

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen

D E C I S I O N
of 10 December 1995

Case Number: T 0691/91 - 3.3.4

Application Number: 85300391.1

Publication Number: 0152190

IPC: A01N 25/18

Language of the proceedings: EN

Title of invention:
Pest control in animals

Applicant:
BEND RESEARCH, INC.

Opponent:
-

Headword:
Pest control/BEND RESEARCH

Relevant legal provisions:
EPC Art. 106, 107, 109(1), 113
EPC R. 89, 64, 67

Keyword:
"Procedural violations (yes)"

Decisions cited:
G 0001/90, T 0934/91

Catchword:
-



Case Number: T 0691/91 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 10 December 1995

Appellant: BEND RESEARCH, INC.
64550 Research Road
Bend
Oregon, 97701 (US)

Representative: Skerrett, John Norton Haigh
H.N. & W.S. Skerrett
Charles House
148/9 Great Charles Street
Birmingham B3 3HT (GB)

Decisions under appeal: Decisions of the Examining Division of the
European Patent Office dated 8 August 1990 and
5 April 1991 refusing European patent application
No. 85 300 391.1 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: U. M. Kinkeldey
Members: F. L. B. Davison-Brunel
S. G. Perryman

Summary of Facts and Submissions

- I. European patent application No. 85 300 391.1 was refused by a decision of the Examining Division of 8 August 1990 (hereinafter "the '90 decision"), in which the Examining Division raised for the first time an objection under Article 123(2) EPC against a newly submitted Claim 1, and stated (Reasons 1) "... Since the above amendment is not acceptable it is not possible to withdraw the clarity, novelty and inventive step objection which have been repeated already in our letter of ...".

- II. On 10 October 1990, a Notice of Appeal was filed accompanied by the payment of the appropriate fee. The Statement of Grounds of Appeal was received on 18 December 1990. The Appellant requested that the decision of the Examining Division be set aside and that the case be remitted to the Examining Division for further prosecution on the basis of the replacement claims set out in Schedules A, B or C or, alternatively, on the basis of any of these schedules found allowable by the Board.

- III. Repayment of the appeal fee was also requested, on the basis that the Examining Division had committed a substantial procedural violation because it had based its refusal decision on only Claims 1 to 4, whereas there were thirteen claims on file.

- IV. On a Form 2701 dated 24 January 1991 signed by all members of the Examining Division, an indication was given to the Formalities Section that the appeal was admissible, that the decision was to be rectified (Art. 109(1) EPC), that preparation of the fair copy of the decision on Form 2702 was instructed, and that the application for reimbursement of the appeal fee was not to be granted for reasons given on the attached sheet.

- V. On the attached Form 2702.2, there appeared the statement "Following the appeal by the applicant of 8 October 1990 rectification is ordered and the decision of the Examining Division of 8 August 1990 is maintained in amended form". The words "maintained in amended form" had been substituted for the printed word "annulled".
- VI. In addition, the attached sheet contained under the heading "The application for reimbursement of the appeal fee is not granted" the reasons "Irrespective of the reasons given in this decision one should take into account that only one deficiency in the application which has not been removed by the Applicant, justifies refusal of the whole application".
- VII. The Examining Division formally issued Form 2702.2 headed Decision on Rectification (Art. 109(1) EPC) on 5 April 1991 (hereinafter "the '91 decision"). Attached to this were several pages the first of which starts:

"Correction of errors according to Rule 89 EPC

The decision of 8 August 1990 of the Examining Division to refuse the application No. 85 300 391.1 is formally corrected because there has been a flaw in indicating the claims.

Pages 1 and 3 of the decision have been subsequently amended and are attached to this decision together with the complete set of claims."

There follows a heading "Grounds" and several paragraphs of which the final one reads:

"The substantive objections against the subject matter as indicated in the above paragraph are fully maintained."

