

Publication in the Official Journal ~~Yes~~ / No

File Number: T 872/90 - 3.2.1
Application No.: 85 304 005.3
Publication No.: 0 172 613
Title of invention: Resin-laminated rubber plug

Classification: B65D 51/00

D E C I S I O N
of 27 June 1991

Applicant: Kabushiki Kaisha Daikyo Gomu Seiko

Headword:

EPC Article 116, Rule 86(3), Rule 68(2), Rule 67

Keyword: "exercise of discretion under Rule 86(3)"
"request for "an opportunity to be heard" not considered to be a
clear request for oral proceedings in accordance with
Article 116 EPC"
"Substantial procedural violation"

Headnote



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Boards of Appeal

Chambres de recours

Case Number : T 872/90 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 27 June 1991

Appellant : Kabushiki Kaisha Daikyo Gomu Seiko
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Tokyo (JP)

Representative : Hardisty, David R.
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Decision under appeal : Decision of Examining Division 082 of the
European Patent Office dated 25 May 1990
refusing European patent application
No. 85 304 005.3 pursuant to Article 97(1) EPC.

Composition of the Board :

Chairman : F. Gumbel
Members : P. Alting van Geusau
J.-C. de Preter

Summary of Facts and Submissions

- I. European patent application No. 85 304 005.3 filed on 5 June 1985 and published under number 0 172 613, was refused by a decision of the Examining Division 082 on 25 May 1990.
- II. The decision was based on Claims 1 to 8 filed with letter of 17 July 1989 since according to the Examining Division the last amended claims filed with letter of 1 March 1990 could not be accepted having regard to Rule 86(3) EPC.

The reason given for the refusal was that the subject-matter of Claim 1 did not involve an inventive step in the light of the prior art disclosure in the documents:

D1: GB-A-2 106 084 and
D2: GB-A-1 224 732.

It was further set out in the decision (see point 5 of the statement of reasons) that the Examining Division did not regard the request for "an opportunity to be heard" put forward in the letters of 17 July 1989 and 1 March 1990 as a request for oral proceedings in accordance with Article 116 EPC.

- III. The Appellant filed a Notice of Appeal against this decision on 25 July 1990 paying the appropriate fee simultaneously. The Statement of Grounds of Appeal was submitted on 25 September 1990.
- IV. Apart from discussing the substantive issue concerning inventive step of the subject-matter of the application, the Appellant submitted that the Examining Division was wrong to refuse to consider the amended Claim 1 filed with

letter of 1 March 1990 as it was clearly filed in an attempt to overcome objections raised in the communication dated 7 September 1989. The Appellant further stated that no indication is given in the EPC or Guidelines for Examination of the wording to be used for requesting oral proceedings and that the request "for an opportunity to be heard" must be interpreted as a request for oral proceedings.

The Appellant requests that the application be referred back to the Examining Division for further examination on the basis of the claims filed with letter of 1 March 1990.

The Appellant further requests that the appeal fee be reimbursed.

V. Claim 1 filed with letter of 17 July 1989 reads as follows:

"1. A resin-laminated rubber plug for a medical vial or bottle, having an annular leg part to be inserted into the mouth of the vial or bottle, in which the annular leg part is completely laminated with a chemical-resistant resin except the outer circumference of an upper end of the leg part to expose there the rubber surface, the chemical-resistant resin being selected from the group consisting of tetrafluoroethylene polymers, tetrafluoroethylene-hexafluoropropylene copolymers, tetrafluoroethylene-pentafluoropropylene copolymers, tetrafluoroethylene-ethylene copolymers, tetrafluoroethylene-propylene copolymers and chlorotrifluoroethylene polymers".

Claim 1 filed with letter of 1 March 1990 has the following wording:

"1. A resin-laminated rubber plug for a medical vial or bottle, having an annular leg part to be inserted into the mouth of the vial or bottle, in which the annular leg part is completely laminated with a chemical-resistant resin except for an outer circumference of an upper end of the leg part where the rubber surface is exposed, the chemical-resistant resin being selected from the group consisting of tetrafluoroethylene polymers, tetrafluoroethylene-hexafluoropropylene copolymers, tetrafluoroethylene-pentafluoropropylene copolymer, tetrafluoroethylene-ethylene copolymers, tetrafluoroethylene-propylene copolymers and chlorotrifluoroethylene polymers, which is produced by a two-step process comprising placing the chemical-resistant resin film on a lower metal mould having an annular recess corresponding to the annular leg part, stacking a first quantity of vulcanizable compound rubber and a first upper metal mould over the resin film on the lower metal mould, heating and pressing the lower metal mould and upper metal mould and punching or trimming the thus formed and laminated leg part, and a second step of charging the laminated and trimmed leg part in a second lower metal mould, said second lower mould having a larger depth than said first lower mould, placing a second quantity of the vulcanizable compound rubber and a second upper metal mould having a recess in the shape of a cap part thereon and then heating and pressing the lower metal mould and upper metal mould to vulcanize the compound rubber and simultaneously join the cap part to the annular leg part."

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.

