

Publication in the Official Journal ~~Yes~~ / No

File Number: T 531/88 - 3.2.3  
Application No.: 84 850 026.0  
Publication No.: 0 150 694  
Title of invention: Heat recovery device

Classification: F28D 21/00, F28F 19/00, F23J 15/00

D E C I S I O N  
of 8 January 1991

Applicant: Weitman, Jacob

Proprietor of the patent:

Opponent:

Headword: Heat recovery/Weitman

EPC Articles 109(1), 111(1)

Keyword: "Claims substantially amended on appeal to meet grounds  
of refusal by Examining Division" - "remittal" -  
"interlocutory revision"

Headnote



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Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number : T 531/88 - 3.2.3

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.3  
of 8 January 1991

**Appellant :** Weitman, Jacob  
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S-61163 Nyköping (SE)

**Representative :** Wärulf, Olov  
Oxelösunds Patentbyrå HB  
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**Decision under appeal :** Decision of Examining Division 074 of the European Patent Office dated 20 July 1988 refusing European patent application No. 84 850 026.0 pursuant to Article 97(1) EPC

**Composition of the Board :**

**Chairman :** C.T. Wilson

**Members :** H. Andrä  
W. Moser

## Summary of Facts and Submissions

- I. European patent application No. 84 850 026.0 filed on 27 January 1984 and published under No. 0 150 694 was refused by decision of the Examining Division on 16 May 1988, dispatched in writing on 20 July 1988.
- II. In its decision, the Examining Division held that the subject-matter of the independent Claim 1 concerning a heat recovery device did not involve an inventive step in the sense of Article 56 EPC having regard to the documents cited in the search report.
- III. The Appellant filed an appeal against this decision on 15 September 1988, submitting a Statement of Grounds of Appeal on the same day and paying the fee for appeal on 14 September 1988.

In the Statement of Grounds of Appeal the Appellant:

- (i) requested that a European patent be granted on the basis of new Claims 1 to 6 drawn up in the category "method" as contained in the statement and
- (ii) asked for a new communication with the possibility of another amendment of the claims should the Examining Division not agree to the new set of claims.

## Reasons for the Decision

1. The appeal is admissible.
2. In the Statement of Grounds of Appeal the Appellant has given supporting arguments intended to meet the present objections of the Examining Division.

In consideration of the fact that the new set of claims directed to a different category (i.e. method claims) constitutes an amendment which renders the only objection on which the refusal of the application is based completely irrelevant, the Board is of the opinion that the first instance could have rectified its decision within the meaning of Article 109(1) EPC (cf. T 139/87; OJ EPO 1990, 68).

The Board considers that in the present case the amendments filed by the Appellant, taking account of the change of category of the claims and of additional features incorporated in the claims, are substantial amendments within the meaning of T 63/86 (OJ EPO 1988, 224), which require a substantial further examination in relation to the requirements of the EPC.

3. In the above-cited decision T 63/86, it was set out in paragraph 2:

"Once an admissible appeal has been filed, the Board of Appeal has responsibility for the case in place of the Examining Division, and "can exercise any power within the competence of the department which was responsible for the decision appealed" (Article 111(1) EPC). Nevertheless, in a case such as the present, where substantial amendments to the claims have been submitted with the grounds of appeal, in the Board's view there are good reasons why the Board should not, at this stage, exercise the discretionary power under Rule 86(3) EPC in relation to such proposed amendments. The wording of the whole of Rule 86(3) EPC points specifically to the Examining Division. In cases of minor amendments filed during the appeal, it may be appropriate for a Board of Appeal to exercise the discretion of the Examining Division under Rule 86(3) EPC. However, in a case such as the present, where substantial amendments

have been proposed which require a substantial further examination in relation to both the formal and substantive requirements of the EPC, such further examination should be carried out, if at all, by the Examining Division as the first instance, only after the Examining Division has itself exercised its discretion under Rule 86(3) EPC."

4. In these circumstances, the Board considers it appropriate, in accordance with the Decision T 63/86, to exercise its power under Article 111(1) EPC to remit the case to the Examining Division, in order that it should examine and decide:
  - (i) whether the further amendments to the claims, filed with the Notice of Appeal on 15 September 1988, can be made under Rule 86(3) EPC; and,
  - (ii) provided such amendments can be made, whether such claims are allowable under the further provisions of the EPC.

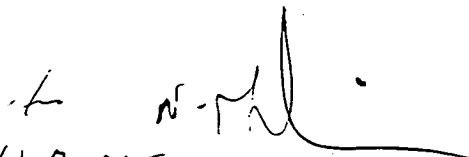
#### Order

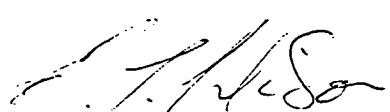
For these reasons, it is decided that:

1. The contested Decision is set aside.
2. The case is remitted to the Examining Division for further prosecution.

The Registrar:

The Chairman:

  
N. Maslin

  
C.T. Wilson