

Internal distribution code:

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

**Datasheet for the decision
of 6 May 2010**

Case Number: T 2133/09 - 3.2.07

Application Number: 05712307.7

Publication Number: 1713622

IPC: B25C 1/08

Language of the proceedings: EN

Title of invention:

Exhaust system for combustion-powered fastener-driving tool

Applicant:

Illinois Tool Works Inc.

Headword:

-

Relevant legal provisions:

EPC Art. 111(1)
EPC R. 101(3)(a), 111(2)

Relevant legal provisions (EPC 1973):

-

Keyword:

"Substantial procedural violation: yes, decision not reasoned
(point 9)"

"Remittal: yes"

"Reimbursement of the appeal fee: yes"

Decisions cited:

T 0897/03, T 1356/05

Catchword:

-



Case Number: T 2133/09 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 6 May 2010

Appellant: Illinois Tool Works Inc.
(Applicant) 3600 West Lake Avenue
Glenview, IL 60026-1215 (US)

Representative: Zech, Stefan Markus
Meissner, Bolte & Partner GbR
Postfach 10 26 05
D-86016 Augsburg (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 5 June 2009
refusing European application No. 05712307.7
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: H. Meinders
Members: P. O'Reilly
I. Beckedorf

Summary of Facts and Submissions

- I. The examining division decided to refuse European application No. 05 712 307.
- II. The appellant (applicant) filed an appeal against that decision.
- III. With its appeal grounds the appellant requested that the decision under appeal be set aside and that a patent be granted according to the main or one of the three auxiliary requests.
- IV. In the course of the examination proceedings the appellant, in response to the communication of the examining division dated 17 July 2008, filed with letter of 12 January 2009 sets of claims constituting a main request and first and second auxiliary requests. In that letter the applicant also requested oral proceedings as an auxiliary request.

A summons dated 16 February 2009 to oral proceedings on 12 May 2009 was issued by the examining division.

In a communication that was annexed to that summons the examining division set out its opinion regarding the requests of the applicant. The examining division set a limit of 9 April 2009 for making further submissions and/or amendments.

With letter of 11 March 2009 the appellant explained why it did not agree with the opinion of the examining division and requested a decision on the file as it stood without having oral proceedings.

With its communication dated 30 March 2009 the examining division indicated that it maintained the date for the oral proceedings.

With its communication dated 12 May 2009 and sent on the same day by fax the examining division indicated that it had cancelled the oral proceedings and that the procedure would be continued in writing.

- V. The decision grounds of the examining division are as follows:

"In the communication(s) dated 16.02.2009 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 has 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 12.03.2009.

The application must therefore be refused."

- VI. The Board issued a communication dated 2 February 2010 containing its provisional opinion in which it expressed the view that the decision of the examining division was deficient in that it was not reasoned as required by Rule 111(2) EPC. The Board further indicated that it intended to remit the case to the department of first instance for further prosecution and to reimburse the appeal fee.

VII. With letter of 23 March 2010 the appellant indicated that it agreed with the provisional opinion of the Board and requested that the case be remitted to the department of first instance for further prosecution and that the appeal fee be reimbursed.

VIII. The relevant arguments of the appellant may be summarised as follows:

The letter of the appellant of 11 March 2009 explained in detail why the assessment of the examining division in its annex to the summons of 16 February 2009 was not justified. The examining division failed to take account of these arguments and incorrectly stated in its decision that no comments or amendments were filed in response to this - its latest communication. Even if a decision on the state of the file is requested the decision must still take account of all the arguments of the applicant.

Reasons for the Decision

1. *Lack of reasoning in the decision - substantial procedural violation*

1.1 As pointed out by the appellant in its grounds of appeal the examining division failed to take account of the arguments contained in the letter of the appellant dated 11 March 2009.

1.2 In the reasoning for its decision the examining division made the factually incorrect statement that the "applicant made no comments or amendments in reply

to the latest communication". In fact, the appellant filed a six-page response to that communication of 16 February 2009, i.e. its letter dated 11 March 2009.

In that response the appellant dealt with the objections of the examining division under Article 84 and 123(2) EPC, as well as those of lack of novelty and lack of inventive step. In other words, it dealt with all the objections raised by the examining division in its latest communication.

- 1.3 Although the appellant indicated that it would not appear at the scheduled oral proceedings it nevertheless indicated that any necessary clarifications could be discussed by telephone.

It was therefore quite clear that the appellant had not lost interest in the application, which in some circumstances might justify a shortened decision.

- 1.4 The examining division did not deal with the response of 11 March 2009 in its decision grounds.

For the present appeal proceedings this means that the Board is not in a position to examine the reasons why the examining division did not accept the arguments of the appellant. The decision of the examining division is therefore deficient in that it is not reasoned as required by Rule 111(2) EPC.

- 1.5 This view of the Board is in line with the case law of the Boards of Appeal; see, for example, decisions T 0897/03 and T 1356/05 (not published in OJ EPO).

1.6 The lack of reasoning is a substantial procedural violation since it results in the Board being unable to deal with the case and in the appellant being deprived of any reasoning in respect of its latest submission.

2. *Remittal to the department of first instance*

In view of the aforesaid lack of reasons in the impugned decision the Board considers that it is appropriate to remit the case to the department of first instance for further prosecution in accordance with Article 111(1) EPC.

3. *Reimbursement of the appeal fee*

The substantial procedural violation has led to the appeal being allowable and to remittal of the case so that it is equitable to reimburse the appeal fee pursuant to Rule 103(1)(a) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders