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D E C I S I O N
of 9 April 2005

Case Number: J 0017/04 - 3.1.1

Application Number: 02011369.2

Publication Number: 1252925

IPC: B01J 23/42

Language of the proceedings: EN

Title of invention:

Exhaust gas purifying catalyst and exhaust gas purifying method

Patentee:

TOYOTA JIDOSHA KABUSHIKI KAISHA

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 21(1)(3)(a)(c), 79(2), 107, 113(1)
EPC R. 51(4), 67, 69(1)(2), 85a(1)(2), 88, 89

Keyword:

"Admissibility of the appeal with regard to appellant's actual intentions and facts submitted by the appellant"

"Competence of the Board consisting of three legally qualified members"

"Regional scope of application"

Decisions cited:

G 0008/95, J 0012/85, T 0824/00

Catchword:

"Procedural violation caused by non-observance of the incompleteness of a form"

"Ambiguity of a pre-printed text in a form"



Case Number: J 0017/04 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 9 April 2005

Appellant:

TOYOTA JIDOSHA KABUSHIKI KAISHA
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Toyota-shi
Aichi-ken 471-8571 (JP)

Representative:

Winter, Brandl, Fürniss, Hübner
Röss, Kaiser, Polte
Partnerschaft
Patent- und Rechtsanwaltskanzlei
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Decision under appeal:

Decision of the Examining Division of the
European Patent Office dated 12 May 2004
deciding that the requested patent is granted
with a restricted regional scope.

Composition of the Board:

Chairman: J.-C. Saisset
Members: S. U. Hoffmann
T. Bokor

Summary of Facts and Submissions

- I. This is an appeal against the decision of the Examining Division of 13 May 2004 granting European patent No. 1252925 for the designated Contracting States DE, FR and GB.
- II. The European Patent application in suit no. 02 011 369.2 was filed as a divisional application to the parent application No. 97 121 697.3 with the EPO on 23 May 2002 using EPO FORM 1001, 07.99. (In the parent application the contracting states DE, GB, ES, IT, FR and SE were designated).

Section 32 of this form concerned designation of contracting states and associated declarations and contained a pre-printed text and two check boxes. Point 1 of this text read as follows: "*All states which are contracting states to the EPC at the filing of this application are hereby designated. Payment of seven times the amount of the designation fee is deemed to constitute payment of the designation fees for all the contracting states (Art. 2, No. 3 Rules Relating Fees)*". The check box for this text was marked by a pre-printed cross.

Point 2 of section 32 contained two paragraphs with a text as follows: "*It is currently intended to pay fewer than seven designation fees for the following contracting states (please indicate country codes and contracting states):*"

After a blank provided for entering specific states the text continued: "*No communication under Rules 85a(1) or*

69(1) need to be notified in respect of the contracting states not indicated under No. 2". At the top of the text under point 2 the form provided for a box to be crossed by the applicant.

In the present case the check box at the top of point 2 was not ticked but the contracting states DE, FR and GB were added in the blank between the first and second paragraph of this text.

In a voucher (EPO Form 1010) attached to the application the EPO was authorised to debit from the representatives' deposit account *inter alia* three designation fees which were debited by the EPO.

III. The Search Report was published on 30 October 2002. On 13 May 2003 the EPO issued a Communication pursuant to Article 96(2) EPC inviting the applicant to rectify the deficiencies indicated in that communication.

The text of this communication was introduced with the statement: "*Text for the Contracting States: DE, ES, FR, GB, IT, SE*" (sic!).

IV. In response to this communication the applicant filed amended application documents.

V. By communication under Rule 51(4) EPC dated 16 December 2003 the EPO informed the applicant *inter alia* that it was intended to grant a European patent on the basis of the application with the text for the contracting states: DE, FR and GB.

