

**Decision of Technical Board of Appeal 3.4.1 dated 9 July 1997**

**T 1105/96 - 3.4.1**

(Language of the proceedings)

Composition of the board:

Chairman: G. D. Paterson

Members: U. G. O. Himmler

R. K. Shukla

**Applicant: HAMAMATSU PHOTONICS K.K.**

**Headword: Requests/HAMAMATSU**

**Rule: 67, 68(2), 86(3) EPC**

**Keyword: "Further auxiliary request indicated to be allowable but stated to be inadmissible unless all previous requests are abandoned" - "Substantial procedural violation" - "Appeal allowed on basis of further auxiliary request"**

*Headnote*

*I. An applicant has a right both to file one or more auxiliary requests in addition to a main request, and to maintain all such requests (that is, not to withdraw or abandon them), even if the Examining Division communicates its view that all except the last auxiliary request (possibly with further amendment) are inadmissible or unallowable,*

*and he is then entitled to a reasoned appealable decision in respect of rejection of each such request.*

*II. Where an Examining Division has communicated its view that a further request in the form of an amended text of a claim would be allowable, the rejection in advance of such a further request unless all preceding requests are abandoned is an unlawful exercise of discretion under Rule 86(3) EPC, and a substantial procedural violation within Rule 67 EPC.*

### **Summary of facts and submissions**

I. This application was refused by a decision of the Examining Division dated 7 August 1996 following oral proceedings held on 29 July 1996, on the ground of lack of inventive step of the subject-matter of claim 1 of the main request. Furthermore, according to the decision the first and second auxiliary requests which had been filed by the applicant were held to be inadmissible under Rule 86(3) EPC because they related to different inventions which were not in unity with the main request.

II. According to the minutes of the oral proceedings, which are also dated 7 August 1996, during the oral proceedings the applicants were informed that according to the initial opinion of the Examining Division the main request was not allowable due to lack of inventive step and violation of Article 123(2) EPC, and the first and second auxiliary requests did not relate to the same invention as the main request. The applicants were also informed that "a new claim based on the second subsidiary request amended to include the features of original claims 1, 3 and 28 (as earlier suggested in a communication dated 13 January 1995)...would be acceptable". Following the presentation of further arguments and an interruption of the proceedings, the applicants were informed that the main request was not allowable

and that the two auxiliary requests were not admissible under Rule 86(3) EPC, but that a new main request based on the suggested new claim "would be allowable ... and ... would be admissible provided that the present main, first and second requests were abandoned". Following a further interruption of the proceedings the applicants stated "that no new subsidiary request would be filed at present, and that the main, first and second requests...were maintained as a final request". The decision to refuse the main request under Article 52(1) EPC and not to admit the two auxiliary requests under Rule 86(3) was then announced.

III. The applicants duly filed an appeal. The notice of appeal was filed on 16 October 1996, and stated that "the applicants intend to file an amended set of claims with the Statement of Grounds to follow", and requested interlocutory revision under Article 109 EPC. The notice of appeal also requested reimbursement of the appeal fee under Rule 67 EPC, as being "equitable by reason of a substantial procedural violation occurring during the oral proceedings ...". The grounds of appeal were filed on 9 December 1996, and duly included an amended description and amended claims, and referred to the specified parts of the decision, as well as "the undertakings given at the oral proceedings" as a basis for requesting rectification of the decision of the Examining Division by interlocutory revision. The grounds of appeal were accompanied by a separate letter also filed on 9 December 1996, which requested reimbursement of the appeal fee on the basis of alleged substantial procedural violations during the oral proceedings, which letter may be summarised as follows:

Substantial procedural violations occurred during consideration by the Examining Division as to whether a further auxiliary request based on a suggested amended claim including the subject-matter of original claim 28 would be admissible. The Examining Division "stated that such an amendment could be entered, but only on condition that the Applicant's main, first auxiliary and second auxiliary requests were

abandoned". The placing of such a condition upon the admissibility of the further auxiliary request was said to be "clearly an abuse of the Examining Division's power under Rule 86(3) EPC." Reference was made to Decision T 166/86 as setting out the proper basis on which the discretion under Rule 86(3) EPC should be exercised. The Examining Division wrongly attempted "to force the Applicant to abandon its right to appeal the ... imminent decision regarding the main, first auxiliary and second auxiliary requests". Furthermore, the Examining Division failed to provide any real reasoning for its decision not to admit the further auxiliary request, as required under Rule 68(2) EPC (see Decision T 183/89), "but instead erroneously relied on attaching a condition to the exercise of its discretion."