2. Considering the procedural matters referred to by the Appellant, the question arises whether the Examining Division correctly applied Rule 86(3) EPC and also whether the Appellant's request for "an opportunity to be heard" constitutes a valid request for oral proceedings in accordance with Article 116 EPC.
 - 2.1 As regards the refusal of the Examining Division to consider the last filed claims and its subsequent taking of the claims filed with letter of 17 July 1989 as a basis for its decision, it has been set out in a former decision by this Board (see T 183/89 of 30 July 1989) that in view of the requirement of Article 113(2) EPC according to which the European Patent Office shall consider and decide upon the European application only in the text submitted to it, or agreed, by the Appellant, former claims which have been replaced by newly filed claims cannot any longer be considered to constitute a text agreed to by the Applicant.

The present decision under appeal refusing the application on the ground of Article 56 EPC in that the subject-matter of Claim 1 filed with letter of 17 July 1989, which had been replaced by Claim 1 filed with letter of 1 March 1990, lacked an inventive step, is therefore void in respect of this ground, since this claim did not at that time represent a valid claim of the application.

It is further observed that the Examining Division's decision with respect to its not allowing the claims filed with letter of 1 March 1990 is not reasoned and is, therefore, contrary to the requirement of Rule 68(2) EPC.

In this respect, neither the remark in point 1 of the Statement of Reasons "that the applicant has already once amended the claim" nor the reference to Rule 86(3) in the communication dated 7 September 1989 can be considered to represent a reasoning because, in the Board's opinion, such statements solely constitute a reference to the power given to the Examining Division by the above Rule.

In view of these conclusions the Board is of the opinion that the Examining Division has not correctly applied Rule 86(3) EPC.

- 2.2 Considering the claims filed with letter of 1 March 1990, the Board is satisfied that these new claims and in particular Claim 1 were filed in an attempt to overcome the objections made in the communication dated 7 September 1989 and that thus there is no reason to refuse these claims under Rule 86(3) EPC.

As will be clear from a comparison of Claim 1 filed with letter of 17 July 1989 and Claim 1 filed with letter of 1 March 1990 the latter claim comprises in addition to all the features of the former Claim 1 further features relating to the manufacturing steps of the claimed product (plug). However, since this claim was rejected by the Examining Division under Rule 86(3) EPC its subject-matter has neither been examined for inventive step nor for the other requirements of the EPC such as the requirements of Article 123(2) and Article 84 EPC. In view of this fact and of the Appellant's request for referral back to the Examining Division, the Board does not consider it to be appropriate in the present case to decide on these points as a first instance but makes use of its power under Article 111(1) EPC to remit the case for further prosecution.

2.3 As regards the question whether the request for "an opportunity to be heard" in the letter of 1 March 1990 constitutes a valid request for oral proceedings in accordance with Article 116 EPC, the Board observes that the Examining Division's decision as the sole reason for refusing this request in point 5 thereof merely contains the statement that the Examining Division "does not regard such a request as a request for oral proceedings in accordance with Article 116 EPC".

In accordance with established jurisprudence based on former Decisions of the Boards of Appeal (see T 19/87 OJ EPO 1988, 268 and T 668/89 of 19 June 1990), if any reasonable doubt exists in the minds of the Examining Division as to the true nature of a potentially ambiguous request made to it by the Applicant it is clearly desirable, as a matter of practice, that the Examining Division should seek clarification from the party concerned, in particular because the right to an oral hearing provided by Article 116 EPC is an extremely important procedural right which the EPO should take all reasonable steps to safeguard. Violation of this right must, therefore, in principle, be considered as a substantial procedural violation within the meaning of Rule 67 EPC unless the circumstances and reasons for the refusal to grant that right can be considered as a mere error of judgement. Having regard to the somewhat ambiguous nature of the request for an opportunity "to be heard", which in the first place gives rise to the interpretation to represent a request for an informal interview, the allowance or refusal of which is entirely a matter of discretion, the Board finds that such an error of judgement has in fact occurred and there was no procedural violation in this respect.

2.4 However, since the issuing of a final decision by the Examining Division on the basis of no longer valid documents was a clear violation of Article 113(2) EPC, the decision under appeal has to be set aside and, to this extent, the appeal is allowable for the purpose of deciding the Appellant's request for reimbursement of the appeal fee under Rule 67 EPC. This reimbursement is considered equitable as the committal of the procedural violation was cause for the necessity to lodge an appeal at this stage.

Order

For these reasons, it is decided that:

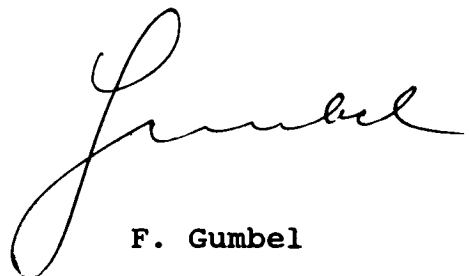
1. The decision under appeal is set aside.
2. The application is remitted to the Examining Division for further prosecution taking account of the request for oral proceedings under Article 116 EPC, to decide the allowability of the patent application in suit.
3. Reimbursement of the appeal fee is ordered.

The Registrar:



S. Fabiani

The Chairman:



F. Gumbel