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**Datasheet for the decision
of 2 April 2014**

Case Number: T 2287/13 - 3.4.01

Application Number: 05782717.2

Publication Number: 1891461

IPC: G01S 7/521, G01S 15/89,
G01S 15/96, H04R 1/44

Language of the proceedings: EN

Title of invention:
Sonar imaging system for mounting to watercraft

Applicant:
Johnson Outdoors, Inc.

Headword:
-

Relevant legal provisions:
EPC Art. 113(1), 116(1), 125
EPC R. 103

Keyword:
J 0004/82

Decisions cited:
"Substantial procedural violation (no)"
"Refund of the appeal fee (no)"

Catchword:
-



Case Number: T 2287/13 - 3.4.01

D E C I S I O N
of the Technical Board of Appeal 3.4.01
of 2 April 2014

Appellant:
(Applicant)

Johnson Outdoors, Inc.
555 Main Street, Suite 028
Racine WI 53403 (US)

Representative:

Elsworth, Dominic Stephen
Hargreaves Elsworth
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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted on 22 July 2013
refusing European patent application
No. 05782717.2 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: G. Assi
Members: H. Wolfrum
H. Vogel

Summary of Facts and Submissions

I. European patent application 05 782 717.2 (publication No. WO2006/017511 and EP 1 891 461) was refused by a decision of the examining division dispatched on 22 July 2013 for the reason of lack of inventive step within the meaning of Articles 52(1) and 56 EPC 1973 of the subject-matter of claim 1 then on file.

II. On 20 September 2013 the applicant lodged an appeal against the decision, filed a statement setting out the grounds of appeal and paid the prescribed appeal fee.

The appellant requested interlocutory revision of the decision under Article 109 EPC on the basis of an amended set of claims. Moreover, reimbursement of the appeal fee pursuant to Rule 103(1)(a) EPC was requested in view of an alleged substantial procedural violation on the part of the examining division.

III. The requested interlocutory revision according to Article 109(1) EPC was granted by a rectification (EPO Form 2710) dated 30 October 2013, informing the appellant that the decision under appeal was set aside and the proceedings were continued. Moreover, the appellant was informed that the request for reimbursement of the appeal fee could not be allowed and would be forwarded to the Board of Appeal for a decision (Rule 103(2) EPC).

IV. On 20 January 2014 the appellant was summoned to oral proceedings to take place on 2 April 2014.

In an annexed communication pursuant to Article 15(1) RPBA the Board confirmed that the sole issue to be dealt

with in the oral proceedings was the appellant's request for refund of the appeal fee. As to the merits of the case, the Board explained why it would seem likely that the appellant's request would be refused.

V. By letter of 20 March the appellant's representative announced that the applicant would not be attending the oral proceedings because the cost of attending oral proceedings significantly outweighed the appeal fee. According to the appellant, the immediate summons to oral proceedings was disproportionate and contrary to Article 125 EPC, in particular in view of the fact that no corresponding request had been made. As to the justifications for refusing a refund of the appeal, reference was made to decision J 04/82, which made clear that there was a substantial procedural violation if arguments of the parties were not discussed. Thus the summons to oral proceedings should be withdrawn and the appeal fee should be refunded.

VI. On 2 April 2014 oral proceedings were held in the absence of the appellant.

Reasons for the Decision

1. In the following reference is made to the provisions of the EPC 2000 ("*EPC*"), 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 and Rule 99 EPC and is, therefore, admissible.

3. Refund of the appeal fee

- 3.1 In an invitation pursuant to Article 94(3) and Rule 71(1) EPC of 7 December 2012, referring to a consultation by telephone with the representative on 28 November 2012, the examining division had raised an objection as to lack of inventive step of the subject-matter of claim 1 then on file and had pointed to the facts and evidence on which it had based its view.

The applicant had responded thereto by a letter dated 16 April 2013, by which it had filed amended dependent claims and an affidavit from the inventor D. A. Betts referring to a "2005 Application Note" from "Edge Tech" in support of a diverging view as to the skilled person's knowledge.

The examining division had then issued the contested decision without previously commenting on the affidavit and application note.

