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Bezeichnung der Erfindung: Programmable medical device
Title of invention: Programmable cardiac pacemaker
Titre de l'invention : Heart pacemaker with separate A-V intervals for
atrial synchronous and atrial-ventricular sequential pacing modes
Klassifikation / Classification / Classement : H61N 1/36

ENTSCHEIDUNG / DECISION

vom / of / du 16 November 1990

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet : Medtronic Inc.

Einsprechender / Opponent / Opposant : Biotronic Meß- und
Therapiegeräte GmbH & Co.

Stichwort / Headword / Référence : Administrative Agreement/MEDTRONIC
Articles 4,5,6,7,10,33,99(1),112; Administrative Agreement between
EPO / EPC / CBE the President of the EPO and the President of the German Patent
Office dated 29 June 1981; Decision of the President dated 10 May 1989
Schlagwort / Keyword / Mot clé : "Treatment of documents intended for the EPO
and received by the German Patent Office in
Berlin" - "Functions and powers of the President" -
"Principle of good faith" -
"Protection of the legitimate expectations of
users of the EPO"

Leitsatz / Headnote / Sommaire

I. The capacity of the President of the European Patent Office to represent the European Patent Organisation by virtue of Article 5(3) EPC is one of his functions but is not one of his powers. The extent of the President's power is governed by the EPC, but not by Article 5(3) EPC.

II. To the extent that the Administrative Agreement dated 29 June 1981 between the President of the EPO and the President of the German Patent Office contains terms regulating the treatment of documents intended for the EPO and received by the German Patent Office in Berlin, the President of the EPO did not himself have the power to enter into such an agreement on behalf of the EPO, at any time before the opening of the Filing Office for the EPO in Berlin on 1 July 1989.

.../...

III. In application of the principle of good faith and the protection of the legitimate expectations of users of the EPO, if a person has at any time, since publication of the Agreement in the Official Journal and before 1 July 1989, filed documents intended for the EPO at the German Patent Office in Berlin (otherwise than by hand), the EPO was then bound to treat such documents as if it had received them on the date of receipt at the German Patent Office in Berlin.

Summary of Facts and Submissions

I. In case T 117/87 (OJ EPO 1989, 127), Board of Appeal 3.4.1 in its Decision dated 6 July 1988 of its own motion referred three questions of law to the Enlarged Board of Appeal under Article 112(1)(a) EPC:

- (i) If the President of the EPO makes an agreement with an outside organisation (here: the German Patent Office), has he the power to include in such an agreement a term which requires the EPO in certain circumstances to treat a document which was filed at the EPO outside a time limit set by the EPC as if it had been filed within such time limit?
- (ii) If the making of an agreement which includes such a term is not within the power of the President of the EPO, what is the legal effect of such a term in such an agreement, having regard to the fact that the agreement was published in the Official Journal in order that parties to proceedings before the EPO should be informed of and rely upon its contents?
- (iii) In the present case, are time limit and place for filing the notice of opposition at the EPO governed by Article 99(1) EPC alone, or by Article 99(1) EPC in combination with Article 1, paragraph 3 of the Administrative Agreement dated 29 June 1981?

II. The questions were raised in the context of an appeal in opposition proceedings, and concern the admissibility of the opposition. The notice of opposition to a European patent together with the opposition fee was delivered to the German Patent Office in Berlin on the last day of the

nine-month period for filing an opposition prescribed by Article 99(1) EPC. The notice of opposition and the fee were transmitted to the EPO in Munich, where they were received five days after the expiry of the nine-month period.

