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**D E C I S I O N**  
**of 8 June 2006**

**Case Number:** T 0303/05 - 3.5.03

**Application Number:** 99300138.7

**Publication Number:** 0940735

**IPC:** G05B 19/042

**Language of the proceedings:** EN

**Title of invention:**

Surface maintenance machine with computer controlled  
operational and maintenance systems

**Applicant:**

TENNANT COMPANY

**Opponent:**

-

**Headword:**

Surface maintenance machine/TENNANT

**Relevant legal provisions:**

EPC Art. 18(2), 96(2), 108, 109, 111(1), 122(1)

**Keyword:**

"Interlocutory revision"

**Decisions cited:**

G 0003/03, T 0473/91

**Headnote:**

A decision to grant interlocutory revision, once validly taken and irrespective of whether the department of first instance was correct in considering the appeal to be admissible and well founded, cannot be set aside by the Examining Division, let alone by a Formalities Officer. The grant of interlocutory revision communicated to the applicant (appellant) is not invalidated by the mere fact that there is no record on the file that the interlocutory revision had been ordered by all three members of the Examining Division (Points 2 and 3.2 of the Reasons).



Case Number: T 0303/05 - 3.5.03

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.03  
of 8 June 2006

**Appellant:** TENNANT COMPANY  
701 North Lilac Drive  
Minneapolis  
Minnesota 55422 (US)

**Representative:** Spencer, Michael David  
Bromhead Johnson  
Kingsbourne House  
229-231 High Holborn  
London WC1V 7DP (GB)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 22 March 2004  
refusing European application No. 99300138.7  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** A. S. Clelland  
**Members:** R. Menapace  
A. J. Madenach

## **Summary of Facts and Submissions**

- I. On 24 May 2004 the Appellant's representative filed a notice of appeal against the decision of the Examining Division posted on 22 March 2004 refusing European patent application no. 99 300 138.7, the notice including an order for payment of the appeal fee.
- II. On 3 or 4 August 2004 the representative spoke with a Formalities Officer at the EPO asking whether it was necessary for him to request re-establishment of rights. He was allegedly told that the Board of Appeal would look at this matter and would make a decision on it.
- III. On 4 August 2004, a Wednesday, fresh claims were submitted (by telefax) "in response" to the decision under appeal. In the accompanying letter it was explained that these amendments were believed to overcome all the outstanding objections raised by the Examiner and that, therefore, the appeal should be successful and the application allowed to proceed for grant. Furthermore, it was stated that "if this amendment is not acceptable the Applicant reserves the right to an Oral Proceeding".
- IV. On 16 August 2004 the Formalities Officer marked on (internal) EPO Form 2701 that the statement of the grounds of appeal had not been filed within the time limit and that the appeal was to be remitted to the Boards of Appeal.
- V. On 10 September 2004 an official letter (Form 2710) headed "Rectification (Article 109(1) EPC)" was dispatched by a different Formalities Officer "[f]or

the Examining Division". It was stated that "Following the appeal of 24.5.04 rectification is ordered and the decision dated 22.3.04 is set aside. The proceedings are continued." On the same day, a communication pursuant to Article 96(2) EPC was sent to the representative, in which the Primary Examiner ("for the Examining Division") raised objections against the fresh claims and invited the applicant to file observations and to correct the indicated deficiencies within a period of four months.

VI. The representative's response including amended description and claims together with a request for further processing was received on 7 February 2005.

VII. On 15 March 2005 the original Formalities Officer sent a "Brief communication" to the applicant, stating inter alia:

" ... our letter (Rectification Art. 109(1) EPC) dated 10.09.04) was sent to you erroneously. Therefore the examiner's report (Rule [correctly: Article] 96(2) EPC) sent on the same day should not have been sent to you. .... the file must be submitted to our Appeal Board, and all communications mentioned above disregarded."

By letter of the same day the Registry confirmed that the appeal had been referred to the Technical Board of Appeal 353.

VIII. By official letter (EPO Form 2907) dated 6 April 2005 the appellant was informed that a refund of the fee for further processing in the amount of € 75.00 would be made by crediting the representative's deposit account.

IX. On 8 July 2005 the Appellant, "in reply to the Examiner's official letter of 6th April, 2004" (sic), filed a request for re-establishment of rights and a payment order for the fee. In the accompanying statement it was explained in detail why the grounds of appeal had been filed only on 4 August 2004; it was furthermore stated that the Appellant's representative, prior to filing these grounds, had spoken with a Formalities Officer (see Point II, above). He then received "the decision of the Board of Appeal informing [him] that the objections were rescinded and that it was sent back to the Examining Division" (sic).

As a result he believed that his verbal explanation had been accepted. In view of this clear breach of process the filing of the request for re-establishment of rights fell within the time limits set by Article 122 EPC. It was requested that the ground for the appeal be deemed to have been filed in time.

