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**Datasheet for the decision  
of 19 October 2007**

**Case Number:** J 0016/06 - 3.1.01

**Application Number:** 99118970.5

**Publication Number:** 0997900

**IPC:** G11B 20/10

**Language of the proceedings:** EN

**Title of invention:**

Method and apparatus for recording and reproducing information  
on and from disk

**Patentee:**

MATSUSHITA ELECTRIC INDUSTRIAL CO., LTD

**Headword:**

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**Relevant legal provisions:**

EPC R. 85a

**Keyword:**

"Designation fees - whether waiver under Rule 85a EPC  
cancelled by alleged mistake of EPO (no)"

**Decisions cited:**

J 0014/94, J 0017/98, J 0034/03, J 0017/04, T 0601/91

**Catchword:**

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Case Number: J 0016/06 - 3.1.01

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.01  
of 19 October 2007

**Appellant:** MATSUSHITA ELECTRIC INDUSTRIAL CO., LTD  
1006, Oaza Kadoma  
Kadoma-shi, Osaka 571-8501 (JP)

**Representative:** Manitz, Finsterwald & Partner GbR  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office of 7 April 2006.

**Composition of the Board:**

**Chairman:** B. Günzel  
**Members:** C. Rennie-Smith  
P. Schmitz

## Summary of Facts and Submissions

I. The present appeal concerns European patent application No. 99118970.5. The appeal is against the decision of 7 April 2006 of the Examining Division which held that the appellant's request for payment of the designation fee for the United Kingdom was not allowable and that the designation of the United Kingdom was deemed to be withdrawn. The appellant's notice of appeal was both dated and filed on 29 May 2006. The appeal fee was also paid on 29 May 2006 and the statement setting out the grounds of appeal was filed on 26 July 2006.

II. The relevant facts are as follows.

The appellant filed a Request for grant of a European Patent (Form 1001.1) on 27 September 1999. Under 2 in section 32 of the form the boxes for all the then current Contracting States were individually crossed. The standard-form printed waiver of a communication under Rule 85a(1) EPC appearing immediately below the listed States did not therefore apply. In a letter dated 20 December 2001, in response to a communication of 13 November 2001 from the Receiving Section regarding payment of *inter alia* designation fees, the appellant paid such fees for three States (Germany, France and Italy) and specifically requested that no communications under Rule 85a(1) and Rule 69(1) EPC be sent concerning the other Contracting States originally designated (including the United Kingdom).

On 13 June 2002, the Receiving Section sent a communication pursuant to Rules 85a and 85b EPC stating, erroneously as is not disputed, that the

examination fee and designation fees for Germany, France and Italy had not been paid. The appellant replied by fax of 24 June 2002 drawing attention to the payment made on 20 December 2001 and enclosing a copy of its letter of that date endorsed with the EPO's stamped date of receipt. The faxed letter concluded with the following paragraph:

"We therefore request to confirm immediately that the above communication can be disregarded and that the examination fee and also the designation fees for Germany, France and Italy have timely been paid."

A reply of 5 July 2002 from a Formalities Officer acknowledged that the previous communication had been sent in error and confirmed that the appellant's fax had been sent to the Cash & Accounts department for the fees to be booked. The file shows that the fees were booked on 9 July 2002 but with an effective date of 20 December 2001. In the body of the EPO letter the appellant's fax was erroneously referred to as being dated "20/06/02" but the heading of the letter read correctly "Subject: Your letter of 24/06/02".

The Examining Division issued a communication under Rule 51(4) EPC dated 20 October 2005 which mentioned Germany, France and Italy as designated states. In a letter dated 12 January 2005 (but received on 12 January 2006 and no doubt in fact sent on that date) the appellant requested that the designation fee for the United Kingdom be paid from its deposit account or alternatively, if the EPO should consider that request too late, a decision which could be appealed.

III. The Examining Division's decision acknowledged that the communication of 13 June 2002 was issued despite the prior waiver of 20 December 2001 but observed the mistake was acknowledged as soon as it was challenged by the appellant and the designation fees for Germany, France and Italy were treated as paid in time. The appellant did not suffer any disadvantage as a result of the mistake and cannot establish a link between that mistake and its subsequent failure, through of its own volition not being notified, to obtain protection for the United Kingdom. The reference to an incorrect date in the EPO's fax of 5 July 2002 had no effect, as the correct fees were subsequently paid as requested by the appellant.

