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D E C I S I O N
of 14 October 2005

Case Number: J 0034/03 - 3.1.01

Application Number: 01402783.3

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Language of the proceedings: EN

Title of invention:
Thermosiphon

Applicant:
Twinbird Corporation

Opponent:
-

Headword:
Legitimate expectations/TWINBIRD CORP.

Relevant legal provisions:
EPC Art. 75(1)(b), 80, 87, 185
EPC R. 24(2)(4), 26(2), 35, 39, 67, 88

Keyword:
"According a filing date - claims - issuing a receipt pursuant to Rule 24(2) and (4) EPC - protection of legitimate expectations"

Decisions cited:
G 0005/88, G 0007/88, G 0008/88, G 0003/89, J 0003/87,
J 0001/89, J 0020/94, J 0018/96, J 0007/97

Catchword:
-



Case Number: J 0034/03 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 14 October 2005

Appellant: Twinbird Corporation
2084-2, Azakatamukai
Ohaza-Nishiohta
Yosidamachi Nishikanbara-gun
Niigata-ken (JP)

Representative: Maillet, Alain
SCP Le Guen & Maillet
5, Place Newquay
B.P. 70250
F-35802 Dinard Cedex (FR)

Decision under appeal: Decision of the Receiving Section of the
European Patent Office posted 23 July 2003
stating that the application has been accorded
the date of filing 14 February 2002 and that
the claimed priority was lost.

Composition of the Board:

Chairman: J.-C. Saisset
Members: R. Menapace
E. Dufrasne

Summary of Facts and Submissions

I. On the morning of 26 October 2001 the representative of the applicant (appellant) sent both by telecopy and (as confirmation copy) by mail a set of application documents to the Institut National de la Propriété Industrielle (henceforth "INPI") in its quality as central industrial property office within the meaning of Article 75(1)(b) EPC.

The documents received by the INPI at 10.47 a.m. on that day via telecopy consisted of 28 pages, as confirmed in its "Récipissé d'un dépôt par télécopie" transmitted by return telecopy to the representative, and included a description, the request for grant form (EPO Form 1001) with the declaration of priority "JAPAN 01/11/00 ..." and the list of accompanying documents prescribed by Rule 26(2)(j) EPC (EPO Form 1001.6) in which *inter alia* one ("1") sheet of claim(s) was indicated.

Still on 26 October 2001 the INPI issued the receipt pursuant to Rule 24(2) EPC by adding that date as date of receipt and issuance, the application number, seal and signature on EPO Form 1001.6 as filled in by the applicant's representative and (re)sending it to him.

II. The application documents were then duly forwarded to the European Patent Office and received there on 31 October 2001. On that same day the EPO then issued the receipt pursuant to Rule 24(4) EPC, again on Form 1001.6 as filed by the applicant's representative and, thus, mentioning in particular one sheet of claims.

- III. The confirmation (hard) copy of the application documents was received by the EPO on 8 November 2001; it did not contain a sheet with claims.
- IV. By communication dated 7 February 2002 the Receiving Section informed the applicant pursuant to Rule 39 EPC that the European patent application in question did not meet the requirements laid down in Article 80 EPC, because the claims had not been filed ("in one of the languages referred to in Article 14(1) and (2) EPC" - instead of crossing the box "The application does not contain a claim"). In an annex it explained that the application documents filed with the INPI on 26 October 2001 consisted of the description (11 pages), drawings (8 sheets), abstract (1 sheet), cover sheet, EPO forms 1001 and 1002 and receipt form, totalling to 28 pages as appearing on the INPI "Récipissé". Thus, no claims were received by telefax, nor were they received in the confirmation copy.
- V. When he received the communication on 8 February 2002 the appellant's representative immediately contacted the EPO by phone on the matter and, still on the same day, sent a registered letter including a set of four claims, the wording of three of them being present (almost) to the letter in the text of the description as originally filed at the INPI. In the letter which was received at the EPO on 14 February 2002 he submitted that it had been the applicant's intention to file these claims on 26 October 2001, this being corroborated by the [then filed] form 1001.6, on which one page of claims was indicated. Regrettably, the INPI had not carefully checked the number and nature of the documents filed as required by Rule 24(2) EPC.