The notice of opposition was communicated to the patent proprietor pursuant to Rule 57(1) EPC, who immediately challenged the admissibility of the opposition. The application of the "Administration Agreement dated 29 June 1981 between the German Patent Office and the European Patent Office concerning procedure on receipt of documents and payments" (OJ EPO 1981, 381) (hereafter "the Agreement") to the notice of opposition and opposition fee in the case was questioned. In particular, it was suggested that the notice of opposition had presumably been delivered by hand to the German Patent Office, and that the Agreement should not be interpreted as covering such delivery. In reply, the Formalities Officer of the Opposition Division issued a letter dated 28 January 1986 stating that he did not accept that the opposition was inadmissible under Rule 56(1) EPC on the ground that it was filed outside the nine-month opposition period, because the Agreement "covers all documents which are intended for the EPO but which are sent to the post room of the German Patent Office in Munich or Berlin The mechanism is to accept documents received at the post room of the German Patent Office as being filed at the post room of the European Patent Office and vice versa From the practical point of view it is rather difficult to distinguish between filings made by error or intention. "Intended for the EPO" (German: "gerichtet", French: "destiné") refers to the final destination of the letter. The Agreement allows filings in either post room to be accorded a date of receipt Whether or not the document was filed by hand does not, at the stage of the proceedings now reached, affect the stated opinion."

In due course, the Opposition Division issued a substantive Decision which rejected the opposition, in which the opposition was held to be admissible for the reasons set out by the Formalities Officer and summarised above.

- III. In two further cases, T 149/87 and T 96/88, Board of Appeal 3.4.1 has issued Decisions both dated 21 July 1988 of its own motion, in which the same three questions have been referred to the Enlarged Board of Appeal under Article 112(1)(a) EPC. Each of these two cases are opposition proceedings between the same two parties as in case T 117/87, and the facts of these two cases are essentially similar.

In a letter to both parties dated 17 November 1988, the Registrar of the Enlarged Board informed the parties that under Article 8 of its Rules of Procedure, the Enlarged Board had decided to consider the three referred questions of law in consolidated proceedings. Thus, any observations from either party in case G 5/88 before the Enlarged Board would be treated as filed within the consolidated proceedings.

- IV. Following the issue of the Decision of the Board of Appeal dated 6 July 1988, the parties were invited in case G 5/88 to file observations on the referred questions, but neither did so. Subsequently, under Article 11(a) of its Rules of Procedure (OJ EPO 1989, 363), the Enlarged Board decided to invite the President of the EPO to comment in writing upon the referred questions and to provide it with information in response to the following questions:

- (1) Prior to the entry into force on 1 July 1989 of the President's Decision dated 10 May 1989 setting up a filing office in the Berlin sub-office of the EPO (OJ EPO 1989, 218), and therefore at the date of the

Administrative Agreement dated 29 June 1981 (OJ EPO 1981, 381), it was not permissible to file any documents intended for the EPO at the sub-office of the EPO in Berlin, although it was possible to file European patent applications at the German Patent Office in Berlin under Article 75(1)(b) EPC. Thus, for documents other than European patent applications which were intended for the EPO, there appears to have been no reason for these to be sent either to the EPO or to the German Patent Office in Berlin at all.

In this context, therefore, what was the background to and reason for those provisions of the Administrative Agreement which concern the receipt of documents which were intended for the EPO in Berlin?

- (2) Did the Administrative Council authorise the President to negotiate the Administrative Agreement, or give its approval to the President to conclude that Agreement, pursuant to Article 33(4) EPC? If so, please provide relevant details. If not, under what power does the President consider that the Administrative Agreement was made?
- (3) Although the President's Decision dated 10 May 1989 can clearly have no direct relevance to the issues raised by the referred questions insofar as they relate to prior events, nevertheless, the Enlarged Board may wish to consider the present legal situation: in this context, therefore, what was the background to and reason for the issuing of the President's Decision dated 10 May 1989? Does that Decision have any relevance to the current legal status of the Administrative Agreement dated 29 June 1981?

V. In reply, the President commented substantially as follows, with reference to the numbered paragraphs:

- (1) The Agreement was based on experience that confusion could arise between the German Patent Office and the European Patent Office in Munich due to their geographical proximity and similar function, particularly as regards the delivery of mail by post. Documents intended for one office were often delivered by mistake to the other, which could cause severe legal consequences and loss of rights.

Both patent offices, the EPO and the German Patent Office, felt it necessary to come to an agreement providing for the necessary mechanisms to avoid loss of rights in cases of erroneously delivered mail.