- VIII. An appeal was filed on 4 June 1991 against the '91 decision accompanied by the appropriate fee. Following a change in Representative, the appeal fee was paid a second time with a letter dated 18 June 1991. A Statement of Grounds was submitted on 14 August 1991.
- IX. In this second appeal the Appellant stated that the appeal was against the decision to refuse dated 8 August 1990 given by the Examining Division, said decision having been maintained in amended form in the decision on Rectification given in a notification dated 5 April 1991. Three sets of claims: Schedules A-C accompanied the grounds of appeal. It was requested that the decision to refuse be set aside and that the application be returned to the Examining Division for further prosecution, on the basis of the submissions and amendments set out in Schedule A, with instructions to issue a notice of grant. In the alternative, the application should be remitted to the Examining Division for further prosecution on the basis of one of the alternative claim sets B and C. Refund of the precautionary duplicated payment of the appeal fee was also requested.
- X. A communication was sent by the Board according to Article 11(2) of the Rules of Procedure of the Boards of Appeal informing the Appellant of the Board's provisional intention to remit the case to the first instance with the order of pursuing the examination on the request referred to as Schedule C filed on 14 August 1991, and to order repayment of all appeal fees in view of procedural violations that had taken place.
- XI. With his letter of 4 September 1995, the Appellant announced its intention to let the patent application lapse by nonpayment of renewal fees, but that the appeal was maintained solely for the purpose of repayment of the appeal fees.

Reasons for the Decision

Appeal against '91 decision

Admissibility

- I. The admissibility of the appeal lodged against the '91 decision hinges upon whether said 'decision' may be considered as a decision within the meaning of Articles 106 and 107 EPC.
2. The Enlarged Board of Appeal in case G 1/90 (OJ EPO 1991, 275) dealt with the legal status of an automatic revocation of a patent under Article 102(4)(5) EPC and came to the conclusion that such an action needs a "reasoned decision" against which an appeal is possible.
3. In subsequent case T 934/91 (OJ EPO 1994, 184), the Board of Appeal 3.3.1 considered that a document issued by the Examining Division to confirm an earlier decision of the Board of Appeal 3.3.2 could not have the legal status of a decision because a decision involved a reasoned choice between two legally viable alternatives and the finality of the earlier decision of the Board of Appeal 3.3.2 did not leave any room for any alternatives in view of the doctrine of res judicata.

In this specific case, the so called "decision" could not be considered as a final action of the Examining Division, nor does it have any consequences on the Applicant's rights, since the case had already been fully decided by the Board of Appeal 3.3.2.

4. In the present case, the '91 decision entitled "Decision on rectification under Article 109(1) EPC" has been issued by the Examining Division to deal with the appeal

lodged against the refusal of the application. The substantive contents of this document are identical to those of the first decision of refusal. In fact, the sole purpose of the issuance of this document is to answer to the argument of the Appellant that a procedural violation had occurred in the decision of refusal since said decision failed to consider all of the filed claims. Indeed, the document simply extends the refusal initially based on the first four claims to all claims and, thus, only deals with one ground for the appeal.

5. The direct consequence of the issuance of the '91 decision is that the Appellant was definitely and irrevocably deprived of all of his rights with regard to the invention, even of his rights to the first appeal because a "decision on rectification" according to Article 109(1) EPC always entails that the appeal does not reach the Boards of Appeal. Thus, the document entitled "Decision on rectification" is an action by the Examining Division which is final and of the sort which bears adverse consequences for the Appellant. These two attributes are those of a decision which is appealable.
6. The requirements of Articles 106 and 107 EPC are fulfilled. The Appellant complied with the requirements of Article 108 and Rule 64 EPC. The appeal against the '91 decision is therefore admissible.

Examining Division not empowered to make decision

7. The circumstances in which Article 109 EPC empowers the Examining Division to rectify are narrowly circumscribed. The article reads:
 - (1) If the department whose decision is contested considers the appeal to be admissible and well founded, it shall rectify its decision. This shall

not apply where the Appellant is opposed by another party to the proceedings.

(2) If the appeal is not allowed within one month after receipt of the Statement of Grounds, it shall be remitted to the Board of Appeal without delay, and without comment as to its merit.

