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D E C I S I O N
of 17 February 2003

Case Number: T 1183/02 - 3.5.2

Application Number: 99910558.8

Publication Number: 1064722

IPC: H03F 3/08

Language of the proceedings: EN

Title of invention:
BUFFER CIRCUIT

Applicant:
QinetiQ Limited

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 109
EPC R. 67

Keyword:
"Substantial procedural violation (no)"
"Reimbursement of appeal fee following interlocutory revision (no)"

Decisions cited:
T 185/82, J 10/84

Headnote:
A response to a summons to oral proceedings before the examining division which response contains good faith

responsive amendments and arguments does not stay the summons. Hence omission of confirmation that the summons remains valid does not constitute a substantial procedural violation within the meaning of Rule 67 EPC. (Reasons 3 to 8).

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 1183/02 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 17 February 2003

Appellant: QinetiQ Limited
85 Buckingham Gate
London, SW1 6TD (GB)

Representative: -

Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 2 February 2002 refusing European patent application No. 99 910 558.8 pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: W. J. L. Wheeler
Members: R. G. O'Connell
P. Mühlens

Summary of Facts and Submissions

I. This is a residuary appeal referred to the board for a decision on the reimbursement of the appeal fee following the granting of interlocutory revision by the examining division pursuant to an appeal filed against its refusal of European patent application No. 99 910 558 (Article 109 EPC and Rule 67 EPC).

II. The application originated as a PCT international application which was the subject of an international preliminary examination report (IPER) which formed the basis for a first communication of the examining division dated 20 September 2001. In a response dated 26 October 2001 and received on 26 November 2001 the applicant filed amended claims and description and largely rehearsed the arguments which had been adduced in the PCT procedure. On 1 February 2002 the examining division issued a summons to oral proceedings to take place on 23 May 2002. The summons was accompanied by a reasoned communication explaining in detail *inter alia* why the objection of lack of novelty was maintained in respect of claim 1 and including a claim proposal which could overcome the objection. In response to this communication the applicant filed on 19 February 2002 *inter alia* a redrafted claim 1. A covering letter explained the rationale behind the redrafting and included the sentence: "Applicant would be grateful if the Examiner would confirm that oral proceedings need not now be held".

III. On 23 May 2002 the oral proceedings were held as appointed. The applicant was not represented. The chairman of the examining division observed *inter alia* that the subject-matter of redrafted claim 1 was not

new for the reasons given in the communication accompanying the summons to oral proceedings and, having secured the agreement of the other members of the examining division, he proceeded to announce the decision of the examining division that the application was refused. The reasoned written refusal decision was posted on 2 July 2002.

IV. On 13 August 2002 the applicant (now appellant) appealed the decision of the examining division and in the statement of grounds of appeal filed on 4 October 2002 requested reimbursement of the appeal fee (Rule 67 EPC). As noted at point I above, the examining division rectified its refusal decision (Article 109(1) EPC, first sentence) but did not order reimbursement of the appeal fee.

V. The appellant's argument in support of his request for reimbursement of the appeal fee is reproduced verbatim below:

"6. Applicant also requests return of the Appeal Fee, on the grounds that the need for the Appeal arises because of the Examining Division’s failure to notify errors, apply principles of good faith and respond to Applicant’s letter, contrary *inter alia* to T 185/82 "Posso" and J 10/84 "Texas". In this connection, Applicant’s letter of 19 February 2002 was written in response to the Summons to attend oral proceedings dated 1 February 2002, and was thought by Applicant to have resolved all outstanding issues without the need for oral proceedings. Applicant fully appreciates that the Examining Division may not have accepted that all issues were in fact resolved, but if so Applicant

respectfully submits that T 185/82 and J 10/84 indicate that the Examining Division should have notified Applicant to that effect by a short note, e-mail or telephone call.

7. Applicant's letter specifically requested the Examining Division to confirm that Oral Proceedings would not now be held, but received no reply. Applicant understands from J 10/84 Texas in particular that the European Patent Office has a duty to react to parties' requests and that letters from applicants should not go unanswered.

8. Applicant was very surprised to read the Examining Division's statement that Applicant's letter of 19.02.02 was "in preparation for the oral proceedings" - see paragraph 5 of the Facts and Submissions section of the Grounds for the decision (Annex); this accompanies the Examining Division's letter of 02.07.02. This Examining Division statement is difficult to understand unless it is an oversight, because Applicant's letter of 19.02.02 contained the following sentence at the end of paragraph 3, *"Applicant would be grateful if the Examiner would confirm that oral proceedings need not now be held"*: this cannot be consistent with preparation for oral proceedings.