IV. In a further letter dated 23 January 1997 which was filed in the appeal proceedings, the applicants complained that the action of the Examining Division in failing to grant interlocutory revision under Article 109 EPC was in bad faith and incorrect, having regard to the assurances given by the Examining Division during the oral proceedings to the effect that they would grant interlocutory revision. Following a communication on behalf of the Board of Appeal in which inter alia it was pointed out that the Examining Division probably did not grant interlocutory revision because of the additional allegation by the applicants that a substantial procedural violation had occurred (which could not be dealt with by interlocutory revision), the applicants withdrew the allegation of bad faith.

#### **Reasons for the decision**

1. It is very well established that in both examination and opposition proceedings before the EPO amendments to the text of an application or patent may be proposed in the form of main and one or more auxiliary requests (see Legal Advice 15/84, OJ EPO 1984, 491; T 79/89, OJ EPO 1992, 283; T 234/86, OJ EPO 1989, 79; T 169/96 30 July 1996). An auxiliary request is a request which is contingent on

the main request or any preceding auxiliary request being held to be unallowable (T 153/85, OJ EPO 1988, 1).

When one or more auxiliary requests are filed in addition to the main request (as in the present case), the EPO is bound to these requests, and to their order. Before a decision can be made in relation to an auxiliary request, the main request and all preceding auxiliary requests must be examined and decided upon (Article 113(2) EPC; T 155/88, 14 July 1989, and T 484/88, 1 February 1989, both cited in Case Law of the Boards of Appeal of the EPO; T 169/96 supra) - so long as such preceding requests have not been withdrawn, and are therefore still pending (T 169/96 supra).

Thus, an applicant has a right to file one or more auxiliary requests in addition to a main request, and has a right to maintain all such requests (that is, not to withdraw or abandon them), even if the Examining Division communicates its view that all requests except the last auxiliary request (possibly with further amendment) are inadmissible or unallowable. If the applicant does maintain such main and previous auxiliary requests in such circumstances, he is entitled to a reasoned appealable decision in respect of rejection of each such request.

2. In the present case, according to the minutes of the oral proceedings before the Examining Division dated 7 August 1996 as summarised in paragraph II above, during such oral proceedings the Examining Division stated in effect that an amended text of claim 1 of the application would be allowable, but that such an amended text for claim 1 would only be regarded as an admissible request provided that all the other pending preceding requests were abandoned. The applicant did not abandon the preceding pending requests; and, not surprisingly, he did not file an amended text of claim 1 as suggested by the Examining Division, because he had

already been told that it would not be admissible unless the preceding requests were abandoned.

3. It was stated in T 155/88 (*supra*) in the context of opposition proceedings that "It would clearly be very wrong if an Opposition Division did attempt to "require" a patentee to withdraw a main request or any auxiliary request". It is similarly very wrong for an Examining Division to make it a condition for admissibility of a further request that all preceding requests must be abandoned. As stated above, an applicant has a right both to file and to maintain on file a main request and one or more auxiliary requests. What happened during the oral proceedings before the Examining Division in the present case appears to have been a blatant attempt to coerce the applicant into abandoning the preceding requests, and thus into abandoning the right to appeal against the rejection of the preceding requests.

4. The admissibility of any main or auxiliary request which is filed after the reply to the first communication from the Examining Division is a matter within the discretion of the Examining Division (Rule 86(3) EPC). Such discretion must be exercised lawfully having regard to the relevant circumstances. In a case such as the present, where an Examining Division has indicated that a further request in the form of an amended text for the main claim of an application would be allowable, it is difficult to imagine any circumstances in which it would be lawful for the Examining Division to deny the admissibility of such request, in the exercise of such discretion. Certainly, in the circumstances of the present case, the rejection in advance of such a further auxiliary request unless all preceding requests were abandoned was an abuse of procedure, an unlawful exercise of discretion under Rule 86(3) EPC, and thus a substantial procedural violation within the meaning of Rule 67 EPC. Reimbursement of the appeal fee is clearly equitable.

5. In the statement of grounds of appeal the applicant has requested grant of a patent with text which had been indicated as allowable by the Examining Division during the proceedings before it. In the absence of the allegation in the grounds of appeal of a substantial procedural violation during the examination proceedings, the Examining Division should have ordered interlocutory revision under Article 109 EPC. Thus the appeal is clearly allowable.

6. The Board also notes that according to the decision under appeal the first and second auxiliary requests were held to be inadmissible because their subject-matter was not in unity with that of the main request. No legal or factual reasons for this finding are set out in the decision, and Rule 68(2) EPC has therefore also been violated by the decision under appeal.

### **Order**

#### **For these reasons it is decided that:**

1. The decision of the Examining Division is set aside, and the appeal is allowed.
2. The case is remitted to the first instance with an order to grant a patent on the basis of the text specified in the grounds of appeal filed on 9 December 1996.
3. The appeal fee shall be reimbursed.