

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

D E C I S I O N
of 20 February 2006

Case Number: T 0021/02 - 3.3.01

Application Number: 95111575.7

Publication Number: 0684249

IPC: C07F 9/50

Language of the proceedings: EN

Title of invention:

Phosphine compounds, complexes containing the phosphine compounds as ligands, and process for producing optically active aldehydes using the phosphine compounds or complexes

Applicant:

TAKASAGO INTERNATIONAL CORPORATION

Opponent:

-

Headword:

Reimbursement of appeal fee/TAKASAGO

Relevant legal provisions:

EPC Art. 109(1), 106, 21(1)
EPC R. 67

Keyword:

Interlocutory revision - request for reimbursement pursuant to Rule 67 EPC - examination by Board of Appeal (no) "

Decisions cited:

G 0003/03, J 0032/95

Headnote:

Where a request for reimbursement of the appeal fee pursuant to Rule 67 EPC was submitted only after the contested decision had been rectified under Article 109(1) EPC, the procedural situation differs from that underlying decisions G 0003/03 and J 0032/95 and, failing a decision of the department of first instance, no legal basis exists for the Board of Appeal to decide on that request.



Case Number: T 0021/02 - 3.3.01

D E C I S I O N
of the Technical Board of Appeal 3.3.01
of 20 February 2006

Appellant: Takasago International Corporation
37-1, Kamata 5-chome
Ohta-ku
Tokyo (JP)

Representative: Dixon, Donald Cossar
Wilson Gunn Gee
Chancery House
Chancery Lane
London WC2A 1QU (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 23 March 2001
refusing European application No. 95111575.7
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. Nuss
Members: J. Jonk
R. Menapace

Summary of Facts and Submissions

I. European patent application 95 111 575.7 (publication number 0 684 249) was refused by the Examining Division with its decision posted on 23 January 2001.

In the decision the Examining Division held that the subject-matter of claims 5 and 6 of the then pending main request did not comply with Article 123(2) EPC and expressed its "opinion" that the application could proceed to grant on the basis of the claims of the auxiliary request filed during the oral proceedings.

II. The applicant (appellant) gave notice of appeal against this decision on 23 May 2001, paid the appeal fee partly paid at the same date and for the remainder on 25 May 2001, and requested that the application proceeds (exclusively) on the basis of the claims according to his former auxiliary request.

III. On 26 July 2001 the Examining Division rectified the decision under appeal and ordered the dispatch of form 2710 (see section III of EPO Form 2701). Said form, which is an official letter informing the applicant that rectification was ordered and the decision under appeal was set aside, was posted on 31 July 2001.

IV. In his letter of 20 August 2001 the applicant stated *inter alia* that he understood that the appeal filed as a precaution was not necessary. As the main request at the oral proceedings had been withdrawn the appeal should also be withdrawn and he was, accordingly, looking forward to receiving confirmation, that the appeal fee would be refunded.

- V. With a communication under Rule 51(4) EPC posted on 27 November 2001 the Examining Division informed the applicant that it intended to grant a European patent on the basis of the text as indicated and, in respect of the applicant's request for reimbursement of the appeal fee, that it could not order such reimbursement, the requirements of Rule 67 EPC not having been met.
- VI. Accordingly, the Examining Division, by additionally crossing the relevant box under Section III of form 2701, ordered referral of a duplicate dossier to the Board of Appeal, where it arrived on 24 January 2002.

Reasons for the Decision

1. The applicant's statements in his letter of 20 August 2001 (see point IV, above) can only be understood as a request for reimbursement of the appeal fee pursuant to Rule 67 EPC. The remittal of that request to the Board of Appeal was apparently made in view of the relevant jurisprudence, which at that time was the decision of the Legal Board of Appeal J 32/95 of 24 March 1999 (OJ 1999, 713) in which it was held that, if the department of the first instance whose decision is contested considers the requirements of Article 109 EPC for interlocutory revision to be fulfilled, but not the requirements of Rule 67 EPC for reimbursement of the appeal fee, it must rectify its decision and remit the request for reimbursement to the Board of Appeal for a decision.

2. This finding has been confirmed by the Enlarged Board of Appeal in its decision G 3/03 (OJ EPO 2005, 344), according to which in the event of interlocutory revision the department of first instance whose decision has been appealed is not competent to refuse a request of the appellant for reimbursement of the appeal fee; rather, the Board of Appeal which would have been competent to deal with the substantive issues is competent to decide on the request.

3. However, in the present case, the applicant submitted the request for reimbursement of the appeal fee only after the Examining Division had granted interlocutory revision pursuant to Article 109(1) EPC and he had been informed thereof. Hence, no such request had been submitted at the time when pursuant to Rule 67 EPC the Examining Division, within the framework of interlocutory revision and regardless of whether or not the appellant had actually submitted such a request (see G 3/03, point 3), had to examine whether the requirements for reimbursement of the appeal fee were met.

4. In this context the Enlarged Board of Appeal considered in its decision G 3/03 (see points 2 and 3 of the Reasons) that
 - in case of interlocutory revision and reimbursement of the appeal fee not being contentious, the appeal is not remitted to, and thus will not be pending before a Board of Appeal, the decision under appeal having been set aside and the appeal allowed by the first instance;

- in the absence of a request for reimbursement of the appeal fee, the decision of the department of the first instance granting the interlocutory revision will make no mention of the issue of reimbursement of the appeal fee, and the appellant will not be adversely affected by the decision.
5. This means, that in the present case the appeal had been fully dealt with (by way of interlocutory revision) and was, thus, no longer pending, when the request for reimbursement was submitted. As a consequence, the request was submitted in the absence of a pending appeal and could not, hence, constitute an ancillary issue to be dealt with in appeal proceedings. The procedural situation is the same as if the request for reimbursement of the appeal fee, which in itself does not qualify as an appeal within the meaning of Articles 106 *et seq.* EPC, had been submitted without an appeal having been lodged at all, or only after the Board of Appeal had decided upon it and remitted the case to the department of first instance for further prosecution.
6. That being so, in the case at hand no appeal exists from a decision of department of first instance for which the Boards of Appeal are responsible pursuant to Article 21(1) EPC and the Board is not empowered to decide on the request for reimbursement which has to be considered to be a request addressed to a department of first instance in proceedings (exclusively) pending before it. It is that department, which remains the competent body to deal with that request.

7. It is only after the department of first instance has issued a decision refusing the reimbursement of the appeal fee, that the applicant may appeal against this decision in accordance with the provisions of the EPC and thereby obtain a second instance review of the matter by the Board. It is true, that the applicant would then have to pay again the same fee for that (separate) appeal, to enforce his rights and, thus, could not gain, in financial terms, anything from that appeal. However, in contrast to the procedurally relevant facts underlying decisions J 32/95 and G 3/03, the present request was not based on an appeal dealt with by interlocutory revision, as set out above, so that the findings in those decisions do not apply in the case at hand where no legal basis exists for the Board to decide on the request directly, i.e. in the absence of a previous decision of the responsible department of first instance.

8. It follows, that the Board is prevented from examining the request for reimbursement, neither as to its procedural requirements - *inter alia*, whether reimbursement under Rule 67 EPC can be validly requested and ordered when the appeal is no longer pending -, nor as to its merits, in particular whether it constituted a substantial procedural violation within the meaning of Rule 67 EPC to refuse the European patent application despite the fact that claims had been filed as auxiliary request, on the basis of which the application could proceed to grant, as the Examining Division has expressly stated in its decision of refusal.

Order

For these reasons it is decided that:

The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:

N. Maslin

A. Nuss