

## **Decision of the Legal Board of Appeal dated 31 March 2008 J 10/07 - 3.1.01**

(Translation)

Composition of the board:

Chairman: B. Günzel  
Members: C.-P. Brandt  
G. Weiss

**Appellant: Amazonen-Werke H. Dreyer GmbH & Co. KG**

**Headword: Subsequent filing of drawings/AMAZONEN-WERKE**

**Article: 80, 106, 108, 109, 111 EPC**

**Rule: 40(1)c), 56, 99 EPC**

**Article: 11, 24 RPBA (2007)**

**Article: 5 PLT**

**Relevant legal provisions (EPC 1973):**

**Article: 106, 108, 109, 111(1) EPC**

**Rule: 43(1), (2), (3), 64, 67 EPC**

**Keyword: "Transitional provisions of the EPC 2000" - "Subsequent filing of drawings not contained in the original application; re-dating of the application (no)" - "Substantial procedural violation (yes)" - "Reimbursement of appeal fee (yes)" - "Protection of legitimate expectations"**

*Headnote:*

*On the question of the applicability of the EPC 1973 or EPC 2000 in accordance with the transitional provisions of the EPC 2000 (see Points 1, 3, 6 and 7 of the Reasons).*

### **Summary of facts and submissions**

I. The appeal is directed against a decision of the Receiving Section of 25 September 2006 refusing the appellant's application to set aside a communication under Rule 69(1) EPC 1973, issued by the Receiving Section on 12 November 2004. In the communication it had been stated that, as a result of the re-dating (from 9 October 2004 to 2 November 2004) of European patent application No. 04 024 119.2 pursuant to Rule 43(2) EPC 1973, the date of priority claimed for the application (16 October 2003) no longer lay within the twelve-month period under Article 87(1) EPC 1973.

II. On Saturday, 9 October 2004, the appellant's European patent application No. 04 024 119.2 was received by letter at the EPO. Priority was claimed from German patent application DE 1 034 806.7 of 16 October 2003.

The receipt for documents (EPO Form 1001.6; hereinafter "RD 1001.6") contains, inter alia, the following typewritten indications under point "A. Application documents and priority document(s)":

Description: Number of sheets 10; Claim(s): Number of sheets 3; Drawing(s): Number of sheets 6.

As stated in the contested decision, the number of sheets relating to the description, given as "10", was struck through and amended by hand to "6" by the staff member dealing with the application in the Post Room and Filing Office.

III. As stated in the contested decision, the appellant received - together with RD 1001.6 - EPO Form 1021, issued on Monday, 11 October 2004 by the head of the Post Room and Filing Office, containing the information that the drawings listed as attached documents were missing.

IV. In connection with the examination as to formal requirements, the communication pursuant to Rule 43(2) EPC 1973 (EPO Form 1114) was issued by the Receiving Section on 2 November 2004. The appellant was told that the examination by the Receiving Section had revealed that no drawings had been filed, although the European patent application contained references thereto. A non-extendable time limit of one month was set for filing the drawings. If the drawings were filed in due time, the application would be re-dated to the date on which the drawings were filed. Otherwise, all references in the application to the drawings would be deemed to be deleted and the initial date of filing of the application would remain unchanged. The appellant was also informed that, as a result of the re-dating of the application, the priority date claimed might cease to lie within the twelve-month priority period, which could lead to a loss of priority (Rule 43(3) EPC 1973).

V. In a letter dated 29 October 2004, received by the EPO on 2 November 2004, the appellant stated: "attached [are] ... the priority document and the drawings for the above-mentioned patent application". The drawings as filed comprised six sheets with six figures.

VI. On 10 November 2004 the Receiving Section issued a "Notification pursuant to Rule 43(3) EPC 1973", informing the appellant that "your ... application has been re-dated in accordance with your request (Rule 43(2) EPC 1973) to the date on which the drawings were filed, i.e. 2. November 2004". It was also pointed out that the loss of priority rights would be notified separately.

VII. In a further letter, received at the EPO on 11 November 2004, to which the drawings already sent by letter of 29 October 2004 were re-attached, the appellant stated that it was filing the drawings "in response to the communication of 2 November 2004".

VIII. In a communication dated 12 November 2004 ("Noting of loss of rights under Rule 69(1) EPC 1973") the Receiving Section stated that, as a result of the re-dating of the application from 9 October 2004 to 2 November 2004 pursuant to Rule 43(2) EPC 1973, the date of priority (16 October 2003) had ceased to lie within the twelve-month priority period of Article 87(1) EPC 1973.

