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D E C I S I O N
of 9 March 1995

Case Number: T 0999/93 - 3.4.2
Application Number: 88120625.4
Publication Number: 0319997
IPC: C25D 3/32, C25D 3/60, C25D 3/36
Language of the proceedings: EN

Title of invention:

Tin, lead or tin/lead alloy electrolytes for high speed electroplating

Applicant:

LeaRonal, Inc.

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 113(2)
EPC R. 51(5)

Keyword:

"Basis of decisions - lack of agreed text (no)"

Decisions cited:

-

Catchword:

If, upon a communication under Rule 51(4) EPC based upon an auxiliary request of the applicant, the applicant states disapproval of the proposed text while insisting upon receiving an appealable decision regarding the main request, this is not a case of lack of a text agreed by the applicant.



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Boards of Appeal

Chambres de recours

Case Number: T 0999/93 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 9 March 1995

Appellant: LeaRonal, Inc.
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Representative: Hansen, Bernd, Dr.rer.nat
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Decision under appeal: Decision of the Examining Division of the
European Patent Office dated 19 July 1993 refusing
European patent application No. 88 120 625.4
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: E. Turrini
Members: W. W. G. Hofmann
B. J. Schachenmann

Summary of Facts and Submissions

1. During examination of the European patent application No. 88 120 625.4 oral proceedings took place at the instance of the Examining Division. At the oral proceedings of 27 October 1992, the Applicant submitted four different sets of claims as a main and three auxiliary requests. At the end of these proceedings the Examining Division stated that Claims A, B and C (essentially corresponding to the main and first and second auxiliary requests) were not allowable whereas Claim D (third auxiliary request) could be accepted. On 4 December 1992 a communication under Rule 51(4) EPC was sent to the Applicant based on the corresponding set of claims and description. It was accompanied by the minutes of the oral proceedings and an "ANNEX" to the minutes containing reasons for the conclusion of the Examining Division referred to above.

- II. In response to this communication, the Applicant, in a letter of 6 April 1993, stated his disapproval with the text proposed for grant and requested that a decision should be issued based upon the claims according to the main request. The Formalities Officer acting for the Examining Division refused the application pursuant to Rule 51(5) EPC by decision of 19 July 1993 for the reason that there was no text to serve as a basis for the grant in the sense of Article 113(2) EPC.

- III. The Appellant lodged an appeal against this decision. He requested that the decision of the Examining Division be set aside and a patent be granted on the basis of a new set of claims filed together with the grounds of appeal. In a further letter, the Appellant withdrew the formerly submitted pages, requested that the application should proceed on the basis of the text annexed to the

communication under Rule 51(4) EPC of the Examining Division, stated his approval of the text proposed for grant with the above communication under Rule 51(4) EPC, and suggested that the case might be returned to the Examining Division for entry into the formal granting procedure.

Reasons for the Decision

1. The notice of appeal was filed and the appeal fee paid within two months after the date of notification of a decision of the Examining Division to refuse the application, and the grounds of appeal were filed within four months after that date. The appeal is therefore admissible.
2. The Appellant has now directed his only request to the text of the application documents in which the Examining Division had intended to grant a patent according to its communication under Rule 51(4) EPC. Since, evidently, the Appellant does no longer feel adversely affected by the intentions of the Examining Division, there is no reason for the Board to continue the appeal procedure by examining the text already accepted by the Examining Division.

The Appellant is, of course, still adversely affected by the pending decision to refuse the application. However, this decision has to be set aside not only because of the newly agreed text of the application, but in particular on the following grounds.

3. The formal decision of 19 July 1993 to refuse the application under Rule 51(5) EPC, first sentence, for lack of any approved text of the application

(Article 113(2) EPC), was incorrect since the fact that the Appellant never withdrew the main and first and second auxiliary requests as well as the Appellant's letter of 6 April 1993 (disapproval of the text proposed for grant, but request for a decision on the main request) clearly shows that he indeed approved and proposed the text according to his higher-ranking requests (see also Rule 51(5) EPC, second sentence). The decision would instead have required a reasoning as to the substance of the main, first auxiliary and second auxiliary requests, of the type contained in the "ANNEX" to the minutes of the oral proceedings of 27 October 1992, and should have been signed by the members of the Examining Division. Not only were the reasons of this decision contrary to the facts, the procedure leading up to this decision was also contradictory in itself. As appears from the minutes of the oral proceedings of 27 October 1992 (cf in particular page 2, last paragraph and the text on the last page of the EPO FORM 2009), a decision refusing Claims A, B and C (essentially corresponding to the main and first and second auxiliary requests) had been orally announced, which announcement for taking effect, according to Rule 68(1) and (2) EPC would have required completion by notifying to the Appellant a reasoned decision in writing.

Such a notification of the decision in writing was never prepared. The "ANNEX" to the minutes of the oral proceedings - although containing reasons - cannot validly fulfil the function of a decision in writing since it does not bear any name or signature. It is not possible to see from it that it has been made by the examiners who were appointed to the particular examining division responsible for the oral proceedings. However, if a decision of a particular division is to be legally valid, it must have been written on behalf of and represent the views of the members who were appointed to

that division to decide the issues forming the subject of the decision, and it must bear signatures which indicate this (see T 390/86, OJ EPO 1989, 30, No. 7 of the reasons). Moreover, the Formalities Officer informed the Appellant (in a telephone call of 15 January 1993) that the minutes and the annex did not constitute an appealable decision.

4. The impugned decision of 19 July 1993, on the other hand, does not, for the reasons set out above, comply with the provisions of Article 113(2) EPC. The fact that the Examining Division when refusing the application ignored the proposed claims according to the Appellant's higher-ranking requests amounts to a substantial procedural violation within the meaning of Rule 67 EPC. The way in which the examination procedure was conducted led, in the present case, to a confusing situation for the Applicant requiring him to invest additional time and effort to safeguard his rights. The reimbursement of the appeal fee is, in the Board's judgment, equitable in these circumstances.
5. Since, with its decision, the Board fully grants the request of the Appellant, the Appellant's subsidiary request for a "hearing" does not have to be considered.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of the text of the application communicated to the Appellant under Rule 51(4) EPC on 4 December 1992.
3. The reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

P. Martorana

E. Turrini

