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D E C I S I O N
of 24 May 2005

Case Number: T 0245/05 - 3.2.6

Application Number: 96306765.7

Publication Number: 0763614

IPC: D04B 9/44

Language of the proceedings: EN

Title of invention:

Bias-cut, knit cover for a belt, hose or the like

Applicant:

Highland Industries, Inc.

Opponent:

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Headword:

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Relevant legal provisions:

EPC R. 67

Keyword:

"Reimbursement of the appeal fee (no)"

Decisions cited:

T 0153/84, T 0201/98

Catchword:

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Case Number: T 0245/05 - 3.2.6

D E C I S I O N
of the Technical Board of Appeal 3.2.6
of 24 May 2005

Appellant: Highland Industries, Inc.
422 Gallimore Dairy Road
Greensboro, North Carolina 27409 (US)

Representative: Warren, Anthony Robert
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 21 November 2000
refusing European application No. 96306765.7
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: P. Alting van Geusau
Members: K. Garnett
G. Pricolo

Summary of Facts and Submissions

- I. European patent application 96 306 765.7 was filed on 18 September 1996 for a bias-cut knit cover for drive belts and the like.
- II. By its communication pursuant to Article 96(2) and Rule 51(2) EPC dated 29 December 1999, the Examining Division expressed its view that the application did not meet the requirements of the EPC, mainly for the following reasons:
- (a) In respect of independent claims 1 and 2, the requirements of Article 83 EPC did not appear to be met. The Examining Division stated its view that although one of the features of the claimed invention was that stitches of the knitted cover for a drive belt were not locked by the cured rubber of the belt, such that the stitches and thus the fabric remained moveable with respect to the belt, it was not clear how this could be carried out by the person skilled in the art ('the Article 83 point').
 - (b) In respect of independent claims 1, 4 and 5, the requirements of Arts. 52(1) and 56 EPC did not appear to be met, for the reasons set out in the communication.
- III. By a letter dated 1 June 2000 a detailed response was made on behalf of the applicant, which included various amendments to the application to meet some of the objections which had been raised. The Article 83 point was dealt with relatively briefly. The letter ended by

- requesting the Examiner, if he had any further objections, to issue a further invitation under Article 96(2) EPC before reaching a decision.
- IV. On 21 November 2000 the Examination Division refused the application. In its reasons for the decision, the Division relied only on the Article 83 point. It repeated and expanded upon its earlier observations on the point and commented that in its letter of 1 June 2000 the applicant had not advanced any sound arguments or amendments dealing with the Article 83 point.
- V. With a letter of 11 January 2001, the applicant lodged a Notice of Appeal against this decision. A statement setting out the grounds of appeal was lodged with a letter dated 22 March 2001. This statement provided a much more detailed answer to the Article 83 point. It pointed out that the claimed invention was not intended to improve the mobility of the knit stitches with respect to the rubber cured thereon: indeed the stitches were not moveable with respect to the rubber.
- VI. On 6 April 2001 the Examining Division allowed the appeal and rectified its decision under Article 109(1) EPC. In its reasons, it stated that the applicant had on the appeal responded comprehensively to the objections made under Article 83 in the 29 December 1999 communication, such that the Article 83 objection was no longer maintained. It added, however, that since the relevant information could have been provided before the original decision to refuse the application, there had been no procedural violation. A refund of the appeal fee was therefore refused.

- VII. Following the decision of the Enlarged Board of Appeal in case G 0003/03, the applicant's request for reimbursement of the appeal fee was assigned to Technical Board 326 on 3 March 2005.
- VIII. By a letter dated 18 October 2001, and amplified in a letter dated 20 April 2005, the applicant put forward reasons why it was alleged there had been a substantial procedural violation and why it would be equitable, by reason of such a violation, to reimburse the appeal fee. The applicant's arguments can be summarised as follows;
- (a) The Examining Division issued its decision following the applicant's response to the first examination report. The decision was issued without further notice despite the fact that, firstly, the response was bona fide and dealt fully with the objections raised and, secondly, the response had contained a specific written request that in the event of further objections, a further invitation under Article 96(2) EPC be issued before the Examiner reached a decision.
 - (b) In its letter of 1 June 2000, the applicant had dealt concisely, yet comprehensively with the specific objection under Article 83 raised by the Examining Division, not only by identifying the particular feature which enabled the invention to be carried out by a person skilled in the art, but also by amending the claims to emphasise this feature. The applicant did not deal more fully with the objection at the time because it failed to recognise what is said to be the Examining

Division's misunderstanding or lack of appreciation as to how the feature which enabled the invention to be carried out achieved the desired result, i.e., improved durability.

