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D E C I S I O N
of 15 October 2003

Case Number: J 0008/02 - 3.1.1

Application Number: 96115710.4

Publication Number: 0833178

IPC: G02 B13/06

Language of the proceedings: EN

Title of invention:
Optics assembly for observing a panoramic scene

Applicant:
ROCKWELL INTERNATIONAL CORPORATION

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 121

Keyword:
"Request for further processing unnecessary but granted anyway"
"Reimbursement of the fee for further processing (yes)"

Decisions cited:
-

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: J 0008/02 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal3.1.1
dated 15 October 2003

Appellant: ROCKWELL INTERNATIONAL CORPORATION
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 8 January 2002 refusing the request for reimbursement of the fee for further processing concerning the European patent application 96115710.4.**

Composition of the Board:

Chairman: J-C. Saisset
Members: M. B. Tardo-Dino
J. H. P. Willems

Summary of Facts and Submissions

I. The decision under appeal is a decision dated 8 January 2002 issued by the Examining Division relating to the European application No. 96 115 710.4.

II. By this decision issued after a request for a decision pursuant to Rule 69(2) EPC the Examining Division rejected the request to refund the fee for further processing, granted the request for further processing and revoked the finding notified in the communication dated 25 July 2001 that the application was deemed to be withdrawn.

III. The applicant lodged an appeal against this decision on 5 March 2002. The relevant facts are the following:

IV. After the first further time limit of four months was set the applicant requested two further extensions, one was granted on 2 February 2001, the second filed on 23 March 2001, was granted on 2 May 2001.

V. But, in case the EPO did not intend to extend the requested time limit extension, the applicant submitted with a letter dated 23 April 2001 a preliminary response to the communication dated 13 September 2000.

VI. A notification of loss of rights under Rule 69(1) EPC was issued on 25 July 2001 on the grounds that the applicant had not complied with the invitation to file observations on the communication dated 13 September 2000 with the legal consequence that the application was deemed withdrawn (Article 96(3) EPC).

VII. The applicant sent two separate letters both dated 4 September 2001:

– in the first one the applicant stated that he had previously submitted a preliminary response to the communication of 13 September 2000 and had requested oral proceedings as a precaution. Additional explanatory documents numbered pages 1 to 6 were attached to this letter.

– in the second one it applied for further processing under Article 121 EPC ,and for refund of the fee for further processing on the ground that the Official Communication of 13 September 2000 had been answered by its amendments dated 23 April 2001.

VIII. The decision under appeal to reject the request to refund fee for further processing assumed that the submissions attached to the reply filed on 23 April 2001 were filed on the condition that they were to be used only if no extension of time limit according to the request dated 23 March 2001 was granted. A further extension of time limit was granted, and the Examining Division thus concluded that the preliminary response was to be considered as "null and void".

IX. Before the Board of Appeal the appellant requested that the decision of 8 January 2002 be annulled as far as the refusal to refund the fee for further processing was concerned.

Oral proceedings were also requested.

Reasons for the Decision

1. The appeal is admissible since it complies with the conditions set out in Articles 106, 107 and 108 EPC combined with Rules 64 and 65 EPC.

2. Since the Board for the reasons mentioned below intends to allow the appeal, it does not see any purpose in holding oral proceedings.

3. In rejecting the request dated 4 September 2001 for reimbursement of the fee for further processing the Examining Division did not consider the reply of 24 April 2001 as complying with the invitation issued on 13 September 2000 , because the applicant specified that it was a preliminary reply filed on the condition that it was to be used only if no additional extension of time limit requested on 23 March 2001 was granted. As the extension was allowed, the preliminary reply was not taken into account.

This course of action cannot be supported by the Board. The request of the applicant addressed to the Examining Division on 4 September 2001 after the communication of loss of rights under Rule 69(1) EPC, albeit not totally clear, aimed first of all to safeguard its application against the risk that the Examining Division considered its preliminary response invalid.

The fact that at the same time it requested further processing it contended that the preliminary response did comply with the invitation of the Examining Division dated 13 September 2000, shows that the request for further processing was only a precautionary

measure, and that the main request was that the decision concerning loss of rights be reversed.

The reason given by the first instance for refusing to reverse its decision under Rule 69(2) EPC and consequently to consider the reply of 23 April 2001 as not complying with its communication of 13 September 2000 is a purely formalistic one. The simple fact that the applicant added at the top of the response that it was a preliminary reply in case no extension of time limit would be granted does not deprive this response of its essential nature.

An amended text was submitted in order to comply with the invitation of the Examining Division, and it could not be simply ignored only because it was included as a precautionary measure.

It appears that the Examining Division erred when it refused to consider the reply of 23 April 2001 as a valid reply and when it chose to grant further processing, rather than reversing its decision on loss of rights.

In fact there was no need to request further processing and the Examining Division should have continued the prosecution of the application after reversing its decision on loss of rights.

Thus there was no reason for a request for further processing and the fee paid for this request has no basis in law. This does not change just because the appellant filed a request for further processing, as this clearly was done by way of precautionary measure.

A fee that has been paid for a specific request the object of which has never existed - or is deemed not to have existed - is to be refunded.

The appeal therefore is allowed and the decision under appeal set aside.

Order

For these reasons it is decided that:

The decision under appeal is set aside and the fee for further processing is refunded

The Registrar: The Chairman:

M. Fabiani M. Saisset