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**Datasheet for the decision  
of 7 November 2013**

**Case Number:** J 0022/12 - 3.1.01

**Application Number:** 01963852.7

**Publication Number:** 1358272

**IPC:** B01D46/54, D01D5/00,  
D01F6/14

**Language of the proceedings:** EN

**Title of invention:**

FILTER STRUCTURE COMPRISING POLYMER NANOFIBERS

**Patent Proprietor:**

DONALDSON COMPANY, INC.

**Opponent:**

Alexander Schmitz

**Headword:**

**Relevant legal provisions:**

EPC Art. 99(3), 104, 106, 107, 109

EPC R. 101

RPBA Art. 16(1)(e)

**Keyword:**

Admissibility of an appeal against a communication issued on behalf of the Examining Division (no)

**Decisions cited:**

J 0005/81, J 0008/81, J 0010/87, T 0705/90, T 0001/92,  
J 0028/94, T 0713/02, J 0028/03

**Catchword:**



**Juristische Beschwerdekammer**  
**Legal Board of Appeal**  
**Chambre de recours juridique**

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Case Number: J 0022/12 - 3.1.01

**D E C I S I O N**  
**of Legal Board of Appeal 3.1.01**  
**of 7 November 2013**

**Appellant:**  
**(Opponent)**

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**Respondent:**  
(Patent Proprietor)

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**Decision under appeal:**

**Letter of/on behalf of the Examining Division**  
**dated 24.05.2012**

**Composition of the Board:**

**Chairman:** R. Menapace  
**Members:** D. Rogers  
C.-P. Brandt

## **Summary of Facts and Submissions**

- I. The appeal is directed against what is purported to be a decision of the Examining Division set out in a letter dated 24 May 2012. This letter stated that the Appellant's Notice of Opposition could not be considered as validly filed.
- II. The factual background to this decision involves two appeals: the appeal which is the subject of this decision and which is mentioned above, and a chronologically earlier appeal filed by the proprietor against the grant of its patent.
- III. The decision to grant the European patent No: 1358272 was notified to the proprietor's representative on 16 February 2012. The EPO took this action because it had in error deducted the fees for grant and publication from the account of a firm of representatives that had ceased to represent the proprietor in 2005. This erroneous action of the EPO led to the mention of grant of the patent in suit appearing in the Patent Bulletin on 14 March 2012
- IV. On 11 April 2012 the proprietor's representative filed a notice of appeal and a statement of grounds of appeal against the decision to grant the patent, "...prematurely and in error ...". The detriment that the proprietor claimed to have suffered was that he was no longer able to file a divisional application.
- V. On 10 May 2012 the Appellant filed a notice of opposition against the patent whose mention of grant had appeared in the Patent Bulletin on 14 March 2012.

- VI. On 15 May 2012, the Examining Division informed the proprietor's representative that it would rectify its decision to grant the patent and would refund the appeal fee.
- VII. In a letter dated 24 May 2012, the Formalities Officer, on behalf of the Examining Division, informed the Appellant as follows:
- "...
- Following the appeal of 11.04.2012 the decision to grant dated 16.02.2012 was rectified with EPO Form 2710 of 15.05.2012 and sent to EPO postal services on 08.05.2012.
- As the examination procedure is resumed, it is not possible to file an opposition during this part of the procedure.
- Consequently your notice of opposition of 10.05.2012 cannot be considered as validly filed.
- For the Examining Division"
- VIII. On 24 July 2012 the Appellant filed an appeal against the purported decision of the Examining Division set out in the Formalities Officer's letter dated 24 May 2012 and paid the appeal fee. A statement of grounds of appeal was filed.
- IX. The Appellant argued that it had fulfilled all the requirements for filing a valid opposition. The interlocutory revision of the decision to grant by the Examining Division took place subsequent to the filing of the opposition and did not affect the validity of the filing of the opposition. The Appellant referred to

the principle of legal certainty in support of its position.

- X. The Board issued a first communication, setting out its preliminary opinion in this case, on 19 March 2013. The parties responded to this communication.
  
- XI. The proprietor, hereafter the Respondent-Proprietor, argued that once the Examining Division had decided to order interlocutory revision of its decision to grant the patent, the grant decision is deemed never to have taken place and that no patent was to be considered as ever having been granted. The consequence of this was that there was no granted patent against which an opposition could be filed. Thus the appeal should be considered to be inadmissible.
  
- XII. The Board summoned the parties to oral proceedings and issued a second communication setting out its preliminary views in this case on 8 July 2013. This second communication expressed the view that the letter of the Examining Division of 24 May 2012 was not a decision that could be appealed against, but was rather a letter providing information.
  
- XIII. The Appellant responded to this second communication. The arguments of the Appellant, as far as they are relevant to this decision are as follows:  
The Examining Division's letter of 24 May 2012 was a decision. Whether a document was to be construed as a decision or as a communication depended on its substance and not its form - see decisions T 1849/12, T 1181/04 and J 10/87. In addition, the letter of 24 May 2012 had the effect of finally disposing of the Appellant's opposition, it was the last document on

this subject that the Appellant had received from the EPO.

