

Publication in the Official Journal Yes / No

File Number: T 228/89 - 3.2.1

Application No.: 85 116 316.2

Publication No.: 0 188 784

Title of invention: Composite pipe, process for producing the same, and heat pipe using the same

Classification: F16L 58/08, F28F 19/06, F28F 21/08, B21C 23/22, B21C 37/06, F28D 15/02

D E C I S I O N
of 25 November 1991

Applicant: Sumitomo

Headword:

EPC Articles 111(1), 113(1); Rule 67

Keyword: "Remittance for further prosecution (yes) - Reimbursement of the appeal fee (no)"

Headnote



Case Number : T 228/89 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 25 November 1991

Appellant : Sumitomo Electric Industries, Ltd.
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Decision under appeal : Decision of Examining Division 2.3.11.118 of the
European Patent Office dated 26 October 1988
refusing European patent application
No. 85 116 316.2 pursuant to Article 97(1) EPC.

Composition of the Board :

Chairman : F. Gumbel
Members : F.J. Pröls
F. Benussi

Summary of Facts and Submissions

- I. European patent application No. 85 116 316.2 filed on 20 December 1985 and published on 30 July 1986, was refused by a Decision of the Examining Division dated 26 October 1988.
- II. The Decision was based on Claims 1 to 24 received on 21 March 1988 which comprise independent product Claims 1 and 16, independent method Claims 2 and 15 as well as dependent Claims 3 to 14 and 17 to 24.
- III. The reason given for the refusal was that in view of US-A-3 233 320 the subject-matter of Claim 1 did not involve an inventive step.
- IV. On 27 December 1988 a Notice of Appeal was filed and the appeal fee was paid at the same time. The Statement of Grounds of Appeal was submitted on 3 January 1989.

The Appellant, after having received a communication of the Board, dated 4 December 1989, requests that

- (a) the decision under appeal be set aside and, the application be remitted to the Examining Division in order that the examination be continued on the basis of method Claims 2 to 24 as received on 21 March 1988,
- (b) the appeal fee be reimbursed, and
- (c) an oral proceedings be held only for the case that the application is not remitted for further prosecution.

He argued that the decision under appeal contains a procedural violation due to the fact that it has only judged Claim 1 but has not considered the so far unexamined method Claims 2 to 24 which were independent from Claim 1 and has not informed the Applicants of any reasons for rejecting these claims;

Given this substantial procedural violation and considering that Rule 67 does not require that the Appellant must be successful with all requests, the appeal fee should be refunded in the case of allowance of above request a).

V. The three independent valid Claims 2, 15 and 16 now on file read as follows:

2. A method for manufacturing a composite pipe (1), comprising the steps of forming a lead pipe (3), and supplying said lead to a continuous aluminium extrusion machine (6) capable of extruding while enveloping a long object, and forming an aluminium pipe (2) on said lead pipe (3) by extruding the aluminium with said lead pipe (3) as a core.

15. A method for connecting composite pipes (1) each comprising an aluminium pipe (2) and a lead pipe (3) provided in said aluminium pipe (2) and having its outer wall in contact with the inner wall of said aluminium pipe (2), comprising the steps of cutting off the ends of said aluminium pipes (2) at the end of the composite pipes (1) to expose the ends of said lead pipes (3), expanding the exposed end (23) of at least one of said lead pipes (3), and connecting the exposed ends (23) of said lead pipes (3) together.

16. A heat pipe having as a container a composite pipe (1) comprising an aluminium pipe (2) and a lead pipe (3) provided in said aluminium pipe (2) and having its outer wall in contact with the inner wall of said aluminium pipe (2), and a working fluid sealed in said container.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is admissible.
2. Claims 2 to 24 which now represent the valid claims were first filed on 21 March 1988 in response to the communication of the Examining Division. Thereafter the application was immediately rejected for reason of lack of inventive step as concerns the then Claim 1. An examination of Claims 2 to 24 had been considered as unnecessary in the decision. Claim 1 forming the basis for the decision under appeal has been deleted in the appeal procedure in response to the Board's communication.
3. It is apparent from these circumstances that in the case at hand the subject-matter of the present claim set has not been examined as to whether it satisfies the requirements of the EPC.

