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**D E C I S I O N**  
**of 3 May 2006**

**Case Number:** T 1474/05 - 3.2.05

**Application Number:** 02006709.6

**Publication Number:** 1247648

**IPC:** B41J 2/175

**Language of the proceedings:** EN

**Title of invention:**

Ink cartridge, printing apparatus using the ink cartridge, and method for detecting remaining amount of ink using the ink cartridge

**Applicant:**

Brother Kogyo Kabushiki Kaisha

**Opponent:**

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**Headword:**

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**Relevant legal provisions:**

EPC Art. 107, 112

EPC R. 51

**Keyword:**

"Appeal against the decision of the Examining Division granting European patent (not admissible); appellant not adversely affected"

**Decisions cited:**

T 1181/04

**Catchword:**

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Case Number: T 1474/05 - 3.2.05

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.05  
of 3 May 2006

**Appellant:**  
(Applicant)

Brother Kogyo Kabushiki Kaisha  
15-1 Naeshiro-cho  
Mizuho-ku  
Nagoya-shi, Aichi-ken 467-8561 (JP)

**Representative:**

Prüfer, Lutz H.  
PRÜFER & PARTNER GbR  
Patentanwälte  
Harthausen Strasse 25d  
D-81545 München (DE)

**Decision under appeal:**

Decision of the Examining Division of the  
European Patent Office posted 28 July 2005  
granting European patent No. 1247648.

**Composition of the Board:**

**Chairman:** W. Moser  
**Members:** W. Zellhuber  
P. E. Michel

## Summary of Facts and Submissions

- I. The appellant (applicant) lodged an appeal against the decision of the Examining Division granting the European patent No. 1 247 648.
- II. In the course of the examination procedure, on 26 October 2004, the appellant filed claims 1 to 15 which were to replace the previously pending claims. On 17 December 2004, the Examining Division issued a communication pursuant to Rule 51(4) EPC informing the appellant that it intended to grant a European patent on the basis of claims 1 to 15 filed on 26 October 2004, and that it made an amendment to claim 1 thereby referring to Rule 29(1) EPC. The amendment consisted in the replacement of the term "wherein" by the term "characterised in that", thus modifying claim 1 from the previous one-part form into the two-part form. The appellant was requested to file one set of translations of the claims in the two other EPO official languages and to pay the grant and printing fees within four months of the notification of the communication. Furthermore, the appellant was informed that if the grant or printing fees were not paid, or the translations not filed in due time, the European patent application would be deemed to be withdrawn (Rule 51(8) EPC).

Subsequently, an extension of that time limit by two months was granted by the EPO under Rule 84 EPC on 21 April 2005. The time limit laid down in Rule 51(4) EPC thus expired on 27 June 2005.

On 20 June 2005, the translations of the claims were submitted and grant and printing fees paid. The claims in the two other EPO official languages contained the amendment to claim 1 made by the Examining Division.

On 28 July 2005, the decision to grant a European patent was sent to the appellant.

The date of publication and mention of the grant of the European patent EP 1 247 648 was 7 September 2005 in Bulletin 2005/36.

On 7 October 2005, the appellant filed an appeal against the decision of the Examining Division granting the European patent No. 1 247 648.

III. Oral proceedings were held before the Board of Appeal on 3 May 2006.

IV. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the following documents:

(i) claim 1 filed on 6 October 2005; and

(ii) the documents otherwise included in the communication under Rule 51(4) EPC posted 17 December 2004.

The appellant further requested that the following questions be referred to the Enlarged Board of Appeal:

"i) If the applicant pays the fee for grant and printing and files a translation of the claims in the

two official languages of the EPO other than the language of the proceedings in response to the communication under R 51(4) EPC, does this constitute an amended request for the grant of the patent, if the Examining Division amended the application for the communication under R 51(4) EPC.

ii) If question i) is answered negatively, and if the applicant pays the fee for grant and printing and files a translation of the claims in the two official languages of the EPO other than the language of the proceedings in response to the communication under R 51(4) EPC, does this prevent the applicant to be adversely affected by the decision to grant based on the amended documents forming the basis for the communication under R 51(4) EPC, and to file an appeal against the decision to grant."

