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File No.: T 0063/93 - 3.2.2  
Application No.: 88 311 543.8  
Publication No.: 0 345 396  
Classification: A61M 5/14  
Title of invention: IV pump cassette

**D E C I S I O N**  
of 28 July 1993

Applicant: IMED CORPORATION

Proprietor of the patent:

Opponent:

Headword:

**EPC:** Art. 108; R. 64(b), 65(1), 67

**Keyword:** "Form of appeal, grounds, substantiation (no)" - "Procedural violation (no)" - "Reimbursement (no)"

**Catchwords**

*A patent application may be refused after the first communication if the Applicant's response fails to convince the Examining Division, particularly when the claimed subject-matter has not been substantially modified.*



Case Number: T 0063/93 - 3.2.2

**D E C I S I O N**  
**of the Technical Board of Appeal 3.2.2**  
**of 28 July 1993**

**Appellant:**

IMED CORPORATION  
9925 Carroll Canyon Road  
San Diego  
California 92131 (US)

**Representative:**

Coxon, Philip  
Eric Potter & Clarkson  
St. Mary's Court  
St. Mary's Gate  
Nottingham NG1 1LE (GB)

**Decision under appeal:**

**Decision of the Examining Division of the European  
Patent Office dated 13 August 1992 refusing  
European patent application No. 88 311 543.8  
pursuant to Article 97(1) EPC.**

**Composition of the Board:**

**Chairman:** G. Szabo  
**Members:** M. Noel  
G. Davies

### Summary of Facts and Submissions

- I. European patent application No. 88 311 543.8 (Publication No. 0 345 396) comprising sixteen claims was filed on 6 December 1988.
- II. In a first communication dated 24 January 1992, the Examining Division objected to the claims on the ground of lack of inventive step with respect to the prior art and requested the Applicant to specify the particular matter regarded by it as patentable and to substantiate its view in relation to the prior art.
- III. In its response dated 18 May 1992, the Applicant filed amended claims, independent Claim 1 having substantially the same subject-matter as Claim 1 as originally filed but redrafted in the two-part form to take account of the closest prior art document. The Applicant also submitted arguments to support the inventive step of Claim 1 in relation to the prior art.
- IV. By the decision dated 13 August 1992, the European patent application was refused by the Examining Division on the ground that the subject-matter of the claims still did not involve an inventive step with respect to the same prior art documents, i.e. for the same reasons as those set forth in the first communication.
- V. The Appellant (Applicant) lodged an appeal against the decision by Notice of Appeal dated 7 October 1992, paying the appeal fee on 8 October 1992. A Statement of Grounds dated 17 December 1992 was received in due course.
- VI. In the Statement of Grounds for Appeal, the Appellant made the following statement:

"It is submitted that the claims rejected by the examiner are inventive over the disclosure of documents D1 and D2 for the reasons given in our letter of 18th May 1992. It is requested that the Appeal Board consider this matter.

It is submitted that the issue of the decision to refuse the application was a procedural violation and our detailed reasons for this were given in our letter of 28th September 1992".

VII. Following a communication dated 1 June 1993 by which the Appellant was informed of the provisional opinion of the Board, the Appellant withdrew his request for oral proceedings.

VIII. The Appellant requests

- that the contested decision be set aside and that a European patent be granted on the basis of the claims on file, and
- that reimbursement of the appeal fee be ordered.

### **Reasons for the Decision**

#### **1. Admissibility**

The Appellant has appealed the decision of the Examining Division on two issues, one procedural, one substantive.

1.1 As regards the procedural issue, the Appellant submitted in both the Notice of Appeal and the Statement of Grounds of Appeal that the decision had been a procedural violation for the reasons given in his letter

of 28 September 1992. As this letter was sent after the issue of the decision dated 13 August 1992, the Appellant was entitled to refer back to his previous submission.

Therefore, the Board takes the view that the appeal is admissible on the procedural point, in conformity with the requirements of Article 108, first sentence, and Rule 64(b) EPC, since on this point the Notice of Appeal left the Board in no doubt as to the arguments on which the appellant based its request for cancellation of the decision under appeal.

In the letter of 28 September 1992, it was submitted that in the response to the first communication of the Examining Division, an attempt had been made to deal with the examiner's objections and to put the application into a form ready for grant. Refusal of the application after only one communication, to which a *bona fide* response had been filed, represented a procedural violation and was in contradiction with the instructions given in the Guidelines for Examination in the EPO, C.VI. 4.3, according to which the application should not have been refused immediately.

However, in the opinion of the Board, the Examining Division behaved properly in the present case, as Article 113(1) EPC does not require that the Applicant be given a repeated opportunity to comment on the argumentation of the first instance so long as the decisive objections against the grant of the European patent remain the same (cf. T 84/82, OJ EPO 1983, 451, point 7 and T 161/82, OJ EPO 1984, 551, point 11).

1.2. As regards the substantive issue, i.e. patentability, the Statement of Grounds of Appeal of 17 December 1992 is confined to referring back to the reasons given in

the previous submission of 18 May 1992 to the first instance and a request for the Board to reconsider the matter. As a matter of fact, the reasons were commented upon in detail in the decision (cf. in particular point 3 therein). Without any explanation as to why such comments are wrong, no ground for appeal can be recognised. Grounds for Appeal may not be confined to an assertion that the contested decision is incorrect, for in that case it would say no more than what was already implicitly stated by the fact of the appeal being filed. Since the Appellant has not actually set out any legal or factual reasons why the decision under appeal should be set aside as regards patentability, the appeal is considered by the Board as inadmissible in this respect (cf. T 220/83, OJ EPO 1986, 249, point 4; T 145/88, OJ EPO 1991, 251; and T 213/85, OJ EPO 1987, 482).

For grounds to be sufficient for the admissibility of an appeal they must provide a proper analysis contesting the main reason - here alleged lack of inventive step - given for the contested decision. It is not sufficient for the Appellant merely to refer in general terms to the prior art documents and to do nothing more than reiterate the previous reasons without explaining why their refutation in the decision was wrong. Therefore, the Statement of Grounds of Appeal cannot be accepted as substantively adequate grounds within the meaning of Article 108, third sentence, EPC and the appeal must be rejected as inadmissible in accordance with Rule 65(1) EPC in this particular respect.

2. *Reimbursement*

The Appellant requested reimbursement of the appeal fee on the basis that there had been a procedural violation on the part of the Examining Division.

Rule 67 EPC only allows an appeal fee to be reimbursed if the appeal is allowed and if such reimbursement is equitable by reason of a substantial procedural violation.

In the present case, reimbursement of the appeal fee cannot be ordered for the reason that, as stated in point 1.2 above, the appeal on substantive grounds is inadmissible and therefore unsuccessful.

Further, as stated in point 1.1 above, the Board finds that there has been no procedural violation in the present case, so that reimbursement of the appeal fee is not justified on the facts.

**Order**

**For these reasons it is decided that:**

1. The appeal is dismissed.
2. The request for reimbursement of the appeal fee is refused.

The Registrar:



S. Fabiani

The Chairman:



G. Szabo

