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Datasheet for the decision of 21 July 2014

Case Number: T 0784/11 - 3.2.02

Application Number: 06022874.9

Publication Number: 1782744

IPC: A61B19/00, A61B17/22, A61B17/28, A61B17/32, A61B1/005, A61B1/018, A61B1/00

Language of the proceedings: EN

Title of invention:
Endoscope system with a manipulating unit detachably and slidably attached to the insertion tube

Applicant:
Olympus Medical Systems Corp.

Headword:

Relevant legal provisions:
EPC Art. 109(1)
EPC R. 71(3), 71(5), 103(1)(a), 103(2)

Keyword:
Reimbursement of appeal fee after interlocutory revision (no) - not equitable

Decisions cited:
T 0004/98

Catchword:

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Case Number: T 0784/11 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 21 July 2014

Appellant: (Applicant)	Olympus Medical Systems Corp. 43-2, Hatagaya 2-chome Shibuya-ku Tokyo 151-0072 (JP)
Representative:	von Hellfeld, Axel Wuesthoff & Wuesthoff Patent- und Rechtsanwälte Schweigerstrasse 2 81541 München (DE)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 18 October 2010 refusing European patent application No. 06022874.9 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	E. Dufrasne
Members:	M. Stern
	D. Ceccarelli

Summary of Facts and Submissions

I. The applicant lodged an appeal against the decision of the Examining Division dispatched on 18 October 2010 refusing European application No. 06 022 874.9.

II. Notice of appeal was received on 16 December 2010 and the fee for appeal was paid on that same day. With the statement setting out the grounds of appeal, received on 17 February 2011, the appellant requested reimbursement of the appeal fee under Rule 103(1) EPC.

III. The Examining Division rectified its decision on 25 March 2011 under Article 109(1) EPC and forwarded to the Board the appellant's request for reimbursement of the appeal fee under Rule 103(2) EPC.

IV. The facts concerning the examination proceedings, the appeal and the interlocutory revision which are relevant for deciding the request for reimbursement of the appeal fee can be summarised as follows:

(i) In a communication under Rule 71(3) EPC dated 9 July 2009, the Examining Division indicated that it intended to grant a patent on the basis of the auxiliary request then on file and gave the reasons for not allowing the main request then on file.

(ii) With its response dated 6 November 2009, the applicant did not give its approval of the text proposed for grant and filed amended claims under Rule 71(4) EPC instead.

(iii) In a communication under Article 94(3) EPC dated 15 December 2009, the Examining Division informed the applicant why it took the view that the filed

amendments were not allowable and gave the applicant the opportunity, under Rule 71(5) EPC, to submit its observations with respect to the raised objections and/or to withdraw the amendments. It also informed the applicant, with reference to the Guidelines, C-VI, 14.4, that if the amendments were not withdrawn it was to be expected that the application would be refused.

(iv) With its response dated 23 June 2010, the applicant filed a main request and again filed the previous allowable auxiliary request as annexed to the communication under Rule 71(3) EPC.

(v) In its decision under Article 97(2) EPC dated 18 October 2010, the Examining Division refused the application on the grounds that the main request was not allowable for reasons which had been previously communicated and that the (previous) auxiliary request was not admissible under Rule 137(3) EPC.

(vi) With the statement of grounds of appeal dated 17 February 2011, the appellant requested the grant of a patent on the basis of the (previous) auxiliary request, and reimbursement of the appeal fee under Rule 103(1) EPC.

(vii) The Examining Division rectified its decision to refuse the present application under Article 109(1) EPC and forwarded to the Board the appellant's request for reimbursement of the appeal fee. A patent was granted as requested.

V. The appellant's arguments in support of its request for reimbursement of the appeal fee can be summarised as follows:

Since the Examining Division had not admitted the auxiliary request into the proceedings, a procedural violation had occurred which justified reimbursement of the appeal fee. A procedural violation was in principle a failure to apply the rules of procedure as prescribed in the EPC. The right of the applicant to submit amendments was expressly stated in Rule 71(5) EPC. The applicant had used this right by filing amended claims according to a main request and, in order to prevent refusal of the application, an auxiliary request which was word for word the same as the claims annexed to the communication under Rule 71(3) EPC and thus clearly allowable. The Examining Division should therefore not have refused the application, but should have indicated its intention to grant a patent on the basis of the allowable auxiliary request.