VI. Following the communication pursuant to Rule 39 EPC posted on 11 March 2002 indicating that the date of filing "14.02.02" had been accorded to the application in question, on 14 March 2002 the Receiving Section issued the communication pursuant to Rule 69(1) EPC noting the loss of the priority right because the priority date no longer lay within the 12-month period for claiming priority 87(1) EPC.

In reaction, the representative, in his letter dated 6 May 2002, reiterated that it had been his intention also to file the claims on 26 October 2001 and that he believed in good faith that they had been correctly received; he requested retraction of the finding of loss of priority.

VII. In the decision under appeal posted on 23 July 2003 the Receiving Section rejected the applicant's request to set aside the noting of loss of rights dated 14 March 2002 and held that the application, to which the filing date 14 February 2002 has been accorded, had lost the claimed priority of 1 November 2000.

In the Reasons it was explained that, in particular in view of the number of (28) pages and the type of documents received by the INPI by telecopy and the absence of the claims sheet in the hard copy separately transmitted by mail for confirmation, it must be concluded that the claims sheet was missing in the application documents originally filed at the INPI. This was contrary to Article 80(d) EPC, which clearly mentions "a description **and** one or more claims ..."; case J 20/94, in which the question of whether the

presence of a "derivable" claim in the application documents would be sufficient was referred to the Enlarged Board, had not been decided.

The decision did not deal with the arguments presented by the applicant's representative in his letters dated 8 February 2002, 6 May and 21 August 2002, namely that the INPI should have informed him immediately by phone of any discrepancy between the faxed documents and the number of sheets indicated in the receipt form; that he had relied in good faith on the indication in the Receipt of documents that one page of claims had been filed; that, had he been warned of the missing page of claims at the time the Receipt was faxed [to him by the INPI], he would still have been on time to fax a complete version of the application, thus keeping the benefit of the claimed priority date, and that the principle of good faith should take precedence in the present case over the provisions of Article 80(d) EPC.

VIII. Against this decision a notice of appeal was filed on 23 September 2003 containing a request for oral proceedings should the Board intend to uphold the decision, together with the statement of grounds and a debit order for the appeal fee.

The appellant (applicant) requested "revocation in its entirety" of the decision which accorded the filing date 14 February 2002 and that 26 October 2003 (*sic*, correctly: 2001) be accorded as date of filing. He further requested to find that claims within the meaning of Article 80(d) EPC were present in specified parts of the text of the description (as filed on 26 October 2001) and that the claim to priority from

Japanese patent application 20000335053 dated 01.11.2000 be held valid.

IX. In the grounds of appeal it was submitted in essence, that in particular in view of the two receipts sent by the INPI and the EPO respectively, which both indicated that one page with claims had been filed with the other application documents, it was more likely than not that that page was also amongst the application documents as filed, so that this should be established as fact. In any event, claims were present in the application documents, in that certain passages because of their wording, content and the apparent intention of the applicant qualified as claims within the meaning of Article 80(d) EPC, which provision does not require that the claims must be on a separate sheet; rather this is a requirement to be dealt with under Rule 35 EPC and irrelevant for the determination of a filing date. Furthermore, the applicant had been misled. If INPI and/or the EPO had issued correct receipts or warned him otherwise of the missing sheet, he could and actually would have immediately filed it and thereby kept the claimed priority date. The erroneous receipts prevented him to take steps to overcome in time the problem of the missing page.

Reasons for the Decision

1. The appeal is admissible.
2. The appellant's request, as regards the validity of the claimed priority, is understood as being limited to setting aside the finding in the decision under appeal,

that the claimed priority was lost. There is no basis for a positive finding by the Board on the validity of the priority claim as such, in that this would require, that all other relevant conditions - e.g. same applicant/successor in title, same invention pursuant to Article 87(1) EPC, first application within the meaning of Article 87(4) EPC - are also met. The respective examination is, if needed at all, a matter left (at first instance) exclusively to the Examination Division and was, hence, not at issue in the proceedings before the Receiving Section. Such an understanding of the appellant's true intention is also underlined by the wording of the notice of appeal.

