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**Datasheet for the decision  
of 21 July 2011**

**Case Number:** J 0025/10 - 3.1.01

**Application Number:** 07865305.2

**Publication Number:** 2120695

**IPC:** A61B 5/042

**Language of the proceedings:** EN

**Title of invention:**

Catheters having linear electrode arrays and their method of use

**Applicant:**

Medtronic Vascular, Inc.

**Opponent:**

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**Headword:**

Catheters having linear electrode arrays/MEDTRONIC VASCULAR

**Relevant legal provisions:**

EPC Art. 18(1), 94(1)  
EPC R. 10(2), 103(1)(a), 111(2)  
RFees Art. 11(b)  
PCT R. 43bis.1

**Relevant legal provisions (EPC 1973):**

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**Keyword:**

"Partial refund of the examination fee (yes)"  
"Start of substantive examination"  
"Reimbursement of the appeal fee (yes)"

**Decisions cited:**

G 0003/08, J 0037/03, J 0038/03, T 0278/00, T 0850/95

**Headnote:**

Following the withdrawal of a European patent application, a refusal by the Examining Division of a request for a 75% refund of the examination fee, on the basis that substantive examination had already begun (Article 11(b) RFees), must be based on facts which objectively demonstrate that this is so.



Case Number: J 0025/10 - 3.1.01

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.01  
of 21 July 2011

**Appellant:** Medtronic Vascular, Inc.  
3576 Unocal Place  
Santa Rosa  
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**Representative:** Zimmermann & Partner  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office of 14 July 2010 refusing  
the request for a partial refund of the  
examination fee.

**Composition of the Board:**

**Chairman:** K. Garnett  
**Members:** P. Schmitz  
J. Geschwind

## **Summary of Facts and Submissions**

- I. European patent application 07 865 305.2 was filed as international application PCT/US2007/086633 on 6 December 2007, claiming a priority of 13 December 2006. The European Patent Office, as the International Searching Authority, produced the international search report and the written opinion.
- II. On 13 July 2009, the application entered the European phase before the EPO, following the filing of Form 1200 and the payment of the filing fee, the designation fee and the examination fee. On 29 July 2009, the Receiving Section issued a communication pursuant to Rules 161 and 162 EPC giving the applicant the opportunity to file amended documents within one month. By communication of the Receiving Section dated 28 October 2009, the applicant was informed about the application of Article 67(3) EPC and the publication of the bibliographic data in the European Patent Bulletin.
- III. By letter dated and received on 23 March 2010, the applicant withdrew the European patent application and requested that a refund of fees be made to the representative's EPO deposit account. By brief communication of 8 April 2010, the Formalities Officer acting for the Examining Division informed the applicant that a refund of 75% of the examination fee was no longer possible since substantive examination had already begun. The applicant was asked to inform the EPO whether it wished to maintain the notice of withdrawal, noting that the notice had not been explicitly conditional on a refund of the examination fee.

IV. By letter dated 20 May 2010, the applicant confirmed the withdrawal of the application and maintained the request for a partial refund of the examination fee. It was argued that since the Examining Division had not specified when substantive examination had begun and how such date was determined, the Examining Division was not entitled to deny the refund. Article 11(b) RFees specified that 75% of the examination fee would be refunded if the application was withdrawn before substantive examination had begun. Accordingly, the applicant had a right to the refund. If such refund was denied the factual circumstances allowing the denial had to be presented in such a way that the applicant was able to determine whether the decision was correct or not. Otherwise the Examining Division would violate the applicant's right to a refund without allowing the applicant to challenge the decision on an objective basis.

V. By communication dated 23 June 2010, the Formalities Officer acting for the Examining Division maintained the finding that a refund was not possible. The start of substantive examination depended on the individual circumstances of the case. Although the Examining Division had not yet issued a communication at the date on which the withdrawal of the application had been received, the assessment regarding the start of the examination procedure lay entirely within the responsibility of the Examining Division. As the primary examiner had confirmed that he had already started with the substantive examination when the application was withdrawn, a partial refund of the examination fee was no longer possible.

