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**Datasheet for the decision  
of 30 January 2009**

**Case Number:** T 0421/08 - 3.2.02

**Application Number:** 97116287.0

**Publication Number:** 0830839

**IPC:** A61B 3/08

**Language of the proceedings:** EN

**Title of invention:**

Binocular view function inspecting apparatus and inspecting method

**Applicant:**

Nidek Co., Ltd.

**Opponent:**

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**Headword:**

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**Relevant legal provisions:**

EPC R. 100(1), 103(1)(a), 111(2), 137(3)

**Relevant legal provisions (EPC 1973):**

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**Keyword:**

"Unreasoned decision"  
"Substantial procedural violation"  
"Reimbursement of appeal fee"

**Decisions cited:**

T 0278/00, T 0897/03, T 1356/05

**Catchword:**

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Case Number: T 0421/08 - 3.2.02

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.02  
of 30 January 2009

**Appellant:**

Nidek Co., Ltd.  
34-14 Maehama  
Hiroishi-cho  
Gamagori  
Aichi 443-0038 (JP)

**Representative:**

Glawe, Delfs, Moll  
Patentanwälte  
Postfach 26 01 62  
D-80058 München (DE)

**Decision under appeal:**

Decision of the Examining Division of the  
European Patent Office posted 21 September 2007  
refusing European application No. 97116287.0  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** M. Noel  
**Members:** S. Chowdhury  
C. Vallet

## Summary of Facts and Submissions

I. The appeal is directed against the decision of the examining division, notified on 21 September 07 to refuse the European patent application No. 97 116 287.0, relating to a "Binocular view function inspecting apparatus and inspecting method".

II. The grounds of the contested decision reads as follows:

*"In the communications dated 09.07.2007 and 26.02.07 the applicant was informed that the application does not meet the requirements of the European Patent Convention. The applicant was also 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 17.09.2007.*

*The application must therefore be refused."*

III. The appellant lodged an appeal against the decision on 20 November 2007 and paid the prescribed fee on the same day. A statement setting out the grounds of appeal was filed on 1 February 2008, together with amended claims according to a main request and three auxiliary requests.

IV. The appellant requests that the contested decision be set aside and that a patent be granted:

- on the basis of the claims 1 to 10 according to the main request, or

- on the basis of claims 1 to 8 of the first auxiliary request, or
- as second auxiliary request, on the basis of claims 1 to 3 of the first auxiliary request, claims 4 to 8 being cancelled, or
- as third auxiliary request, on the basis of claim 1 of the second auxiliary request, claims 2 and 3 being cancelled,
- and on the basis of a correspondingly amended description.

He also requested the reimbursement of the appeal fee due to a substantial procedural violation and oral proceedings as an auxiliary request.

V. The appellant's arguments can be summarised as follows:

The decision simply referred to the Annex to the summons to attend oral proceedings dated 9 July 2007 and a communication dated 26 February 2007. It was stated therein that the amendments introduced at the beginning of claims 1 and 2 of the auxiliary request then on file were not admitted into the procedure under Rule 86(3) EPC 1973 since they were not prima facie allowable under Articles 123(2) and 84 EPC.

Despite all explanations submitted by the appellant, the examining division failed to give reasons why the amendments were not supported by the application as filed and therefore not allowable.

The same applied to the subject-matter of the main request.

The lack of reasoning constituted a substantial procedural violation justifying that the decision be set aside and the appeal fee be reimbursed.

### **Reasons for the decision**

1. The appeal meets the requirements of Articles 106 to 108 and Rule 99 EPC and is therefore admissible.
2. The purpose of an appeal procedure is mainly to give a party adversely affected by a decision of the first instance the possibility of challenging this decision on its merits. In order for a party to be able to examine whether a decision is justified or not, decisions open to appeal shall be reasoned. This principle, stated in Rule 111(2) EPC, is of major importance for ensuring the fairness of the procedure. Pursuant to the established jurisprudence of the Boards of Appeal, a reasoned decision must contain the grounds upon which the decision is based and all decisive considerations in respect of the legal and factual aspects of the case in file. (see T 278/00, OJ 2003 546, T 897/03, T 1356/05).
3. In the present case, the contested decision neither specifies the grounds upon which it is based nor contains any facts or arguments that justify the refusal of the patent application.

The appealed decision contains solely a reference to reasons given in two communications issued in the course of the examination, each of these relating to a

different set of claims filed by the applicant in response to the respective preceding communication.

4. In the fourth communication of the examining division dated 26 February 2007 which refers to the previous one, the first instance simply stated that the newly filed claims, i.e. filed on 6 February 2007, were not admissible under Rule 86(3) EPC (1973) since they were not prima facie allowable under Articles 123(2) and 84 EPC.

This represents a mere assertion and does not allow a reader to understand the reasons why the newly filed claims would neither be admissible nor allowable.

5. The communication dated 9 July 2007 accompanying the summons to attend oral proceedings which refers to the previous fourth communication, does not clarify the objections. The sole explanation which is put in brackets "*it is immediately seen that page 17, second paragraph mentioned by the applicant discloses in fact something which is different*" cannot be regarded as a sufficient reasoning allowing the party and the board to understand why the amendments brought the claims do not meet the requirements of Articles 84 and 123(2) EPC.
6. In its letter dated 14 September 2007, the appellant withdrew its request for oral proceedings before the first instance and requested continuation of the procedure in writing, i.e. implicitly requested a decision according to the state of the file.

This request cannot be interpreted as a renouncement to a reasoned decision from the examining division.

7. The decision under appeal must therefore be set aside due to the lack of reasoning required by Rule 111(2) EPC, which amounts to a substantial procedural violation.
  
8. Pursuant to Rule 103(1)(a) EPC "*The appeal fee shall be reimbursed... where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation...*".

In the present case, as explained above, the absence of reasoning in the contested decision amounts to a substantial procedural violation. The request for reimbursement is therefore justified.

9. Since the decision must be set aside, there is no need to hold oral proceedings before the board.
  
10. Exercising its discretion under Rule 137(3) EPC, which is applicable by virtue of Rule 100(1) EPC, the Board decides to admit the set of claims filed with the statement of grounds of appeal into the proceedings, for further prosecution before the first instance.

**Order**

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

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of the main and the first to third auxiliary requests filed on 1 February 2008, with the statement of the grounds of appeal.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:

D. Sauter

M. Noel