Originally, Berlin was not included at all in the draft agreement, since it was not permitted to file any documents intended for the EPO at the sub-office of the EPO in Berlin.

The inclusion of Berlin first appeared in a draft prepared by the German authorities at a late stage of the discussions. It is supposed that the main reason may have been the political one to have the Berlin branch of the German Patent Office mentioned in an agreement concluded by that Office.

At that time, cases pending before the EPO in Munich had become quite urgent. A further delay seemed not to be acceptable. The EPO considered that the inclusion of Berlin was a matter which concerned the German Patent Office only and, therefore, concluded the agreement on the basis of the draft revised by the German authorities.

- (2) The President did not ask for the authorisation by the Administrative Council to negotiate and conclude the agreement.
- (a) Article 5(3) EPC provides that the President of the European Patent Office shall represent the Organisation, and gives the President a comprehensive power of representation vis-à-vis third parties, be it private or public ones, persons or institutions. The comprehensive power of representation provided in Article 5(3) EPC does not only cover the cases where the President directly acts for the European Patent Organisation (hereafter "the Organisation") as such but also where he acts for the Office vis-à-vis third parties pursuant to Article 10(1) EPC. The preparatory documents for the EPC (see Minutes of the 4th Meeting of the Intergovernmental conference, Doc. BR/125/71; Nos. 97, 100, 102) were relied upon in support.
- (b) The President was also entitled to conclude the Agreement with the German Patent Office without having to ask for prior authorisation and approval by the Administrative Council pursuant to Article 33(4) EPC, for the following reasons:

Article 4(3) EPC confers on the EPO the task of the Organisation to grant European patents.

Pursuant to Articles 10(1) and (2)(a) EPC, the EPO shall be directed by the President who shall, in particular, have the power to take all necessary steps to ensure the functioning of the EPO. An agreement ruling a particular aspect of

the filing of documents for the start and processing of European patent applications is essentially directed to a measure ensuring the functioning of the EPO within its task of granting patents.

Article 10(2)(a) EPC explicitly gives the President the power to take all necessary steps. It can clearly be derived from the preparatory documents that this also covers the power to conclude agreements.

When concluding the Agreement with the German Patent Office, the President acted pursuant to Article 10(2)(a) EPC for the EPO, and not directly for the Organisation.

The President's power to conclude an agreement without prior authorisation or approval of the Administrative Council depends on the nature of the undertakings provided in that agreement. Moreover, as the President does not have a general legislative power, he would certainly not be entitled to deviate from the provisions of the EPC by way of agreements.

- (c) In this respect, it is important to note that the Agreement does not provide for an extension of time limits in the EPO, nor does it define the legal requirements under which a document has to be considered as filed in time.

The exact and also limited meaning of the Agreement becomes more clear if one looks at the German wording, which is the language in which the Agreement was concluded. Article 1, paragraph 3 of the Agreement only provides that

documents having been delivered at the German Patent Office shall be treated as if they were directly "eingegangen". However, for the legal evaluation whether or not a time limit has been met, it is relevant under what conditions and when the requirement of the application to have been "zugegangen" (received within the legal meaning of the term) is fulfilled. The English translation of the Agreement does not reflect that difference as it uniformly uses the term "received". The Agreement does not change anything in the definition of when a document has to be regarded as being received within the legal meaning of the term, and, therefore, does not provide for a change in the interpretation of the EPC or of the time limits set up by the EPC.

Although it is true that the date of actual receipt ("Eingang") of a document is in general a very important factor to determine at what time the document has been received within the legal meaning of the term ("Zugang"), this does not change the fact that a fiction as contained in the Agreement does not change the interpretation of the law, but only creates a certain factual basis for this interpretation.

- (d) It was the purpose of the Agreement only to remedy those cases where a document was directed to the EPO and erroneously delivered to the German Patent Office. It was not designed for those cases where a document intended for the EPO had been deliberately filed with the German Patent Office. The EPO has never encouraged parties to file documents with the German Patent Office.