The decision under appeal also referred to case-law (J 14/94, OJ EPO 1995, 824, point 8 of the Reasons; J 17 /98, OJ EPO 2000, 399; J 34/03 of 14 October 2005, point 8 of the Reasons; T 601/91 of 27 July 1993, point 1.1 of the Reasons) showing that the principle of legitimate expectations requires that communications are clear and unambiguous and parties must not suffer as a result of relying on misleading information. However, that principle did not apply in this case as the United Kingdom designation was lost by failure to pay the designation fee by 7 May 2002 and the alleged loss of the right to be notified resulted directly from the appellant's waiver of 20 December 2001.

IV. The Board issued a written communication dated 20 April 2007 containing its preliminary views which were substantially as the reasons set out below. The appellant replied by filing further written submissions

dated 18 June 2007 in which it also requested oral proceedings which were held on 19 October 2007.

V. The appellant's arguments, in writing and at the oral proceedings, can be summarised as follows.

The decisions J 14/94, J 17/98 and T 601/91 (see III above) illustrate the principle of legitimate expectations. In T 601/91 it was said (at point 1 of the Reasons):

"In application of the principle of good faith governing relations between the EPO and the users of the EPO system, a party to the proceedings before the EPO should not suffer a disadvantage as a result of having been misled by an erroneous communication of the EPO."

In J 17/04 of 9 April 2005 it was said (see point 12 of the Reasons):

"As a result of these considerations, the Board holds that an applicant is allowed to rely on a possible interpretation of a EPO form under the principle of legitimate expectations even if another interpretation is more current."

So a party may rely on the less probable interpretation of a mistaken communication. The present case is similar to J 17/04 which held that an applicant has a right, which can only be renounced by an unambiguous declaration, to a Rule 85a EPC communication and the EPO has a duty to send such a communication (see J 17/04, points 8 and 13 of the Reasons). Even when a

waiver is given, a subsequent unclear communication from the EPO means the applicant then has the right to a Rule 85a EPC communication.

In the present case the communication of 13 June 2002 showed, on one possible interpretation, that the letter of 20 December 2001 containing the waiver had not reached the EPO file and thus had been "not officially recognised", so the appellant considered not only that the designation fees had not been paid but also that the waiver had no effect, in which case a communication under Rule 85a(1) EPC could have been expected.

On an alternative interpretation of the 13 June 2002 letter, the appellant assumed that the monies it intended to be debited from its account to pay the designation fees for Germany, France and Italy were in fact used to pay other designation fees and therefore the communication of 13 June 2002 was a reminder that only those three countries were unpaid. The ambiguous nature of the 13 June 2002 letter explains why the appellant asked in its letter of 24 June 2002 for it to be disregarded and, in that letter, did not waive its right to a notice under Rule 85a(1) EPC.

There was then a further misleading communication from the EPO of 5 July 2003 which referred to a letter dated 20 June 2002 which did not exist and did not indicate which designation fees were then being paid. The reference to a letter dated 20 June 2002 might have been a simple error but another interpretation is that it was a mistaken reference to another case, perhaps another case handled by the representative's firm. The appellant assumed that the expected Rule 85a EPC

communication would clarify this ambiguity, allowing it to decide what other designation fees should then be paid with a surcharge.

An applicant can designate states at any time until the end of the time limit for doing so. In the present case, the time limit for payment with a surcharge expired on 7 July 2002, two days after the second misleading communication. So at the expiry of the time limit the applicant knew that a mistake had been made but not what form that mistake took, namely which designation fees were paid or not paid.

Lastly, the appellant argued that the absence in the decision under appeal of any statement as requested, giving a correct notification under Rule 85a(1) EPC for the remaining originally designated states before issuing a decision to grant, in itself meant the decision was incomplete and must be cancelled.

- VI. The appellant requested that the decision under appeal be set aside and confirmation that GB is validly designated or, as auxiliary request, either that the Board order the issue of a Rule 85a(1) EPC communication for the originally designated but unpaid states or that the case be remitted to the first instance for that purpose.