IX. In a letter dated 15 November 2004, received at the EPO on 18 November 2004, the appellant, referring to the Receiving Section's communication of 10 November 2004 under Rule 43(3) EPC 1973, objected to the re-dating of the application and the loss of priority. The appellant explained that its internal investigations had shown that the drawings had been filed with the application. This was also apparent from the receipt issued by the EPO, which contained no reference to missing drawings. In addition to the receipt, the appellant had received a communication dated 11 October 2004 stating that the drawings were missing.

The appellant requested that the original date of filing, 9 October 2004, be recognised with priority of 16 October 2003; or otherwise that an appealable decision be issued.

X. In a letter dated 7 December 2004 the appellant reiterated its conviction that it had filed the drawings together with the application. Although it was stated in the receipt that the number of sheets had not been checked, the correction of the number of sheets of the description showed that a check had in fact been carried out. The fact that the number of sheets had not been corrected for the drawings clearly indicated that the drawings had been filed.

XI. In a letter dated 10 January 2005, the appellant applied for an appealable decision in respect of the noting of loss of rights under Rule 69(1) EPC 1973.

XII. In a letter dated 18 March 2005 the Receiving Section stated that "in consequence of the filing of the drawings on 2 November 2004 and 11 November 2004 ... the notification pursuant to Rule 43(3) EPC (EPO Form 1107) [was] despatched on 10 November 2004". The fact that the number of sheets of the description was amended in the receipt could not be regarded as proof of the filing of the drawings. Only the presence of the documents indicated was checked.

The absence of the drawings had not been noted separately in the receipt, but only on EPO Form 1021, sent with the receipt. The notifications concerning the loss of priority and the re-dating of the application were therefore upheld.

XIII. In a letter dated 11 May 2005 the appellant thereupon made a further application for an appealable decision.

XIV. By decision of 25 September 2006 the Receiving Section refused the application for a decision under Rule 69(2) EPC 1973 setting aside the noting of loss of rights under Rule 69(1) EPC 1973 and upholding the original filing date of 9 October 2004, and upheld the communication of 12 November 2004 and the filing date of 2 November 2004.

XV. In a letter dated 24 November 2006, received at the EPO on the same date, the appellant filed an appeal against this, requesting:

1. that the decision of 25 September 2006 be set aside and a declaration issued that the application, including the drawings, was accorded a date of filing of 9 October 2004, and that the priority from application DE 1 034 806.7 of 16 October 2003 was validly claimed;
2. auxiliarily, that the decision of 25 September 2006 and the communication of 12 November 2004 be set aside and the original date of filing, 9 October 2004, set as the date of filing for the documents which the Office confirmed as filed (i.e. without the drawings);
3. auxiliarily, that oral proceedings be held.

XVI. In the statement of grounds of appeal, dated 25 January 2007, it was said that the statement in the contested decision that a first check had been carried out in the Post Room on 9 October 2004 - a Saturday - did not appear to be correct. It was safe to assume that the check had been performed on the next working day, i.e. Monday, 11 October 2004, when the receipt was issued. It also remained unclear why the staff member who had corrected the number of sheets of the description should not also have corrected the number of sheets of the drawings if he found that no drawings were enclosed. The drawings of 2 November 2004 had not been filed in reply to EPO Form 1114 with the intention of accepting the legal consequence explained therein, but evidently in response to the information in EPO Form 1021, which was said to be annexed to the receipt. The appellant refers, furthermore, to the principle of the protection of legitimate expectations (J 3/87), according to which the appellant must not suffer a disadvantage from having relied on a communication which could fairly be regarded as misleading to a reasonable addressee.

Main request:

The EPO's action in issuing the receipt had not been clear and unambiguous, since the receipt indicated that drawings were present, whereas EPO Form 1021 stated that the drawings were missing. At all events, from this "note for information" (EPO Form 1021), the appellant would not have recognised the serious implications of the information, indicating that only four days remained to re-file the drawings and avoid the loss of priority. The unsatisfactory nature of the previous treatment under the EPC of allegedly missing documents in applications claiming priority of an earlier application was also evident from the fact that the future EPC 2000 had eliminated this problem with the new Rule 56(3) of the Implementing Regulations.