It has to be admitted that in the past the EPO applied the Agreement liberally in order to avoid a loss of rights for the applicant. The German Patent Office did not make any difference between wrong deliveries and intentional sending of documents to the wrong Office. In this situation, the EPO preferred a broad interpretation of the Agreement in order to avoid any loss of rights for formal reasons.

- (3) One reason for the decision to set up a filing office in the Berlin sub-office was to provide applicants and representatives in northern regions of the Contracting States with a geographically convenient filing office. Another aim was to abolish the discrepancy caused by the fact that the Berlin sub-office is very well known as a sub-office of the EPO but that applications and subsequent documents could not be filed there. When such documents were erroneously filed at the Berlin office of the EPO, this could lead to loss of rights. It has also led to legal uncertainty in cases where documents were intended for the EPO but filed with the German Patent Office in Berlin, in particular if the branch of the German Patent Office in Berlin transmitted those documents to the Berlin EPO office and not to Munich.

The decision to set up a filing office at the Berlin sub-office was based on the consideration that pursuant to Section I(3)(a), second sentence of the Protocol on Centralisation, the Berlin sub-office operates under the direction of the branch at The Hague. Article 75(1)(a) EPC must not be interpreted in a geographical way so as to fix the geographical places Munich and The Hague as places where applications could exclusively be filed. On the

contrary, the provision is to be interpreted functionally, attributing to the Hague branch (which is actually located in Rijswijk) as well as to the Munich Headquarters, the function of receiving applications, although only the Hague branch is concerned with the processing of applications in their initial stage. Pursuant to Article 75(1)(a) EPC, the power to receive European patent applications can, therefore, be given to an office unit which forms a legally integrated part of the branch at The Hague, even if it is not geographically located there.

- VI. (i) The Appellant filed observations in response to the President's comments, in which he contended in particular that such comments made it clear that the Agreement is properly founded. If the Enlarged Board took an opposite view in relation to the President's authority to make the Agreement, there has been no publication of the possibility that the Agreement lacked proper authority. In accordance with the general legal principle of "legitimate expectations", users of the EPO should be entitled to rely on the Agreement, especially as this Agreement was intended to increase legal certainty and to simplify procedure for such users.
- (ii) The Respondent also filed observations in response to such comments, in which he referred in particular to the provisions of Articles 4, 5 and 7 EPC, and also submitted that the EPC lays down the procedures and time limits for filing documents, and that it is clear that "all documents must be received in the EPO before the expiry of the appropriate time limit" (subject to the exception for filing applications in Article 75(1) EPC).

While the Agreement appeared to modify this, and while the effect of the Agreement was not clear, it cannot be interpreted as allowing the deliberate filing of any document intended for the EPO at a branch of the German Patent Office (Munich or Berlin) because this would extend the provisions for receipt of documents far beyond Articles 4, 5, 7 and 75 EPC.

The Appellant had never suggested that their notices of opposition were filed in error at the German Patent Office in Berlin.

The Decision of the President dated 10 May 1989, setting up a filing office in the Berlin sub-office of the EPO, clearly indicates that before the date of that Decision, such sub-office was not a filing office, and, in particular, could not receive notices of opposition.

In response to the Appellant's observations, the Respondent contended that the Agreement clearly was only intended to protect misdirected documents, and that the correct offices for filing documents at the EPO, namely Munich and The Hague, were well known. Similarly, the function of the Berlin sub-office only as a searching office before 10 May 1989 was well known. It was, therefore, difficult to see that the Agreement could have been honestly interpreted as allowing documents intended for the EPO, such as a notice of opposition, to be filed as a matter of course either at the EPO sub-office or at the German Patent Office in Berlin.

Reasons for the Decision

1. Background

1.1 The filing of documents in proceedings before the EPO

The filing of a European patent application is dealt with specifically in the EPC, in Article 75 EPC. Such an application may be filed either at the EPO, at Munich or The Hague, or at national industrial property offices or other competent authorities of Contracting States, under national laws which so provide.

