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D E C I S I O N
of 17 February 1997

Case Number: T 0370/96 - 3.2.3

Application Number: 91913443.7

Publication Number: 0540601

IPC: E21D 20/00, E21D 21/00

Language of the proceedings: EN

Title of invention:
Rock bolt system and method of rock bolting

Applicant:
COMMONWEALTH SCIENTIFIC AND INDUSTRIAL RESEARCH ORGANISATION

Opponent:
-

Headword:
Rock Bolt System

Relevant legal provisions:
EPC Art. 54, 111(1), 113(1)
EPC R. 67

Keyword:
"Novelty (yes)"
"Decision re appeals - remittal (yes)"
"Reimbursement of the appeal fee (no)"

Decisions cited:
-

Catchword:
-



Case Number: T 0370/96 - 3.2.3

D E C I S I O N
of the Technical Board of Appeal 3.2.3
of 17 February 1997

Appellant: COMMONWEALTH SCIENTIFIC AND INDUSTRIAL
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 7 February 1996
refusing European patent application
No. 91 913 443.7 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: C. T. Wilson
Members: J. B. F. Kollar
L. C. Mancini

Summary of Facts and Submissions

- I. European patent application No. 91 913 443.7 (international publication number WO-A-92/01859) was filed on 16 July 1991 claiming a priority date of 17 July 1990.
- II. On 8 July 1994, the Examining Division issued a communication in which it was indicated that the subject-matter of independent apparatus claim 1 as well as of independent method claim 4 filed with letter of 13 January 1993 appeared to lack novelty with respect to AU-B-576 157 (D1) and that the subject-matter of independent apparatus claim 2 as well as of dependent claims 3 and 5 to 8 filed with said letter appeared to lack inventive step.
- III. With letter dated 22 December 1994 the applicant (now appellant) filed new claims 1 to 8. The wording of claim 1 was the same as of the one filed with the letter of 13 January 1993 except that the feature "through the fluid inlet the expansible tube can be pressurised to permanently expand radially" was omitted.

The appellant pointed out that although the parts of the subject-matter of claim 1 were known individually, the combination was novel and inventive.

- IV. On 26 May 1995, the Examining Division issued a second communication which indicated that the subject-matter of claim 1 filed with the letter of 22 December 1994 appeared not to be allowable for lack of novelty in view of the disclosure of D1. Furthermore, it was indicated that claim 1 infringed Article 123(2) EPC by omitting the feature mentioned above under point III.

In addition, by virtue of the statement on the cover sheet of the Communication of 26 May 1995 the appellant was made aware that failure to rectify the indicated deficiencies may lead to a refusal of the application pursuant to Article 97(1) EPC.

- V. With letter of 3 July 1995 the appellant submitted a new set of claims (claim 1 to claim 6 (partly)), of which claim 1 was identical with claim 1 filed with the letter of 13 January 1993 and regarded as being not allowable because of lack of novelty (Articles 52 and 54 EPC) in view the disclosure of D1 as explained in the first Communication dated 8 July 1994.
- VI. On 7 February 1996, the Examining Division issued a Decision refusing the application. The reason given for the refusal was that the subject-matter of claim 1 lacked novelty having regard to the disclosure of D1 as set out in the communications of 8 July 1994 and 26 May 1995.
- VII. The appellant appealed against the decision on 4 April 1996 submitting a statement of grounds together with a new set of Claims 1 to 8 and duly paying the appeal fee on the same day.

Independent claim 1 reads as follows:

"A rock bolt system comprising an inner part (1) disposed within an outer part (10), said inner part comprising a fluid expansible elongated tube (1) having an internal closed ended fluid receiving chamber having a fluid inlet through which the expansible tube (1) can be pressurised to expand radially, said outer part comprising an elongated tube (10) having a longitudinal slot (12), said slot (12) extending at least part way

along the length of said tube (10) of said outer part characterised in that the inner tube (1) expands permanently in use and remains within the outer tube (10)."