In accordance with the established jurisprudence of the Boards (see e.g. T 161/82, OJ EPO 1984, 551, point 7) the Board of Appeal therefore, in order not to deprive the Appellant of his right to an examination in two instances, deems it necessary to exercise its power under Article 111(1) EPC to remit the application to the Examining Division so that they may examine and decide whether the remaining Claims 2 to 24 satisfy the requirements of the EPC.

4. According to Rule 67 EPC the reimbursement of appeal fees shall be ordered if the following conditions are fulfilled:
- (a) The Board of Appeal deems the appeal to be allowable (or the decision has been rectified by an interlocutory revision);
 - (b) a substantial procedural violation has been committed;
 - (c) the reimbursement must be equitable by reason of such a procedural violation.

4.1 The Appellant argued that a reasonable interpretation of Rule 67 EPC would lead to the result that the reimbursement of the appeal fees is also possible if the appeal is partly allowable, at least in those cases where the procedural violation was made in that part of the application for which the appeal is considered allowable.

4.2 In the Board's view Rule 67 EPC as concerns the wording "where the Board of Appeal deems an appeal to be allowable" is to be interpreted in the sense that the Board is in disagreement with the main argumentation in the decision under appeal as concerns the "ratio decidendi", i.e. that the Board in essence accepts the Appellant's reasons concerning the case decided by the decision under appeal. In the present case, this means that the Board would have to accept the existence of an inventive step of the subject-matter of Claim 1 underlying the impugned decision.

However, in its provisional opinion given in its communication, the Board held that the subject-matter of

Claim 1 was not inventive and in response to this communication the Appellant has cancelled Claim 1. Thus, there remains no basis for the Board to finally consider the view of the Examining Division with regard to the inventivity of Claim 1 and to decide whether the cancelled Claim 1 would have been acceptable and the appeal allowable or not.

Therefore, the mere fact that the Board of Appeal accepts the present modified request of the Appellant and remits the application for further prosecution to the Examining Division on the basis of the remaining Claims 2 to 24 cannot be considered as the Board deeming the appeal to be allowable or partially allowable.

Therefore, the Appellant's request for reimbursement of the appeal fee has to be rejected, since the first condition set out in Rule 67 EPC (see paragraph (a) under point 3 above) is not fulfilled.

For this reason it is not important for the Appellant's request whether the further conditions of Rule 67 EPC are fulfilled, i.e. whether a substantial procedural violation has been committed, which in the Board's view is not the case concerning the fact that Claims 2 to 24 were not examined.

Contrary to the Appellant's opinion there is no obligation under the EPC for the Examining Division to carry out the examination of the application in its entirety, i.e. in respect of all pending claims if a claim considered unallowable was maintained and no auxiliary request relating to a set of claims not comprising this unallowable claim was submitted. In such a case the application clearly fails to meet a requirement of the EPC

and is open to refusal (see T 05/81 OJ 1982, 249, point 3).

- 5. The request for oral proceedings has been made only in the event that the Board does not remit the case for further examination to the Examining Division. As far as the request for reimbursement of the appeal fee is concerned oral proceedings are not requested.

Thus, there was no reason for the Board to appoint oral proceedings.

Order

For these reasons, it is decided that:

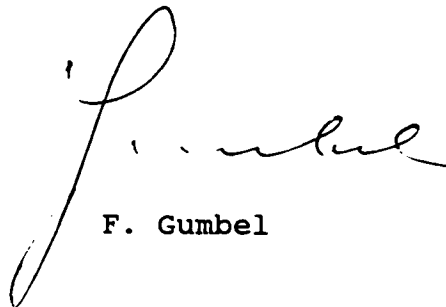
- 1. The contested decision is set aside.
- 2. The application is remitted to the Examining Division for further prosecution on the basis of Claims 2 to 24 filed on 21 March 1988.
- 3. The request for reimbursement of the appeal fee is rejected.

The Registrar:



S. Fabiani

The Chairman:



F. Gumbel

