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D E C I S I O N
of 12 April 2005

Case Number: J 0012/04 - 3.1.1

Application Number: 03075651.4

Publication Number: -

IPC: C08K 3/04

Language of the proceedings: EN

Title of invention:

Synthetic resin composites and bearings formed therefrom and method

Applicant:

Minebea Co., Ltd.

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 106(1)

EPC R. 68(1)

Keyword:

"Form of a decision"

"Transmission by facsimile - Right to priority of patents applications principles of good faith and of the protection of legitimate expectations"

Decisions cited:

J 0008/81, T 0263/90

Catchword:

-



Case Number: J 0012/04 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 12 April 2005

Appellant: Minebea Co., Ltd.
4106 - 73, Oaza Miyota
Miyota-Machi
Kitasaku-Gun
Nagano-Ken 389-0293 (JP)

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Decision under appeal: Decision of the Receiving section of the
European Patent Office dated 1 September 2003
refusing the right to priority of Japanese
patent applications.

Composition of the Board:

Chairman: J.-C. Saisset
Members: E. Lachacinski
A. Pignatelli

Summary of Facts and Submissions

I. This appeal is against the decision of the Receiving Section of 1 September 2003 requested by the appellant (the applicant for European patent application No. 03 075 651.4) and declaring that the right to priority of Japanese patent applications No. 2002-055307 and No. 2002-055308 both of 1 March 2002 had not been validly claimed.

II. The reasons for the decision under appeal can be summarised as follows:

To obtain the benefit of the claimed priority, the application documents had to be filed by 3 March 2003.

However:

- (i) Only 9 pages of the European patent application were received by fax at the EPO and it did not contain a description,
- (ii) "Incomplete documents filed by facsimile shall be treated as not having been received to the extent....that the attempted transmission failed" according to the Decision of the President of the European Patent Office dated 26 May 1992 (OJ EPO 1992, 299),
- (iii) Consequently, the European patent application did not meet the requirements laid down in Article 80 EPC,

- (iv) The deficiency was only remedied by filing the documents on 4 March 2003, which is the date of filing of the European patent application,
- (v) As a result of this date of filing, both claimed priorities dated 1 March 2002 cease to lie within the 12 month period for claiming priority,
- (vi) There was accordingly no right of priority dated 1 March 2002 according to Rule 41(3) EPC.

III. The appellant filed a notice of appeal on 5 November 2003 and duly paid the appeal fee on time. It filed a statement of grounds of appeal the same day.

IV. The appellant was sent a communication on 22 November 2004 and asked for explanations regarding:

- the duration of the transmission of the 37 pages on 3 March 2003 (2'51'') according to the applicant's document, in comparison with the duration of the transmission of 9 pages (2'21'') according to the EPO,
- the duration of the transmission of the above 37 pages (2'51'') in comparison with the duration of the transmission of the 38 pages on 5 March 2003 (12'07'').

The applicants were also asked to explain how the fax transmission of 37 pages to the EPO appears to have taken as long as 9 pages of the same document and why the fax transmission of 38 pages of text took longer

the second time, on 5 March 2003, than the 37 pages of the same text transmitted on 3 March 2003.

V. The appellant's arguments in its grounds of appeal and in its letter of 20 January 2005 can be summarised as follows:

(i) The documents required for the registration of the European patent No. 03 075 651.4 consisting of 37 pages with the priority date of 1 March 2002 was transmitted by fax to the EPO on 3 March 2003.

The mention on the fax report (*TRANSMISSION OK, HORA COM 03/03 10:04, TP USADO 0'51, PAGINAS ENVIADAS 37, RESULTADO OK*) indicated that the 37 pages had been properly transmitted to the EPO without interruption.

(ii) The same documents with the mention "This is a confirmation of a EP patent application filed with the EPO in the Hague Facsimile on 03/03/2003" were sent the same day to the EPO by the company DHL.