The filing of documents other than European patent applications is not dealt with in a specific Article of the EPC. Thus, in particular, a notice of opposition is a notice to the EPO which must be filed in a written statement (Article 99 EPC). As to what constitutes the EPO, Article 6(2) EPC prescribes that "The EPO shall be set up at Munich. It shall have a branch at The Hague". A Notice from the President of the EPO dated 5 December 1979 concerning the establishment of filing offices at the EPO in Munich and The Hague was publicised in the Official Journal at an early stage (OJ EPO 1980, 2).

Article 7 EPC provides for the creation of sub-offices of the EPO which may be created by decision of the Administrative Council. In fact, on the same day as the EPO opened for the receipt of European patent applications (1 June 1978), a sub-office was set up in Berlin, as part of the branch at The Hague, and operating under the direction of The Hague. The Berlin sub-office was provided for in Section I(3) of the Protocol on Centralisation, which is an integral part of the EPC under Article 164(1) EPC. The establishment of the Berlin sub-office was announced in the Official Journal (OJ EPO 1978, 248).

During the initial years of operation of the EPO, the Berlin sub-office was only responsible for carrying out searches. Documents intended for the EPO as part of proceedings before it could not be filed at the Berlin sub-office. However, on 10 May 1989, the President of the EPO made a Decision on the setting up of a Filing Office in the Berlin sub-office (OJ EPO 1989, 218), which came into force on 1 July 1989. According to Article 1 of this Decision, the Berlin sub-office is authorised to receive all documents and fees intended for and due to the EPO.

1.2 The functions and powers of the President of the EPO

Article 5 EPC provides that the President of the EPO shall represent the European Patent Organisation. The EPO is an organ of the Organisation (Article 4(2)(a) EPC), whose task is to grant European patents, under the supervision of the Administrative Council (Article 4(3) EPC).

Article 10(1) EPC provides that the EPO shall be directed by the President, who shall be responsible for its activities to the Administrative Council, which is also an organ of the Organisation by virtue of Article 4(2)(b) EPC.

Furthermore, Article 10(2) EPC provides that for the purpose of directing the EPO, the President has, in particular, a number of functions and powers set out in sub-paragraphs 10(2)(a) to (i) EPC. Thus, in particular, under Article 10(2)(a) EPC "he shall take all necessary steps, including the adoption of internal administrative instructions and the publication of guidance for the public, to ensure the functioning of the EPO". Sub-paragraphs 10(2)(b) to (i) specify functions and powers which are essentially concerned with the internal operations of the EPO.

Under Article 33(4) EPC "The Administrative Council shall be competent to authorise the President of the EPO to negotiate and, with its approval, to conclude agreements on behalf of the European Patent Organisation with States, with intergovernmental organisations and with documentation centres set up by virtue of agreements with such organisations".

1.3 The Administrative Agreement dated 29 June 1981

- (a) This Agreement was made directly between the President of the EPO and the President of the German Patent Office.

Article 1 of the Agreement is concerned with documents which are intended for the EPO but which are received by the German Patent Office, either in Munich or in Berlin. Article 2 is concerned with documents which are intended for the German Patent Office but which are received by the EPO in Munich. Article 2 does not correspond to Article 1 in that it contains no reference to Berlin.

For the purpose of the present case, the following paragraphs of Article 1 are particularly relevant:

1. "The filing offices of the German Patent Office in Munich and Berlin shall forward directly to the nearest EPO establishment any documents they receive which are intended for the EPO."
2. "The date of receipt shall be recorded on the documents in the customary German Patent Office manner ...".

3. "The EPO shall treat the documents as if it had received them directly ...".

4. "Documents intended for the EPO and brought by hand to a filing office of the German Patent Office shall not be accepted."

(b) In relation to paragraph 4, the German Patent Office has a letterbox at its entrance. Thus, while it would be possible for the German Patent Office to refuse to accept documents which were marked as intended for the EPO and delivered by hand to a filing counter there, it would clearly be impossible for the German Patent Office to know whether documents which were marked as intended for the EPO and which were simply placed in the letterbox had been delivered there in error, and it would also be impractical to attempt to distinguish those that had been delivered by hand from those that had been delivered there through the post. Furthermore, when (as in the present case) the German Patent Office has accepted documents delivered to it but intended for the EPO, and has forwarded such documents on to the EPO, it is clearly, in practice, impossible for the EPO to question or otherwise investigate the means of delivery of such documents to the German Patent Office. Thus, the view of the Formalities Officer as expressed in the letter dated 28 January 1986 and quoted in paragraph II above is readily understandable ("The Agreement allows filings in either post room to be accorded a date of receipt Whether or not the document was filed by hand does not, at the stage of the proceedings now reached, affect the stated opinion."

