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**Datasheet for the decision
of 3 December 2012**

Case Number: J 0010/11 - 3.1.01
Application Number: 05796511.3
Publication Number: 1789878
IPC: G06F 9/46, H04L 29/08,
H04L 29/06
Language of the proceedings: EN

Title of invention:

Systems and methods enabling interoperability between network centric operation (NCO) environments

Applicant:

The Boeing Company

Headword:

-

Relevant legal provisions:

EPC Art. 108
EPC R. 99(2), 101(1)

Relevant legal provisions (EPC 1973):

EPC R. 67

Keyword:

"Admissibility of appeal: statement of grounds of appeal compliant with Article 108 EPC (no) "

Decisions cited:

J 0022/86, T 0220/83, T 0162/97, T 0177/97, T 0573/09

Catchword:

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Case Number: J 0010/11 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 3 December 2012

Appellant: The Boeing Company
(Applicant) 100 North Riverside Plaza
Chicago, IL 60606 (US)

Representative: Land, Addick Adrianus Gosling
Arnold & Siedsma
Sweelinckplein 1
NL-2517 GK Den Haag (NL)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 20 June 2011.

Composition of the Board:

Chairman: B. Günzel
Members: B. Müller
R. Cramer

Summary of Facts and Submissions

- I. The appeal is directed against the decision by the formalities officer of the examining division of 20 June 2011. By that decision the appellant's request of 3 December 2008 for a refund of a fee paid for further processing of European patent application number 05796511.3 was rejected.
- II. The sequence of events leading to the decision impugned originated in the examining division's invitation to the appellant to respond to its communication pursuant to Article 94(3) EPC of 14 April 2008, i.e. an examination report, within a period of six months.
- III. Due to the fact that the six-month period had been wrongly coded as a four-month period in the EPO's computer system, the examining division, on 25 September 2008, issued a communication noting a loss of rights pursuant to Rule 112(1) EPC. With a letter dated 10 October 2008 the appellant informed the EPO of the error requesting "to receive a reversal of this Communication before the due date of October 24 next". In reaction thereto the EPO cancelled the noting of loss of rights on 15 October 2008.
- IV. On 24 October 2008 the appellant filed a request to extend the six-month period in question by two months. On 5 November 2008 the formalities officer, using EPO Form 2018, refused that request. On that form the box adjacent to the following sentence was ticked: "The reasons given in the request are not sufficient, see Guidelines EPO, Part E-VIII, 1.6."

- V. With a communication of 28 November 2008 the examining division again noted a loss of rights pursuant to Rule 112(1) EPC. In that communication it was stated that the application in suit was deemed to be withdrawn under Article 94(4) EPC because the invitation to file observations on the communication by the examining division dated 14 April 2008 had not been complied with.
- VI. On 3 December 2008, the appellant requested further processing of the application in suit, paid the corresponding fee of € 210 and carried out the omitted act, i.e. filed the response to the examination report. The appellant also requested a decision for refund of the fee for further processing because the first extension of time should have been allowed, without any need for giving reasons in the respective request, due to the special circumstances surrounding the EPO's erroneous (first) noting of loss of rights of 25 September 2008. The EPO's mistake had been corrected by the communication dated 15 October 2008 which had only been received by the appellant's representative on 20 October 2008. The representative needed more time than four days "to handle the file".
- VII. On 16 December 2008 the request for further processing was granted.
- VIII. In a letter of 23 February 2011 the appellant referring to its previous letter of 3 December 2008 requested confirmation of the refund of the fee for further processing.
- IX. In the decision impugned of 20 June 2011 the formalities officer of the examining division rejected

the appellant's request for refund of the fee for further processing on the basis that the appellant had been afforded a period of six months for filing a response to the examination report. The appellant's representative should have known that sufficient reasons had to be given for a request for extension of time, acceptance of which would lead to a total period set exceeding six months. In this respect the division (at point 1 of the Reasons) referred to the Guidelines for Examination in the EPO (hereinafter: "Guidelines"): According to the Guidelines E-VIII, 1.6, a request for a longer extension should be allowed only **exceptionally**, when the reasons given are sufficient to show convincingly that a reply in the period previously laid down will not be possible especially if the **total period** set **exceeds six months**. (Emphasis added.)

The unintentional mistake by the EPO in noting a loss of rights in error "can not [sic] be regarded as **exceptional** circumstances". (Emphasis added.)

- X. With a letter received on 15 July 2011, the appellant filed an appeal and a statement of grounds of appeal, the latter comprising little more than one page. The appellant also paid the appeal fee. It requested reimbursement of both the fee for further processing and the appeal fee. Referring to the examining division's opinion given in the decision impugned that "an unintentional mistake by EPO cannot be regarded as exceptional circumstances" the appellant argued: "This statement is clearly erroneous as most time limits are entered correctly into the EPO computer system". There was a legitimate expectation that the information given by the EPO could be taken at face value. The applicant and its representative were in good faith under the impression that an extension of two months would be

available "under the circumstances". It had taken a reminder after more than two years' time before any action had been taken, after the EPO had refused to take blame for its mistakes. "For that reason the decision and not replying to our request in 2008 should be considered a violation of proceedings".

XI. In a communication of 8 March 2012 the board expressed the preliminary opinion that the statement of grounds of appeal did not satisfy the provisions of Article 108 and Rule 99(2) EPC and the appeal would accordingly have to be rejected as inadmissible under Rule 101(1) EPC. From the statement of grounds it was not possible to understand immediately why the decision by the examining division rejecting a refund of the fee for further processing was alleged to be incorrect. The appellant relied on exceptional circumstances being the EPO's erroneous coding of the time limit and the delay in delivering a decision but made no submissions as to why those allegedly exceptional circumstances had made it impossible to file a timely reply.

XII. In a letter of reply of 8 May 2012 the appellant argued that, under point 1.2(ii) of Part E, Chapter VIII of the EPO Guidelines, the EPO should set a time limit of four months. Under point 1.6 it was the assumption that such a time limit had been set and that a first two-month extension was always available for obvious reasons rooted in the standard work flow in a patent law firm. Under that standard work flow, an EPO communication was sent to the overseas applicant with an indication of when a reply was due. The patent attorney took up the file again as soon as the time limit for reply to a communication by the EPO

approached. If no instructions had been received from the applicant, then, if possible, the patent attorney drafted a reply for the applicant's approval. If no proper response could be made without further instructions from the applicant, the patent attorney requested further information and an extension of time of two months from the EPO.

The EPO Guidelines did not "explicitly deal with the situation that the first time limit was (erroneously) six months". In this case the Guidelines had to be interpreted. The board of appeal was not bound by the Guidelines. In the present case the first notice of loss of rights interfered with the standard work flow. Therefore the case should be treated as if only (the usual time limit of) four months had passed (at the time the two-month extension was requested) so that a first extension should have been granted automatically. In the alternative, if the first extension were to be considered a "longer extension" (in the meaning of point 1.6 of the Guidelines), then "the sending of a Communication of loss of rights incorrectly by the EPO should had [sic] been regarded as 'exceptional circumstances' ". The appellant also requested oral proceedings in the event that the decision impugned was not reversed.

XIII. In a communication of 20 September 2012 annexed to the summons to oral proceedings, the board provisionally rejected this view. From the Guidelines (points 1.2 (ii) and 1.6 referred to above) it followed that the original time-limit of six months was not per se erroneous. It also followed that a request for extension of the six-month period had to be reasoned

and should be allowed only exceptionally. The board reiterated its position that the incorrect noting of loss of rights could not be regarded as obvious exceptional circumstances making it impossible for the appellant to file a timely reply.

- XIV. In a letter of reply of 2 November 2012, the appellant repeated that "[t]he time limit set by the Office should have been treated as a four months' time limit, so that the Guidelines for the longer extension are not applicable". There was no reason for the examining division to set a six-month time period because "there were no circumstances for which a four months [sic] time limit could not be adhered to ...".

The representative requested that the board withdraw the reasoning under point 5 of the communication annexed to the summons to oral proceedings. The representative's letter of 8 May 2012 did not indicate that the file had been left in the cupboard and that no contact with the applicant had taken place.

- XV. In the oral proceedings held on 3 December 2012 the appellant added to its previous submissions that there were legitimate expectations to the effect that any first extension of the period set for filing observations to a communication pursuant to Article 94(3) EPC would be granted. During years of practice a first extension had always been granted, even in case of an initial time-limit of six months and notwithstanding the wording of the pertinent part of the EPO Guidelines. The applicant's legitimate expectations were expressed in the final paragraph of page 1 of the statement of grounds of appeal:

"Applicant and the undersigned were in good faith under the impression that an extension of two months would be available **under the circumstances**" (emphasis added).

XVI. In the oral proceedings the appellant requested that the decision under appeal be set a side, that the fee for further processing be reimbursed and that the appeal fee be reimbursed. At the end of the oral proceedings the board gave its decision.

Reasons for the Decision

1. The connection between the request for refund and the non-extension of the six-month time limit

The board recalls that it was the rejection of the request for extension of the six-month time limit set to respond to the communication of 14 April 2008 and the noting of loss of rights of 28 November 2008 for lack of a response that triggered the appellant's request for further processing, the payment of the corresponding fee and the request for a decision on the refund of that very fee based on the assertion that the request for extension should have been allowed.

The present appeal is confined to contesting the secondary decision rejecting the request for reimbursement of the fee for further processing. No final decision on the primary request to grant a patent has been issued as of yet.

Prior to any consideration of the question of whether the rejection of the request for extension of the six-

month time limit was in compliance with the law, the board has to examine whether the appeal is admissible.

2. Admissibility: the statement of grounds of appeal

2.1 The legal framework

One of the conditions of admissibility of the appeal is that the statement of grounds of appeal satisfies the provisions of Article 108, third sentence, and Rule 99(2) EPC. Otherwise, the appeal must be rejected as inadmissible under Rule 101(1) EPC.

According to Article 108, third sentence, EPC "[w]ithin four months of notification of the decision, a statement setting out the grounds of appeal shall be filed in accordance with the Implementing Regulations." Pursuant to Rule 99(2) EPC, "[i]n the statement of grounds of appeal the appellant shall indicate the reasons for setting aside the decision impugned, or the extent to which it is to be amended, and the facts and evidence on which the appeal is based."

If the appellant submits that the decision under appeal is incorrect, then the statement setting out the grounds of appeal must enable the board to understand immediately why the decision is alleged to be incorrect and on what facts the appellant bases its arguments, without first having to make investigations of its own (cf. T 220/83 of 14 January 1986, OJ EPO 1986, 249, point 4 of the Reasons and T 177/97 of 8 June 1999, point 1 of the Reasons; affirmed by numerous decisions, and in particular recently by T 573/09 of 26 September 2012, point 1.1 of the Reasons).

Whether the requirements of Article 108, third sentence, EPC in conjunction with Rule 99(2) EPC are met has to be decided on the basis of the statement of grounds of appeal and of the reasons given in the contested decision (see, e.g., J 22/86 of 7 February 1987, OJ EPO 1987, 280, point 2 of the Reasons; T 162/97 of 30 June 1999, point 1.1.2 of the Reasons).

Exceptionally, it has been acknowledged that "the requirement for admissibility [laid down in Article 108, third sentence, EPC 1973] may be regarded as satisfied if it is immediately apparent upon reading the decision under appeal and the written statement [of grounds] that the decision should be set aside" (see J 22/86, *ibid.*, Headnote I).

2.2 The reasons given in the decision impugned

In order to determine whether it is possible for the board to understand immediately why the decision by the examining division rejecting a refund of the fee for further processing is alleged to be incorrect and should therefore be set aside, the board notes that the examining division provided the following reasons for its confirmation of the refusal of the appellant's request for extension of the six-month period:

(i) No reasons were given in that request why exceptionally an extension should be allowed.

(ii) The EPO's unintentional erroneous first noting of loss of rights could not be regarded as exceptional circumstances justifying such extension. This is

because the appellant had been afforded a period of six months for filing a response to the examination report. The appellant's representative should have known that, in accordance with point 1.6 of Part E, Chapter VIII of the EPO Guidelines, sufficient grounds had to be given for a request for extension of time, acceptance of which would lead to a total period set exceeding six months.

The examining division concluded from the above reasons that the request for reimbursement of the fee for further processing had to be rejected.

2.3 The content of the statement of grounds

2.3.1 Re reason (i)

In the statement of grounds, the appellant did not allege that it had filed any reasons together with its request for extension according to which such extension should exceptionally be allowed.

2.3.2 Re reason (ii) above

The examining division, under point 3 of the Reasons of the decision under appeal, found that "the unintentional mistake made by the EPO [i.e. the first noting of loss of rights having been issued in consequence of the erroneous coding of a four month time-limit] ... can not [sic] be regarded as exceptional circumstances" (making a reply in the six-month period impossible).

The appellant, in the brief statement of grounds comprising little more than one page, has not made it clear why this finding is allegedly incorrect.

In the fourth paragraph of the statement of grounds, referring to the above-quoted portion of the decision impugned, the appellant argued as follows: "This statement is clearly erroneous as most time limits are entered correctly into the EPO computer system". The appellant thus asserted that there were exceptional circumstances being the erroneous coding of the six-month time limit as a four-month period that caused the first noting of loss of rights that was later cancelled. In this context the appellant also mentioned that it took a reminder to make the EPO act more than two years from its mistakes. Both facts ran counter to its legitimate expectations.

However, the appellant has made no submissions as to why those allegedly exceptional circumstances made it impossible for the appellant to file a timely reply, i.e. what was the causal relationship between the reasons given in the statement of grounds of appeal and the asserted invalidity of the findings of the decision impugned. Such submissions would have been necessary because a causal relationship is not obvious in the present case. The examining division's communication of 14 April 2008 unambiguously invited the appellant to reply within a period of six months that expired on 24 October 2008, i.e. the date when the appellant filed its request for extension that included no reasons. It is not clear what impact the erroneous loss-of-rights communication by the EPO of 25 September 2008 according to which the time limit had expired two months earlier

(than 24 October 2008) could have had on the appellant's ability to reply within the six-month period. This is even less so as it had been the appellant itself that had spotted the error and informed the EPO thereof by its letter dated 10 October 2008, further to which the EPO, on 15 October 2008, cancelled the noting of loss of rights. In the letter of 10 October 2008 the appellant expressly referred to the "due date of October 24 next".

An alleged or apparent relationship (connection) between the grounds of appeal and the findings of the decision impugned, however, would have been required. Otherwise the board is not in a position to understand immediately why the decision is alleged to be incorrect as required by the case law set out above (at point 2.1). If no causal relationship in the above sense were required, then any submission, even if not having any connection with the reasons on which the decision impugned is based, would be acceptable. This would render the provisions of Article 108, sentence 3, EPC moot. It is true that, taking into account that the furnishing of a statement of grounds is a condition of the admissibility of the appeal and not of its being well-founded, the grounds do not have to be conclusive in themselves, i.e. justify the setting aside of the decision impugned. The grounds must however enable the board to assess whether or not the decision is incorrect.

2.3.3 Re reason related to the term "under the circumstances"

For the first time in the oral proceedings the appellant claimed that the portion of the grounds reading that the

Applicant and the undersigned [its representative] were in good faith under the impression that an extension of two months would be available **under the circumstances** (emphasis added)

explained why the decision under appeal was incorrect. The appellant argued that this portion expressed the legitimate expectation to the effect that any first extension of a time limit set for filing observations to a communication pursuant to Article 94(3) EPC would be granted. During years of practice a first extension of such time limit had always been granted, even in case of an initial time-limit of six months and notwithstanding the wording of the pertinent part of the EPO Guidelines.

However, the board is unable to attribute such a content to the text of the one sentence quoted above, which gives no specific indications as to the nature of the "circumstances" and immediately follows the paragraph referring to the erroneous initial coding of the time limit by the EPO. Nor can any indication to this effect be derived from the remainder of the statement of grounds, which nowhere refers to any constant EPO practice to grant a first extension of a six-month time limit in the absence of any reasons given to this end.

2.4 Whether it is immediately apparent that the decision cannot be upheld

The board cannot discern that this is an exceptional case in the sense of the last paragraph of point 2.1 above. It is not immediately apparent upon reading the decision under appeal and the written statement of grounds that the decision should be set aside.

