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**Datasheet for the decision
of 5 May 2009**

Case Number: T 1612/07 - 3.4.01

Application Number: 99962838.1

Publication Number: 1049939

IPC: G01R 33/54

Language of the proceedings: EN

Title of invention:

MR imaging system with interactive MR geometry prescription control

Applicant:

GENERAL ELECTRIC COMPANY

Opponent:

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Headword:

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Relevant legal provisions:

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Relevant legal provisions (EPC 1973):

EPC Art. 111(1), 67, 68(2)

Keyword:

"Decision according to the state of the file reasoned in the sense of Rule 68(2) EPC (no)"

"Substantial procedural violation (yes)"

"Reimbursement of the appeal fee (yes)"

Decisions cited:

T 0278/00, T 0963/02, T 0897/03

Catchword:

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Case Number: T 1612/07 - 3.4.01

D E C I S I O N
of the Technical Board of Appeal 3.4.01
of 5 May 2009

Appellant:

GENERAL ELECTRIC COMPANY
1 River Road
Schenectady
NY 12345 (US)

Representative:

Pedder, James Cuthbert
London Patent Operation
General Electric International, Inc.
15 John Adam Street
London WC2N 6LU (GB)

Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 2 May 2007
refusing European application No. 99962838.1
pursuant to Article 97(1) EPC 1973.

Composition of the Board:

Chairman: B. Schachenmann
Members: H. Wolfrum
G. Assi

Summary of Facts and Submissions

- I. European patent application 99 962 838.1 (publication No. 1 049 939) corresponding to published international application WO-A-00/31558 was refused by the examining division in a decision dispatched on 2 May 2007 for the reason that the objections raised in its preceding communications were not overcome.
- II. In its first communication dated 12 April 2006, the examining division had raised various objections as to lack of unity, lack of conciseness and clarity of the claims and lack of inventive step. The failure to use the two-part form in the independent claims and the lack of any acknowledgement of the relevant prior art in the description were also objected to.

The applicant replied with letter of 19 October 2006 by filing an amended set of claims and replacement pages for the description.

In a second communication dated 24 November 2006, which was annexed to a summons to oral proceedings, the examining division listed a number of objections from the previous communications, which were "*invariably maintained*", and raised fresh objections as to lack of clarity and added subject-matter.

The applicant responded with letter of 27 March 2007 by commenting on the objections raised and by filing a new set of amended claims, which replaced the former claims, and an amended page of the description.

In a third communication dated 17 April 2007, the examining division listed a variety of objections from its previous communications, including objections as to lack of clarity and lack of inventive step, which it considered to be still valid, and raised further objections as to lack of clarity and added subject-matter with respect to the amended claims on file.

Finally, by letter dated 23 April 2007 the applicant advised the examining division that it did not intend to attend the oral proceedings and therefore requested an appealable decision based on the state of the file.

III. The applicant lodged an appeal against the decision and paid the prescribed fee on 10 July 2007. On 11 September 2007 a statement of grounds of appeal was filed.

The appellant requested that the decision under appeal be set aside and a patent be granted on the basis of a set of claims 1 to 38 filed on 11 September 2007 with the statement setting out the grounds of appeal. Moreover, an auxiliary request for oral proceedings was made.

IV. On 15 January 2009 the board of appeal issued a summons to oral proceedings. In an annex to the summons pursuant to Article 15(1) RPBA the board noted *inter alia* that it was questionable whether the contested decision met the requirements of Rule 68(2) EPC 1973 and, in particular, whether the communications referred to in the decision really dealt with the appellant's arguments as contained in its replies of 19 October 2006 and 27 March 2007. If established, this procedural

deficiency in the first instance proceedings could justify a remittal of the case to the examining division if the appellant so requested.

- V. In its response by letter of 19 March 2009, the appellant requested, by way of a main request, that the application be remitted to the examining division and asked for reimbursement of the appeal fee. As an auxiliary measure it was requested to grant a patent on the basis of the claims currently on file.
- VI. By order of 23 March 2009 the oral proceedings were cancelled.

Reasons for the Decision

1. In the following reference is made to the provisions of the EPC 2000, which entered into force as of 13 December 2007, unless the former provisions of the EPC 1973 still apply to pending applications.
2. The appeal complies with the requirements of Articles 106 to 108 EPC 1973 and Rule 64 EPC 1973 and is, therefore, admissible.
3. The examining division issued its decision, which was requested to be taken "according to the state of the file", in a standardised form, replacing an explicit reasoning by a mere reference to the reasons contained in three preceding communications, as follows:

"In the communication(s) dated 12.04.2006, 24.11.2006, 17.04.2007 the applicant was informed that the

application does not meet the requirements of the European Patent Convention. The applicant was informed of the reasons therein.