2. Question (i)

2.1 The main point of the referred question is whether the President had the power to enter into the Agreement on behalf of the EPO, especially having regard to the inclusion of Article 1, paragraph 3 of the Agreement. However, in the light of the President's comments in response to the questions put to him by the Enlarged Board, the Enlarged Board considers it necessary to consider the validity of the Agreement from a broader viewpoint than that specifically set out in the referred question (i).

2.2 The President has suggested that his power to make the Agreement should be derived from Article 5(3) EPC, especially having regard to certain specified preparatory documents leading to the EPC.

In the Enlarged Board's judgement, however, Article 5(3) EPC is solely concerned with providing the President with a capacity to represent the European Patent Organisation, which is a different concept from that of his power. His capacity to represent the Organisation by virtue of Article 5(3) EPC is one of his functions but is not one of his powers.

The President may only represent the Organisation by performing an act such as the signing of an agreement, provided he has the power to perform that act. The extent of the President's power is governed by the EPC, but by provisions other than Article 5(3) EPC.

The President's suggestion that certain of the preparatory documents support his view that Article 5(3) EPC provides him with broad power to act without authorisation and approval from the Administrative Council is based upon a misinterpretation of these documents (especially a misinterpretation of the phrase "power of representation", which is used in these documents, and which is somewhat misleading).

2.3 The power of the President himself to act in directing the EPO is derived from and governed by Article 10 EPC.

Article 10(1) EPC contains a broad statement that the EPO "shall be directed by the President who shall be responsible for its activities to the Administrative Council", but this must be interpreted in its context, and in particular having regard to Article 10(2) EPC, as well as Article 4(3) EPC.

Article 10(2) EPC contains a list of his particular functions and powers, which, as noted in paragraph 1.2 above, are essentially concerned with internal matters of the EPO. The extent to which, under Article 10 EPC the President can lawfully "direct the EPO" concerning any external activity without the supervision of the Administrative Council in accordance with Article 4(3) EPC, insofar as such external activity is not directly related to the President's particular functions and powers listed in Article 10(2) EPC, is not specifically defined by the EPC, and is a matter of interpretation. In the view of the Enlarged Board, the preparatory documents relied upon by the President are inconclusive in this connection. Having regard to what is set out below, it is not necessary for the Enlarged Board to consider this point of interpretation of the EPC further in this Decision, however.

2.4 So far as the Agreement in this case is concerned, the President has accepted, in response to question (2) put to him by the Enlarged Board (see paragraph IV above), that no prior authorisation and approval was given to him by the Administrative Council pursuant to Article 33(4) EPC. Nor has it been suggested by the President that the Agreement was made under the supervision of the Administrative Council. Thus, in connection with the referred question, the only matter to be considered is whether (as the President has further suggested) he could lawfully enter into the Agreement by exercising his functions and powers to direct the EPO under Article 10(1) and 10(2)(a) EPC: that is, in order "to ensure the functioning of the EPO". This depends upon the nature and contents of the Agreement.

2.5 The text of the Agreement makes it clear that its primary object and purpose is to provide a mechanism whereby documents which are sent to the EPO, but which are delivered by error to the German Patent Office (and vice-versa), should be marked with the date of receipt at the wrong office and treated accordingly by the office for which they are intended. The Agreement clearly distinguishes documents which are brought by hand to either office as not being within the scope of the Agreement.

The above object of the Agreement is confirmed by the President in his comments to the Enlarged Board.

Clearly such errors in the delivery of documents by post could easily occur at Munich, having regard to the close proximity of the EPO and the German Patent Office there.

