

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen
(D) [] No distribution

D E C I S I O N
of 18 May 2006

Case Number: T 0482/06 - 3.5.02

Application Number: 01927915.7

Publication Number: 1281237

IPC: H03K 3/012

Language of the proceedings: EN

Title of invention:
Power adaptive frequency divider

Applicant:
Koninklijke Philips Electronics N.V.

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 109
EPC R. 67
Legal advice No. 15/05

Keyword:
"Substantial procedural violation (yes)"
"Reimbursement of the appeal fee following interlocutory
revision (yes)"

Decisions cited:
T 0549/96, T 0976/97, T 0905/90, G 0005/88

Catchword:
-



Case Number: T 0482/06 - 3.5.02

D E C I S I O N
of the Technical Board of Appeal 3.5.02
of 18 May 2006

Appellant: Koninklijke Philips Electronics N.V.
Groenewoudseweg 1
NL-5621 BA Eindhoven (NL)

Representative: Duijvestijn, Adrianus Johannes
Philips
Intellectual Property & Standards
P.O. Box 220
NL-5600 AE Eindhoven (NL)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 24 November 2005
refusing European application No. 01927915.7
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: W. Wheeler
Members: M. Ruggiu
E. Lachacinski

Summary of Facts and Submissions

- I. The applicant filed an appeal against the decision of the examining division to refuse European patent application No. 01927915.7 and paid the appeal fee. In the statement of grounds of appeal, the applicant requested, *inter alia*, that the appeal fee be reimbursed. The examining division granted interlocutory revision (Article 109(1) EPC), but did not allow reimbursement of the appeal fee. This case concerns the residuary part of the appeal which relates to the reimbursement of the appeal fee.
- II. During the proceedings before the examining division, the applicant responded to summons to attend oral proceedings by filing two sets of claims in accordance with a main request and an auxiliary request. The examining division decided to refuse the application at the oral proceedings, which took place on 19 October 2005 in the absence of the applicant. The examining division found that independent claim 1 of the main request was not allowable and that the auxiliary request was allowable. However, according to point 3.2 of the decision of the examining division, the applicant had failed to indicate his approval of the text of the auxiliary request in that the unallowable main request was maintained. In this situation, the examining division could refuse the application since there was no clear request (cf. decisions T 549/96 and T 976/97). As set out in the legal advice from the EPO No. 15/98 rev. (OJ 1998, 113) there was no reason for the examining division to issue an interlocutory decision finding a particular version of the claims patentable and allowing separate appeal; rather the

appealable final decision refusing the application was issued immediately. There was no obligation for the examining division to delay its decision by reason only of the absence of the applicant at the oral proceedings.

III. The arguments of the appellant, as regards the reimbursement of the appeal fee, can be summarised as follows:

According to the decision of the examining division, there was no clear request because the applicant had failed to indicate his approval of the text of the auxiliary request. Legal advice No. 15/98 (OJ 1998, 133), cited by the examining division to justify its position, was outdated. Currently legal advice No. 15/05 rev. 2 (OJ 2005, 357) was in force, whose point 1.5 indicated that a communication pursuant to Rule 51(4) EPC should have been issued since the applicant had filed an allowable version of the claims as an auxiliary request. Indeed, the applicant expected a communication pursuant to Rule 54(1) EPC and not an interlocutory decision finding some claims patentable and allowing separate appeal. Not issuing the communication pursuant to Rule 51(4) EPC, based on the outdated legal advice No. 15/98, constituted a substantial procedural violation. Reimbursement of the appeal fee was therefore justified (Rule 67 EPC).

Reasons for the Decision

1. The appeal is admissible.

2. Legal advice No. 15/05 (rev. 2), which has been published in the June 2005 issue of the EPO's Official Journal (OJ 2005, 357), is a revised version of legal advices No. 15/84 (OJ 1984, 491) and No. 15/98 (OJ EPO 1998, 113) taking into account new Rule 51 EPC of 1 July 2002. Point 1.5 of legal advice No. 15/05 states that where the applicant has filed an allowable version of the claims as an auxiliary request, the examining division can issue the communication pursuant to Rule 51(4) EPC with regard to the set of claims that it considers to be allowable. Point 1.5(a) of legal advice No. 15/05 further explains that the mechanism for indicating agreement to the version communicated pursuant to Rule 51(4) EPC is the filing of the translations of the claims and the payment of the fees for grant and printing.

3. Legal advice No. 15/98 is superseded by legal advice No. 15/05, which has been published before the date (19 October 2005) of the oral proceedings before the examining division. Decisions T 549/96 and T 976/97 are dated 9 March 1999 and 16 August 2000 respectively, prior to the publication of legal advice No. 15/05. Furthermore, decision T 549/96 states that "an applicant must unambiguously indicate at the end of the proceedings, which text he proposes" (see point 4.1 of the reasons in T 549/96). Point 1.5(a) of legal advice No. 15/05 sets out the mechanism to provide this indication. Thus, legal advice No. 15/05 is compatible with decision T 549/96. Decision T 976/97 concerns a case in which a communication pursuant to Rule 51(4) EPC had already been issued and was therefore substantially different from the present case.

4. In the view of the board, the applicant could legitimately expect that the EPO would follow the procedure set out in legal advice No. 15/05, which had been published in the EPO's official journal prior to the oral proceedings before the examining division (see decisions G 5/88 (OJ 1991, 137), point 3.2 of the reasons, and T 905/90 (OJ 1994, 306), point 5 of the reasons). Thus, the applicant could legitimately expect to receive a communication under Rule 51(4) if the division considered that the claims of either the main or the auxiliary request were allowable (which was the case here) and to be able to express its approval of the text proposed for grant by filing the translations of the claims and paying the fees for grant and printing. By deviating from the procedure published in the official journal, the examining division offended against the principle of the protection of legitimate expectations and thereby committed a substantial procedural violation. It would not have been necessary for the applicant to file an appeal if the division had not violated the official procedure. Thus, reimbursement of the appeal fee is equitable (Rule 67 EPC).

Order

For these reasons it is decided that:

The request for reimbursement of the appeal fee is allowed.

The Registrar:

The Chairman:

U. Bultmann

W. J. L. Wheeler