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D E C I S I O N
of 3 September 2003

Case Number: T 0095/03 - 3.2.3

Application Number: 96943414.1

Publication Number: 0950139

IPC: E02F 9/28

Language of the proceedings: EN

Title of invention:
Tooth arrangement

Applicant:
Componenta Wear Parts Aktiebolag

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 111(1), 113
EPC R. 68

Keyword:
"Bona fide" - in the appeal (yes)"
"Remittal to first instance for further prosecution"

Decisions cited:
-

Catchword:
-



Case Number: T 0095/03 - 3.2.3

D E C I S I O N
of the Technical Board of Appeal 3.2.3
of 3 September 2003

Appellant: Componenta Wear Parts Aktiebolag
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Representative: Lautmann, Kurt O.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 27 September 2002
refusing European patent application
No. 96 943 414.1 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: C. T. Wilson
Members: J. B. F. Kollar
M. K. S. Aúz Castro

Summary of Facts and Submissions

- I. International application PCT/SE/96/01481 published on 28 May 1998 under International publication number WO 98/22 664 now European patent application No. 96 943 414.1 entered into the regional phase before the EPO on 10 June 1999.
- II. The Examining Division issued a communication pursuant to Article 96(2) EPC dated 15 February 2001, in which it raised objections under Articles 54 and 123(2) EPC against claims 1 to 4 filed by telefax on 10 June 1999.
- III. A letter containing observations in reply was filed by the Appellant on 18 May 2001 in which it was stated "...we have prepared new claims which we enclose and we find it ... would be best that we discuss the wording of the claims first and after the discussion we can do other necessary amendments very quick".
- IV. A further communication pursuant to Article 96(2) EPC was issued by the Examining Division on 22 January 2002 in which objections under Articles 56 and 123(2) EPC against claims 1 to 4 received on 18 May 2001 were raised and it was indicated that none of the claims contained inventive subject-matter, so that a refusal of the application under Article 97(1) should be expected. In section 9 of this communication it was noted, with reference to the Appellant's reply of 18 May 2001, that this reply "apart from two statements to the effect that ... the locking device according to the present invention is quite different from these of the prior art ... no substantive comments were advanced in support of this allegation" and that "this is hardly a bona fide reply".

- V. A letter containing information about a notice of Allowance in the corresponding U.S. application on the basis of three claims was filed by the Appellant on 27 March 2002, which ended with the following statement: "we enclose copies of said 3 claims and ask you if we can use the said claims in the present application ... There is also a possibility that we can solve the problem at a visit at the European Patent Office. We have a good praxis of visiting examiners ... and have any time received a very good result".
- VI. A decision to refuse the application was issued on 27 September 2002, in which it was held that "the communication (dated 22 January 2002) in items 1 to 8 listed a number of deficiencies that prevented the application from meeting the requirements of the EPC" and that the "applicant has neither commented in a bona fide manner in the outstanding substantial issues. Nor has he ... filed new/amended documents and a request as to continue processing on the basis of such documents". It was noted "that claim 1 now included in copy is ... identical to claim 1 objected to for lack of novelty in the official action dated 15 February 2001". The decision went on to say "consequently, it would appear that the applicant is making no real effort to deal with the examiner's objections, either by amendments or by counter-arguments. In this circumstance the examining division has decided to refuse the application under Article 97 EPC".

VII. The Appellant filed a Notice of Appeal on 18 November 2002 and paid the prescribed fee on 20 November 2002. In the statement of grounds of appeal filed together with the Notice of Appeal the Appellant, after taking up his experience of personal discussions with the examiners at the EPO, submitted a set of two amended claims and subsidiarily requested an oral hearing.

Reasons for the Decision

1. The appeal is admissible.
2. *Basis of the decision*

According to the statement at the top of page 1 of the contested decision the examination, and hence the decision, was based on the claims 1 to 4 received on 18 May 2001 rather than on the last set of claims filed with the letter of 22 March 2002. The reason for this according to the contested decision, paragraph 5, is that because there is no clear request in respect of these new claims. If this is indeed so, the Examining Division would have been obliged immediately to clarify the requests. In the present case the failure of the Examining Division to do this has no legal consequence since the contested decision is factually not restricted to the claims filed on 18 May 2001 but rather covers all three sets of claims considered in the examination proceedings, Article 113(2) EPC.

The requirements of Article 113(1) and of Rule 68(2) EPC are met in that reference is made in the contested decision to the communications of the Examining Division dated 15 February 2001 and 22 January 2002 in

which fully reasoned objections to lack of novelty and lack of inventive step are made against the claims 1 filed on 10 June 1999 and 18 May 2001 respectively, and in that it is pointed out that the claim 1 filed with the letter of 22 March 2002 is identical with that filed on 10 June 1999 and also therefore is lacking novelty.

3. *Further proceedings*

3.1 The Board agrees with the assessment of novelty and inventive step of the subject-matters of the various claims 1 as set out in the above referred-to communications of the Examining Division and as incorporated into their decision by reference.

3.2 With his statement of grounds of appeal the Appellant submitted a new set of two amended claims; claim 1 is said to have been drawn in two-part form with regard to the objections raised in the communication of the Examining Division of 15 February 2001. The differences between the present invention and the prior art as seen by the Appellant are also set out.

3.3 The Board has not examined whether or not the amended claims meet the raised objections but considers the filing of said claims to represent a **bona fide** attempt to meet them. Under these circumstances the Board deems it appropriate to exercise its power under Article 111(1) EPC and to remit the case to the Examining Division for further prosecution.

4. Since the Board does not envisage to dismiss the appeal oral proceedings as requested in such event by the Appellant need not now be held.

5. The Board would further point out in respect of this case that when an Examining Division issues two communications setting out its opinion on the patentability of a first and then a second set of claims and then receives a reply from an applicant without any counter arguments against these expressed provisional opinions but submitting claims identical to the first set with an inquiry whether the further examination could possibly be based on these claims, the applicant cannot be surprised if the Examining Division doubts that the reply can be considered as a **bona fide** attempt to deal with the objections and rejects the application without inviting further observations since it considers that there is no reasonable prospect that such an invitation would lead to the grant of a patent.

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.

The Registrar:

The Chairman:

A. Counillon

C. T. Wilson