However, as pointed out in paragraph 1 above, at all times prior to 1 July 1989 the Berlin sub-office of the EPO was not authorised to receive documents intended for filing at the EPO. When the EPO first opened, the limited function of the Berlin sub-office was well publicised. Thus, so far as documents intended for the EPO were concerned, there could have been no reason for these to be sent to Berlin at all. This was pointed out to the President by the Enlarged Board (see paragraph IV, question (1) above), and was accepted by the President in his comments in reply (paragraph V above). It has never been suggested that one of the problems underlying the making of the Agreement was caused by documents intended for filing at the EPO being sent to Berlin in ignorance of the fact that prior to 1 July 1989 the EPO had no filing office in Berlin.

The President has explained that the inclusion of Berlin in the Agreement was first proposed by the German Patent Office, primarily, it is supposed, for political purposes.

- 2.6 Article 10(2)(a) EPC empowers and requires the President to "take all necessary steps ... to ensure the functioning of the EPO". The extent of the power thus given to him is not capable of exact definition, nor is it necessary to attempt this for the purposes of this Decision. The question to be considered in each case is how far a particular step is necessary for ensuring the functioning of the EPO.

So far as the Agreement is concerned with the problem of incorrect delivery of documents at Munich (at the EPO and the German Patent Office premises there), in the view of the Enlarged Board it could reasonably be concluded that the making of the Agreement with the German Patent Office

was a necessary step for the President to take in order to avoid unjustified loss of rights to parties, and thus to ensure the proper functioning of the EPO.

In the present case, however, the validity of the Agreement insofar as it contains provisions concerning the delivery of documents in Munich is not in issue.

2.7 The only purpose for including Berlin in the Agreement which has been put forward by the President was not connected with the functional needs of the EPO, but with the political interests of the German authorities. In the Enlarged Board's view, whatever may be the exact extent of the President's functions and powers under Article 10(2)(a) EPC in order "to ensure the functioning of the EPO", they do not include the making of an agreement with an organisation such as the German Patent Office, insofar as certain provisions of such agreement have no connection with the functioning of the EPO, but are included only in order to satisfy the political interest of such other party. In the Board's view, this is the case even when (as has been suggested by the President in the present case) the conclusion of an agreement had "become quite urgent", and when such provisions are included in the agreement by the other party as part of an overall package. In the Board's judgement, in such circumstances the President only has the power to sign such an agreement if he has authorisation and approval from the Administrative Council.

2.8 The terms of the Agreement which concern Berlin are easily separable from those that concern Munich. In the Board's judgement, the President did not have power to make the Agreement insofar as it contains terms concerning the treatment of documents intended for the EPO and received by the German Patent Office in Berlin.

The Enlarged Board observes that the way in which the Agreement came to be signed in its present form, including the terms concerning Berlin, is easily understandable having regard to the President's comments in this respect. Nevertheless, the exercise of the President's functions and powers cannot lawfully go beyond its legally defined limits as set out in the EPC.

- 2.9 In the Enlarged Board's view it is clear from its text that the object and purpose underlying the Agreement was to provide a solution to the problem of delivery of documents to the wrong office by error. However, while those parts of the Agreement in Articles 1 and 2 which are concerned with the delivery of documents to either office in Munich are clearly directed to providing a solution to this problem, those parts of the Agreement which are concerned with the delivery of documents (intended for the EPO) to Berlin (Article 1 only) cannot properly be regarded as concerned with this problem at all, because there could have been no reason at the time that the Agreement was made for such documents to be sent to Berlin. Thus those parts of the Agreement which are concerned with Berlin clearly go beyond its basic object and purpose.

The inclusion in the Agreement of provisions concerning the delivery of documents in Berlin has led to the creation of an alternative route for filing documents which are intended for the EPO, via the German Patent Office in Berlin. If a document intended for the EPO was delivered to the post-box of the German Patent Office in Berlin, it was accepted and forwarded on to the EPO. Once so accepted by the German Patent Office in Berlin and received by the EPO, it was treated by the first instance departments of the EPO as if it was a document covered by the Agreement. Such a route was outside the proper scope of the Agreement.

