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**Datasheet for the decision
of 5 November 2008**

Case Number: T 0630/08 - 3.2.06

Application Number: 01309160.8

Publication Number: 1203628

IPC: B23D 51/01

Language of the proceedings: EN

Title of invention:

Reciprocating saw with special handle arrangement

Applicant:

MILWAUKEE ELECTRIC TOOL CORPORATION

Opponent:

-

Headword:

-

Relevant legal provisions:

-

Relevant legal provisions (EPC 1973):

EPC R. 67

Keyword:

"Request for reimbursement of the appeal fee (rejected)"

Decisions cited:

-

Catchword:

-



Case Number: T 0630/08 - 3.2.06

D E C I S I O N
of the Technical Board of Appeal 3.2.06
of 5 November 2008

Applicant: MILWAUKEE ELECTRIC TOOL CORPORATION
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Decision concerning: Request of the applicant for reimbursement of
the appeal fee, filed on 15 November 2007.

Composition of the Board:

Chairman: P. Alting Van Geusau
Members: M. Harrison
W. Sekretaruk

Summary of Facts and Submissions

I. In the oral proceedings of 8 February 2007 the examining division refused European patent application number 01309160.8, which was filed on 29 October 2001. The written decision of 6 March 2007 was based on the following application documents:

Claims 1-67 received on 17 March 2005 with letter of 11 March 2005, together with the description and drawings as originally filed.

The examining division found that the subject matter of claim 1 lacked novelty.

II. During the prosecution leading up to the decision, amended claims were sent to the European Patent Office (EPO) on 27 January 2006 and, according to a facsimile transmission verification report of the applicant's representative, were received at the EPO on the same day. These claims were to be used as the basis for the further proceedings. These amended claims were however never entered into the electronic file at the EPO.

III. During the continued written procedure, the applicant received two communications from the examining division dated 24 March 2006 and 17 October 2006 respectively. Each of these communications stated that examination was being carried out on the application documents which were specified as including the claims 1-67 received on 17 March 2005. Nowhere was it stated that the faxed amended claims of 27 January 2006 were the subject of the examination procedure. Responses were filed by the applicant to each of these communications

- on 4 September 2006 and 8 January 2007 respectively. Oral proceedings were held on 8 February 2007 in the absence of the applicant who had confirmed its non-attendance at those proceedings.
- IV. On 4 April 2007 the applicant filed an appeal against the decision of the examining division refusing the European application. The appeal fee was paid on 5 April 2007 and the grounds of appeal were received at the EPO on 16 July 2007. In the grounds of appeal it was requested that the application proceed to grant on the basis of enclosed claims which "replace previous claims 1-67 filed with our letter of 11 March 2005 (*sic*)."
- V. With its decision of 18 October 2007 the examining division ordered rectification and set aside its decision of 6 March 2007. This was communicated to the applicant by the EPO's letter dated 18 October 2007. The examining division then continued the examination proceedings.
- VI. With letter dated 15 November 2007, the applicant requested for the first time that the appeal fee be refunded. This request was not allowed and thus was forwarded to the Board of Appeal for a decision. In its letter of 22 April 2008, the applicant submitted a copy of the facsimile transmission verification report (see item II above) and a copy of the faxed documents.
- VII. In the reasons supporting its request for reimbursement, the applicant summarised the prosecution history and submitted that its response to the communication of 24 March 2006 clearly dealt with amended claim 1 of

27 January 2006 and that the communications from the examining division discussed inventive step objections which would only be applicable to that amended claim 1. Moreover, the letter of 27 January 2006 accompanying the amended claims 1 to 27 had been sent at the examiner's request, so that the examiner could make a formal note on the file of the arguments made in support of inventive step, which had been the result of several telephone conversations with the primary examiner. It could thus have been expected that the examiner contact the representative when the claims were not received. The applicant however noted that the ensuing communications from the examining division did refer to claims 1-67 received on 17 March 2005, but that it was easy to overlook the error given that amended claims had been filed and given that all the argumentation put forward by the examiner and themselves related to the inventive step objection. Indeed, whilst it was overlooked that the communications erroneously referred to the originally filed claims, this was an understandable oversight given the detailed argumentation in the communications.

VIII. In its communication of 4 July 2008, the Board informed the applicant of apparent deficiencies in its request for reimbursement, mentioning the question of admissibility of the request for reimbursement and the question as to whether reimbursement was equitable by reason of a procedural violation. Additionally, the Board stated that a decision without oral proceedings could be expected.

Within the two month period set by the Board for filing further submissions, the applicant filed no response.

Reasons for the Decision

1. *Applicability of Rule 67 EPC 1973*

Article 7 of the Act revising the EPC of 29 November 2000 reads:

"(1) The revised version of the Convention shall apply to all European patent applications filed after its entry into force, as well as to all patents granted in respect of such applications. It shall not apply to European patents already granted at the time of its entry into force, or to European patent applications pending at that time, unless otherwise decided by the Administrative Council of the European Patent Organisation."

Article 1 of the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000 reads in its point No. 1. (in parts):

"In accordance with Article 7, paragraph 1, second sentence, of the Revision Act, the following transitional provisions shall apply to the amended and new provisions of the European Patent Convention specified below:

1. Articles ...106, 108, 110 ... shall apply to European patent applications pending at the time of their entry into force"

Article 2 of the Decision of the Administrative Council of 7 December 2006 amending the Implementing Regulations to the European Patent Convention 2000 reads in its Article 2, first sentence:

"The Implementing Regulations to the EPC 2000 shall apply to all European patent applications, ... , in so far as the foregoing are subject to the provisions of the EPC 2000."

