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**D E C I S I O N**  
**of 27 October 2004**

**Case Number:** T 0903/00 - 3.5.1

**Application Number:** 90914375.2

**Publication Number:** 0490992

**IPC:** G06F 15/20

**Language of the proceedings:** EN

**Title of invention:**

A thrombolysis predictive instrument

**Applicant:**

NEW ENGLAND MEDICAL CENTER HOSPITALS, INC., et al

**Opponent:**

-

**Headword:**

Benefit of therapy/NEW ENGLAND MEDICAL

**Relevant legal provisions:**

EPC Art. 125

EPC R. 67

**Keyword:**

"Protection of legitimate expectations"

"Reimbursement of appeal fee (no)"

**Decisions cited:**

G 0002/97

**Catchword:**

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Case Number: T 0903/00 - 3.5.1

**D E C I S I O N**  
**of the Technical Board of Appeal 3.5.1**  
**of 27 October 2004**

**Appellants:**

NEW ENGLAND MEDICAL CENTER HOSPITALS, INC.  
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**Representative:**

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**Decision under appeal:**

**Decision of the Examining Division of the  
European Patent Office posted 10 February 2000  
refusing European application No. 90914375.2  
pursuant to Article 97(1) EPC.**

**Composition of the Board:**

**Chairman:** S. V. Steinbrener  
**Members:** R. R. K. Zimmermann  
B. J. Schachenmann

## Summary of Facts and Submissions

- I. The appeal lies from European patent application number 90 914 375.2 (International publication number WO 91/03203) and is against a decision of an examining division refusing the application for reasons of lack of inventive step.
- II. The examining division raised corresponding objections in two communications issued in 1995 and 1997. Neither one of the communications broached the possibility or the necessity of oral proceedings.
- III. In a reply letter dated 30 March 1998 and received by the EPO on 1 April 1998, the appellants submitted arguments on the merits of the invention and commented on the follow-up procedure as follows:

"If on further review, the Examiner still feels that anything is unclear in this passage, it is thought that a brief discussion by telephone may help to resolve this.

In addition, if on further review there is any other point which the Examiner feels still requires attention, we would be happy to discuss this telephone in the hope that it would avoid the need for the Oral Proceedings which the Examiner has indicated would now be appointed if he remains unsatisfied in the light of the applicants' response. The applicants are keen to resolve this application rather than have it further delayed through Oral Proceedings."

- IV. Two years later, following an enquiry by the appellants in November 1999 and without giving further notice, the examining division refused the application, posting the refusal decision in writing on 10 February 2000. The decision referred to the issue of oral proceedings, stating that contrary to the above-cited passage in the appellants' letter of 30 March 1998 the examiner had never indicated oral proceedings to be appointed, and that the passage did not constitute a request for oral proceedings.
- V. A notice of appeal was filed by the appellants on 10 April 2000; payment of the appeal fee was effected the same day. A written statement setting out the grounds of appeal and an amended set of claims were filed on 13 June 2000. Oral proceedings as an auxiliary request and the reimbursement of the appeal fee because of a substantial procedural violation in the first instance were requested.
- VI. In a communication annexed to summons to oral proceedings the Board stated that the case was not clearly allowable regarding inventive step and raised doubts concerning industrial applicability of the claimed invention. A procedural violation could have been committed by the examining division by not having clarified the situation regarding oral proceedings before taking the refusal decision; nevertheless the reimbursement of the appeal fee as requested was indicated not to be equitable in the light of the circumstances.

- VII. Following the summons to oral proceedings the appellants filed a reply letter on 15 July 2004, now merely requesting the reversal of the decision under appeal and the remittal of the case to the first instance without having oral proceedings before the Board.
- VIII. In the appellants' view, the refusal of the application without holding oral proceedings was a substantial procedural violation. The said paragraph in their letter of 30 March 1998, on a proper interpretation, implicated that the writer considered oral proceedings as the only and mandatory alternative to an informal interview in case the examiner was not persuaded by the contents of the letter, and thus constituted a request for oral proceedings.

The decision under appeal indicated that there was an error of fact in relation to oral proceedings so that the need for clarification had to have been evident to the examining division, a duty the examining division failed to satisfy, however.

The attorney handling the case had left the representative's firm. With the considerable protraction of the examination procedure of two years between the letter of March 1998 and the refusal decision of February 2000 it was, not surprisingly, impossible to find out why the representative believed, possibly for example as a result of a telephone call, that he had received an indication that oral proceedings would have to be held.

The case law of the boards of appeal, as illustrated by decisions like T 19/87 (OJ EPO 1988,268), T 283/88, and T 668/89 (the two last decisions both not publ. in OJ EPO), had laid down the principle that when there was the slightest doubt of whether a request for oral proceedings had been made or not the examining division should seek clarification from the party concerned. Adverse cases on this issue, for example T 299/86 (OJ EPO 1988, 88), T 433/87, and T 263/91 (both decisions not publ. in OJ EPO), turned on a close reading of phrases not used in the letter of March 1998.

### **Reasons for the Decision**

1. The appeal complies with the requirements of Articles 106 to 108 and Rules 1(1) and 64 EPC and is thus admissible.
2. Moreover, the appeal is allowable on the basis of the last filed requests of 15 July 2004 since the examining division committed a procedural violation, the redress of which requires the remittal of the case to the first instance for further prosecution.

According to the procedural principle of the protection of legitimate expectations the EPO pursuant to Article 125 EPC should warn an applicant of any loss of rights if such a warning can be expected in all good faith (see for example decision of the Enlarged Board of Appeal G 2/97-Good faith/UNILEVER, OJ 1999, 123, point 4.1). The paragraph bridging pages 4 and 5 of the appellants' letter dated 30 March 1998, although this passage cannot be considered to contain a request for

oral proceedings, was a clear indication to the examining division that on the part of the appellants there was a misunderstanding regarding the future course of action to be taken by the examining division and the necessity of requesting oral proceedings under the circumstances.

A timely warning to the appellants that the examining division did not intend to hold oral proceedings had secured the appellants' right to be heard in oral proceedings. Such a warning could have been expected by the appellants in all good faith since their mistake in respect of the future course of action was readily identifiable by the examining division during the normal handling of the case, and this at a stage where the application was still pending before the examining division.

It was a rather crude and unfair approach and a violation of the above-said principle of the protection of legitimate expectations when the examining division notified the mistake for the first time in the refusal decision, i.e. when it was already too late for the appellants to take appropriate measures to safeguard their legitimate interests. Under such circumstances it was irrelevant that the mistake was apparently not caused by any erroneous information from the EPO and that thus the ultimate responsibility for the mistake rested with the appellants. The examining division still had the duty to warn the appellants in time since such a warning could be expected in all good faith.

3. Allowing the appellants' request for remittal of the case to the first instance is an expedient means of redress regarding the procedural violation.
4. Pursuant to Rule 67 EPC, reimbursement of the appeal fee shall be ordered if such reimbursement is equitable by reason of a substantial procedural violation. In the present case, the Board does not consider reimbursement of the appeal fee to be equitable since it was also the responsibility of the appellants to avoid confusing situations, for example by requesting oral proceedings in a clear and unambiguous manner.

## **Order**

### **For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

M. Kiehl

S. V. Steinbrener