Auxiliary request:

Nor could it be inferred from the filing of the drawings on 9 November 2004 that the appellant intended thereby to accept the legal consequence indicated in the communication of 2 November 2004, as it had interpreted the communication as meaning that the drawings which it had sent on 29 October 2004 were still not yet in the file. From this, and from the objection immediately raised on 15 November 2004, the Office should have realised that the applicant disagreed with the re-dating of the application and the loss of priority. The relevant provision in this case was not Rule 43(2) EPC 1973, but Rule 43(1) EPC 1973, so that the appellant would have had the right to elect either to pursue the application with priority but without the drawings, or to pursue it with a loss of priority. The communication under Rule 43(1) EPC 1973 must therefore now be issued.

XVII. On 30 November 2007, the board issued a summons to oral proceedings on 9 April 2008.

In the Annex to the summons, the board set out its provisional assessment of the appeal.

(a) On the basis of the documents on file, it could not be assumed that the application documents filed with the EPO on Saturday, 9 October 2004 included drawings to the extent of the number of sheets indicated in the application form. From the procedures (explained in the communication) in the Post Room and Filing Office it also followed that the correction of the number of sheets of the description in the receipt for documents (Form 1001.6) did not permit the inference, even indirectly, that the drawings had been present on Saturday, 9 October 2004, and had only been missing on Monday, 11 October 2004. Nor had the appellant furnished any written statements or affidavits by members of its staff entrusted with despatching patent applications, or any other proof or prima facie evidence concerning the specific circumstances and acts involved in the despatch, relevant to this case, of the documents relating to EP application No. 04 024 119.

Nor was it apparent that any breach of the principle of the protection of legitimate expectations had occurred - on the basis of which the appellant would have to be placed in the same position as if the drawings had been filed, so that no loss of rights would have arisen. Nor, in the light of the consistent case law of the boards of appeal of the EPO on this issue, could such a breach be supposed to have occurred. On the basis of the facts on file, it was to be assumed that the receipt for documents (Form 1001.6) had been sent with Form 1021 to the applicant. At all events, in view of the separate notification with Form 1021 concerning the missing drawings, the applicant could not place all its trust in the indication, in the receipt, of the uncorrected number of sheets for the drawings, in contrast to the corrected number of sheets for the description, and thus infer that the drawings had been present.

Nor, contrary to the view expressed in the statement of grounds of appeal, would Form 1021 have been required to contain an indication of the "importance" of the impending loss of priority. According to decision G 2/97 of the Enlarged Board of Appeal (OJ EPO 1999, 123, 129; referring to decision J 3/87 (OJ EPO 1989, 3), cited by the appellant), the protection of legitimate expectations required the EPO to warn the applicant of any loss of rights (only) if such a warning could be expected in all good faith and if the deficiency could be readily identified by the EPO within the framework of the normal handling of the case at the relevant stage of the proceedings. In proceedings before the EPO, a warning of the impending loss of rights as a result of missing or late-filed drawings would only be issued within the framework of examination as to formal requirements under Article 91(1)(g) EPC 1973 in conjunction with Rule 43 EPC 1973, as had been done in the present case with the communication of 2 November 2004. The Post Room and Filing Office had fulfilled its obligations by issuing Form 1021, at a date which would have left more than sufficient time for the appellant to observe the priority period.

(b) The board further stated that it did, however, see a reason for setting aside the contested decision, in that the Receiving Section should not have issued the communication of 10 November 2004 under Rule 43(3) EPC 1973 at that time, as the requirements for the finding therein were not met (see, for further details, the explanations in the statement of reasons for this decision).

(c) Given these various considerations, there was no prospect for the appellant of obtaining the accord of a date of priority of 9 October 2004, retaining the references to the drawings according to the main request. However, the board intended to allow the auxiliary request to set aside the contested decision and recognise 9 October 2004 as the date of filing for the documents which the Office had confirmed as filed (i.e. without the drawings).

XVIII. In a letter dated 17 December 2007, the appellant, "in view of the comments in the Annex to the summons", withdrew its main request in the notice of appeal of 24 November 2006 and the request for oral proceedings, and asked instead for the original auxiliary request to be considered as the main request, and for a decision to be taken by written procedure.

