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**D E C I S I O N**  
**of 15 July 2005**

**Case Number:** T 0208/04 - 3.3.5

**Application Number:** 00906254.8

**Publication Number:** 1149047

**IPC:** C01B 33/193

**Language of the proceedings:** EN

**Title of invention:**

Procedure for preparing silica from calcium silicate

**Applicant:**

ITALCEMENTI S.P.A.

**Opponent:**

-

**Headword:**

Silica/ITALCEMENTI

**Relevant legal provisions:**

EPC Art. 113(1)

EPC R. 67

**Keyword:**

"Refusal after only one communication of examining division"

"Procedural violation justifying reimbursement of appeal fee:  
no"

**Decisions cited:**

G 0003/03, T 0201/98, T 0939/95

**Catchword:**

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Case Number: T 0208/04 - 3.3.5

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.5  
of 15 July 2005

**Appellant:**

Italcementi S.P.A.  
Via G. Camozzi, 124  
I-24100 Bergamo (IT)

**Representative:**

Coppo, Alessandro  
Ing. Barzanò & Zanardo  
Via Borgonuovo 10  
I-20121 Milano (IT)

**Decision under appeal:**

Decision of the Examining Division of the  
European Patent Office posted 24 September 2003  
refusing European application No. 00906254.8  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** M. M. Eberhard  
**Members:** B. P. Czech  
J. H. P. Willems

## Summary of Facts and Submissions

- I. The application underlying the present appeal case was refused by the examining division on the ground that the subject-matter of independent claims 16, 20 and 24 then on file lacked novelty.
- II. In accordance with the main request submitted by the applicant with its statement of grounds of appeal dated 22 January 2004, the examining division subsequently
- set aside the contested decision;
  - decided to grant a patent on the basis of the amended set of claims 1 to 24 according to the said main request; and
  - forwarded the case to the board for a decision on the applicant's further request for reimbursement of the appeal fee.
- III. In support of its request for reimbursement of the appeal fee, the appellant argued as follows (see page 6 of the statement of the grounds of appeal):
- "... it is also requested a reimbursement of the Appeal fee in view of the fact that no warning was present in the first (and unique) Official Action indicating that the application is to be refused if the rejected claims were not deleted and in view of the fact that the answer filed by the Applicant on June 5, 2002 tried to answer all points of the outstanding Official Action. No amendment was carried out with respect to the objected product and use claims, because the Applicant

was convinced of his arguments and of the fact that such arguments could have demonstrated the patentability of the claims."

- IV. In its communication dated 12 April 2005 (see points 7. and 8.), the board informed the appellant of its provisional opinion concerning the issue of reimbursement of the appeal fee. More particularly, the board noted the following:

"The cover page (EPO Form 2001 05.00CSX) of the first communication (posted 11.12.2001) of the examining division actually does comprise a kind of "warning", which reads as follows: "If the deficiencies indicated are not rectified, the application may be refused pursuant to Article 97(1) EPC". The applicant must thus have been well aware of the possibility of a refusal of its application in case the objected claims were not deleted or amended/restricted."

"Objections concerning the lack of novelty of the subject-matter of independent claims 17 (product), 21 (use) and 25 (composition) in view of D1 had already been raised in the IPER (see Separate Sheet, the part labelled "Re Item V", points 2.1 and 2.4), to which reference was made in the first communication of the examining division. With its reply, the applicant filed a new set of claims. Former claims 17, 21 and 25 had been re-numbered and had become claims 16, 20 and 24. Their wording had not been amended except for changes in the back-references comprised therein."

"Apparently, the arguments submitted by the appellant with its reply to the first communication did not

convince the examining division that the subject-matter of the claims 16, 20 and 24 was to be considered as being novel over D1. Consequently, the examining division decided to refuse the application on this ground, using the essential legal and factual reasoning already given in the IPER and referred to again in its first communication. The fact that the applicant had dealt with all the objections raised, and believed at the time that its arguments would suffice to establish novelty without substantial amendments to the claims, does not necessarily imply that the examining division had to issue a further communication before taking its final decision. On the contrary, it is established jurisprudence of the Boards of Appeal that an examining division may refuse an application after only one communication, provided that the decision complies with Article 113(1) EPC; see e.g. T 201/98 of 27 July 1999 (copy attached), points 1.3 and 1.4 of the reasons. This is also reflected in the currently valid Guidelines for Examination in the EPO, C-VI, 2.5 and 4.3."

"Therefore, under the present circumstances, the board comes to the provisional, non-binding conclusion that the fact that the European application has been refused after only one communication despite a reply answering to the objections raised does not represent a substantial procedural violation justifying the reimbursement of the appeal fee pursuant to Rule 67 EPC."

- V. In its statement of grounds of appeal, the appellant also requested oral proceedings in case its main request (grant of a patent on the basis of the amended set of claims 1 to 24) would not be allowed. Therefore,

to clarify the position, the board informed the appellant in its communication dated 12 April 2005 that, in the circumstances of the case, it did not envisage holding oral proceedings, unless the appellant should request such in reply to the communication.

VI. In its reply dated 1 June 2005, the appellant's representative did not request oral proceedings and indicated that she had "no further comments or observations to file".

VII. The sole pending request of the appellant is that the appeal fee be reimbursed.

### **Reasons for the Decision**

1. Following decision G 3/03 of 28 January 2005 (to be published in the OJ, see Order), it is the present board of appeal that is competent to decide on the appellant's request for reimbursement.
2. A refund of the appeal fee is equitable in the case of an interlocutory revision by reason of a substantial procedural violation, see Rule 67 EPC and decision T 939/95 (OJ EPO, 1998, 481).
3. In its communication dated 12 April 2005, the board informed the appellant of its provisional opinion concerning the issue of reimbursement of the appeal fee and indicated the reasons why no substantial procedural violation justifying such a reimbursement had occurred (see point IV. above). The appellant has not provided any further arguments in reply to this reasoned

provisional opinion. Therefore, the board has no reason to depart from its provisional opinion. For the reasons indicated in the said communication, the board concludes that, considering the circumstances of the present case, there has been no procedural violation justifying the reimbursement of the appeal fee pursuant to Rule 67 EPC.

**Order**

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

The request for re-imburement of the appeal fee is refused.

The Registrar:

The Chairman:

A. Wallrodt

M. Eberhard