- Annexed to this communication, EPO Form 2056 displayed the envisaged bibliographic data and indicated DE, FR and GB as contracting states for which fees had been paid.
- VI. With letter of 26 April 2004 the applicant paid the fees for granting and printing and filed the due translations of the claims.
- VII. On 13 May 2004 the Examining Division issued a decision pursuant to Article 97(2) EPC that a European patent is granted on the basis of the documents indicated in the communication pursuant to Rule 51(4) EPC for the designated states DE, GB and FR and that the mention of the grant would be published in European Patent Bulletin 04/26 of 23 June 2004.
- VIII. With faxed letter of 21 June 2004 the applicant requested *inter alia* the correction of the designations of states under Rule 88 and 89 EPC such that the six contracting states DE, GB, ES, IT, FR and SE were designated. At the same time the designation fees plus surcharge were paid according to Rule 85a EPC for the contracting states ES, IT and SE.
- IX. The mention of the grant of the patent for the contracting states DE, GB and FR was published in the European Patent Bulletin on 23 June 2004.
- X. On 1 July 2004 the applicant filed a notice of appeal against the decision to grant dated 13 May 2004. The appeal fee was paid on the same date by a deposit order.

In the reasons for the appeal simultaneously filed with the notice of appeal the appellant argued that the period of grace according to Rule 85a EPC had started to run not before the date on which the correction in respect of the designation of the three further contracting states ES, IT and SE was requested and the respective designation fees with surcharge had been paid. By filing EPO FORM 1001 on 23 May 2002 the appellant did not abandon his right to be notified under Rule 85a EPC, because the check box at the top of point 2 under Section 32 concerning a waiver for being notified under Rules 85a(1) and 69(1) EPC had deliberately not been crossed. The appellant argued furthermore that the fact that the contracting states DE, GB and FR were listed in the data field between the two paragraphs under point 2 of section 32 was only based on the necessity to indicate for which contracting states the deposit order should be executed because EPO Form 1001 did not provide for the possibility to dedicate the designation fees to specific states. In view of the appellant, the EPO could not interpret the statement on the three contracting states under point 2 of section 32 as a waiver to be notified under Rules 85a(1) and 69(1) EPC because the present divisional application concerned a subject matter which had already obtained preliminary protection for six contracting states by the parent application.

- XI. The appellant requested that the decision for grant dated 13 May 2004 is to be amended such that the states ES, IT and SE be designated in addition to the states DE, FR and GB and, as an auxiliary request, that oral proceedings be arranged.

According to the appellant's letter dated 28 February 2005, oral proceedings were not requested in case the Board sets aside the impugned decision and remits the case to the first instance. Additionally, the appellant approved the competence of the Legal Board to decide in the present case.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rules 1(1) and 64 EPC.

First of all, the Board notes that the decision under appeal did not decide on appellant's requests for correction under Rules 88 and 89 EPC and that therefore these requests are not directly subject matter of the appeal proceedings. Additionally, a request under Rule 88 EPC for correction of a document as the sole reason for the appeal would be inadmissible for reasons of procedural certainty and lack of being adversely affected (cf. T 824/00). As regards the request under Rule 89 EPC, the Legal Board (J 12/85) already decided that a Board of Appeal can only examine appeals from decisions of other instances of the EPO (Article 21(1) EPC). Thus it cannot examine a request for a correction of the decision under appeal based on Rule 89 EPC. A decision on this request must first be rendered by the Examining Division before the matter can be referred to the Board of Appeal.

2. However, in order to assess the admissibility of the appeal the Board is not bound to the pure wording of the request but has to interpret this request with

- respect to appellant's actual intentions and the facts he submitted.
3. Even if the appellant in his notice of appeal only referred to a correction of the decision under appeal under Rules 88 and 89 EPC he made therewith (implicitly) the allegation that the decision under appeal incorrectly limited the regional scope of the patent to DE, GB and FR and that this decision should be set aside. Furthermore, the appellant submitted conclusively that there had been circumstances which could establish a violation of his right to be heard under Article 113(1) EPC with respect to his final request before the Examining Division. According to appellant's submissions, he would have realised that he failed to pay the designation fees for the contracting states ES, IT and SE if he had been duly informed under Rule 85a EPC. Thus, assuming these submissions as given, the Board concludes that the appellant claimed in a legally sufficient way to be adversely affected by the contested decision under Article 107, first sentence EPC and that his request is directed to setting aside the impugned decision. The appeal is therefore admissible.