- 3.2 In the appellant's view, the decision of refusal contravened the provisions of Article 113(1) EPC in that the general procedural principle of its "*right to be heard*" had not been respected. More specifically, the applicant had not been given an opportunity to comment on the reasoning which was given in paragraphs 3.1.5 to 3.1.7 of the contested decision dealing with the aforementioned affidavit and application note.
- 3.3 According to Rule 103(1)(a) EPC, first alternative, the reimbursement of the appeal fee shall be ordered in the event of interlocutory revision, if such reimbursement is equitable by reason of a substantial procedural violation.

Thus, the refund of the appeal fee cannot be ordered unless two requirements are met:

- the interlocutory revision has been granted, and
- the proceedings before the first instance suffer from a substantial procedural violation by which the reimbursement would appear equitable.

3.4 In the present case, the first condition is met. It remains therefore to be examined whether the fact that the reasoning in points 3.1.5 to 3.1.7 of the contested decision, which deals with an affidavit and a technical note filed by the applicant, had not been previously communicated to the applicant violates the applicant's right to be heard and thus constitutes a substantial procedural violation.

3.5 In this context, a clear distinction has to be made between grounds and evidence on which a decision is based, on the one hand, and arguments, on the other hand. Whereas Article 113(1) EPC obliges the instances of the EPO to give a party an opportunity to comment on the relevant grounds and evidence before any adverse decision is taken, there is no such obligation with respect to the merits of a party's arguments.

In the present case, the appealed decision is based on a ground (lack of inventive step) and evidence (the cited prior art) which had been communicated by way of the telephone consultation of 28 November 2012, on which the appellant had been given the opportunity to comment. Moreover, as it is not contested by the appellant, the amendments to the claims filed with the applicant's

response of 16 April 2013 did not concern the wording of claim 1 and thus did not require a further communication.

In contrast, neither the affidavit referring to said application note filed by the appellant nor the corresponding reasoning in the decision qualify as new facts or evidence. The former merely relates to the opinion of one of the inventors and thus concerns at most additional arguments put forward by the applicant, whereas the latter constitutes respective counterarguments. Therefore, the reasoning given in paragraphs 3.1.5 to 3.1.7 of the contested decision does not introduce new grounds or evidence on which the applicant would have had to be heard, but merely responds to arguments which the appellant had put forward in support of the presence of an inventive step.

3.6 It follows from the above that the proceedings before the first instance department do not suffer from a substantial procedural violation which would render a reimbursement of the appeal fee equitable.

3.7 The appellant's request for refund of the appeal fee is therefore refused.

4. Cancellation of scheduled oral proceedings

4.1 The appellant's complaint that the immediate summons to oral proceedings was disproportionate and contrary to Article 125 EPC is unfounded.

4.2 According to Article 116(1) EPC, oral proceedings shall take place if a board of appeal considers this to be expedient. Thus, already because of the procedural

provision of Article 116(1) EPC, Article 125 EPC is not applicable.

The purpose of having oral proceedings is to bring as soon as possible a case to a conclusion in that it implies the fixing of a date at which the decision will normally be taken. The Board's communication annexed to the summons to oral proceedings gave the appellant the opportunity to comment in writing on the reasons as to why the request for refund of the appeal fee could presumably be refused and, as the case may be, to prepare the submissions to be made at the oral proceedings.

- 4.3 The appellant's argument that the cost of attending oral proceedings would be disproportionate to the refundable amount disregards the fact that the appellant had the possibility of submitting all its arguments in favour of a reimbursement of the appeal fee in reply to the Board's communication. In such a case, it may be expected that the absence of the appellant from the oral proceedings will not lead to any undue disadvantage.
- 4.4 Decision J 04/82 is not pertinent to the present case. In that case a receiving section of the EPO had prematurely rejected a request for correction of a mistake made in the request for grant of a European patent. The legal board of appeal held that the adverse decision of the receiving section was given too early, *ie* before the appellants had had a reasonable opportunity to submit supporting information and evidence.
- 4.5 For these reasons, the appellant's request for cancellation of the scheduled oral proceedings was refused.

Order

For these reasons it is decided that:

The request for reimbursement of the appeal fee is refused.

The Registrar

The Chairman

R. Schumacher

G. Assi