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D E C I S I O N
of 6 April 1994

Case Number: T 0647/93 - 3.5.2

Application Number: 88309812.1

Publication Number: 0313334

IPC: G11B 5/64

Language of the proceedings: EN

Title of invention:

Magneto-optic recording medium and method of magneto-optic recording using the same medium

Applicant:

Hitachi Maxell Limited

Opponent:

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Headword:

Procedural violation/HITACHI MAXELL

Relevant legal norms:

EPC Art. 109, 111(1), 113(2)

EPC R. 67, 68(2)

Rules of Procedure of the Boards of Appeal Art. 10

Keyword:

"Decision of first instance not taken on text submitted by applicant - substantial procedural violation"

"Failure to follow procedure set out in Guidelines - not a substantial procedural violation"

"Decision of first instance not well reasoned - not a substantial procedural violation"

"Remittal to first instance for further prosecution"

"Reimbursement of appeal fee"

Decisions cited:

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Headnote:

I. The provision of Article 113(2) EPC, that the European Patent Office shall consider and decide upon the European patent application or the European patent only in the text submitted to it, or agreed, by the applicant for or proprietor of the patent, is a fundamental procedural principle, being part of the right to be heard, and is of such prime importance that any infringement of it, even as the result of a mistaken interpretation of a request, must, in principle, be considered to be a substantial procedural violation. In any case, such violation occurs when, as in the present case, the Examining Division does not make use of the possibility of granting interlocutory revision under Article 109 EPC, after the mistake has been pointed out in the grounds of appeal.



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Chambres de recours

Case Number: T 0647/93 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 6 April 1994

Appellant: Hitachi Maxell Limited
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Decision under appeal: Decision of the Examining Division 067 of the
European Patent Office dated 8 February 1993
refusing European patent application
No. 88 309 812.1 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: R.E. Persson
Members: W.J.L. Wheeler
A.G. Hagenbucher

Summary of Facts and Submissions

- I. The Appellant lodged an appeal against the decision of the Examining Division to refuse application No. 88 309 812.1. The reason given for the refusal was that an invention could not be recognized in view of what was already described in GB-A-2 162 008 (referred to as D1).
- II. The Appellant requested that the application be remitted to the Examining Division for further examination on the basis of Claims 1 to 10 submitted with the Statement of Grounds of appeal and that the appeal fee be reimbursed.
- III. Claim 1 reads as follows:

"1. A magneto-optic recording medium comprising a transparent substrate (1), a magneto-optic recording film (3) having a vertical anisotropic characteristic formed on the transparent substrate (1), and a perpendicular magnetization film (4) formed on the magneto-optic recording film (3), the perpendicular magnetization film (4) having a small coercive force at room temperature and a sufficiently high Curie point relative to the coercive force and Curie point of the magneto-optic recording film (3)."

The wording of Claims 2 to 10 is not relevant to the present decision.

- IV. The Appellant argued essentially that the claims filed with the Statement of Grounds of appeal corresponded exactly to the originally filed claims with the amendments to Claims 1 and 2 set out in the letter of 22 December 1992 in reply to a communication from the Examining Division. The amendments overcame objections

under Articles 54 and 84 EPC which had been raised in the communication. The reply also included an argument in support of inventive step. The Appellant had therefore clearly made a *bona fide* attempt to deal with the objections (c.f. Guidelines for Examination in the EPO, C-VI, 4.3). The Examining Division had committed substantial procedural violations in that it had misinterpreted the amendment to Claim 1 set out in the letter of 22 December 1992, not followed the procedure set out in the Guidelines, C-VI, 4.3 and not provided a written reasoned decision as required by Rule 68(2) EPC.

Reasons for the Decision

1. The appeal is admissible.
2. The Appellant has submitted that the Examining Division committed a substantial procedural violation in that it misinterpreted the amendment to Claim 1 set out in the letter of 22 December 1992.
 - 2.1 The Appellant's letter of 22 December 1992 contains the following statement:

"I wish to make the following amendments:

Claim 1, lines 8 to 10, delete ":the magneto-optic...recording film." and insert "relative to the coercive force and Curie point of the magneto-optic recording film (3)".

