

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

File Number: T 390/91 - 3.3.1

Application No.: 87 301 471.6

Publication No.: 0 236 022

Title of invention: Lubricating oil for plastic working and articles worked
using the same

Classification: C10M 133/20

D E C I S I O N
of 14 May 1992

Applicant: Hitachi, Ltd.

Headword: Lubricating oil/HITACHI

EPC Article 82, Rules 46(2), 67 and 68(2)

Keyword: "Lack of unity - a posteriori - unreasoned"
"Reimbursement of appeal fee (yes) - lack of reasons"

Headnote



Case Number : T 390/91 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 14 May 1992

Appellant : Hitachi, Ltd
(Applicant) 6, Kanda Surugadai 4-chome
Chiyoda-ku
Tokyo 101 (JP)

Representative : Harrison, D.C. et al
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Decision under appeal : Interlocutory decision of the Examining Division
of the European Patent Office dated
10 January 1991 refusing the refund of additional
search fees.

Composition of the Board :

Chairman : K.J.A. Jahn
Members : R.W. Andrews
J.-C. Saisset

Summary of Facts and Submissions

- I. European patent application No. 87 301 471.6 (publication No. 0 236 022) was filed on 20 February 1987.
- II. By an interlocutory decision of 10 January 1991, the Examining Division refused the Applicant's request for the refund of the two additional search fees paid in respect of original Claims 4 and 5. Claims 1, 4 and 5 as filed read as follows:
- "1. A lubricating oil for plastic working comprising a lubricating oil and a powder of a compound having a urea bond dispersed and incorporated in said lubricating oil.
4. A lubricating oil for plastic working according to any one of Claims 1 to 3 which contains, as well as
(A) said powder of a compound having a urea bond,
(B) at least one extreme-pressure additive selected from:
- (1) condensed phosphoric acid,
(2) phosphite and phosphate esters,
(3) organic sulfur compounds, and
(4) organic chlorine compounds.
5. A lubricating oil for plastic working according to any one of Claims 1 to 4 wherein said powder is coated with wax."
- III. The Examining Division held that the lack of novelty of the subject-matter of the original Claim 1 in the light of the disclosure of US-A-3 454 495 (4) led to a lack of unity between the invention of Claims 1 to 3 and 6 and those of Claim 4 and Claim 5 since the common linking concept of the dependent claims was not novel.

IV. An appeal was lodged against this decision on 14 March 1991, the payment of the appeal fee and the filing of the Statement of Grounds of Appeal both being effected on the same date. In his statement the Appellant contended that, in principle, lack of unity cannot arise between a dependent claim and the independent claim from which it depends (Guidelines for Examination in the EPO, Part C, Chapter III, paragraph 7.8).

Furthermore, the Appellant considered that a posteriori analysis is only appropriate for independent claims. Dependent claims are explicitly permitted by Rule 29 EPC and are allowed even in a case where the original main claim is narrowed during the application procedure as a result of prior art.

Finally, the Appellant argued that the reimbursement of the appeal fee is proper since the perversity of the decision on the lack of unity objection raised against dependent claims in the application is of a degree that it constitutes a substantial procedural violation.

V. The Appellant requests the refund of two additional search fees and the appeal fee.

Reasons for the Decision

1. The appeal is admissible.
2. According to Rule 46(2) EPC any additional search fee shall be refunded if, during the examination of the European patent application by the Examining Division, the Applicant requests a refund and the Examining Division

finds that the request for the additional search fee was not justified.

In the present case the Examining Division, after giving reasons as to why, in its opinion, the subject-matter of original Claim 1 lacked novelty in the light of the disclosure of document (4), justified its refusal to refund the additional search fees by the statement.

"The lack of novelty of the subject-matter of the original Claim 1 results in the lack of unity reported by the Search Division, because the common linking concept of the dependent claims is not novel."

This finding fails to give any details regarding this "common linking concept" which are capable of being reviewed by the Board. Therefore, the above statement cannot be considered as a reason for rejecting the request for the reimbursement of the additional search fees.

Consequently, in the Board's judgment the decision under appeal is unreasoned and contravenes the provisions of Rule 68(2) EPC which requires that the decisions of the European Patent Office which are open to appeal shall be reasoned. Thus, the decision under appeal, which is void and of no legal effect, must be set aside.

3. The Board holds that the absence of reasons in the decision under appeal constitutes a substantial procedural violation which justifies the reimbursement of the appeal fee under Rule 67 EPC.

Order

For these reasons, it is decided that:

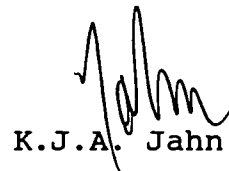
1. The decision under appeal is set aside.
2. Reimbursements of the two additional search fees is ordered.
3. Reimbursement of the appeal fee is ordered.

The Registrar:



E. Görgmayer

The Chairman:



K.J.A. Jahn