XIX. The oral proceedings, scheduled for 9 April 2008, were thereupon cancelled.

#### **Reasons for the decision:**

By default, references in the following to EPC Articles and Rules are to the revised version of the European Patent Convention which entered into force on 13 December 2007 (EPC 2000); references to the text valid until that date are indicated by adding "1973".

1. The appeal complies with the requirements of Articles 106 to 108 and Rule 64 EPC 1973 and is therefore admissible.

1.1 Although there are no legal reservations about the admissibility of the appeal, a decision is necessary as to whether the applicable provisions are those of the EPC 1973 or the EPC in the revised text. Article 1.1, first sentence, of the decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000 (Special edition No. 1 of OJ EPO 2007, 197) states that the revised Articles 106 and 108 EPC shall apply to European patent applications pending at the time of their entry into force. Since the European patent application at issue here was pending on 13 December 2007, the revised Articles 106 and 108 EPC would be applicable, in accordance with the literal wording of the above-mentioned decision of the Administrative Council. By contrast, Article 107 EPC is not mentioned in the relevant provision of the decision of the Administrative Council; therefore, in accordance with Article 7(1), second sentence, of the Act revising the European Patent Convention of 29 November 2000 (see Special edition No. 1 of OJ EPO 2007, 196) Article 107 EPC 1973 would continue to apply, which provision, however, has remained unamended.

1.2 When examining the admissibility of the appeal, the board nevertheless referred, for the reasons set out below, to Articles 106 und 108 EPC 1973. Article 106 EPC 1973 (Decisions subject to appeal) defines what decisions of which EPO departments are appealable. Article 108 EPC 1973 governs the time limit and form of appeal, stating how and especially by when the notice of appeal and the statement of grounds must be filed.

The requirements for admissibility must be sustained throughout the duration of the appeal proceedings (see *Singer/Stauder*, EPÜ, 4th ed., Art. 110, margin number 6), i.e. approximately until a decision is issued in written proceedings or delivered at the end of oral proceedings. However, this does not answer the question as to which law should be applied at the time of examining and deciding on the admissibility of an appeal if the law has changed since the date of lodging the appeal.

Articles 106 und 108 EPC 1973 govern the requirements to be met by the date of expiry of the two-month period for filing the appeal and the four-month period for filing the written statement of grounds, in order that the appeal may be considered admissible. If these requirements are not met before the time limits expire, the appeal is to be rejected as inadmissible (Rule 65(1) EPC 1973). The purpose of setting time limits for complying with the admissibility requirements specified in these provisions is to ensure the possibility of determining, when the relevant time limits expire, whether the appeal is admissible and the board can proceed to examine whether it is allowable. Therefore, the decision as to whether an appeal can be considered admissible according to the relevant provisions, geared to the fulfilment of the requirements for admissibility within a certain legally defined period, depends entirely on the substantive and legal position at the time of expiry of the time limits. Since the belated fulfilment of admissibility requirements after the expiry of the relevant time limit cannot be taken into account in the examination of admissibility, so too a change in the legal position occurring after the expiry of the time limit for fulfilling the admissibility requirements can have no impact, either to the appellant's advantage or to his detriment, on the assessment of admissibility.

The logic of this is obvious where admissibility requirements applying at the date of expiry of the time limit, and met by the appellant, are tightened before the decision is issued. The appeal would then become retrospectively inadmissible, although it was impossible, or at any rate unnecessary, for the appellant to comply with the new provisions before the expiry of the time limit. Conversely, it would be incompatible with the principle of legal certainty for other parties to the proceedings and for third parties (e.g. in the case of a revoked patent or a refused application) if an appeal which did not meet the requirements for admissibility when the relevant time limits expired - and therefore was not eligible for examination as to allowability by the board of appeal - did after all lead to the examination of allowability because of a change in the legal position which occurred later, but before the decision was issued.

Article 1.1 of the decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000 merely provides in general terms - as an exception from the otherwise valid principle under Article 7(1), first sentence, of the Revision Act that the revised version of the Convention shall apply - only - to European patent applications filed after its entry into force - that Articles 106 and 108 EPC shall apply to European patent applications pending at the time of their entry into force. There is no indication, in the decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000 and the further transitional provisions and rules for the introduction of the revised EPC, of any intention that Articles 106 and 108 EPC should apply retroactively to appeals where the time limits for examination as to admissibility had already expired at the time of entry into force of the revised EPC and the relevant legal consequences had already arisen. On the contrary, the transitional provisions would tend to indicate, in so far as the legislator expressly refers to such cases, that this was not the legislative intention. Thus Article 1.5 of the decision of the Administrative Council provides that the new Articles 121 and 122 shall apply to European patent applications pending at the time of their entry into force, in so far as the time limits for requesting further processing or re-establishment of rights have not yet expired at that time.

