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**DECISION**  
**of 11 August 2005**

**Case Number:** T 0244/05 - 3.5.3

**Application Number:** 95830020.4

**Publication Number:** 072467

**IPC:** G11C 15/00

**Language of the proceedings:** EN

**Title of invention:**

Programmable Multibit Register for Coincidence and Jump  
Operations and Coincidence Fuse Cell

**Applicant:**

STMicroelectronics S.r.l.

**Opponent:**

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**Headword:**

Reimbursement of appeal fee/STMICROELECTRONICS

**Relevant legal provisions:**

EPC Art. 109(1), 113(1), 21  
EPC R. 67

**Keyword:**

"Reimbursement of appeal fee (no)"

**Decisions cited:**

G 0003/03, T 0201/98

**Catchword:**

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Case Number: T 0244/05 - 3.5.3

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.3  
of 11 August 2005

**Appellant:** STMicroelectronics S.r.l.  
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I-20041 Agrate Brianza (Milano) (IT)

**Representative:** Pellegri, Alberto  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 12 November 1999  
refusing European application No. 95830020.4  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** A. S. Clelland  
**Members:** A. Ritzka  
R. Moufang

## Summary of Facts and Submissions

I. This appeal, which was filed on 5 January 2000, lies against the decision of the examining division dated 12 November 1999, refusing European patent application No. 95 830 020.4. The appeal fee was paid together with the notice of appeal and the statement of grounds of appeal was filed on 1 March 2000.

II. The application as filed included independent claims 1 and 6, together with claims 2 to 5 depending on claim 1 and claims 7 and 8 depending on claim 6. In a communication dated 11 March 1999 the examining division cited the documents:

D1: EP 058 049 A

D2: Patent abstracts of Japan vol. 18 No. 216 (P-1728), 18 April 1994 & JP 06 012884 A (NEC Corp), 21 January 1994.

It was stated that claims 1 to 5 were not new in view of D1 and that the only difference between the subject matter of claim 6 and D1 was that in D1 no sense amplifier to amplify the signal on the sensing line was used. As the use of sense amplifiers for amplification purposes was generally known to the skilled person, as shown by D2, claims 6 to 8 did not involve an inventive step. Under point 5 of the communication it was stated that it was not apparent which part of the application could serve as a basis for a new allowable claim.

III. With a letter of 16 July 1999 the appellant filed a set of seven claims, claim 1 being a combination of

- original claims 1 and 5 and claims 2 to 7 corresponding to original claims 2 to 4 and 6 to 8. It was argued that the subject matter of these claims involved an inventive step.
- IV. The examining division then refused the application on the grounds that the subject matter of claims 1 to 5 was not new and that of claims 6 to 8 did not involve an inventive step.
- V. With the statement of the grounds of appeal the appellant submitted a new set of claims and requested that the decision under appeal be set aside and that the appeal fee be reimbursed. It was argued that the examination division had issued its decision with unjustified haste and without giving the applicant the opportunity to consider the reasons why the examining division did not consider the applicant's response to be persuasive. This implied that the applicant had not made any real effort to deal with the objections.
- VI. In view of the amended set of claims filed with the statement of the grounds of appeal the examining division, by its decision dated 17 April 2000, rectified the appealed decision under Article 109(1) EPC but did not allow the appellant's request for reimbursement of the appeal fee.

### **Reasons for the Decision**

1. This case has been delayed pending a decision of the enlarged board of appeal in the case G 3/03 on the questions of whether in the event of interlocutory

revision under Article 109(1) EPC, the department of the first instance whose decision has been appealed has the power to refuse a request of the appellant for reimbursement of the appeal fee and, if the department of the first instance does not have that power, how the competent board should be constituted. The enlarged board has now decided that the department of the first instance is not competent to deal with the matter and instead the board of appeal which would have been competent under Article 21 EPC to deal with substantive issues of the appeal if no interlocutory revision had been granted is competent to decide on the request.

Accordingly the present board is competent to decide on the request for reimbursement of the appeal fee.

2. According to Rule 67 EPC, in the event of interlocutory revision the appellant's request for reimbursement of the appeal fee can only be granted if equitable by reason of a substantial procedural violation. In the present case the board understands the appellant's argument that the examining division issued its decision with unjustified haste, and without giving any further opportunity to respond, to be an allegation that the decision is based on grounds or evidence on which the appellant did not have the opportunity to present his comments, so that the decision does not comply with Article 113(1) EPC.

However, in the board's view no substantial procedural violation was committed, for the following reasons:

The applicant was informed with the communication dated 11 March 1999 of the examining division's view that

claims 1 to 5 were not novel and claims 6 to 8 did not involve an inventive step. Reasons for this view were given in the communication. The new set of claims filed in response to the communication consisted of an amended claim 1, which was a combination of original claims 1 and 5, and claims 2 to 7 corresponding to original claims 2 to 4 and 6 to 8. Thus the amended claims did not contain subject matter on which the examining division had not given their view.

The decision under appeal is based on the reasons given in the communication. Thus the applicant had had the opportunity to present comments. The decision therefore complies with Article 113(1) EPC.

The appellant's argument in favour of the request for reimbursement of the appeal fee is that the decision of refusal was made with unjustified haste and without giving the applicant the opportunity to consider the reasons why the examining division did not consider the applicant's response to be persuasive. In essence, the appellant objects that the examining division should not have refused the application after only a single communication.

However, it is established jurisprudence of the boards of appeal (see e.g. T 201/98) that an examining division is not obliged to issue a further communication if the applicant has presented his comments on a first communication and a decision can be made based on the reasons of the first communication. Although a previous version of the Guidelines for Examination in the European Patent Office, Part C, Chapter VI, Section 4.3 suggested that refusal might be

appropriate if the applicant had not made any real attempt to deal with the examining division's objections, the present version, dated December 2003, merely states that if the applicant has not dealt with all the main objections, and no positive reaction is to be expected from drawing deficiencies to his attention then immediate refusal should be considered.

As the examining division had indicated in their communication that it was not clear to them which part of the description could serve as a basis for a new, allowable claim the applicant should have been aware that, if his arguments were not deemed to be persuasive, there was a possibility that the application would be refused. Although it was open to the applicant to file a request for oral proceedings to deal with this eventuality no such request was made.

Although the examining division stated clearly in the communication dated 11 March 1999 that original claims 1 to 5 were not considered to be novel, the applicant's response of 16 July 1999 seems to assume that the objection to the appended claims was lack of an inventive step. The response does not discuss the objection of lack of novelty of original claims 2 to 5 raised at points 2 and 3.1 of the communication.

Although it might have been appropriate to draw the applicant's attention to the deficiencies e.g. by a telephone call, as suggested in the Guidelines for Examination in the European Patent Office, edition of December 2003, Part C, Chapter VI, Section 4.3, in the board's view the examining division did not exceed its

discretionary power by not doing so. No procedural violation can be found.

**Order**

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

The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

D. Magliano

A. S. Clelland