(iii) On 4 March 2003, at 16.47, i.e. 30 hours after receiving the fax from the EPO, the EPO sent a fax in which notice was given that the documents sent by fax on 3 March 2003 concerning the European patent application were incomplete and that only a few pages had only been received. These pages included the first page of the application, pages 22 to 24 of the description and pages 1 to 5 of the drawings.

- (iv) On 5 March 2003, all 37 pages of the initial documents of the European patent application plus one more sheet for the new cover sheet were again sent by fax to the EPO (time taken for the transmission of the 38 pages: 13'44'').
- (v) According to the applicants the enclosed documents numbered A1 to A8 demonstrate that the patent application was sent in time on 3 March 2003 and that the right of priority was not lost.
- (vi) Oral proceedings were requested should the Board not accept the findings of the request setting aside the decision under appeal.

VI. The appellants requested that the decision under appeal be set aside and that the date of 1 March 2003 be considered as a valid priority date.

Reasons for the Decision

1. The appeal lies against a "document" of the Receiving Section dated 1 September 2003. Even if it does not fulfil the formal provisions of Rule 68(2) EPC the question whether it constitutes a "decision" or not depends on the substance of its content and not on its form (J 8/81, OJ EPO 1982, 10 and T 263/00, not published).

The above document contains a short factual analysis, a statement of legal grounds, a reasoned argument and a

conclusion resulting in a refusal of a priority date for a European patent application.

It appears therefore that it is a decision in accordance with Article 106(1) and Rule 68(1) EPC against which an appeal is possible.

The appeal is consequently admissible.

2. The applicants are of the opinion that the application was correctly sent to the EPO and that it made no error in the fax transmission of 3 March 2003.

The applicants explained the general principle of how the fax machine used for transmitting the fax on 3 March 2003 operates.

The applicants gave the Board convincing arguments in explanation of the duration of the transmission of the 37 pages (2'51'') in comparison with the duration of the transmission on one hand of 9 pages (2'21'') according to the EPO and on the other hand of the 38 pages on 5 March 2003.

In fact, the transmitting fax machine can read a document to be sent and store it in its memory. When sending a fax document to a receiving machine over the telephone network, the transmitting fax machine receives acknowledgments of correct receipt from the receiving fax machine, on a page-by-page basis.

If the sending fax machine observes that a page is not correctly transmitted to the receiving fax machine, the sending fax machine interrupts the transmission, waits

for a pre-set period of time and subsequently establishes a new connection or session, trying to transmit the pages that were not correctly transmitted in the previous session.

The sending fax machine starts with a retransmission of page 1 of the original document, to allow the receiver to identify the case to which the following pages relate, followed by the remaining pages.

This is the reason why in a first session, pages 1 to 29 of a document comprising 37 pages were correctly transmitted, whereas pages 30 to 37 were not correctly transmitted; transmission interruption occurred during transmission of page 30. Following the lack of acknowledgement of receipt of pages 30 to 37 from the receiving fax machine, the sending fax machine had to re-dial the number of the receiving fax machine in order to establish a second session during which the sending fax machine would re-transmit page 1 of the document, i.e. the cover page and subsequently pages 30 to 37.

During this second session, only 9 pages would have been transmitted, i.e. page 1 plus pages 30 to 37.

According to the type of sending fax machine used the transmission report has indicated that a total of 37 pages were sent, i.e. during the two sessions, but only indicated the transmission time corresponding to the second session, i.e. 2'51''.

This is attested by the transmission report (document A1) which states "*PAGINAS ENVIADAS 37 RESULTADO OK*" that corresponds to the remarks indicated on the top

right side of the pages of the application received by the EPO on 3 March 2003 "001/037 - 030/37 to 037/37 and 001 to 009 of 03.03.2003 from 10:04:22" to 10:06:43.