**Reasons for the decision:**

1. The circumstances of the present case are somewhat unusual. Very early in the procedure both the Office and the Appellant's representative became aware of the fact that the statement setting out the grounds for appeal had been filed after expiration of the four month time limit prescribed in Article 108 EPC. Nevertheless, the Appellant did not react as might have been expected by filing a request for re-establishment of rights. In turn and contrary to what had originally (Point IV, above) and correctly (see decision T 473/91,

OJ EPO 1993, 630) been intended by the Formalities Officer, the appeal was not remitted to the Board of Appeal. Instead, a communication under Article 96(2) EPC written by the Primary Examiner and dealing with substantive issues concerning the fresh claims submitted with the (late) statement of the grounds for appeal was issued together with a - standard - brief communication from the Formalities Officer that rectification was ordered and that the decision under appeal was set aside (point V, above). It is unclear whether and, if so to what extent, the two other members of the Examining Division were involved. Only about half a year later and after the Appellant had filed a reply to the Primary Examiner's communication was he informed by the Formalities Officer that those communications should be disregarded and the file would be submitted to the Board of Appeal. It is unclear whether and, if so to what extent, the members of the Examining Division (including the Primary Examiner) were involved in this retraction.

2. As for any decision, a decision to grant interlocutory revision is binding upon the department which took it. It is also final, given that the appellant is not adversely affected (Decision G 3/03, Point 2 of the reasons). Hence, once validly taken and irrespective of whether the department of first instance was correct in considering the appeal to be admissible and well founded (Article 109(1) EPC), it cannot be set aside by the Examining Division, let alone by a Formalities Officer. That being so, the crucial question is whether, in the circumstances of the present case, the interlocutory revision communicated to the applicant (Appellant) is invalidated by the fact that there is no

record on the file that the interlocutory revision had been ordered by all three members of the Examining Division (cf. EPO form 2701 Section III).

3. The Board concludes that the validity of the interlocutory revision was not affected, the following factual and legal issues in their context being decisive:
  - 3.1 From the perspective of the applicant and the public at large the Office, through the Formalities Officer (dispatch of EPO Form 2710 stating that rectification had been ordered) and the Primary Examiner (communication pursuant to Article 96(2) EPC, dated 10.09.04), acted exactly as it normally does consequent to the grant of interlocutory revision. So, not to acknowledge these official actions as valid could be seen as *venire contra factum proprium*, i.e. inconsistent, and thus also contrary to the principle of good faith governing procedure between the EPO and applicants.
  - 3.2 In contrast to the decision granting a patent or refusing the application, interlocutory revision is only an intermediate, purely procedural decision without prejudice to the final outcome of the examination of the European patent application. Its only effect is that the decision under appeal is set aside without intervention of the Board of Appeal and (substantive) examination is continued by the department of first instance, more specifically by the entrusted member pursuant to Article 18(2) EPC, second sentence (" ... before a decision is taken on a European patent application, its examination shall, as



a general rule, be entrusted to one member of the Division"), i.e. the Primary Examiner. Hence, whilst it is certainly appropriate to involve all members of the Division in the interlocutory revision of a decision refusing the application, which was taken by all of them in common (Article 18(2) EPC, first sentence), it is not wholly incompatible with the concept and purpose of the entrusting of examination to one member of the Examining Division provided for in Article 18(2) EPC if interlocutory revision is ordered by the Primary Examiner alone. Such a procedure does not, in the board's view, render the interlocutory revision null and void.

- 3.3 There is no indication in the file that any of the three members of the Examining Division was either against rectification of the decision in question or that that they, acting in common as Examining Division, had decided to proceed under Article 109(2) EPC, i.e. not to rectify the decision and to remit it to the Board of Appeal.
- 3.4 The board moreover notes that as there is no prescribed form in which rectification has to be ordered, it can be ordered also implicitly. In the present case, at least the Primary Examiner has shown the intention to grant interlocutory revision, otherwise he would not have issued the communication under Article 96(2) EPC based on the amendments which had been submitted as part of the grounds of appeal.
4. From the preceding considerations it follows that the decision refusing the application had been irreversibly rectified under Article 109(1) EPC and, as a

consequence, the appeal was no longer pending when the Formalities Officer issued the brief communication dated 15 March 2005 and the case was remitted to the Board of Appeal. Thus, that communication, in which the Formalities Officer stated that the rectification and the examiner's report had to be disregarded (Point VII, above), had no procedural effect either in respect of the Board of Appeal as department of second instance, or on acts of the department of first instance within the continued examination, in particular the "examiner's report" under Article 96(2) EPC, or on the applicant's request for further prosecution in respect of the time limit for filing observations to that (valid) communication, or on those observations as such.

5. Since the non-observance of the time limit provided for in Article 108 EPC for filing the statement of the grounds for appeal did not cause the Appellant the loss of any right or means of redress within the meaning of Article 122(1) EPC, there was no longer room for re-establishment of rights and the relevant fee in the amount of € 350 was paid without legal basis. On the other hand, the refund of the fee for further processing (Point VIII, above) in the amount of € 75 was not justified either. However, the Board is not empowered to make an order in this respect, as the appeal is no longer pending (Point 4, above), so that Article 111(1) EPC cannot be relied on.

**Order:**

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

The case is remitted to the Examining Division for further examination of the European patent application.

Registrar

Chairman

D. Magliano

A. S. Clelland