V. In the written and oral procedures, the appellant argued essentially as follows:

The appellant could not agree to the amendment to claim 1 made by the Examining Division. However, the communication under Rule 51(4) EPC sent to the appellant on 17 December 2004 had only allowed two courses of action: either to pay the fees and to file the translations, thus implicitly stating agreement, or not to pay the fees and not to file the translations thus giving rise to the fact that the application had to be deemed to be withdrawn.

Since a communication under Rule 51(4) EPC did not constitute an appealable decision, the appellant had decided to file an appeal against the decision to grant

a patent on the basis of the documents annexed to the communication under Rule 51(4) EPC.

The appellant was adversely affected by the decision under appeal, because the two-part form of claim 1 as proposed by the Examining Division indicated that the subject-matter of the preamble of claim 1 constituted prior art, which actually was not the case, and which might adversely affect the appellant's position in an infringement action.

The appellant abstained from filing amended documents in response to the communication under Rule 51(4) EPC, because this would have given rise to the fact that the application had to be deemed to be withdrawn under Rule 51(8) EPC.

The same situation had given rise to the decision T 1181/04 (OJ EPO 2005, 312). According to the communication under Rule 51(4) EPC issued in that case, the Examining Division intended to grant a patent on the basis of an auxiliary request, whilst a main request was not allowed. Thus, in both cases, the appellants had not got what they had wanted, ie. in case T 1181/04 the main request, and, in the present case, the one-part form of claim 1.

Since the Board seemed to come to a conclusion different from that in case T 1181/04, the questions mentioned above should be referred to the Enlarged Board of Appeal.

## Reasons for the Decision

### 1. *Admissibility of the appeal*

- 1.1 According to Rule 51(4) EPC, before "the Examining Division decides to grant the European patent, it shall inform the applicant of the text in which it intends to grant it, and shall invite him to pay the fees for grant and printing and to file a translation of the claims in the two official languages of the European Patent Office other than the language of the proceedings".

In the present case, by the communication under Rule 51(4) EPC of 17 December 2004, the Examining Division informed the appellant of the text in which it intended to grant a patent, and, in particular, it informed the appellant of the amendment to claim 1. The appellant has not requested any amendments to the text proposed for grant by the Examining Division, which he might have done in accordance with Rule 51(5) and (6) EPC. Rule 51(5) and (6) EPC explicitly determines the procedure to be applied if the applicant requests amendments under Rule 86(3) EPC within the period laid down in Rule 51(4) EPC.

On the contrary, the appellant filed the requested translations and paid the printing and grant fees within the period specified by the Examining Division. It thus follows that the legal fiction referred to in Rule 51(4), second sentence, that, if the applicant pays the fees and files the translation within that period, the text intended for grant is deemed to have been approved applies in the present case.

Consequently, the appellant was not adversely affected by the decision under appeal, i.e. by the decision to grant a European patent on the basis of the documents referred to in the communication under Rule 51(4) EPC of 17 December 2004. Pursuant to Article 107 EPC, the appellant was thus not entitled to appeal.

- 1.2 The present situation is different to the factual and legal situation underlying decision T 1181/04.

In that case, a main request and two auxiliary requests of the appellant were on file, cf. point I of that decision, and in a communication under Rule 51(4) EPC, the Examining Division informed the appellant that it intended to grant a patent on the basis of the documents according to the second auxiliary request, whilst reasons have been given why the main and first auxiliary requests did not meet the requirements of the EPC, cf. point II of that decision. The Examining Division thus did not allow these higher ranking requests, and, consequently, the appellant was adversely affected.

2. *Referral of questions to the Enlarged Board of Appeal*

As follows from the above, the question of whether or not the appellant was entitled to appeal could be answered fully on the basis of, and in accordance with, the provisions of the EPC. In the Board's view, in the present case, no decision of the Enlarged Board of Appeal is required for the purposes of ensuring uniform application of the law or assessing an important point of law. Consequently, the Board did not consider it



appropriate to refer the questions mentioned above under point IV to the Enlarged Board of Appeal in accordance with Article 112(1)(a) EPC.

**Order**

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

1. The request to refer questions to the Enlarged Board of Appeal is refused.
2. The appeal is rejected as inadmissible.

The Registrar:

The Chairman:

M. Dainese

W. Moser