8. Here the appeal was, in effect, allowed a few days after the month term after receipt of the Statement of Grounds and in an unusual way because the Examining Division was not in fact of the opinion that the appeal was well founded, but rather wanted to maintain its previous decision subject to correction of what it considered to be an obvious error. The fact that to do this they had to amend the standard wording on Form 2702.2 for Rectification by substituting "maintained in amended form" for "annulled" should have been a warning sign that they were exceeding their powers. The correct procedure would have been to remit the case to the Board of Appeal.

9. Nor can the '91 decision be treated as a decision to amend under the provisions of Rule 89 EPC rather than one under Article 109 EPC. While an appeal is pending the Examining Division should not issue any decision on amendment as this produces results contrary to Article 106(1) last sentence EPC which provides that an appeal shall have suspensive effect. For the Examining Division to attempt to amend the appealed decision can only cause procedural chaos. If, as in this case, the Examining Division considers that the error alleged by the Appellant is obvious and does not affect the decision, it should be left to the Board of Appeal to deal with.

10. Further, by the manner in which the appeal was dealt with in the '91 decision, which ignores completely the auxiliary requests made by the Appellant there is also a violation of the provisions of Article 113 EPC because these auxiliary requests have not been considered at all. If the Examining Division had wished to proceed along the procedurally correct rectification route, it should have annulled its decision, re-opened the examination proceedings, corrected any procedural mistake they believed had been committed, and re-examined the patent application taking into account all submissions made with the appeal against the annulled decision, if necessary writing a further communication and only then issuing another decision.

11. Thus, Article 109 EPC provides for two legally viable alternatives: to maintain or annul the decision which is appealed. In the first case, the appeal is remitted to the Board of Appeal without comments or delay. In the second case, a decision on rectification is issued resulting in the granting of a patent or, as the case may be in the re-opening of the examination, which will lead to the granting of a patent or possibly a second refusal of the patent application. In the present case, the Examining Division has chosen a third way: the maintenance of the earlier decision by means of the issuance of a decision on rectification. This alternative is not covered by the provisions of Article 109 EPC. A procedural violation has occurred.

'91 decision to be set aside, appeal fee to be repaid

12. The decision of 5 April 1991 must thus be set aside as being **ultra vires** the Examining Division. The appeal against this decision is thus allowed, and the making of such a decision **ultra vires** is a substantial procedural violation and reimbursement of the appeal fee under Rule 67 EPC is equitable.

13. The consequence of setting aside the decision of 5 April 1991 is that the appeal against the decision of 8 August 1990 is now before the Board of Appeal.

Appeal against '90 decision

Admissibility

14. The appeal against the decision of 8 August 1990 ('90 decision) complies with the requirements of Articles 106 to 108 and Rule 64 EPC and is admissible.

Procedural violation

15. As the Appellant is no longer interested in pursuing the application, the only question to be decided is whether there was a procedural violation justifying setting aside the '90 decision, and if yes whether it is equitable to reimburse the appeal fee.
16. In its '90 decision, the Examining Division raised an objection under Article 123(2) EPC to the newly filed Claim 1. As this claim had been filed, together with expert evidence, in a **bona fide** attempt to meet earlier objections raised by the Examining Division, and the objection was fundamental to the decision to reject, the absence of a preliminary communication setting out this new objection amounted to a violation of the rights given under Article 113 EPC. This violation of the procedural requirements makes it necessary to set aside the '90 decision, and makes it equitable that the appeal fee in this appeal also be reimbursed.
17. At the outset, the Board would remark that it is true that one deficiency in the application which has not been removed by an applicant, justifies refusal of the whole application. Therefore, the Examining Division made no procedural violation in refusing the grant of

the patent on the count that the first four claims did not fulfil the requirements of Articles 54, 56 and 84 EPC.

18. As the Appellant does not wish to pursue the application, the only outstanding matter is the repayment of the appeal fees, and no order is needed as regards the application.

Order

For these reasons it is decided that:

1. The decision of 5 April 1991 under appeal is set aside.
2. The decision of 8 August 1990 under appeal is set aside.
3. Reimbursement of all pending appeal fees is ordered.

The Registrar:

The Chairwoman:

L. McGarry

U. Kinkeldey