 4. As the appeal is aimed at obtaining the Board's statement that the decision of the Examining Division to grant a patent is (partially) incorrect (with respect to its regional scope) the competence of a Board consisting of three legally qualified members (Article 21(3)(c) EPC, so-called Legal Board) is not immediately evident because Article 21(3)a) assigns the competence to the Boards consisting of two technically qualified members and one legally qualified member (so-

called Technical Board) when the decision concerns the refusal of a European patent application or the grant of a European patent and the decision was taken by an Examining Division consisting of less than four members. As a rule, this provision also applies in cases where the appeal is based on grounds that the incorrectness of the decision under appeal is caused by a procedural violation in order to ensure that it is always a Technical Board which decides on the grant of a patent. On the other hand, it is argued that the decision under appeal resulted, *inter alia*, in an unjustified loss of rights as regards the designation of the contracting states ES, IR and SE which allegedly occurred during the examining procedure. Therefore, the subject matter of the appeal exclusively concerns a preliminary question to the decision of grant which would clearly fall into the Legal Board's competence if this question would be a subject matter of a separate decision pursuant to Rule 69(2) EPC. The purported omission of the first instance to issue a communication pursuant Rule 85a(1) EPC then caused that the decision under appeal not only concerns the final decision to grant a patent but also contains a decision on the loss of rights with respect to the contracting states ES, IT and SE even if this decision has not been explicitly mentioned in the order or the reasons of the decision. The appeal is not directed against the substance of the decision, namely the act of the grant or the text in which the patent is to be or has been granted (cf. G 8/95, OJ EPO 1996, 481, reasons point 4) but exclusively against the restricted regional scope of the patent granted. The Board is aware that it might be questionable to base its competence on only one part of the decision if, as a result, the Board then may

exercise, pursuant to Article 111(1) EPC, any power within the (whole) competence of the department which was responsible for the decision appealed. However, considering the specific circumstances of the present case and also having in mind the appellant's approval to the Legal Board's competence, the Legal Board takes its competence for granted under Article 21(3)c) EPC to decide whether or not a loss of rights with regard to the territorial scope of the requested patent occurred during the examination proceedings.

5. As preliminary remark and *obiter dictum* and in divergence to appellant's submission, the Board points out that no error occurred in the application in respect of the designation of the contracting states ES, IT and SE because these and all other contracting states were designated by the pre-printed text of point 1 under Section 32 of EP Form 1001. Thus, a correction of the application form under Rule 88 EPC would not be appropriate to remedy the purported deficiency that the decision to grant did not take effect for the contracting states ES, IT and SE. Furthermore, the decision of the Examining Division could hardly be affected by an error on the valid designations of contracting states because designation fees were only paid for the contracting states DE, FR and GB and a correction under Rule 88 EPC could not replace omitted payment of further designation fees for ES, IT und SE.

6. Starting from appellant's allegation that the decision was incorrect because it did not reflect appellant's true intention and if the Examining Division had issued a communication under Rule 85a(1) EPC he would have had

paid the designation fees for ES, IT and SE in due time before the decision to grant had been taken, the Board has to examine whether or not there occurred in the course of the examining proceedings a substantial procedural violation on which the appealed decision was based.

According to the appellant's submission, such a substantial procedural violation occurred when the Examining Division disregarded the period of grace for payment of designation fees under Rule 85a(1) EPC.

7. Rule 85a EPC reads in paragraph 1:

"If...a designation fee has not been paid within the time limits provided for in...Article 79, paragraph 2, Rule 15 paragraph 2..., it may still be validly paid within a period of grace of one month from notification of a communication pointing out the failure to observe the time limit, provided that within this period a surcharge is paid."

Rule 85a(2) EPC concerns a waiver to be notified and reads as follows: *"Designation fees in respect of which the applicant has dispensed with notification under paragraph 1 may still be validly paid within a period of grace of two months of expiry of the normal time limits referred to in paragraph 1, provided that within this period a surcharge is paid."*

8. In the Board's opinion, Rule 85a(1) EPC does not only provide for a period of grace for the applicant i.e. a further possibility to pay designation fees within an extension of time but also imposes a duty on the EPO to

issue a warning to the applicant. This duty is to be regarded as so essential that a final decision must not be taken without such reminder having been sent. Vice versa, the omission to issue such reminder pursuant to Rule 85a(1) EPC establishes a substantial procedural violation unless the applicant has validly renounced the right to be notified. It is noted that the issuance of the reminder pursuant to Rule 85a(1) EPC is not a "courtesy service" offered by the EPO, but an act that is prescribed by the Implementing Regulations.