3. In view of the correlation of the number of pages of each document concerned (see Point IV, above) with the total number of pages (28) originally received by the INPI, in combination with the lack of a claims sheet in the confirmation copies transmitted separately by mail, it must be excluded, realistically, that such a sheet was actually present amongst the documents filed on 26 October 2001 at the INPI. This was, apparently, also the appellant's view during the proceedings before the first instance. The respective finding in the Reasons of the decision under appeal is not rendered questionable, all the less disproved, by the fact, that in both official receipts the claims sheet appears in the list of documents filed, as the appellant argued for the first time in the statement of the grounds of appeal. The two receipts, whilst issued from two different authorities, in respect of their content were factually linked to each other and to the entries made by the applicant's representative on EPO Form 1001.6, in that this form is intended to be and in the present

case was used for the distinct purposes of Rules 26(2)(j), 24(2) and (4) EPC. A not unrealistic explanation could be, therefore, that the INPI had overlooked the missing claims sheet (as the appellant himself supposed, see Point V, above) and consequently issued the receipt with the applicant's entries on Form 1001.6 uncorrected; the EPO did the same, contrary to what it had actually received from the INPI.

4. Hence, the question arises whether the issuance of the receipt for documents, which wrongly confirmed the filing of a sheet with claims, under the given circumstances was contrary to the principle of legitimate expectations, which the appellant invoked. This principle of procedural law is generally recognized in the EPC contracting states (within the meaning of Article 125 EPC) and the case law of the Boards of Appeal. It implies that measures taken by the EPO in proceedings before it should not violate the reasonable expectations of parties to such proceedings (G 5/88, G 7/88, G 8/88, OJ 1991, 137). From the same concept, sometimes also described as "good faith", emanates also the obligation of the EPO to draw attention to easily remediable deficiencies, if that is to be expected under the relevant circumstances (e.g. J 18/96, OJ 1998, 403).

5. There is no reason why this principle should not apply equally to the conduct of national authorities when dealing with European patent applications filed at them under Article 75(1)(b) EPC. According to said provision a European application which was, as the present one, filed at the central industrial property office of a Contracting State whose law so permits, shall have the

same effect as if it had been filed on the same date at the European Patent Office. This rules out any disadvantage to an applicant if he made use of that alternative way of filing offered to him by the EPC. As a consequence, vis-à-vis a (European) applicant the responsible national authority has to act in good faith just as the EPO, in particular to warn the applicant in the case of easily remediable deficiencies.

6. The filing date being highly critical for a patent application, in particular where, as in the large majority of European patent applications including the present one, a priority is claimed and the application documents have been filed at the end of the priority year, the lack of a whole document required under Article 80 EPC - here (the sheet with) the claims - is a deficiency of serious consequences which, in contrast to a single page missing from amongst a long description of many pages (a situation underlying decision J 7/97), would be discoverable already by a superficial completeness of content check. Furthermore, in the present case it could be immediately seen from the nature of the incoming documents, the entries appearing on the Form 1001.6 and the number of sheets/pages actually received at the INPI at 10.47 a.m. that contrary to the applicant's intentions and belief the sheet with the claims had not been received. It was equally obvious that this deficiency could be easily and immediately remedied by the applicant, e.g. by sending (again) a telecopy of the missing sheet to the INPI, and that the applicant's representative could - and most likely would - have done so still on 26 October 2001 and certainly before expiration of the twelve month period pursuant to Article 87(1) EPC. In

these circumstances the applicant could, indeed, objectively and reasonably expect from the INPI to inform his representative by phone or via telefax of the missing claim sheet immediately after the application documents had been received there by telecopy.

7. In fact, the INPI reacted promptly by issuing two receipts, an informal one and the one prescribed by to Rule 24(2) EPC still on the same day. However, none of them constituted an appropriate warning to the applicant's representative, in that one was silent on the nature of the document's received and the other expressly, but wrongly, confirmed the receipt (also) of the sheet of claims. It does not matter that the entries on the latter were those originally made by the appellant's representative on Form 1001.6 , which form is designed to serve also national authorities (/the EPO) for the purposes pursuant to Rule 24(2)/(4) EPC and was so used in the present case (see Point 3, above). This multiple usability aims at simplifying the issuance of the receipt; it has no bearing on the responsibility the receiving national authority to check and to correctly confirm which documents had actually been received. Therefore, it acts in breach of its duties, if it relies on the entries made by the applicant on Form 1001.6 and/or does not correct them to the extent necessary, before returning it to the applicant as receipt of documents pursuant to Rule 24(2) EPC. As a consequence, the issuance of the incorrect receipt, irrespective of whether or not it reached the applicant's representative by telecopy still on 26 October 2001, constituted a negligence of the duty to draw the parties' attention to easily remediable

deficiencies. Moreover, in that it also expressly confirmed the receipt of the claims sheet, it was positively misleading the Applicant ('s representative), who was thereby effectively prevented from acting as necessary and possible. The applicant would not have suffered from any disadvantage, had the INPI acted correctly. Had it done so, a (second) warning later by the EPO would have been redundant; hence the negligence by the former was the original cause for the late filing of claims. Nevertheless, the issuance of an equally wrong receipt pursuant to Rule 24(4) EPC by the EPO some days later, as such constituted a neglect of it's duties (see Points 8, 9 and 12, below).