Claim 2, line 4, delete "12,000" and insert "1200"."

- 2.2 Although the originally filed Claim 1 has a comma rather than a colon in line 8, it is nevertheless unambiguously clear that, in response to the suggestion made by the Examining Division in the last paragraph on page 1 of the official communication of 6 March 1992, the Appellant wanted to delete the following passage from the end of the originally filed Claim 1: ", the magneto-optic recording film (3) and the perpendicular magnetization film (4) making up a multilayered recording film."
- 2.3 Furthermore, although the place where "relative to the coercive force and Curie point of the magneto-optic recording film (3)" is to be inserted is not explicitly specified in the Appellant's letter of 22 December 1992, it is implicit in the context that, in the absence of an indication to place it elsewhere, it should be inserted at the end of the claim to replace the deleted passage.
- 2.4 Thus, in the opinion of the Board, there is no reasonable doubt that the Appellant requested Claim 1 to be amended so as to have the wording of Claim 1 of the set of claims submitted with the grounds of appeal (recited in paragraph III above). This, therefore, is the text submitted by the applicant at the time when the decision under appeal was taken.
- 2.5 However, the text of Claim 1 attached to the decision under appeal differs from the text submitted by the applicant in that the phrase "and the perpendicular magnetization film (4) making up a multilayered recording film." has not been deleted. Furthermore, this does not appear to be the result of a clerical error made in preparing the copy of the claim attached to the decision, since it is clear from points 1.1 and 1.2 of

the decision under appeal that the Examining Division considered and decided upon the application on the basis of the text of Claim 1 attached to the decision.

- 2.6 In the opinion of the Board, this involves an infringement of Article 113(2) EPC, according to which the European Patent Office shall consider and decide upon the European patent application only in the text submitted to it, or agreed, by the applicant. This is a fundamental procedural principle, being part of the right to be heard, and is of such prime importance that any infringement of it, even as the result of a mistaken interpretation of a request, must, in principle, be considered to be a substantial procedural violation. In any case, such violation occurs when, as in the present case, the Examining Division does not make use of the possibility of granting interlocutory revision under Article 109 EPC, after the mistake has been pointed out in the grounds of appeal. 2
3. According to Article 10 of the Rules of Procedure of the Boards of Appeal, the Board shall remit the case to the first instance if fundamental deficiencies are apparent in the first instance proceedings. It is therefore not necessary for the Board to examine the case any further.
4. Nevertheless, the Board considers it to be appropriate in the circumstances of the present case to comment on the Appellant's submissions that the Examining Division committed substantial procedural violations in that it had not followed the procedure set out in the Guidelines, C-VI, 4.3 and had not provided a written reasoned decision as required by Rule 68(2) EPC.

- 4.1 Although it is normally desirable for Examining Divisions to act in accordance with the Guidelines, the Board wishes to point out that the Guidelines are guidelines, not rules of law, so that failure to follow a procedure set out there is not in itself a substantial procedural violation.
- 4.2 The reasons for the refusal, as set out under points 3 and 4 of the decision under appeal, are no doubt somewhat enigmatic. In particular, they would seem to reflect the idea that a "not essential" difference over the prior art or a lack of technical advance would rule out the recognition of a patentable invention. There is no basis for this in the EPC. However, even if thus the reasons for the decision are not well founded, this does not mean that the decision is not reasoned at all in the sense of Rule 68(2) EPC. Consequently, there is no procedural violation in this respect.
5. The Board thus comes to the conclusion that the decision under appeal must be set aside and makes use of its powers under Article 111(1) EPC to remit the case to the first instance for further prosecution, as requested by the Appellant. Furthermore, the Board considers that in view of the procedural violation (see points 2 to 2.6 above) it is equitable to refund the appeal fee, as provided for under Rule 67 EPC.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution.
3. The request for reimbursement of the appeal fee is allowed.

The Registrar:

The Chairman:


M. Kiehl


E. Persson