This also appears to be in line with what is mentioned in Document A3 (Canon FAX-1900 Manual de Instrucciones) and in its English version A3trans on pages 12 and 13:

TP USED

It represents the time used in the last transmission attempt. Bear in mind that the time used does not reflect the total time spent sending all the pages of the document when the re-attempt takes place. By printing an ACTIVITY MANAGMENT REPORT and comparing the TX REPORT transaction number with the ACTIVITY MANAGEMENT REPORT transaction number it is possible to know the exact number of attempts made to send the document, the number of pages sent at each attempt as well as the time used on each occasion.

PAGES SENT

It represents the total number of pages that were sent satisfactorily.

RESULT

OK means that all the pages were sent at the first attempt or after the first and the second attempt. It is possible to change the pre-set option, which are two attempts.

NG means that one or all the pages could not be sent after the two attempts. It is possible to change the pre-set option, which is two attempts.

Mr Juan Manuel Rodriguez Nuñez, a fax machine expert, confirmed by letter dated 14 January 2005 (document A8) and its English translation (document A8trans) that after memorization of the 37 pages of the document the transmission to the EPO was made in two attempts, the first set with pages 1 to 29 and the second one with pages 30 to 37 plus the cover page 1.

The entire 37 pages of the document were then correctly transmitted to the EPO on 3 March 2003.

This results unambiguously from the statement "RESULTADO OK" indicated on the "REPORTE DE TX". In case of a defect transmission the statement would be "RESULTADO NG", instead of OK.

What happened at the receiving fax machine or to the 29 pages sent with the first attempt remains unknown.

According to the expert, a paper jam in the printer, lack of paper or of toner, receiver memory overflow, temporary power cut, inbox blockage or other temporary failure depending of the type of receiving fax machine could be responsible.

These explanations correspond exactly to a re-attempt to send pages 30 to 37 after a successful transmission of pages 1 to 29 and are convincing arguments which do not need further evidence.

The explanations about the duration of the transmission of documents by fax are also acceptable. The length of the fax, the density of the information to be transmitted, the resolution chosen for the

transmission, the method/mode used for the transmission (Sending from memory used on 3 March 2003, Direct sending used on 5 March 2003 which is slower), the load on the telephone network, the state of the receiving fax machines which were not the same on 3 March 2003 and on 5 March 2005 are parameters which obviously influence the time needed for the transmission of the fax.

3. It results from the above that the European patent application was integrally and correctly sent to the EPO on 3 March 2003.

Consequently, the provisions of Article 3 of the Decision of the President of the European Patent Office dated 26 May 1996 on the use of technical means of communication for filing patent application and other documents could not apply.

Where a document transmitted to the proceedings using a facsimile is illegible or incomplete, the document shall be treated as not having been received to the extent that it is illegible or that the attempted transmission failed.

In the present case it appears beyond doubt that there were two successful attempted transmissions. The European patent application comprising 37 pages was correctly sent to the EPO. The statement on the "REPORTE DE TX" and those on the 9 pages of the second session, i.e. 001/037, 030/037 to 037/037 are material evidence which demonstrate that the transmission was successfully received in time by the receiving fax machine at the EPO.

No pages shall be treated as not received under Article 3 of the above-mentioned Decision.

What actually happened at the Receiving Section to pages 1 to 29 cannot cause a disadvantage to the applicant since the principles of good faith and the protection of legitimate expectations must be applied to the applicant who is not able to bring evidence to prove what happened to the transmitted pages after receipt thereof by the EPO.

4. All other arguments put forward by the applicant, particularly those concerning the notification to the applicant of the failed transmission and the acknowledgement of receipt of the document filed by fax are superfluous in the present case.

5. Since the decision under appeal has to be set aside no oral proceedings are necessary.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The European patent application No. 03 075 651.4 claiming the right to priority of Japanese patent applications No. 2002-055307 and No. 2002-055308 of 1 March 2002 was validly filed on 3 March 2003.

The Registrar:

The Chairman:

S. Fabiani

J.-C. Saisset