BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS

BOARDS OF APPEAL OF THE EUROPEAN PATENT OFFICE

CHAMBRES DE RECOURS DE L'OFFICE EUROPEEN DES BREVETS

Internal distribution code:
(A) [ ] Publication in OJ
(B) [ ] To Chairmen and Members
(C) [X] To Chairmen
(D) [ ] No distribution

D E C I S I O N
of 11 January 2002

Case Number: T 0470/00 - 3.2.1

Application Number: 95902186.6

Publication Number: 0750723

IPC: F16B 31/02, B25B 23/14, H01R 4/30

Language of the proceedings: EN

Title of invention:
Improvements relating to clamping screws

Applicant:
SICAME ELECTRICAL DEVELOPMENTS LTD

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 111(1)

Keyword:
"Decision re. appeals - remittal (yes)"

Decisions cited:
-

Catchword:
-

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0470/00 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 11 January 2002

Appellant: SICAME ELECTRICAL DEVELOPMENTS LTD
Riverholme Works
Huddersfield Road
Holmfirth HD7 2TN (GB)

Representative: Wood, Graham
Bailey Walsh & Co
5 York Place
Leeds LS1 2SD (GB)

Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 28 September 1999 refusing European patent application No. 95 902 186.6 pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: F. A. Gumbel
Members: J. Osborne
G. E. Weiss

Summary of Facts and Submissions

I. The appeal is directed against the decision of the Examining Division to refuse application No. 95 902 186.6 (EP-A-0 750 723), which was posted on 28 September 1999. The European application originated from a PCT application PCT/GB94/02608 which was subject to examination by the EPO in accordance with Chapter II of the PCT. Notice of appeal was filed on 22 November 1999 together with payment of the due fee. The grounds of appeal were received on 7 February 2000.

II. During the regional phase before the EPO the Examining Division issued a first examination report pursuant to Article 96(2) and Rule 51(2) EPC in which it raised objections by reference to the opinion indicated in the International Preliminary Examination Report (IPER). According to that opinion the subject-matter of the independent claims 1, 25, 31 lacked novelty whilst the subject-matter of the remaining claims lacked inventive step because "the technical features therein are either known from the documents of the search report or are features which the man skilled in the art can be expected to consider in the course of his normal activity ... ". In response to the first examination report the applicant filed on 20 April 1998 a first new set of Claims 1 to 19, including three independent Claims 1, 13 and 17.

III. In a second examination report dated 28 October 1998 the Examining Division objected that the subject-matter of Claims 1, 17 filed in April 1998 lacked novelty and raised objections in accordance with Article 123(2) EPC. In response to the second report the applicant filed on 28 April 1999 a second new set of

Claims 1 to 19, including three independent Claims 1, 13, 17.

IV. The Examining Division based its decision to refuse only on lack of novelty of Claim 1 filed in April 1999 and regarded it as unnecessary to treat the other claims (Point 5 of the reasons).

V. Upon appeal the applicant filed as Appendix 7 to a letter dated 7 February 2000 a third new set of Claims 1 to 15 in which the two independent Claims 1, 14 essentially correspond to Claims 13, 17 of the second new set of April 1999. The applicant requested that the decision of the Examining Division be set aside and that a patent be granted on the basis of the newly filed claims. The applicant further requested that the appeal fee be refunded due to an alleged procedural violation in that the Examining Division issued its decision without giving a further opportunity for comment and in that the decision treated only Claim 1. Oral proceedings were requested as an auxiliary measure.

VI. With a communication dated 21 March 2001 pursuant to Article 12 RPBA the Board informed the applicant of its opinion that no procedural error had occurred and that it therefore intended to refuse the request for refund of the appeal fee. The Board furthermore proposed to remit the file to the first instance for further prosecution.

VII. With a letter dated 12 July 2001 the applicant agreed to the Board's intention to remit the case and indicated its acceptance of the Board's opinion as regards refund of the appeal fee. The request for oral

proceedings was withdrawn.

Reasons for the Decision

1. The appeal is admissible.

2. The applicant has deleted the only claim which was treated in the decision and so has overcome the single ground for refusal. Claim 14 is identical to Claim 17 filed in April 1998, in respect of which the Examining Division had raised an objection of lack novelty. However, the applicant filed comments in response thereto and it is unclear from the file whether the Examining Division maintains its objection of lack of novelty against the subject-matter of present Claim 14. Moreover, the sole mention in the file of inventive step is by reference to the general statement in the IPER relating to all of the dependent claims as a group. It therefore is unclear whether inventive step of the present independent claims has been considered by the Examining Division. Under these circumstances the Board exercises its discretion in accordance with Article 111(1) EPC to remit the case to the first instance for further prosecution.

3. In the letter dated 12 July 2001 the applicant indicated its acceptance of the Board's opinion that the request for refund of the appeal fee should be refused. The Board interprets that acceptance as a withdrawal of the request which therefore need not be treated further.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the first instance for further prosecution.

The Registrar: The Chairman:

S. Fabiani F. Gumbel