Therefore, the decision in the present case regarding the applicability of Articles 106 and 108 EPC 1973 does not conflict with Article 1.1, first sentence, of the decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000; instead, it reflects the intention and purpose of those transitional provisions.

1.3 If the examination as to admissibility of the appeal in the present case is governed by the above-mentioned Articles of the EPC 1973, the same also applies to the provisions of the EPC Implementing Regulations which specify and supplement those Articles. The applicable implementing provision, therefore, is Rule 64 EPC 1973, which is linked to Article 108 EPC 1973, and not the corresponding Rule 99 EPC, which supplements Article 108 EPC. Article 2, first sentence, of the decision of the Administrative Council of 7 December 2006 amending the Implementing Regulations to the European Patent Convention 2000 (Special edition No. 1 of OJ EPO 2007, 89)

states that the Implementing Regulations to the EPC 2000 shall apply to all European patent applications in so far as they are subject to the provisions of the EPC 2000. This can only mean that a Rule of the Implementing Regulations to the EPC 2000 is to be applied where, or in so far as, the European patent application in question is subject to the Article of the EPC 2000 to which that Rule relates and which is specified and supplemented by it. Otherwise, irresolvable contradictions and legal discrepancies would arise between the applicable Articles of the EPC 1973 and the applicable provisions of the Implementing Regulations to the EPC 2000, which cannot have been the legislator's intention. This interpretation of the German version of Article 2, first sentence, of the above-mentioned decision of the Administrative Council ("Die Ausführungsordnung zum EPÜ 2000 ist auf alle dem EPÜ 2000 unterliegenden europäischen Patentanmeldungen ... anzuwenden") is confirmed by the even clearer wording of the equally binding English and French texts ("The Implementing Regulations to the EPC 2000 shall apply to all European patent applications, ..., in so far as the foregoing are subject to the provisions of the EPC 2000"; "Le règlement d'exécution de la CBE 2000 s'applique à l'ensemble des demandes de brevet européen, ..., dans la mesure où ils sont soumis aux dispositions de la CBE 2000").

2. Since the appellant has withdrawn its main request in the notice of appeal of 24 November 2006 (see point 1 thereof), a decision is no longer required as to whether - having regard also to considerations such as the principle of the protection of legitimate expectations - the application, together with the drawings, should be accorded a date of filing of 9 October 2004 and whether, therefore, a right to priority can be claimed from the German first application of 16 October 2003.

Instead, the only matter at issue is now the (sole) main request according to the letter of 17 December 2007, initially formulated as an auxiliary request in the original notice of appeal (see point 2 thereof), that the decision of the Receiving Section of 25 September 2006 (and the communication of 12 November 2004) be set aside and the original date of filing, i.e. 9 October 2004, set as the date of filing for the documents which the Office confirmed as filed (i.e. without the drawings).

3. The request is allowable if - even though no breach of the principle of the protection of legitimate expectations can be said to have occurred - the finding of the Receiving Section of 12 November 2004 concerning the loss of priority as a result of re-dating the application to the date of filing the drawings, i.e. 2 November 2004, was incorrect, so that the requirements for noting a loss of priority were not met. That is the case here.

According to the relevant transitional provisions, the fact that the decision in the present case was issued after 13 December 2007 does not entail the application of Rule 56 of the revised EPC in the appellant's favour. The appellant itself merely added, when setting out the facts in its statement of grounds of appeal, that its view that the previous EPC treatment of allegedly missing documents in applications claiming priority was unsatisfactory, because of the danger of a serious loss of rights, was confirmed by the fact that the EPC 2000 had eliminated this problem with the new Rule 56(3) EPC. Rule 56 EPC corresponds to Rule 43 EPC 1973, but provides, inter alia, the possibility, subject to the conditions specified in paragraph 3 of Rule 56 EPC, of retaining the original date of filing of the application with the initially missing and subsequently filed drawings.

