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**Datasheet for the decision
of 03 April 2009**

Case Number: J 0018/08 - 3.1.01

Application Number: 05852554.4

Publication Number:

IPC: A61B 5/00

Language of the proceedings: EN

Title of invention:

Medical sensing device and system

Applicant:

Alden, Dana Andrew

Opponent:

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Headword:

Appointment of representative/ALDEN

Relevant legal provisions:

EPC Art. 90(5), 133(2)
EPC R. 112(1),(2), 163(5),(6)

Relevant legal provisions (EPC 1973):

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Keyword:

Appointment of representative corrected on appeal

Decisions cited:

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Catchword:

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Case Number: J 0018/08 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 03 April 2009

Appellant: Alden, Dana Andrew
312 Hudson Avenue
Claredon Hills IL 60514 (US)

Representative: Grünecker, Kinkeldey,
Stockmair & Schwanhäusser
Anwaltssozietät
Leopoldstraße 4
D-80802 München (DE)

Decision under appeal: Decision of the Receiving Section of the
European Patent Office of 03 July 2008 refusing
the European patent application pursuant to
Article 90(5) EPC.

Composition of the Board:

Chairman: B. Günzel
Members: P. Schmitz
D. S. Rogers

Summary of Facts and Submissions

- I. Euro-PCT application 05 852 554.4 was filed as international application PCT/US2005/043355 on 1 December 2005 on behalf of Dana Andrew Alden, having her residence in the United States. The application claimed a priority of 1 December 2004.
- II. On 29 June 2007, the applicant filed Form 1200 for entering the European phase before the European Patent Office and paid the necessary fees. In a communication dated 7 January 2008, the applicant was requested to notify the appointment of a professional representative. A time limit of two months was set. Since the deficiency was not corrected, the Receiving Section refused the application under Article 90(5) EPC on 3 July 2008.
- III. On 30 July 2008, notice of appeal was filed by a professional representative who notified the European Patent Office at the same time that he had been appointed as the representative in this application. The appeal fee was paid on the same day. The appellant's requests were:
to rectify the decision under Article 109 EPC and to continue the examination procedure; or
if the decision was not rectified, to set the decision under appeal aside and to remit the case back to the first instance with an order to continue the examination procedure; or
if the decision was not rectified and the case not remitted to the first instance to set the decision under appeal aside and to grant a patent on the

application on the basis of the papers on file.

- IV. In justifying these requests, the appellant submitted that the deficiency on which the refusal was based had been rectified by the appointment of the representative.

Reasons for the Decision

1. The appeal is admissible.
2. According to Article 133(2) EPC, natural or legal persons not having their residence or principal place of business in a Contracting State shall be represented by a professional representative and act through him. When entering the European phase, no representative had been appointed. In a communication headed "Request to notify the appointment of a representative pursuant to Rule 58 or Rule 163(5) EPC", the applicant was therefore requested to correct this deficiency within a time limit of two months. Since this was not done, the application was refused. The refusal was based on Article 90(5) EPC, although the legal basis should have been Rule 163(6) EPC which is the special provision for Euro-PCT applications. However, Rule 163(6) EPC is in line with Article 90(5) EPC (see explanatory remarks to Rule 163(6) EPC, Special edition No. 5 OJ EPO 2007, 254) and therefore there seems to be no difference.
3. When filing the appeal, the deficiency on which the refusal was based was corrected. Thus the underlying ground for the refusal has been overcome and the reasoning in the decision under appeal no longer applies.

4. Article 90(5) EPC provides that if any deficiency noted in the examination under paragraph 3 is not corrected, the European patent application shall be refused unless a different legal consequence is provided by the Convention. From this it follows that if an appeal is filed against such a refusal, the Board of Appeal has to examine whether the deficiency noted has been corrected or not.

5. The present case is different from the situation where the non-observance of a time limit automatically leads to the application being deemed to be withdrawn. In such a case the legal consequence automatically ensues when an act required within a specific time limit is not performed, without any decision to be taken concerning the refusal of the application. The loss of rights will be communicated to the applicant under Rule 112(1) EPC. He may then apply for a decision under Rule 112(2) EPC and thereafter appeal against a negative decision. Within this context it will only be examined whether the finding in the loss of rights communication under Rule 112(1) EPC was accurate or not. It will only be inaccurate if the act required was performed within the prescribed period since it is the non-observance of this act which automatically causes the loss of rights. With this procedure deficiencies cannot be corrected but it only results in a re-examination of the loss of rights communication.

6. By contrast, if the application is refused under Article 90(5) EPC the deficiency on which the decision is based can be corrected at the appeal stage. Since

this has been done in the present case, the appeal is to be allowed.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar

The Chairman

S. Fabiani

B. Günzel