

Decision of Technical Board of Appeal 3.4.1 dated 5 December 1997

T 951/97 - 3.4.1

(Language of the proceedings)

Composition of the board:

Chairman: G. Davies

Members: U. G. O. Himmler

R. K. Shukla

Applicant: CASIO COMPUTER CO., LTD.

Headword: Right to be heard/CASIO

Article: 111(1), 113(1), 117(1) EPC

Rule: 67, 68(2), 71a(1), (2) EPC

Keyword: "Right to be heard" - "Introduction of new evidence by the examining division during the oral proceedings" - "Admissibility of a new auxiliary request during the oral proceedings" - "Lack of reasoning in the decision" - "Reimbursement of appeal fees"

Headnote

The subject of the proceedings is changed within the meaning of Rule 71a(1) and (2), inter alia where the examining division itself introduces a new document, which

is pertinent new material, into the proceedings for the first time during oral proceedings convened following a Rule 71a notification.

Summary of facts and submissions

I. European patent application No. 93 103 140.5 was refused by a decision of the examining division dated 18 April 1997, following oral proceedings held on 5 March 1997, on the ground that the subject-matter of the claims of the main and first auxiliary requests did not involve an inventive step (page 10, point 6 of the decision).

Furthermore, according to the decision, the examining division decided not to admit for consideration the method claims 1-3 of the second auxiliary request, which had been filed during the oral proceedings, stating that its refusal to do so was "in accordance with Rule 71a EPC since the subject of the proceedings has not changed" (page 3, point 8 of the decision).

Moreover, continuation of the proceedings in writing was refused on the ground that the case was ready for a decision (page 3, point 8 of the decision).

II. According to the minutes of the oral proceedings, which are also dated 18 April 1997, in the course of these proceedings the examining division introduced for the first time a further document, namely D4 = IEEE Transactions on Electron Devices, 35(7), July 1988, pp. 923-928. This document had been mentioned in the European search report but had not been cited at any stage in the examining procedure prior to the oral proceedings; in particular, D4 had not been referred to by the examining division in the communication under Rule 71a issued together with the summons to oral proceedings.

Following the introduction of this new citation, the oral proceedings were adjourned for half an hour to allow the representative of the appellant to study D4. Thereafter,

the representative of the appellant (according to the minutes) said that he intended to file a method claim since the content of D4 was surprising and represented a change in the subject of the proceedings. Subsequently, the representative filed method claims 1-3 as a second auxiliary request. Thereafter, a further adjournment of the oral proceedings took place in order to allow the examining division to study the submitted method claims.

According to the minutes, after the newly-submitted method claims 1-3 had been studied by the examining division:

"the chairman stated that the submitted method claims would not be admitted into the proceedings under Rule 71a EPC and gave brief reasons for this, namely, they were prima facie not admissible (Article 123(2) EPC) and not allowable, inter alia, due to a lack of clarity (Article 84 EPC)" (cf. page 3, last para., to page 4, first para.).

In response to this statement of the examining division, the representative of the appellant submitted that a further opportunity for amendment should be given since a newly-cited document had been introduced by the examining division, changing the subject of the proceedings. In addition, the appellant should be given sufficient time to comment on this newly-cited document; otherwise Article 113 EPC would be violated. In support of his arguments, the representative cited Decision **T 783/89** of 19 February 1991.

Following two further deliberations of the examining division, the chairman announced its decision, according to which the application was refused under Article 97(1) EPC on the grounds, as stated in the minutes:

"that the subject-matter of claims 1 of both the main and [first] auxiliary requests lacked an inventive step with respect to the teaching of D1 and/or D4 and the

common general knowledge of the skilled person", (page 5, penultimate para.).

(Emphasis added by the Board)

Furthermore, according to the minutes, claims 1-3 of the second auxiliary request, which had been filed during oral proceedings:

"were not admitted and the resumption of the proceedings in writing was denied since the case was ready for a decision" (page 5, last sentence of penultimate para.).

III. The applicant duly filed an appeal. The notice of appeal was filed on 30 June 1997 and the appeal fee was paid the same day. The grounds of appeal were filed on 28 August 1997 and the appellant requested that the decision of the examining division be set aside and a patent granted on the basis of the main request refused by the examining division and a new auxiliary request. The appellant additionally requested that the appeal fee be refunded in accordance with Rule 67 EPC. Finally, oral proceedings were requested in the event that neither the main request nor the auxiliary request could be allowed. The appellant submitted arguments as to why, in the appellant's view, the subject-matter of the claims 1 of the main request as well as of the (amended) auxiliary request were allowable (paragraphs I and II of the grounds of appeal).