Article 2 of the decision of the Administrative Council of 7 December 2006 amending the Implementing Regulations to the EPC 2000 states that the Implementing Regulations to the EPC 2000 shall apply to all European patent applications in so far as they are subject to the provisions of the EPC 2000. As already explained under point 1, this Article can only be taken to mean that the applicability of a provision of the Implementing Regulations to the EPC 2000 depends entirely on which EPC Article the implementing provision relates to, i.e. which Article is specified and supplemented by the provision, in accordance with the latter's general function as an "implementing" rule for the EPC.

Rule 56 EPC is concerned with the date of filing where parts of the description or drawings are missing. It therefore fleshes out Article 80 EPC, governing the date of filing, which is defined by reference to the requirements laid down in the Implementing Regulations. The relevant provisions of the latter are Rules 40 and 56 EPC, whose substance is designed to implement Article 5 PLT. These provisions (Rule 40(1)(c) and Rule 56(3) EPC) are based on the new concept whereby the documents required for the accordance of a date of filing do not, under certain circumstances, immediately have to be physically present; instead, they can be introduced into the proceedings by being contained in another application. This change of approach is clearly the reason why Article 80 EPC is not included in the list of provisions applicable to applications pending at the time of the entry into force of the EPC 2000. Therefore, Article 80 and Rule 56 EPC apply only to applications filed after the entry into force of the EPC 2000, and so, in the present case, the EPC 1973 continues to apply.

4. The finding in the communication of the Receiving Section dated 12 November 2004 that priority was not claimed - because, "as a result of the re-dating of the application pursuant to Rule 43(2) EPC 1973 (EPO Form 1114), the date of priority claimed for the application no longer lies within the twelve-month priority period" - was based on incorrect facts and therefore objectively involved a substantial procedural violation.

4.1 The communication pursuant to Rule 43(2) EPC 1973 sent by the Receiving Section on 2 November 2004 (EPO Form 1114) was, objectively, wrongly issued on that date. The drawings sent with the appellant's letter of 29 October 2004 were received at the EPO on 2 November 2004. At this point in time, therefore, drawings had been filed with the EPO, so on 2 November 2004, the date relevant for the issue of the communication by the Receiving Section, a case according to Rule 43(2) EPC 1973 was objectively no longer in existence.

Therefore, on the basis of the objective procedural situation, the Receiving Section should have issued a communication pursuant to Rule 43(1) instead of Rule 43(2) EPC 1973 on 2 November 2004.

4.2 The appellant's letter of 29 October 2004 and the communication issued by the Receiving Section (Form 1114) on 2 November 2004 evidently crossed. This means, furthermore, that the filing of the drawings with the letter of 29 October 2004 could indeed only be a response to the reference by the Post Room and Filing Office on 11 October 2004 (Form 1021) to the missing drawings, and not to the communication from the Receiving Section dated 2 November 2004 mentioning, for the first time, the legal consequences pursuant to Rule 43(2) EPC 1973.

From this, too, it follows that the notification pursuant to Rule 43(3) EPC 1973 issued by the Receiving Section on 10 November 2004 informing the appellant that the application had been "re-dated ... to the date on which the drawings were filed, i.e. 2. November 2004" did not reflect the facts of the situation and the resultant legal position at that date and therefore was substantively and legally incorrect. On 10 November 2004 the Receiving Section could and should have recognised - since it was obvious from the file that the relevant letters had crossed - that the filing of the drawings with the appellant's letter of 29 October 2004 was not a response to the communication issued only later, on 2 November 2004, by the Receiving Section, and therefore did not constitute a decision in favour of the late filing of drawings with re-dating of the application and thus could not be a request under Rule 43(1) EPC 1973.

4.3 In its letter of 9 November 2004, received at the EPO on 11 November 2004, re-submitting the drawings within the time limit of one month set in the Receiving Section's communication of 2 November 2004, the appellant did indeed refer expressly to the communication of 2 November 2004. It is true that this statement and procedural act can only be interpreted as meaning that the appellant, having become aware of the legal consequences, had opted for one of the possibilities under Rule 43(2) EPC 1973 referred to in the Receiving Section's communication of 2 November 2004, i.e. in this case for the re-dating of the application to the date of filing the drawings, with the resultant loss of priority. However, the statement could have no legal force, since the time limit set by the Receiving Section under Rule 43(2) EPC 1973 was itself invalid because the relevant requirements under this Rule were not met. Nor can the statement be regarded as a request according to Rule 43(1) EPC 1973, as it was only received on 11 November 2004, i.e. after the Receiving Section issued its notification of 10 November 2004.