9. Applicant experienced cancellation of oral proceedings in connection with another European Patent Application No 92 924 837.5 (Applicant's ref P2069EPW) also in the electronics field: Applicant filed amendments to this application following a Summons to attend oral proceedings. On

that occasion the oral proceedings were cancelled but Applicant only discovered this by telephoning the European Patent Office - Applicant later confirmed the substance of the call by writing to the European Patent Office. Applicant therefore believed that the Examining Division did not notify cancellation of oral proceedings unless an applicant requested it.

10. In the present case Applicant’s attorney telephoned the Examining Division following receipt of the Decision to reject this European patent application: Applicant was informed that the Examining Division’s practice was to inform applicants if oral proceedings were cancelled but not if they were not cancelled (despite it would seem Applicant’s request in this regard). This seems illogical, because a failure to notify cancellation does not result in loss of a patent application, but this loss does occur if there is failure to notify a lack of cancellation.

11. Applicant requests oral proceedings in the event that the European Patent Office is minded to refuse this appeal."

VI. In a reasoned communication accompanying a summons to oral proceedings the board expressed its provisional view that there appeared to be no basis for a refund of the appeal fee in the circumstances of the present case.

VII. By letter dated 24 January 2003 the appellant informed the board that he would not attend the oral proceedings, whereupon the board cancelled the latter.

VIII. Interlocutory revision having been granted by the examining division, the appellant requests reimbursement of the appeal fee pursuant to Rule 67 EPC.

Reasons for the Decision

1. The appeal is admissible.

2. Rule 67 EPC provides *inter alia* that reimbursement of the appeal fee shall be ordered in the event of interlocutory revision "...if such reimbursement is equitable by reason of a substantial procedural violation."

3. The appellant alleges that the failure of the examining division to reply to his statement in his letter of 19 February 2002 that he "would be grateful if the Examiner would confirm that oral proceedings need not now be held" constituted a substantial procedural violation within the meaning of Rule 67 EPC.

4. In the judgement of the board the quoted statement was an expression of the applicant's belief that all outstanding issues had been resolved without the need for oral proceedings coupled with a request to the examining division that it should signal its acceptance of the applicant's amendments and arguments by cancelling the oral proceedings.

5. It appears to the board to accord with linguistic idiom, with the norms of procedural law and indeed with common sense that the tacit assumption in the formulation of such a request is that if the examining

division is not persuaded by the applicant's arguments then the oral proceedings will take place.

6. Whether it would be good administrative practice on the part of the examining division to signal its non-acceptance of the applicant's arguments by confirming that oral proceedings will take place as appointed is debatable in administrative terms, but is not something for the board to consider. The only question for the board is whether the applicant had a legal procedural right to such a confirmation whose omission would therefore constitute a substantial procedural violation within the meaning of Rule 67 EPC.

7. The appellant argues at paragraph 10 of the statement of grounds of appeal that the examining division is obliged to issue such a confirmation, since "failure to notify a lack of cancellation" (of oral proceedings) results in a loss of a patent application. This argument appears to be premised on the proposition that a response to a summons to oral proceedings which response contains good faith responsive amendments and arguments is to be regarded as having the effect of a stay of the original summons, which therefore has to be either cancelled or renewed by a confirmatory summons (notice of lack of cancellation) to obviate the risk of the applicant losing his application as an outcome of oral proceedings conducted in his absence.

8. The board is not persuaded that there is any legal basis for such a proposition.

9. As regards the decisions T 185/82 ("Posso" OJ EPO 1984, 174) and J 10/84 ("Texas" 29 November 1984, not published in OJ EPO) relied on by the appellant, the

board observes that in the latter case the board refused reimbursement of the appeal fee since it had not found any substantial procedural violation and in the former case the board found that the examining division had committed a substantial procedural violation in that it had exploited an obvious factual mistake made by the applicant in an inventive step argument to refuse the application. In the judgement of the board neither of these decisions supports the appellant's case.

Order

For these reasons it is decided that:

The residuary appeal relating to the reimbursement of the appeal fee is dismissed.

The Registrar: The Chairman:

D. Sauter W. J. L. Wheeler