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D E C I S I O N
of 1 March 2005

Case Number: T 0489/03 - 3.4.1

Application Number: 99973127.6

Publication Number: 1135699

IPC: G01T 1/161

Language of the proceedings: EN

Title of invention:

Minimally invasive surgical instrument for tissue
identification, dislodgment and retrieval

Applicant:

Carewise Medical Products Corporation

Opponent:

-

Headword:

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Relevant legal provisions:

EPC Art. 113(1)

EPC R. 67

Keyword:

"Reimbursement of the appeal fee in the event of interlocutory
revision (refused)"

Decisions cited:

G 0003/03, T 0870/94, T 0063/93

Catchword:

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Case Number: T 0489/03 - 3.4.1

D E C I S I O N
of the Technical Board of Appeal 3.4.1
of 1 March 2005

Appellant: Carewise Medical Products Corporation
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CA 95037 (US)

Representative: Symons Rupert Jonathan
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1 Hagley Road
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 23 May 2003
concerning European application No. 99973127.6,
granting interlocutory revision (Article 109(1)
EPC) and forwarding to the Board of Appeal the
request for reimbursement of the appeal fee.

Composition of the Board:

Chairman: G. Davies
Members: H. K. Wolfrum
M. G. L. Rognoni

Summary of Facts and Submissions

- I. The subject of the proceedings was the appellant's request for a refund of the appeal fee in connection with its appeal against the decision of the examining division, dated 4 February 2003, refusing European patent application 99 973 127.6 (publication No. 1 135 699) corresponding to published international application WO-A-00/33105.

- II. The refusal was based on the grounds of lack of novelty within the meaning of Articles 52(1) and 54(1) and (2) EPC of the subject-matter of claim 1 and of infringement of the requirements of Article 123(2) EPC by the subject-matter of a dependent claim then on file.

These grounds had been communicated to the applicant together with further objections in a first and only communication pursuant to Article 96(2) EPC dated 2 July 2002. In this communication the applicant had also been informed that the examining division considered a combination of claims 1 and 2 then on file to define patentable subject-matter.

In response to the communication the applicant had refuted the lack of novelty objection of the examining division and filed an amended set of claims. Although the wording of claim 1 had been amended, the subject-matter of the claim had remained in essence unchanged. Moreover, one of the dependent claims which had been objected to as defining added subject-matter had been maintained without amendment.

III. On 1 April 2003 the applicant filed a notice of appeal against the decision as well as a statement of grounds of appeal and paid the prescribed fee.

With the statement of grounds of appeal the appellant requested that the contested decision be cancelled and that the application be referred back to the examining division for interlocutory revision under Article 109 EPC on the basis of a new set of claims, claim 1 of which corresponded to the suggestion of the examining division. Moreover, refund of the appeal fee was requested in the event that interlocutory revision should be allowed. Finally, an auxiliary request for a hearing prior to any adverse decision was made.

IV. The requested interlocutory revision according to Article 109(1) EPC was granted by a rectification dated 25 May 2003 informing the appellant that the appeal had been rectified, the decision under appeal set aside and the proceedings continued. However, the appellant was also 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.

V. In a communication dated 15 October 2004 and annexed to a summons to oral proceedings the Board indicated that it did not consider any procedural violation to have occurred in the proceedings before the first instance and explained that thus an indispensable prerequisite for a refund of the appeal fee was not met.

VI. Oral proceedings were held on 1 March 2004 in the absence of the appellant, who informed the Board by

fax of 25 February 2005 that he would not attend the oral proceedings. The request of the appellant for reimbursement of the appeal fee was maintained and the Board requested to take a decision on the basis of the file.

- VII. Apart from regretting that he was not given another opportunity to consider the offer made by the examining division in its first and only communication, the appellant has not put forward any argument why the refund of the appeal fee would be justified.

Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. In the present case the examining division granted an interlocutory revision but did not allow reimbursement of the appeal fee. Thus it remitted the case to the board of appeal for a decision on the request for reimbursement of the appeal fee.

As regards the question of the composition of the board of appeal to decide such matter, the Enlarged Board found in decision G 3/03 (decision of 28 January 2005, to be published in the OJ) that the competent board of appeal is the board which would have been competent under Article 21 EPC to deal with the substantive issues of the appeal if no interlocutory revision had been granted. Since the present Board would have been competent to decide the substantive issues of the

present appeal it is thus also competent to decide on the appellant's request for reimbursement of the appeal fee.

3. According to Rule 67 EPC, first sentence, the reimbursement of appeal fees shall be ordered in the event of interlocutory revision or where the board of appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation.

Thus, a board of appeal cannot order reimbursement of an appeal fee unless two requirements are met:

- an interlocutory revision has been granted (or the board considers an appeal allowable), and
- the proceedings before the first instance suffer from a substantial procedural violation by which the reimbursement would appear equitable.

4. In the present case, only the first condition is met.

As a matter of fact, the appellant has not alleged any procedural violation and the Board has not found any procedural deficiency in the first instance proceedings either. In particular, no procedural violation is to be seen in the present case in the fact that the application was refused after a single communication since objections raised in that communication remained (see for instance T 870/94, not published in the OJ, point 4 of the Reasons) and claimed subject-matter was not substantially modified (see for instance T 63/93, not published in the OJ, point 1.1 of the Reasons).

Thus, the decision has solely been based on grounds on which the appellant had been given an opportunity to present its comments so that the appellant's right to be heard (Article 113(1) EPC) has not been breached.

5. Therefore, the request for reimbursement of the appeal fee is not allowable.

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. Davies