

3.4. Cases where the EPO is uncertain or mistaken about the approval of the text

In T 382/10 the board held that, to avoid any misunderstanding, in particular when requests were amended during oral proceedings, the examining division should clarify the final requests before pronouncing its decision at the conclusion of oral proceedings (see also chapter V.B.4.4.2 "Rule 104(b) EPC – failure to decide on a party's request"). In accordance with prevailing case law (T 666/90, T 552/97 and T 1439/05, see below), the fact that the final requests were not established contravened Art. 113(2) EPC and was considered a substantial procedural violation. In T 1104/14 it was held that failure to obtain clarification where needed also amounted to a procedural violation because it was then not clear which version of the patent was being put forward by the patent proprietor for decision, resulting in a breach of Art. 113(2) EPC. Basing a decision on the wrong requests constituted a substantial procedural violation because freedom of disposition was cardinal and disregarding it adversely impacted the entire proceedings.

In T 666/90 the status of the requests was not clarified during oral proceedings before the opposition division. This resulted in a disagreement between the patentee and the opposition division in the period between oral proceedings and the drafting of the decision. According to the board, the appropriate action would have been to request, prior to the decision being issued, a written copy of the final version of the requests and a clarification of their order. In T 552/97 the opposition division had taken no decision on the main request, incorrectly assuming that it was no longer in the proceedings. The board pointed out that EPO departments should clarify the position before issuing decisions, especially if requests had been amended in oral proceedings. In T 355/03 it was unclear which text the applicant wished to have as the basis for grant. The board held that the examining division should have established what the applicant really wanted.

In T 1653/16, the appellant (applicant) argued that its main request had not been addressed in the examining division's decision. Instead, the decision was based on a version of a claim "unofficially submitted" by e-mail as a basis for discussion, of which there was no record on the file. From the minutes of the oral proceedings, it was not clear whether the main request was still maintained or whether the applicant even requested a decision on the amended claim since it appeared that at the end of the proceedings, before announcing the decision, the applicant was not asked to state its final requests. The board concluded that as the examining division had not established whether the main request which it refused was the version agreed by the applicant, it had violated Art. 113(2) EPC thereby committing a substantial procedural violation.

In T 1439/05 it was held that if there were several requests in the form of a main request and successive auxiliary requests submitted in order of relevance, the examining division was bound in its decision by the order in which the requests had been submitted.

In T 425/97, the text of the single claim attached to the written decision of the opposition division was different from the text apparently held patentable at the oral proceedings. From the original minutes of the oral proceedings, the history of the case and further circumstances, the board concluded that the opposition division, in violation of