- (c) It was only when the Examining Division amplified its reasons in the Grounds for its decision that the misunderstanding was recognised by the applicant and then "corrected" in the Grounds of Appeal.
- (d) The Article 83 objection should never have been raised in the first place because (a) the original disclosure was not defective, but was misunderstood or misinterpreted by the Examining Division, and (b) a person skilled in the art would have directly and unambiguously recognised that the invention was disclosed in a manner sufficiently clear and complete for it to be carried out.
- (e) It was therefore a substantial procedural violation for the Examining Division to maintain the Article 83 objection after the applicant's letter of 1 June 2000, and what the Division should have done was to identify the perceived problem in greater detail (as, it is said, it did in the Grounds for the decision) and then given the applicant an opportunity to explain.
- (f) While it is accepted that the term "further objections" used in the applicant's letter of 1 June 2000 was not the most appropriate, in the context it was obviously not restricted to new

objections to the exclusion of previously raised objections.

- (g) It was unnecessary to request oral proceedings, since the applicant was convinced that the 1 June 2000 letter was fully responsive to the objections raised.

- (h) The applicant feels aggrieved because it is felt that the expense involved in appealing could have been avoided had the Examiner explained his objection more fully, and given the applicant an opportunity to deal with it.

Reasons for the Decision

1. Rule 67 of the Implementing Regulations of the EPC provides 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.

2. From the applicant's submissions, the Board identifies three substantial procedural violations which are said to have occurred, namely:

Violation 1: The raising of an invalid objection in the first place.

Violation 2: The maintaining of the objection after receipt of the applicant's letter of 1 June 2000.

Violation 3: The issuing of a decision without further notice following receipt of the applicant's letter of 1 June 2000.

2.1 Alleged violations 1 and 2

The Board declines to go into the questions raised by the applicant, namely whether the Examining Board misunderstood or failed to appreciate how the feature which enabled the invention to be carried out achieved the desired result, and thus whether the Article 83 objection should ever have been raised in the first place or maintained thereafter.

The reason why the Board declines to go into these questions is that even if the matters referred to were to be fully accepted they would not demonstrate a substantial procedural violation within the meaning of Rule 67 EPC. Erroneous interpretation of features of the application by the Examining Division does not by itself amount to a substantial procedural violation within the meaning of Rule 67 EPC. See, e.g., Decision T 153/84.

2.2 Alleged violation 3

Decision T 201/98 points out that it is the established jurisprudence of the Boards of Appeal that an examining division does not exceed its discretionary powers by proceeding to an immediate refusal after a first communication, provided that the decision complies with Article 113(1) EPC, i.e. is based on grounds on which the appellant has had an opportunity to present

comments (referring to decisions T 84/82 (OJ EPO 1983, 451) and T 300/89 (OJ EPO 1991, 480)).

In the present case, the applicant had been given the opportunity to comment, and had indeed commented on the Examining Division's Article 83 EPC objection, if only briefly. The Board accepts that the request to the Examiner at the end of the letter of 1 June 2000 (to issue a further invitation under Article 96(2) EPC if he had any "further" objections, before reaching a decision), can properly be read as referring to any "remaining" objections of the Examiner. The Board does not, however, consider that the Examiner needed to repeat his invitation to the applicant to answer the Article 83 point. He was entitled to assume that the applicant's entire answer on the point was contained in the letter of 1 June 2000. The fact that he did not repeat his invitation to answer the point cannot amount to a procedural violation.

3. It thus follows from the facts of the case that the alleged violations do not amount to a procedural violation within the meaning of Rule 67 EPC. In the absence of any such procedural violation there is no basis for reimbursement of the appeal fee.

Order

For the above reasons it is decided that:

The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

M. Patin

P. Alting van Geusau