8. In view of the foregoing the Board, in following its established case law on the protection of legitimate expectations (see, for example, the decisions cited above under Point 4), concludes that the appellant must be protected in his legitimate expectation, here in his objectively justified belief, that the application documents filed by his representative on 26 October 2001 contained in particular also (a sheet of) claims. That means in particular, that the applicant must not suffer a disadvantage as a result of having relied on a misleading official information given to him (see J 3/87, OJ 1989, 3); on the contrary, if his actions were based on a misleading communication, he is to be treated as if he had satisfied the legal requirements (J 1/89, OJ 1992, 17). More specifically, in a case, where the EPO had given the applicant the impression that his application was validly filed, the board accorded a filing date, although a requirement under Article 80 EPC had not been fulfilled (J 18/96, cited above).

9. That has to be the consequence also in the present case where the applicant's representative was given the impression, by way of the official receipt pursuant to Rule 24(2) EPC, that the documents filed by him on 26 October 2001 were complete for the purposes of Article 80 EPC. Since the receipt under Rule 24(4) EPC given to him was equally incorrect, he was kept under that wrong impression until he received the communication dated 7 February 2002.

10. The missing claims having been the only deficiency in respect of the requirements of Article 80 EPC, the loss of the priority right, on the other hand, being only one - albeit in the present case apparently the most - detrimental consequence of a late filing date, in the case at hand the harm caused to the appellant can only be averted or at least minimized by according the application the 26 October 2001 as filing date, the relevant documents embracing also the claims as filed on 14 February 2002 in response to the aforementioned communication. Otherwise, the appellant would remain disadvantaged in respect of the initial content of his application. On the other hand, the appellant may not, to the detriment of the public interest, take advantage of the inclusion of the actually later filed claims into the initial content and, thus, in the original disclosure of the application within the meaning of the EPC. Such effect, however, is not to be feared in the present case, where, in view of the relevant circumstances including the number and the wording of the claims filed as an immediate reaction to the communication posted on 7 February 2002, and in the absence of any indication to the contrary, there is no

serious doubt, that the text of those claims was identical to that which the applicant's representative intended to file on 26 October 2001 as an integral part of the application documents. In the Board's judgement this is sufficient certainty in a situation where the applicant, differently from a request for correction under Rule 88 EPC, second sentence (cf. G 3/89, Headnote 2) seeks to avoid a loss of rights consequent to an error not attributable to him, but to the EPO and/or a national authority acting under the EPC.

11. With this outcome the appellant is no longer adversely affected by the decision under appeal and, in effect, all his substantive requests are fully met in their broadest scope. Therefore, there is neither a need for oral proceedings nor is it necessary to pursue the legal question raised in the above mentioned decision J 20/94, of whether it is sufficient for the purposes of Article 80 EPC that there is at least one claim which, although not formulated expressly and separately from the description, is derivable from the invention as described in the application documents actually filed.

12. The present appeal is allowed exclusively because of procedural errors. The two authorities involved not only omitted a warning to the applicant in a situation where they were obliged to draw the applicant's attention immediately to an easily remediable deficiency of serious consequences, but each of them issued an official and specific receipt wherein, contrary to the facts, the presence of the document in question was expressly indicated. Thereby both authorities acted in breach of their specific duties

under Rule 24(2) and (4) EPC, respectively, with the consequence that the applicant's representative was effectively prevented from taking appropriate action in order to remedy the deficiency before it led to a loss of rights. This qualifies as substantial procedural violations, whose effects upon the Appellant were such that in the judgment of the Board reimbursement of the appeal fee is equitable (Rule 67 EPC) in the present case.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. European application No. 01 402 783.3 is accorded the filing date of 26 October 2001, the set of four claims filed on 14 February 2002 being deemed to be comprised in the relevant application documents (Article 80 EPC).
3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

S. Fabiani

J.-C. Saisset