VI. In a communication under Article 17(2) RPBA dated 16 April 2014, the Board presented its preliminary view on the appellant's request for reimbursement and offered the appellant the opportunity to provide any further submissions within a period of two months. No reply from the appellant was received.

Reasons for the Decision

1. Following the interlocutory decision by the Examining Division under Article 109(1) EPC rectifying its decision to refuse the application, the sole matter remaining to be decided by the Board is whether the appeal fee is to be reimbursed (Rule 103(2) EPC).

The request was filed with the statement of grounds of appeal and is thus admissible.

2. Allowability of the request

2.1 Rule 103(1)(a) EPC, invoked by the appellant in support of its request of reimbursement of the appeal fee, stipulates inter alia that the appeal fee shall be reimbursed in the event of interlocutory revision if such reimbursement is equitable by reason of a substantial procedural violation.

2.2 The primary question in the present case is to establish whether, irrespective of any substantial procedural violation which may have occurred, the reimbursement of the appeal fee is equitable.

2.3 In its communication dated 15 December 2009, the Examining Division informed the applicant why it took the view that the amendments filed in response to the communication under Rule 71(3) EPC were not allowable (point III(iii) above). Moreover, it gave the applicant the opportunity, under Rule 71(5) EPC, to submit its observations about the raised objections and/or to withdraw the amendments. It also informed the applicant that if the amendments were not withdrawn, it was to be expected that the application would be refused, in accordance with the procedure explained in the Guidelines, C-VI, 14.4.

2.4 Following the applicant's filing of a main request and of the auxiliary request which had been annexed to the communication under Rule 71(3) EPC, the Examining Division refused the application since, inter alia, it considered the main request not to be allowable for at least one reason which had been previously communicated to the applicant.

2.5 With its appeal, the appellant no longer requested the grant of a patent on the basis of the main request which the Examining Division had found to be unallowable, but just on the basis of the auxiliary request which it had said in the communication under Rule 71(3) EPC was patentable.

2.6 It is clear that the applicant had no choice but to appeal if it wanted the result it has now obtained, namely the grant of a patent on the basis of the (allowable) auxiliary request. As a consequence, irrespective of any purported procedural violation regarding the refusal of the auxiliary request, to reimburse the appeal fee would give the appellant a "fee-free" appeal, which the Board does not consider to be equitable, as Rule 103(1)(a) EPC requires (T 4/98, OJ 2002, 139, point 13.3 of Reasons).

2.7 The appellant considers that since the filed auxiliary request was allowable (having been proposed earlier for grant in the communication under Rule 71(3) EPC), the Examining Division should not have refused the application, but should have indicated its intention to grant a patent on the basis of the auxiliary request.

In other words, the appellant considers that a second communication under Rule 71(3) EPC should have been issued, stating once again that the main request was not allowable (for known reasons), whereas the auxiliary request was.

The Board finds, however, that such a second communication under Rule 71(3) EPC would have been pointless, as it would only have reiterated what the applicant already knew. Moreover, as indicated under point 2.3 above, the applicant had been given the

opportunity, under Rule 71(5) EPC, to submit its observations about the objections raised against the amendments (to the main request) and/or to withdraw the amendments. Because the applicant nevertheless maintained its unallowable main request, the Examining Division was then prevented from granting a patent on the auxiliary request which the previous communication under Rule 71(3) EPC had indicated to be allowable.

The possible issue of yet another communication under Rule 71(3) EPC asking the applicant once again to give its approval to the grant of a patent on this basis would have been a needless procedural step. The Board thus finds that the chosen procedural step of refusing the application was appropriate, as it is within the terms of the rules of procedure prescribed in the Convention, and expedient under the present circumstances.

2.8 For the above reasons, the Board considers that reimbursement of the appeal fee is not equitable, as Rule 103(1)(a) EPC requires.

3. The Board notes that the request for oral proceedings filed with the statement of grounds of appeal was conditional on the Examining Division not rectifying its decision and the Board not setting it aside. The request was not conditional on the Board's decision on the requested reimbursement of the appeal fee. The Board thus saw no reason to appoint them.

Order

For these reasons it is decided that:

The request for reimbursement of the appeal fee is refused.

The Registrar: The Chairman:

D. Hampe E. Dufrasne

Decision electronically authenticated