Under paragraph III of the grounds of appeal, the appellant submitted arguments in favour of the requested reimbursement of the appeal fee on the basis of an alleged substantial procedural violation having occurred during the oral proceedings. The essentials of this paragraph may be summarised as follows:

- By introducing a new citation D4 into the examination procedure during the oral proceedings, the examining division had brought up new arguments to which the representative of the applicant had had a chance to listen, but to which he was not

allowed to react by reformulating the claims. Therefore, the applicant's rights according to Article 113 EPC had been violated.

- The reasons for the decision of the examining division had tried to give the impression that document D4 had only been cited "to convince the representative"; however, the reasons for the decision with respect to inventive step were largely based on this document. If document D4 had not been considered to be relevant, there would have been no need to introduce it.

- However, the relevance of the document was illustrated by the fact that not only did the examining division rely on this newly-cited document D4 in the reasons for its decision, but also the oral proceedings were viewed in an entirely new perspective following the introduction of document D4. Therefore, the "Applicant's Right To Be Heard" had been violated, which was a substantial procedural violation justifying the reimbursement of the appeal fee according to Rule 67 EPC.

Reasons for the decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.

2. The conditions under which a European patent application may be amended in proceedings before the European Patent Office are governed by Article 123 and Rule 86 EPC. Following receipt of the European search report and before receipt of the first communication from the examining division, the applicant may, of his own volition, amend the description, claims and drawings (Rule 86(2) EPC). After receipt of the first communication from the examining division the applicant may, of his own volition, again amend once the description, claims and drawings in reply to the communication. No further amendment may be made without the consent of the the examining division (Rule 86(3) EPC). Whether or not that consent is given is at the

discretion of the examining division and depends on the facts of the individual case, on the nature of the grounds for seeking an amendment, and equally on the stage of the procedure. It is easier to secure an amendment at an earlier rather than at a later stage (cf. *Singer*, Lunzer edition, 123.05).

3. Rule 71a is relevant to the filing of amendments prior to oral proceedings.

Rule 71a(1) obliges inter alia the examining division to draw the attention of the parties in advance of oral proceedings, when issuing the summons thereto, to the points which in its opinion need to be discussed for the purposes of the decision to be taken. At the same time a final date for making written submissions in preparation for the oral proceedings is fixed and, pursuant to Rule 71a(2), the parties may be invited to submit documents which meet the requirements of the Convention, including amendments to the description, claims and drawings. Indeed, in the present case, the Rule 71a communication did invite the appellant to submit submissions and amendments. New facts and evidence presented after that date need not be considered, unless admitted on the grounds that the subject of the proceedings has changed (Rule 71a(1), fourth sentence, EPC). This provision applies mutatis mutandis to amendments submitted after that date (Rule 71a(2), second sentence).

4. In the present case, according to the minutes of the oral proceedings before the examining division dated 18 April 1997, as summarised in paragraph II above, during such oral proceedings the examining division introduced a newly-cited document D4 into the procedure, which had been quoted in the European search report but had not been cited previously in the examining procedure.

4.1 The presentation of this newly-cited document constitutes a new fact and evidence in the procedure as is clear from the wording of Article 117(1) EPC which reads:

"In any proceedings before an Examining Division, ... the means of giving or obtaining evidence shall include the following:

- (a) ...
- (b) ...
- (c) the production of documents;"

After the presentation of this new evidence, the oral proceedings were interrupted for half an hour to give the applicant the opportunity to study this document, which is an article from a scientific journal comprising five and a half pages. The text and the structure of such scientific articles are usually, and actually in the present case, more complex than the text and structure of patent literature as the latter are highly standardised. Therefore, in the Board's view, half an hour is too short a period for an adequate analysis of such a complex text. Moreover, in the decision under appeal the examining division did not deal with the submissions of the applicant in relation to the relevance of document D4 to the question of inventive step.

4.2 At the end of the oral proceedings, the examining division announced its decision according to which the application was refused under Article 97(1) EPC based on the reasoning that

"the subject-matter of claims 1 of both the main and auxiliary requests lacked an inventive step with respect to the teaching of D1 **and/or D4** and the common general knowledge of the skilled person"; cf. page 5, penultimate paragraph of the minutes. (Emphasis added by the Board)

Although the examining division implied that document D4 had only been cited

- "to remove any remaining doubts as to how well-founded its (the Examining Division's) position was" (page 3, para. 4, of the minutes) and

- "to emphasize the above textbook knowledge" (page 6, para. 5, of the decision)

there is no doubt that document D4 is neither a text book nor does its content represent textbook knowledge but, as is usual for this kind of scientific journal, represents the most recent developments in the field of electron devices at the time of its publication date.

Furthermore, it follows quite clearly from the argumentation of the examining division

- "**explaining** in particular that the statement on page 927 of D4 was actually clear and specific, and obviously **also referred to** the passage on page 924.

