Decision that no request for oral proceedings had been made by the Appellant. Although in the Board's view for the reasons set out above, that finding was in error, the error by the Examining Division was an error of judgment and was not a procedural violation. Furthermore in the Board's view the failure to seek clarification from the Appellant did not constitute a violation of any procedure. There is therefore no basis for ordering reimbursement of the appeal fee in accordance with Rule 67 EPC.

Order

For these reasons it is decided that:

1. The Decision of the Examining Division dated 4 August 1986 is set aside.
2. The application is remitted to the Examining Division with the order that oral proceedings under Article 116 EPC shall take place before the Examining Division decides whether to grant or refuse European patent application No. 82 304 491.2 under Article 97 EPC.
3. The request for reimbursement of the appeal fee is rejected.

The Registrar:



The Chairman:



Re, 14.04.87

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