### **Reasons for the Decision**

1. The appeal is admissible.
2. For any of the appellant's arguments to succeed, it would have to satisfy the Board that the waiver it gave



by its representative's letter of 20 December 2001 ceased to have effect. The appellant argues that was in fact the case because of mistakes in the EPO communications of 13 June 2002 and 5 July 2002 which lead to such an uncertainty with regard to the designation fees that a Rule 85a EPC communication was required. However, the true nature of the mistake which gave rise to the events on which the appellant now relies was not any communication but the overlooking by the EPO of the payment of the designation fees for Germany, France and Italy which had not been debited from the appellant's representative's deposit account as instructed by the representative's letter of 20 December 2001. That mistake was corrected as soon as, in reply to the communication of 13 June 2002, the appellant brought the true position to the attention of the EPO by its letter of 24 June 2002 - the fees were debited as if that had been done on 20 December 2001. The request in the appellant's letter of 24 June 2002 (see II above) was allowed in full and immediately.

3. Nothing that could have any other consequence can plausibly be read into the correspondence between the appellant and the EPO. The appellant's letter of 20 December 2001 clearly did reach the EPO - the appellant enclosed a copy of it bearing the EPO's receipt-stamp with its later letter of 24 June 2002 - and the letter of 24 June 2002 was acted upon with effect from the date of the earlier letter.
  
4. As regards the use of an incorrect date for that letter in the EPO letter of 5 July 2002, such accidental use of incorrect dates can happen - as the appellant's own misdating of its letter of 12 January 2006 as

12 January 2005 shows. However, in its context there is no possibility to see the letter referred to in the EPO letter of 5 July 2002 as any other than the appellant's letter of 24 June 2002 (correctly identified by the words "Subject: Your letter of 24/06/02" in the heading of the EPO letter) which in turn enclosed a copy of its letter of 20 December 2001. However, it would not matter which letter the author of the EPO letter intended to refer to - whether one of the appellant's letters or, as the appellant now suggests, a letter in another case - since the result was exactly that intended by the appellant, namely retraction of the communication of 13 June 2002 and payment of the three requested designation fees as of 20 December 2001.

5. The appellant's suggested alternative interpretation of the communication of 13 June 2002 - that it showed that monies intended to pay the designation fees for Germany, France and Italy were used to pay other designation fees - is equally implausible but, if that thought had in fact ever occurred to anyone, it would have been instantly dispelled by simply reading the relevant correspondence on file: in response to the appellant's letter of 24 June 2002, which quite naturally reacted to the communication of 13 June 2002 by observing the designation fees for Germany, France and Italy had already been paid and asking that that communication be disregarded, the EPO letter of 5 July 2002 said the 13 June 2002 communication had been sent in error and the three designation fees were to be booked. The only possible interpretation of this sequence of correspondence is that as requested the EPO corrected its own original mistake - the failure to act on the request of 20 December 2001 to pay those three

designation fees. Accordingly, at that point in time matters were exactly as the appellant had requested - three designation fees had been paid as of 20 December 2001 for Germany, France and Italy and a waiver was in place as regards all other designations.

6. It was for the appellant to ensure that payment of any other designation fees was made by the latest possible date, namely 7 May 2002 or, with surcharge, 7 July 2002. It would appear that the appellant overlooked such payment and now seeks to overcome its mistake by a hindsight re-appraisal of correspondence. That re-appraisal is based on the appellant's interpretations of the communication of 13 June 2002 which are in turn relied on to support the statement that the appellant would have then expected or assumed the EPO to take certain steps. However, the mere non-fulfilment of such self-created expectations cannot amount to any failure by the EPO. That is wholly different from the principle of legitimate expectations - that principle can only be invoked where it has been proved that a party has suffered a disadvantage as a result of the EPO having, in whole or in part, not done something as it should, as happened in the cases on which the appellant relies (see V above). Since the appellant's present situation results entirely from acts it has itself done or not done - namely filing a waiver of its right to a communication under Rule 85a(1) EPC and subsequently not paying the designation fee for the United Kingdom in time - there is nothing the EPO should have done and therefore no legitimate expectation which has been unfulfilled.

7. The appellant's final argument (see V above), that the decision under appeal is defective because it makes no statement giving a correct communication under Rule 85a(1) EPC, is self-serving. If no such communication was ever required, its absence in the decision under appeal cannot be incorrect. In any event, it seems clear from the reasons for its decision that the Examining Division was of the view that no such communication was to be issued.
  
8. The Board finds that the decision under appeal was correctly decided and the appeal must therefore be dismissed.

## **Order**

### **For these reasons it is decided that:**

The appeal is dismissed

The Registrar:

The Chairman:

S. Fabiani

B. Günzel