9. In the present case, it is evident from the file that no Rule 85a(1) communication has been issued by the EPO before the decision to grant was issued and that the applicant did not pay designation fees plus surcharge for the states ES, IT and SE within the period of grace under Rule 85a(2) EPC.

Therefore the Board has to examine whether the applicant validly renounced his right to be notified under Rule 85a(1) EPC.

10. Apparently, the Examining Division regarded the text under Section 32, point 2 of the application Form 1001 as a waiver of the right to be notified under Rule 85a(1) EPC.

The appellant did not contest the meaning of the text but argued that he did not tick the correspondent check box referring to the text under Section 32, point 2 of the EPO Form 1001 in order to avoid a waiver of the right to be notified under Rule 85a(1) EPC. However according to the appellant, the entry of the contracting states DE, GB and FR in this section had

been made in order to ensure that at the date of filing of the application the designation fees were only allotted to these states.

11. Firstly, the Board states that in the present case Form 1001 was incompletely filled in and appellants true intention could not be inferred without doubt from section 32 because the fact that the check box was not marked indicated first of all that there could be a mistake but not what mistake occurred. It could be caused by a mere inadvertence to mark additionally the check box but also by the fact that the applicant was disturbed when he filled in the list of contracting states and forgot to complete this list after resuming the completion of the form. As a procedural rule, a decision must not be based on a request without informing the applicant about the ambiguity of his request in cases where this deficiency can still be corrected (see also J 15/92, not published in the OJ). In the present case, the Examining Division should have noticed the incompleteness of the entries in Form 1001 and the ambiguity of the request and, consequently, should have clarified applicant's true intention because a correction of this request was still possible. The Examining Division's omission of this duty amounted to a substantial procedural violation.

12. Secondly, the Board accepts appellant's allegation that the text of EPO Form 1001 under Section 32 point 2 can be misinterpreted in cases where the applicant wants to pay less than seven designation fees for specific contracting states within the basic period under Article 79(2) EPC but does not wish to waive his right to be notified under Rules 85a(1) or 69(1) EPC for the

other contracting states. Such a procedure is permitted under the European Patent Convention and can not be excluded by the compulsory use of EPO Form 1001. It lies within the responsibility of the EPO to provide forms which comply with all procedural possibilities in a clear and unambiguous manner. If the second paragraph of point 2 under Section 32 of the EPO Form 1001 had a separate check box no doubt or misunderstanding could occur completing this form. As a result of these considerations, the Board holds that an applicant is allowed to rely on a possible interpretation of the text of a EPO form under the principle of the protection of legitimate expectations even if another interpretation is more current. As there is no hint or indication let alone a proof that the appellant changed his mind after filing the application form 1001 the Board has to accept appellant's allegation that he did not intend to waive his right to be notified under Rules 85a(1) and 69(1) EPC from the beginning of the proceedings and that, therefore, the examining proceedings and the final decision were affected by the omission of such a notification which established a (further) substantial procedural violation.

13. Neither of the procedural defects as determined under point 11 and 12 could be remedied by issuing the communication under Rule 51(4) EPC of 16 December 2003 although this communication also contained the information that the EPO intended to grant a patent for the contracting states DE, FR and GB. This communication only concerned the approval of the text of the description and the claims and of the drawings but did not set a time limit for the payment of further designation fees plus surcharge under Rule 85a(1) EPC

and did not contain an explicit warning that a loss of right with respect to other contracting states would occur by the decision to grant a patent. The communication under Rule 85a(1) EPC establishes an essential right to be heard under Article 113(1) EPC which cannot be abandoned without an unambiguous declaration by the appellant on this point.

14. Such a communication was not sent to the appellant in the present case and, therefore, the examining proceedings suffered from a substantial procedural violation on which the decision under appeal was finally based.

Thus, the decision under appeal is to be set aside and the case to be remitted to the first instance for further prosecution in order to remedy the procedural deficiencies under Article 113(1) EPC.

15. In view of the substantial procedural violations as stated above and the allowability of the appeal, reimbursement of the appeal fee is warranted for reasons of equity pursuant to Rule 67 EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.
3. The appeal fee is reimbursed.

The Registrar:

The Chairman:

S. Fabiani

J.-C. Saisset