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**Datasheet for the decision
of 24 January 2011**

Case Number: T 1832/10 - 3.3.08

Application Number: 03712483.1

Publication Number: 1493820

IPC: C12Q 1/04

Language of the proceedings: EN

Title of invention:

Method of estimating elimination of microorganisms and
apparatus for estimating elimination of microorganisms

Patentee:

Sharp Kabushiki Kaisha

Headword:

Elimination of microorganisms/SHARP

Relevant legal provisions:

EPC Art. 109(1), 111(1)

Relevant legal provisions (EPC 1973):

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Keyword:

"Claims on file not commented upon by the examining division
either in a communication or in the decision under appeal -
Remittal (yes)"

Decisions cited:

T 0139/87, T 1705/07

Catchword:

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Case Number: T 1832/10 - 3.3.08

D E C I S I O N
of the Technical Board of Appeal 3.3.08
of 24 January 2011

Appellant: Sharp Kabushiki Kaisha
22-22 Nagaike-cho
Abeno-ku
Osaka-shi
Osaka-fu 545-0013 (JP)

Representative: Jacob, Reuben Ellis
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 26 May 2010
refusing European patent application
No. 03712483.1 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: M. Wieser
Members: T. J. H. Mennessier
R. Moufang

Summary of Facts and Submissions

- I. The applicant (appellant) lodged an appeal against the decision of the examining division dated 26 May 2010, whereby European patent application No. 03 712 483.1 with publication number 1 493 820 was refused. The application, entitled "*Method of estimating elimination of microorganisms and apparatus for estimating elimination of microorganisms*", originated from an international application published as WO 03/85126.

- II. After an exchange of communications and replies between the examining division and the appellant, on 6 July 2009, the examining division issued a summons to oral proceedings to take place on 8 December 2009. In a communication attached thereto, the preliminary opinion was expressed that the appellant should expect that the set of claims 1 to 11 filed with letter of 28 May 2008 would be refused for the presence of added matter (as regards claims 1 and 8), lack of clarity and conciseness (as regards claims 8, 9 and 11) and lack of novelty (as regards claim 8).

- III. In reply to the examining division's communication, the appellant filed a letter on 5 November 2009 which was accompanied by a new main request and an auxiliary request. In its submissions, the appellant explained as regards the main request which consisted of nine claims after deletion of previous claims 9 and 11 that the language of previous claims 1 and 8 had been amended in an attempt to overcome the pending objections.

- IV. Claims 1 and 8 of the main request, respectively, were directed to a method for evaluating elimination of microorganisms and an apparatus for evaluating elimination of microorganisms. The rest of claims were dependent claims directed to preferred embodiments of claim 1 (as regards claims 2 to 7) and claim 8 (as regards claim 9).
- V. As announced on 9 April 2010, the appellant did not attend the oral proceedings which had been postponed to take place on 16 April 2010. At the oral proceedings, the examination division decided to refuse the application.
- VI. On 26 May 2010, the examining division issued the written reasons for its decision to refuse the application which was based on the main request (claims 1 to 9) and the auxiliary request (claims 1 to 9) both filed on 5 November 2009. The main request was refused for reasons of lack of inventive step of the subject-matter of claim 8. The auxiliary request was not admitted into the proceedings pursuant to Rule 137(3) EPC.
- VII. On 3 August 2010, the appellant filed a notice of appeal together with a statement setting out the grounds of appeal. The statement was accompanied by a new set of claims which differed from the main request refused by the opposition division in that previous claims 8 and 9 had been deleted.
- VIII. The examining division did not rectify its decision and referred the appeal to the board of appeal (Article 109 EPC).

- IX. The submissions made in writing by the appellant may be summarised as follows:

The application was suitable to be accepted for grant as the claims filed with the statement of grounds corresponded exactly to those claims (1 to 7) of the main request which had not been objected to in the decision under appeal.

- X. The appellant requests that the decision of the examining division be set aside and a patent be granted on the basis of the request filed together with the statement of grounds of appeal on 3 August 2010. As an auxiliary measure, the appellant has requested that oral proceedings be held if it is contemplated to dismiss the appeal.

Reasons for the Decision

1. The set of claims on file corresponds exactly to method claims 1 to 7 of the main request on which the decision under appeal was based. Those claims were not commented upon by the examining division either in a communication or in the decision under appeal, the refusal being solely based on an objection of lack of inventive step raised against apparatus claim 8.
2. Notwithstanding the amendments contained in the claims and carried out by the appellant in an attempt to overcome the objections raised in the decision and the communication of 6 July 2009, the examination division did not make use of the possibility of granting

interlocutory revision pursuant to Article 109(1) EPC. However, according to the established case law (see in particular decision T 139/87, OJ EPO 1990, 68), an appeal by an applicant is to be considered well-founded within the meaning of Article 109(1) EPC if the main request includes amendments which clearly meet the objections on which the refusal of the application has been based.

3. In view of the fact that it is not normally the function of the appeal board to consider and decide upon claims which were filed during the prosecution of the examination but were neither commented nor decided upon by the examining division and in order to give the appellant an opportunity to have the issue decided upon by two instances, the board, exercising its discretion conferred by Article 111(1) EPC, regards it as appropriate to remit the case to the first instance.
4. Since a remittal does not amount to a dismissal of the appeal, the request that oral proceedings be held in case that a dismissal of the appeal is contemplated does not need to be considered.
5. The board is aware of decision T 1705/07 of 10 June 2010 (not published in the EPO Official Journal) taken by another board. In that decision claims which had been part of a set of claims on file before the first instance and which had been re-submitted as one of several auxiliary requests together with the statement of grounds of appeal, were not admitted by the board into the appeal proceedings. However, the situation in the case of decision T 1705/07 differs from the situation in the present case *inter alia* in that it was

an *inter partes* proceedings. The board considers it inappropriate to transfer and extend the holding of decision T 1705/07 to the present *ex parte* case and therefore the board sees no reason to further comment on it.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution on the basis of the claim request submitted on 3 August 2010.

The Registrar

The Chairman

C. Eickhoff

M. Wieser