Consequently ... could not be seen as involving an inventive step **in view of D4**" (cf. page 3, para. 2, of the minutes) and

- "as D4 clearly teaches on page 927 ... **taken together** with page 924" and "Therefore, D4 gives the skilled person a clear **incentive to try** " (cf. page 6, last para. to page 7, first para. of the decision) (Emphasis added by the Board)

that the decision of lack of inventive step with respect to the main and the first auxiliary requests could not have been well-reasoned without introducing document D4 as new evidence. For the foregoing reasons it is clear that document D4 was essential to the finding of the examining division in relation to inventive step.

Consequently, the decision was based on evidence on which the applicant did not have a sufficient opportunity to present his comments as required by Article 113(1) EPC.

As the right to be heard is one of the basic procedural principles of the EPC, the disregarding of this principle constitutes a substantial procedural violation.

5. Furthermore, according to its decision, the examining division decided not to consider the second auxiliary request pursuant to Rule 71a EPC on the ground that the subject of the proceedings had not changed.

5.1 The admissibility of any main or auxiliary request which is filed after the final date fixed by the examining division when issuing the summons for oral proceedings has to be considered in the light of both Rule 86(3), which gives the examining division a general discretion to admit or refuse amendments, and the fourth sentence of Rule 71a(1), which, according to Rule 71a(2), applies *mutatis mutandis* to amendments and reads as follows:

"New facts and evidence presented after that date **need not** be considered, **unless admitted** on the grounds that the subject of the proceedings has changed."

(Emphasis added by the Board)

In the Board's opinion, the words "need not be considered, unless admitted" mean that as a general rule the examining division is not obliged to admit new facts and evidence, or amendments as the case may be, but maintains its discretion to do so; however, if the subject of the proceedings has changed, it should exercise its discretion in favour of admitting them.

The question, therefore, arises whether in this case the introduction of Document D4 by the examining division itself during the oral proceedings had changed the subject of the proceedings. The examining division took the view that the subject had not changed but gave no reasons in support of its view. Rule 71a EPC entered into force relatively recently on 1 June 1995 and the meaning of the expression "a change in the subject of the proceedings" has not so far been interpreted by the boards of appeal. According to the Guidelines, an example of such a change in the subject of the proceedings and its consequences would be "where the opponent files, before the indicated date, pertinent new material, the patent proprietor must be

given a chance to present his comments and submit amendments (Art. 113(1))" (E-III, 8.6). The Board concurs with this definition.

By analogy, therefore, in the opinion of the Board, the presentation of D4 by the examining division in the oral proceedings was equivalent to the filing of pertinent new material and, in the circumstances of the present case, the examining division could have been expected to exercise its discretion to admit amendments filed in response thereto, in order to avoid any violation of Article 113(1). Furthermore, in the Board's view, it would be contrary to the proper exercise of such discretion, if clearly allowable amendments overcoming the outstanding objections were not to be admitted into the proceedings.

However, in the particular circumstances of this case, the Board is unable to assess whether the examining division exercised its discretion reasonably or whether its decision was based on wrong principles, for the reasons given in paragraph 5.2, below.

5.2 According to the minutes of the oral proceedings at the end of which the decision under appeal was announced, the examining division decided not to admit the second auxiliary request but failed to give any reasons or arguments as to why it considered the subject of the proceedings not to have changed. Under "I. Summary of Facts and Submissions", point 8 of the decision under appeal, it is simply stated:

"The Examining Division decided not to consider the method claims (second auxiliary request) in accordance with Rule 71a EPC since the subject of the proceedings has not changed."

This is no more than a bald statement, unsupported by any legal or factual reasons to justify the finding that the subject of the proceedings had not changed. In chapter "II. Reasons for the Decision" of the decision of the examining division, the second

auxiliary request is not even referred to. Thus, the examining division totally failed to provide any reasoning in support of its decision not to admit the second auxiliary request, as required under Rule 68(2) EPC (see T 182/88 (OJ EPO 1990, 287) and T 183/89 of 30 July 1990) and failed even to refer to the brief further reasons for the decision mentioned in the minutes of the oral proceedings. Furthermore, these reasons were themselves not sufficiently substantiated (cf. page 3, last para., to page 4, first para.).

Therefore, the decision under appeal is not in conformity with Rule 68(2) EPC, which amounts to a further substantial procedural violation.

6. The Board thus comes to the conclusion that the decision under appeal must be set aside and makes use of its power under Article 111(1) EPC to remit the case to the first instance for further prosecution of the application, taking into account the submissions of the appellant with regard to document D4.

Furthermore, the Board considers that in view of the substantial procedural violations (see points 4.2 and 5.2 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 of the examining division is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. The appeal fee shall be reimbursed.