- VI. By letter of 30 June 2010, the applicant maintained its request for a partial refund of the examination fee and requested an appealable decision. By decision dated 14 July 2010, the request to refund the examination fee at a rate of 75% was refused for the same reasons as set out in the communication of 23 June 2010.
- VII. On 6 September 2010, notice of appeal was filed and the appeal fee was paid on the same day. The appellant requested that the decision of the Examining Division be set aside and a partial refund of the examination fee be ordered. Also requested was a refund of the appeal fee, and oral proceedings in the event that the Board did not intend to allow the preceding requests.
- VIII. In the statement setting out the grounds of appeal, received on 23 September 2010, the appellant submitted that according to Article 11(b) RFees it did not lie within the discretion of the EPO whether a refund was possible. Rather, the EPO was obliged by law to refund the fee if the requirements for a refund were met. The EPC did not specify any criteria defining the action of substantive examination within the meaning of Article 11(b) RFees. The Examining Division had not provided any information allowing the appellant to determine the basis and reasons of the decision. Without such objective criteria, the date of the beginning of substantive examination could not be objectively determined. Rather, determination of this date was exclusively at the discretion of the Examining Division. Without any objective criteria, decisions of the Examining Division might be arbitrary. Each Examining Division might employ its own criteria,

possibly resulting in deviating decisions for factually identical cases. The appellant had explicitly asked the Examining Division for the exact date and the criteria applied. However, no such information was provided. The appellant could not determine the correctness of the decision without having objective criteria. This violated the fundamental principles of predictability and verifiability as well as of legal certainty, which were acknowledged by the Enlarged Board of Appeal in G 3/08.

### **Reasons for the Decision**

1. The appeal is admissible.
2. According to Article 11(b) RFees the examination fee is refunded at a rate of 75% if the European patent application is withdrawn after the Examining Divisions have assumed responsibility but before substantive examination has begun. As rightly pointed out by the appellant, this provision does not leave any room for discretion, but rather lays down two conditions which must be met for the examination fee to be refundable. These two conditions must therefore be examined.
3. As to the first condition, the Examining Division is responsible for the examination of a European patent application under Article 94(1) EPC from the time when a request for examination is filed (Rule 10(2) EPC). The request is not deemed to be filed until the examination fee has been paid (Article 94(1), second sentence, EPC). The request for examination in this case was contained in box 4 of Form 1200, which was

filed on 13 July 2009. On the same day, the examination fee was paid. Thus, as from this day the Examining Division assumed responsibility. Notice of withdrawal was received after this date, i.e. on 23 March 2010.

4. The second condition gives rise to the point in dispute, namely whether it has been established that at the date of the withdrawal substantive examination had already begun. Substantive examination is the examination of whether the European patent application and the invention to which it relates meet the requirements of the Convention, as set out in Article 94(1), first sentence, EPC. This examination is only performed upon request. According to Article 18(1) EPC, it is the Examining Division which is responsible for this examination.
5. For reasons which will become apparent, it is not necessary to consider precisely what kind of act or acts amount to the beginning of substantive examination in any particular case. It is only necessary to say that it requires a concrete act of the Examining Division as regards substantive examination after the request for examination has been filed.
6. In the present case there is no indication whatsoever in the file showing, by reference to objective criteria, that the Examining Division had performed a concrete act of any kind which could be regarded as a start of substantive examination in the regional phase after the request for examination had been filed.



7. It is clear that the written opinion issued by the European Patent Office during the international phase according to Rule 43*bis*.1 PCT cannot be considered as an act of substantive examination, and indeed the Examining Division in the decision appealed from did not assert that it could be so considered. In the written opinion, the International Searching Authority establishes whether the claimed invention appears to be novel, to involve an inventive step, and to be industrially applicable, as well as whether the international application complies with the requirements of the PCT in so far as checked by the International Searching Authority. This opinion is drawn up in the international phase and is governed by the provisions of the PCT. It is not part of the procedure before the European Patent Office as designated or elected Office and does not give any assessment of whether the requirements of the EPC are met. Under the PCT, the international phase and the regional phase are clearly conceived as separate. Therefore, for the purpose of deciding whether substantive examination before the EPO as a regional patent granting authority has begun, acts performed by the EPO as an international authority under the PCT are not relevant (J 37/03 and J 38/03 both dated 15 March 2006, point 6 of the Reasons). Moreover, as set out above, substantive examination can only be carried out upon request (Article 94(1), first sentence EPC). Thus, acts performed during the search stage without a valid request for examination cannot be part of the examination procedure.
8. It then remains to be decided whether it can be accepted in this case that substantive examination can