In the judgement of the Enlarged Board, at all times prior to the entry into force on 1 July 1989 of the President's Decision setting up a filing office in Berlin, the Agreement should only have been applied to documents which were intended for the EPO in Munich and which were unintentionally delivered to and received by the German Patent Office in Munich, or vice-versa.

- 2.10 Since the entry into force on 1 July 1989 of the President's Decision setting up a filing office of the EPO in Berlin, there is clearly a risk that documents intended for the EPO in Berlin are delivered by error to the German Patent Office. Those parts of Article 1 of the Agreement which concern delivery of documents in Berlin can properly be regarded as foreshadowing the present situation in which both the EPO and the German Patent Office have filing offices in Berlin, with consequent risk of delivery errors. Accordingly, in the view of the Enlarged Board, insofar as Article 1 of the Agreement concerns Berlin, it has now become appropriate to cover such documents.

3. Questions (ii) and (iii)

- 3.1 With reference to question (ii), the Appellant has contended that having regard to the publication of the Agreement in the Official Journal, including the terms therein concerning the treatment of documents received at the German Patent Office in Berlin, the Appellant was entitled to rely upon such terms as being applicable to a notice of opposition delivered there. The Respondent, on the other hand, has contended that there could be no legitimate expectation that a course of deliberate filing of notices of opposition at the German Patent Office in Berlin (as evidenced by the three cases in which questions have been referred to the Enlarged Board) was within the intended meaning of the Agreement.

3.2 One of the general principles of law which is well established in European Community Law and which is generally recognised among the Contracting States and within the jurisprudence of the Boards of Appeal is the protection of legitimate expectations. In the present case this principle is applicable having regard to the good faith existing between the EPO and its users. In the application of this principle to procedure before the EPO, measures taken by the EPO should not violate the reasonable expectations of parties to such proceedings.

3.3 Although as discussed above before 1 July 1989 the Agreement per se was legally not applicable to documents which were intended for the EPO and which were delivered to and received by the German Patent Office in Berlin, nevertheless the wording of the Agreement specifically includes terms indicating that such documents should be treated as set out in Article 1, paragraphs 2 and 3 thereof, with the sole proviso as set out in paragraph 4 that documents intended for the EPO and brought by hand to a filing office of the German Patent Office should not be accepted.

Having regard to the publication of the Agreement containing such wording in the Official Journal, in the Enlarged Board's judgement users of the EPO were entitled to rely upon what the Agreement promised: namely that documents which were intended for the EPO and which were delivered to and accepted by the German Patent Office in Berlin would be recorded with the date of receipt and treated by the EPO as if it had received them directly.

3.4 Accordingly, in the Enlarged Board's judgement a person who, in reliance upon the text of the Agreement, filed documents intended for the EPO deliberately at the German Patent Office in Berlin, was entitled to expect that such

documents would be treated by the EPO as if they had been received at the EPO on the day of receipt by the German Patent Office. This is consequent upon the publication of the Agreement in the Official Journal.

- 3.5 No separate discussion of question (iii) is necessary having regard to the above.

Order

For these reasons, it is decided that:

the questions of law which were referred to the Enlarged Board of Appeal are answered as follows:

- (i) To the extent that the Administrative Agreement dated 29 June 1981 between the President of the EPO and the President of the German Patent Office contains terms regulating the treatment of documents intended for the EPO and received by the German Patent Office in Berlin, the President of the EPO did not himself have the power to enter into such an agreement on behalf of the EPO, at any time before the opening of the Filing Office for the EPO in Berlin on 1 July 1989.
- (ii) In application of the principle of good faith and the protection of the legitimate expectations of users of the EPO, if a person has at any time since publication of the Agreement in the Official Journal and before 1 July 1989 filed documents intended for the EPO at the German Patent Office in Berlin (otherwise than by hand), the EPO was

then bound to treat such documents as if it had received them on the date of receipt at the German Patent Office in Berlin.

The Registrar:

The Chairman:

J. Rückerl
J. Rückerl

P. Gori
P. Gori

Hel
CP
Wm
MP
Judemin
Sty.