Nor, therefore, in view of the obvious time overlap, can the notification pursuant to Rule 43(3) EPC 1973, issued by the Receiving Section on 10 November 2004, regarding the re-dating of the application to 2 November 2004, refer to the letter of 9 November 2004 with the drawings, which only arrived a day later, on 11 November 2004; consequently, too, the requirements for the findings and legal consequences mentioned in that notification were not met.

4.4 From the circumstances described above, it follows, on the one hand, that the finding in the communication under Rule 69(1) EPC 1973 issued by the Receiving Section on 12 November 2004 that, "as a result of the re-dating of the application pursuant to Rule 43(2) EPC 1973 (EPO Form 1114), the date of priority claimed for the application no longer lies within the twelve-month priority period" was based on incorrect facts and, therefore, that the conditions giving rise to the legal consequences mentioned in the communication are not met.

From the above, it also follows that, after the appellant had sent the drawings, no communication as prescribed under Rule 43(1) EPC 1973 was issued, either on 2 November 2004 or on 11 November 2004, and therefore, that the application could not be re-dated. Therefore, the legal requirements for the notification, in the Receiving Section's communication of 12 November 2004, of a loss of rights under Rule 69(1) EPC 1973 were not met. For the reasons indicated above, the communication of 12 November 2004 is generally marred by fundamental legal deficiencies and therefore cannot be upheld.

5. The Receiving Section is not to be blamed for issuing the communication under Rule 43(2) EPC 1973, as the drawings cannot yet have been in the file at that date. In that case, however, the Receiving Section should not have issued the notification of 10 November 2004 under Rule 43(3) EPC 1973. Instead, a communication pursuant to Rule 43(1) EPC 1973 should have been issued. This amounts to a substantial procedural violation.

Had this step been taken, the appellant - while forfeiting the references to the drawings - could have kept the original date of filing, 9 October 2004, and, to this extent, the claimed priority of 16 October 2003. Therefore, a legally correct procedure before the Receiving Section could have enabled the appellant to achieve a position corresponding to its original auxiliary request, which is now its sole main request.

6. Having regard to the special circumstances of the present case, the board is deciding on the matter itself instead of remitting it to the Receiving Section. The legal basis for this is Article 111(1) EPC 1973 in conjunction with Article 11 of the Rules of Procedure of the Boards of Appeal of the EPO (RPBA) as amended by decision of the Administrative Council of 25 October 2007 (OJ EPO 2007, 536), which under Article 24 RPBA shall enter into force upon entry into force of the revised text of the European Patent Convention on 13 December 2007. Article 111 EPC, which remains unchanged by the revision of the EPC, is not mentioned in Article 1.1, first sentence, of the decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000 (Special edition No. 1 of OJ EPO 2007, 197), so that, in accordance with Article 7(1), second sentence, of the Act revising the European Patent Convention of 29 November 2000 (Special edition No. 1 of OJ EPO 2007, 196) the EPC 1973 version of this provision continues to apply.

"Special reasons" within the meaning of Article 11 RPBA present themselves here for not remitting the case. In particular, remittal would conflict with the principle of procedural economy, since on the one hand the patent application at issue has now been pending for over three years - and a substantial part of the responsibility for the delay lies with the Receiving Section, which took over eighteen months to issue an appealable decision as requested by the appellant. Furthermore, remittal and the issuing of a communication pursuant to Rule 43(1) EPC 1973 by the Receiving Section would only lead to the same outcome as that sought by what is now the appellant's main request, i.e. the retention of 9 October 2004 as the date of filing, with the deletion, in accordance with Rule 43(1), first alternative, EPC 1973, of the references to the drawings. Since the appellant has exercised its right of choice pursuant to Rule 43(1) EPC 1973 in the proceedings before the board of appeal, there is no need to issue a communication under Rule 43(1) EPC 1973.

7. The fee for appeal is reimbursed on grounds of equity. The board's understanding is that the applicable provision in this regard is Rule 67 EPC 1973, not the substantively identical Rule 103 of the revised EPC.