The applicant filed no comments or amendments in reply to the latest communication but requested a decision according to the state of the file by a letter received in due time on 23.04.2007.

The application must therefore be refused."

4. Rule 68(2), first sentence, EPC 1973, states that decisions of the EPO which are open to appeal shall be reasoned. This means, according to established case law, that a decision must contain, in logical sequence, those arguments which justify the tenor and that all facts, evidence and arguments which are essential to the decision must be discussed in detail (T 278/00, OJ EPO 2003, 546; T 963/02, point 2 of the reasons; T 897/03, point 3 et seq. of the reasons).

Consequently, if a decision is merely reasoned by a reference to one or more preceding communications, the requirement of Rule 68(2), first sentence, EPC 1973 is only met if the referenced communications themselves fulfil the above defined requirements. The reasons for the refusal of the relevant requests must be clear from these communications both for the party concerned and for the board of appeal.

5. In the present case, this condition is not met for several reasons.

5.1 Doubts arise from the fact that the contested decision makes reference to three communications, each of which contains a plurality of different objections raised against different claim versions.

It would appear from the phrase "*The applicant was informed of the reasons therein*" that the grounds for the decision under appeal are constituted by all of the reasons which have been indicated in the respective communications. However, given the substantive amendments made to the application documents in the course of the examination proceedings, not all of the objections raised still apply to the latest set of documents filed. On the other hand, in view of the fact that the third communication contains explicit references to objections raised already in the two earlier communications, it would appear plausible that the decision is based only on those reasons which are mentioned in the third communication. In that case, however, the question arises why the decision makes reference to the first two communications at all.

For these reasons, it is not unambiguously clear which of the various objections comprised in the first and second communications still apply to the version of the application documents on which the contested decision is based.

5.2 Another deficiency of the contested decision lies in the fact that the second and the third communications of the examining division merely re-state objections as to lack of clarity and inventive step which had been raised in the respective preceding communication(s), but do not contain any indication as to why respective

arguments and explanations submitted by the applicant had been found unconvincing.

Particular reference is made in this respect to the objection raised as to lack of inventive step. In its first communication of 12 April 2006 (see point 4), the examining division's reasoning started from document D1. It was argued that the teaching of D1 left an obvious desire still to be met. Solutions to that desire were however considered to be suggested by the teaching of each of documents D2 and D3. Documents D4 and D5 were only mentioned in passing. The second communication of 24 November 2006 did not add any substantive matter to this reasoning, nor did it deal with the arguments put forward by the applicant in support of inventive step in its reply of 19 October 2006 (see page 2, first paragraph to page 3, first paragraph). Finally, the third communication of 17 April 2007, in the paragraph referring to point 4 of the communication of 12 April 2006, noted that a combination of D1 with D2 or D3 was not the only line of reasoning that led to the conclusion of lack of inventive step and that it would appear that the subject-matter of the independent claims then on file lacked inventive step even with respect to each of documents D2, D3 and D5 taken in isolation. Again, no explanations were given as to why the arguments submitted by the applicant (see in addition page 1, point 1), item 4 of the letter of 27 March 2007) had not been found convincing.

Thus, since the communications do not deal with the applicant's arguments, neither does the standardised final decision.

6. In the board's judgment, the decision under appeal is not sufficiently reasoned in the sense of Rule 68(2) EPC 1973 and the above deficiencies in the reasoning amount to a substantial procedural violation which requires, in line with other decisions of the boards of appeal (see *eg* T 278/00 and T 897/03, both cited above), that the decision under appeal be set aside. Moreover, the procedural deficiency justifies, in application of Article 111(1) EPC 1973, the remittal of the case to the examining division, as has been requested by the appellant.

In consequence, the appeal is deemed to be allowable and the board considers it to be equitable, by reason of the substantial procedural violation incurred, to reimburse the appeal fee (Rule 67 EPC 1973).

7. For the avoidance of misunderstandings, the board notes that it does not generally object to a refusal of an application with reasons drafted in a standardised form by making reference to one or more preceding communications, in cases in which an applicant has requested a decision "according to the state of the file". However, this form of decision should be chosen only exceptionally in clear-cut cases in which the reference to previous communication(s) amounts to a complete reasoning, avoiding any ambiguities as to the exact content and extent of the grounds for refusal and in which the communications have dealt with the applicant's arguments (if any).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.
3. The appeal fee is to be reimbursed.

The Registrar

The Chairman

U. Bultmann

B. Schachenmann