The appellant argues essentially that the subject-matter of claim 1 differs from the disclosure of D1 by the specification that the "expansible tube can be pressurised to permanently expand radially" and with emphasis on the feature "permanently", which cannot be found in D1, stresses that the subject-matter of claim 1 is novel in the sense of Article 54 EPC. By implication he requests that the decision of 7 February 1996 be set aside and a patent be granted on the basis of the new claims 1 to 8 or alternatively on the basis of an alternative Claim 1 also filed with the grounds of appeal.

VIII. The appellant stresses that the contested decision to refuse the application was taken prematurely in that he would have expected a telephone call from the Examiner in response to the last line of his letter of 3 July 1995 "We would appreciate hearing from the Examiner in due course". Consequently he requests a refund of the appeal fee.

Reasons for the Decision

1. The appeal is admissible.
2. *Novelty in relation to document D1*
 - 2.1 In points 2 to 4 of its decision, the Examining Division found that the subject-matter claimed by the independent claim 1 was lacking in novelty having regard to the disclosure of document D1.

2.2 Document D1 relates to a method of stabilizing a rock structure and teaches in the paragraph bridging pages 2 and 3 that "mounting tool 14 is first inserted in the stabilizer 11...Then, the valve 21 is actuated to pressurize the elastic tube 15 to expand so that the tube forces the stabilizer 11 against the borehole...Further, the stabilizer 11 is plastically deformed to adjust to...the borehole...Then, the elastic tube 15 of the mounting tool 14 is depressurized and the mounting tool 14 is removed, leaving the stabilizer 11 anchored in the borehole..."

2.3 The Board is in agreement with the appellant in that the subject-matter of Claim 1 differs from D1 by the characterising feature that "the inner (expandable) tube expands permanently in use and remains within the outer tube" and finds with emphasis on the essential feature "permanently" that said feature is not to be found in D1 according to which, as mentioned in point 2.2 above, contrary to the present claim, the tube is temporarily expanded and then deflated and removed.

As said feature of claim 1 is not disclosed in document D1 the Board is satisfied that this the subject-matter of Claim 1 is novel over D1 for the purposes of Article 54 EPC.

3. Consequently the objection to patentability raised by the Examining Division has been met and the decision must be set aside.

In order not to deprive the appellant of his right to have any findings reviewed the Board considers it appropriate to remit the case to the Examining Division under Article 111(1) EPC for further prosecution on the basis of the amended claims filed with the Board of Appeal.

4. *Request for refund of the appeal fee - Rule 67 EPC*

4.1 The ground for rejection in the present case being lack of novelty in the subject-matter of the main claim it is to be noted that this objection was raised and amply argued by the primary examiner in the first and second Communication of 8 July 1994 and 26 May 1995, respectively. The appellant commented thereon in his letters of 22 December 1994 and 3 July 1995. The Examining Division not being convinced by the appellant's arguments thereupon issued the decision under appeal.

4.2 The appellant requests that the appeal fee be reimbursed in accordance with Rule 67 EPC. He maintains that the decision to refuse the application was taken prematurely in that he would have expected a telephone call from the Examiner in response to the last line of his letter of 3 July 1995 reading "We would appreciate hearing from the Examiner in due course".

4.3 It is well established in the jurisprudence of the Boards that the appointment of an interview or of a telephone conversation as opposed to that of an oral proceedings under Article 116 at the request of one or more parties, is a discretionary matter for the examiner concerned. The Board does not regard the failure to arrange a telephone conversation in the present case as a procedural violation since Article 113(1) EPC does not require that the parties concerned (in this case the appellant) be given a repeated opportunity to comment on the argumentation of the Examining Division so long as the decisive objections against the grant of the European patent remain, as in the present case, the same.

- 4.2 In the circumstances of the present case, therefore, the Board considers that there was no contravention of Article 113(1) EPC and that no substantial procedural violation within the meaning of Rule 67 EPC had occurred which would have justified the requested refund of the appeal fee.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The matter is referred back to the Examining Division for further prosecution as indicated in point 3 above.
3. The appellant's request for refund of the appeal fee is dismissed.

The Registrar:



N. Maslin

The Chairman:



C. T. Wilson