Rule 103 EPC, like the previous Rule 67 EPC 1973, is linked to Articles 109 and 111 EPC, whose substance has remained unchanged, with only minor editorial amendments. From Article 1.1, first sentence, of the decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000 (see above), it follows that the revised Articles 109 and 111 EPC do not apply to European patent applications pending at the time of their entry into force. Therefore, in accordance with Article 7(1), second sentence, of the Act revising the European Patent Convention of 29 November 2000 (see above), Articles 109 and 111 EPC 1973 continue to apply, so that Rule 67 EPC 1973 is to be considered the legal basis.

Under Rule 67, first sentence, EPC 1973, the reimbursement of appeal fees shall be ordered where, inter alia, the appeal is deemed to be allowable and such reimbursement is equitable by reason of a substantial procedural violation. That is the case here. Allowability on the sole basis of an auxiliary request is also a sufficient ground for reimbursement (see *Singer/Stauder*, EPÜ, 4th ed., Art. 111, margin number 38). Rule 67, first sentence, EPC 1973 does not make the order to reimburse appeal fees conditional on the filing of a request to this end - which the appellant did not do in the present case.

7.1 The appellant's own behaviour admittedly contributed to the legally flawed procedure before the Receiving Section with regard to the noting of loss of rights under Rule 69(1) EPC 1973, as described above (see also, on this issue, J 18/96, OJ EPO 1998, 403, 411, point 5 of the Reasons). The appellant could have responded without further ado to the communication from the Post Room and Filing Office dated 11 October 2004 by filing the drawings within the twelve-month priority period in order to avoid the loss of priority owing to the re-dating of the application, and could thus have achieved the aim of obtaining a date of filing, while retaining the drawings, within the priority period. From the date of receiving EPO Form 1021 on 11 October 2004, as confirmed by the appellant in its letter of 15 November 2004, there was a week left for the appellant to file the drawings and preserve priority. The German prior application had a filing date of 16 October 2003, but since 16 October 2004 was a Saturday, the time limit for filing the subsequent application did not expire until Monday, 18 October 2004 (see also, on this issue, *Singer/Stauder*, op.cit., Art. 87, margin number 44).

The appellant, furthermore, went on to file drawings belatedly again, on 29 October 2004 and 9 November 2004, without giving the slightest indication to the EPO that, in its opinion, the drawings had already been filed on



9 October 2004. The first submission to this effect was in the appellant's letter of 15 November 2004, in response to the notification, in the Receiving Section's communication of 12 November 2004, of a loss of rights. Until 18 November 2004, when the letter of 15 November 2004 reached the EPO, there was no reason for the Receiving Section to make any enquiries or investigations as to the whereabouts of drawings allegedly filed on 9 October 2004. Instead, the appellant itself, by twice sending sets of drawings without further comment, allowed the Receiving Section to assume that it (the appellant) also believed that the drawings had not originally been filed.

7.2 Nevertheless, the main cause, which ultimately necessitated the filing of the appeal, lay in the above-mentioned substantial procedural violation by the Receiving Section. As explained above (see, in particular, points 4.4 and 5 of the Reasons), the communication pursuant to Rule 43(2) EPC 1973 was objectively, wrongly issued, because, in view of the drawings which had already been received at the EPA on that date, the requirements for a communication under Rule 43(1) EPC 1973 had been met. No subjective blame can be attributed to the Receiving Section for this procedural violation, since the filing of the drawings crossed with the issuing of the communication of 2 November 2004; however, the communication of 10 November 2004 pursuant to Rule 43(3) EPC 1973 should not have been issued. By this point at the latest, and also in the further course of the proceedings, the Receiving Section could and should have recognised that the position had changed in a way that categorically required the issuing of a communication under Rule 43(1) EPC 1973 - setting aside, if need be, the communication of 2 November 2004.

Had the Receiving Section followed the legally prescribed course of action, it is entirely conceivable that the appellant would then already have consented, in the procedure before the Receiving Section, to the deletion of the drawings and the references thereto. This would have corresponded to the outcome sought and obtained by the appellant in the appeal proceedings according to the auxiliary request in the original notice of appeal, which is now the sole main request; in all probability, therefore, if the Receiving Section had followed the legally correct procedure, the filing of an appeal would not have been necessary. Under these circumstances, reimbursement of the appeal fee is equitable.

**Order:**

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

1. The decision of the Receiving Section of 25 September 2006 is set aside.
2. European patent application No. 04 024 119.2 is accorded a date of filing of 9 October 2004. The references to the drawings in European patent application No. 04 024 119.2 are deemed to be deleted.
3. The reimbursement of the appeal fee is ordered.