2.4.1 The erroneous loss-of-rights communication

In the decision under appeal, the examining division (under point 2 of the Reasons) referred to the appellant's letter of 3 December 2008 in which the appellant explained that there was not sufficient time to file a response due to a mistake made by the EPO, i.e. the noting of a loss of rights in error. In that one-page letter (in its third paragraph) the appellant's representative argued that he only received the EPO's letter cancelling the (first) noting of loss of rights on 20 October 2008 and "needed more time than **four days** to handle this file" (emphasis added). The board is unable to understand this explanation. There is nothing on file suggesting that the representative was unaware at any point in time that he had a period of six months, and not four days, "to handle this file". On the contrary, as referred to under point 2.3.2 above, in its response of 10 October 2008 to the erroneous loss-of-rights communication the appellant itself expressly referred to the "due date of 24 October next" and asked for cancellation of the communication. This makes it crystal clear that the appellant was aware of the six-month time limit and that the loss-of-rights communication had no impact on

the appellant's ability or inability to respond within the time limit set.

But even if the appellant's explanations in this regard made subsequent to the statement of grounds of 15 July 2011 in its letter of 8 May 2012 could be taken into account, the board would still be unable to detect any respective serious mistake in the first-instance proceedings. In that letter the appellant's representative argued that, under the standard work flow in a firm of patent attorneys, the patent attorney took up the file of an overseas applicant again as soon as the time limit for reply to a communication by the EPO approached. If no instructions were received from the applicant, the patent attorney drafted a reply for the applicant's approval, if possible. Otherwise, the patent attorney requested further information from the applicant and an extension of time of two months from the EPO. As to the present case, the representative stated that it was only after the communication of 25 September 2008 noting a loss of rights ("After this had been redressed ..."; see letter of 8 May 2012, page 2, third paragraph) had been cancelled with a letter of 15 October 2008 received on 20 October 2008 that he started studying the case (and concluded that further information was needed from the applicant).

However, as the board had said at point 5 in its communication annexed to the summons to oral proceedings of 20 September 2012,

... it is the rationale of allowing a longer than four-month original time limit expressed in the Guidelines at point 1.2 that it must be "clear that in the circumstances a four-month time limit cannot be adhered to. ... a six-month time limit might be justified if for example the subject-matter of the application ...

or the objections raised are exceptionally complicated." This means that the representative is afforded two more months for dedicating time to working on the case and not for **leaving the file in the cupboard** and waiting until the time limit "approaches" to then contact the applicant if necessary. (Emphasis added.)

With respect to the appellant's request that the board withdraw the reasoning "under 5 of the preliminary opinion", the board notes that there is no legal basis for a board of appeal to withdraw statements of fact or conclusions of law of the kind made provisionally under point 5 of the communication annexed to the summons. The above-quoted statement by the board, being the gist of point 5 of that communication, is a general one and cannot be considered as suggesting that in the case under appeal no contact between the representative and the applicant had taken place at earlier stages of the prosecution of the present application. The board repeats that the appellant had six months and not four days "to handle this file". Hence the board could not detect any obvious serious mistake as far as the period allowed for the appellant to respond to the communication of 14 April 2008, on which the examining division's communications were based, is concerned.

2.4.2 Delay in issuing the decision impugned

The appellant also relied on the fact that the EPO issued its decision only subsequent to a reminder after more than two years' time. However, this cannot have any bearing on the question of whether the content of the decision was influenced by an obvious procedural mistake.

2.5 Conclusion

In the light of the foregoing considerations, the board has arrived at the conclusion that the statement of grounds of appeal does not comply with the provisions of Article 108 and Rule 99(2) EPC. It follows that the appeal must be rejected as inadmissible under Rule 101(1) EPC.

3. The request for reimbursement of the appeal fee

As the appeal is inadmissible, there is no basis for reimbursement of the appeal fee pursuant to Rule 67, first sentence, EPC 1973, which requires that the appeal is allowable.

Order

For these reasons it is decided that:

1. The appeal is rejected as inadmissible.
2. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairwoman:

C. Eickhoff

B. Günzel