- have already started when there had been no communication and when there is also no other indication in the file that the Examining Division had taken up its substantive work.
9. In the decision under appeal the Examining Division first stated that "the assessment regarding the start of the examination procedure lies entirely in the responsibility of the Examining Division" (point 4 of the Reasons). This is true in the sense that the Examining Division has to make the assessment, and that often it will only be the Examining Division which has access to the relevant information needed to make this assessment. But it does not mean the Examining Division can take the decision without reference to the relevant facts.
  10. The only point on which the refusal for the partial refund was then based was "that the primary examiner confirmed that he started already with substantive examination" (point 3 of the Reasons). This is no more than an unsubstantiated assertion. Article 11(b) RFees establishes clear conditions which must be fulfilled in order for a partial refund of the examination fee to be made. Whether these conditions have been fulfilled in any particular case is a question of fact. If the request is to be refused on the basis that these conditions have not been met, the Examining Division must give reasons why the conditions are not met, having established what the facts are. It is not sufficient simply to assert that a condition of a provision is not met without reference to underlying facts which objectively demonstrate that this is so. To do so would amount to an arbitrary decision which is

not verifiable and goes against all legal certainty. In G 3/08 (OJ EPO 2011, 10) the Enlarged Board of Appeal said that "*the predictability and verifiability of all state action are indispensable elements of a democratic legal order*", these being amongst the principles which the EPO must support (point 7.2.1 of the Reasons). The Board further said: "*Another essential element of a democratic legal order is the principle that a public authority is bound by law and justice. This is supplemented by the principle of uniform application of the law. Both principles are designed to ensure predictability of jurisdiction and hence legal certainty by preventing arbitrariness*" (point 7.2.3. of the Reasons). A mere assertion that a condition laid down in a legal provision is not met, without sufficient substantiation by reference to the underlying facts, violates these principles.

11. As the appellant points out, without factual information relevant to the criteria of when substantive examination began, the date of this event cannot be objectively determined. In the present case this resulted in the determination appearing to be at the discretion of the Examining Division. The appellant points out that the Examining Division had been asked for the exact date of the start of substantive examination and the criteria applied to its assessment. However, no such information was provided. Without such information, the appellant could not determine the correctness of the decision. The Board would add that without such information it also cannot determine whether the decision that substantive examination had begun was correct or not. The decision was therefore

neither predictable nor verifiable, contrary to the principles set out in G 3/08 *loc. cit.*, above.

12. It appears to the Board that the application of these principles is particularly important in the present case for two reasons. First, since the decision which the Office, via the Examination Division, is required to take involves its own financial interests, it is important for the public confidence in the Office that the decision-making process should be transparent. For the same reason it is also important that such decisions should be reviewable by the Boards of Appeal. Second, in the present case any relevant information lay solely within the knowledge of the Office. It is not a case in which, for example, a communication had been sent to the applicant, so that there were externally verifiable facts on which a decision to refund fees could be based and reviewed. This makes it important that the applicant (and the Board of Appeal) knows what the actual underlying facts are on which the decision was based.
13. In conclusion, it cannot be accepted as established in this case that substantive examination had already begun when the application was withdrawn.
14. The Board is aware that in the meantime the Office has changed its practice as regards the refund of the examination fee as outlined in the Notice dated 22 October 2009 (OJ EPO 2009, 542), to which the appellant has referred. However, the Board notes that it is still Article 11 RFees which is applicable and therefore a 75% refund of the examination fee can still only be denied if substantive examination has already

begun. As already made clear, this requires a concrete act of the Examining Division with regard to substantive examination.

*Reimbursement of the appeal fee*

15. According to Rule 111(2) EPC decisions which are open to appeal shall be reasoned. The reasons should deal with the facts of the case and should enable the appellant and the Board to understand how the department of first instance came to its conclusion. The Board must be in a position to assess on the basis of the reasoning given in the decision under appeal whether the conclusion drawn by the first instance from the established facts was justified or not (T 278/00, OJ EPO 2003, 546; T 850/95, OJ EPO 1997, 152). This is not the case here. The lack of any sufficient reasoning by reference to established facts constitutes a substantial procedural violation which justifies the reimbursement of the appeal fee (Rule 103(1)(a) EPC).

*Oral proceedings*

16. Since the Board intends to allow the appellant's requests, there has been no need to appoint oral proceedings, which were only requested on an auxiliary basis.

**Order**

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

1. The decision under appeal is set aside.
2. The examination fee is to be refunded at a rate of 75%.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:

C. Eickhoff

K. Garnett