An application that was filed before 13 December 2007 is, in the sense of Article 2 of the decision of the Administrative Council of 7 December 2006 amending the Implementing Regulations to the European Patent Convention 2000, subject to the provisions of the EPC 2000 if the Article of the European Patent Convention implementing the regulation to which an implementing regulation is related, would be applicable from the time EPC 2000 entered into force (see in detail case J 3/06, point 3).

New Rule 103(1)(a) EPC is related to Article 109 EPC and Article 111 EPC (see case J 10/07, point 7). These Articles are not contained in the listing of Article 1 of the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000. As a consequence Rule 67 EPC 1973 applies to the present case.

2. It can be left undecided whether the Board is unable to order reimbursement due to the request not being contentious prior to rectification by the examining division.

3. Rule 67 EPC 1973 states that the reimbursement of the appeal fees shall be ordered in the event of interlocutory revision, if such reimbursement is equitable by reason of a substantial procedural violation. In deciding upon the application with a text that was no more agreed by the applicant the examining division committed a substantial procedural violation. Under Article 113(2) EPC the European Patent Office may examine and decide upon the European patent application only in the text submitted to it by the applicant. Article 113(2) EPC is considered a fundamental procedural principle being part of the right to be heard (see e.g.: Case Law of the Boards of Appeal of the European Patent Office, 5th edition, VI.B.4). The fact that the new claims were not received by the examining division does not change this view. Once an item of mail is received at the EPO it has to be considered as having been received by the organ deciding upon the case (see e.g. Case Law of the Boards of Appeal of the European Patent Office, 5th edition, VI.B.4.2).

4. However, in the present case despite the procedural violation, the conduct of the applicant was such as to render reimbursement of the appeal fee inequitable (see: e.g. Case Law of the Boards of Appeal of the European Patent Office, 5th edition, VII.D.15.3.2).

The appellant received two communications of the examining division (24 March 2006 and 17 October 2006) both specifying, in an introductory section, the documents upon which the examination was being carried out. The communication of 24 March 2006 specified that

the claims upon which examination was being carried out were those received on 17 March 2005. Further, a telephone conversation of 10 January 2006 with the applicant's representative was mentioned and, in reference to this conversation, it was stated that due to an objection of lack of novelty, "the applicant proposed to introduce" a further feature into claim 1. The examining division then noted that "the claim 1 that would result from the above indicated, proposed amendment is lacking inventive step." The use of the words "proposed" and "would" in this context should have left little doubt that the claims upon which examination was being carried out were those not yet including those amendments.

5. In the applicant's response of 4 September 2006, no mention was made of any possible error in the set of claims which were the subject of examination. Instead, the objection of lack of inventive step was discussed. In the penultimate paragraph of this response it was also stated that "claim 1 incorporating the amendment previously discussed ... is both novel and inventive." The amendment "discussed" would normally not be equated with an amendment having been filed/received, but merely with a proposed amendment. Thus, the applicant's reply did not give rise to a situation where the examining division should have realised an error in its communication.

6. In its further communication of 17 October 2006, which was sent as an annex to the summons to oral proceedings, the examining division again specified the claims upon which examination was being carried out as being claims 1-67 received on 17 March 2005. Under point (1)

of the communication the examining division then stated "As already pointed out in the communication dated 24.03.2006, the subject matter of claim 1 presently on file is not novel over the disclosure of D1" (*underlining added for emphasis*). At this point, any possible doubt about the claims being considered was removed. The examining division then proceeded to deal with the amendment of claim 1 which was "proposed by the applicant", stating that this "would not be acceptable for lack of inventive step." This latter consideration of inventive step can only be understood to confirm that the proposed amended claim 1 was considered not to be on file, but if it were to be filed its subject matter would anyway not be inventive. In its reply of 8 January 2007, the matter only of inventive step was addressed by the applicant, but the second paragraph of the letter indicated that the letter should be read in conjunction with the previous letter of 4 September 2006. Further, the letter finished with the paragraph stating that "claim 1 is both novel and inventive..." Again, this reply did not give rise to a situation where the examining division should have realised an error in its communication.

7. The appellant argued that whilst it was regrettable that the error was not noticed, it should be considered an understandable oversight given the detailed argumentation set out in those communications and the firm belief that the amendment had been received. However, the circumstances as indicated above leave no room for "an understandable oversight". Rather, it could have been expected that the applicant would take account of the indication that examination was being carried out on an incorrect basis and notify the

examining division when supplying its response to the communications. Had this been the case, the error in the set of claims being considered would have been easily overcome. The applicant's arguments concerning several telephone conversations with the examiner do not change the foregoing conclusions because the written communications from the examining division discussed above were subsequent to such telephone conversations and it is not the responsibility of the EPO to check whether any amendments proposed in a telephone conversation have indeed been filed.

8. Thus, whilst a procedural violation indeed occurred in not having entered the faxed amended claims of 27 January 2006 into the electronic file and in not having based the examination on those amended claims, the failure to observe and point out the error in a timely manner leads the Board to the conclusion that refund of the appeal fee would not be equitable.

Order

For these reasons it is decided that:

The request for refund of the appeal fee is rejected.

The Registrar:

The Chairman:

M. Patin

P. Alting van Geusau