The Appellant also submitted that the rectification decision of the Examining Division could not have retrospective effect once the publication of the mention of grant had taken place. In this respect the Appellant formulated questions to the Enlarged Board of Appeal.

- XIV. The Respondent-Proprietor argued that the letter of the Formalities Officer of the Examining Division of 24 May 2012 was a communication and hence that the appeal was to be rejected as inadmissible. The Respondent-Proprietor referred to Article 104 EPC and argued for an apportionment of costs in its favour upon the basis that the Appellant's opposition and subsequent appeal constituted an abuse of process.
- XV. The Appellant argued that it had merely filed a valid opposition and that this could not be considered as an abuse of process.
- XVI. The requests of the Appellant are:
- a) That the letter of the Examining Division dated 24 May 2012 be determined to be a decision.
  - b) That this decision be set aside.
  - c) That the Board find that the opposition of the Appellant is admissible.
  - d) That the Board remit the case to the Opposition Division for further prosecution.
  - e) That the appeal fee be reimbursed.
  - f) That the following questions be referred to the Enlarged Board of Appeal:



- i) Can a party to proceedings under Article 99(3) EPC be deprived of its party status without receiving an appealable decision?
- ii) If this question is answered in the affirmative, what are the criteria to be applied for determining such a loss of party status?

XVII. The Respondent-Proprietor requests:

- a) To reject the appeal as inadmissible.
- b) An apportionment of costs.

## **Reasons for the Decision**

### *Admissibility of Appeal*

1. The key issue to be decided is whether the Examining Division's letter of 24 May 2012 is a decision, or merely a communication. Whether a document is to be considered as a decision depends on the substance of its contents, not on its form - see J 8/81 OJ EPO 1982, 10, point I of Headnote and point 3 of the Reasons. The criterion of substance has to be assessed in its procedural context - see e.g. T 713/02 OJ EPO 2006, 267, points 2.12 and 2.14, second paragraph of the Reasons.
2. Procedural context of the Examining Division's letter of 24 May 2012
  - 2.1 In the present case a valid appeal against the decision to grant had been filed by the Respondent-Proprietor after the publication of the mention of the grant.
  - 2.2 Article 106(1) EPC provides that an appeal shall have suspensive effect. Thus, by filing a (valid) appeal

against a decision to grant, an applicant/proprietor prevents the decision to grant from having any legal effect until the appeal is resolved. Otherwise an appeal would be nugatory (decision J 28/94, OJ EPO 1995, 742). If it is not possible to suspend or to defer the publication of the mention of grant until such an appeal is decided, the EPO should take all necessary steps to advise the public that the mention of grant was no longer valid (see also T 1/92, OJ EPO 1993, 685, point 3.1 of the Reasons). On the other hand, even after an appeal the decision as such remains and can only be set aside or confirmed by the Board of Appeal (see J 28/03, OJ EPO 2005, 597) or by way of interlocutory revision under Article 109(1) EPC. This means that the validity of an opposition filed against the patent concerned depends on the outcome of the appeal of the applicant/proprietor against grant.

2.3 Thus, by the time the Appellant filed its notice of opposition, the legal consequences of the decision to grant the patent had become subject to the suspensive effect of the Respondent-Proprietor's appeal against the decision to grant. As the Examining Division decided to rectify its decision to grant under Article 109 EPC, neither this decision, nor the publication of mention of grant had any legal consequences. Thus no granted patent is deemed to have existed against which an opposition might have been filed. It is thus immaterial whether or not the Appellant had fulfilled all the requirements for filing a valid opposition.

2.4 In the light of this procedural situation, namely that there were no proceedings in existence in which a decision could be made vis à vis the Appellant, and from the plain wording used, the letter of 24 May 2012 is to be seen as a mere communication of information,

this information being that there is no granted patent which may be opposed. This letter clearly makes no decision on, nor reference to, the merits of the Appellant's opposition. That this communication is the last word of the EPO on this subject does not imply that it has decisional character; once the EPO has provided this information to the Appellant no useful purpose would have been served by repeating it. Indeed, the legal character of a document issued by the EPO (such as the letter of 24 May 2012) cannot be determined or altered by actions, or inaction, by the EPO after it has been issued. Thus the Appellant's argument that the letter of 24 May 2012 is to be considered as a decision because the EPO did not subsequently issue a further document in this matter is to be rejected. Moreover, under no circumstances is an Examining Division empowered to decide on the "validity", i.e. the admissibility of a (notice of) opposition. As the Appellant itself put it in its letter dated 25 October 2012: the Examining Division is clearly and simply the wrong instance for such a decision.

3. Article 107, first sentence, EPC provides that any party to proceedings adversely affected by a decision may appeal. This provision thus contains the requirement that there was a decision. As in the given circumstances the letter sent by the Formalities Officer on behalf of the Examining Division did not constitute a decision within the meaning of Article 106(1) EPC any appeal against that letter is inadmissible.
4. As set out in point 3 above, the Board has concluded that there was no decision. Thus the Appellant is not a person entitled to appeal under Article 107 EPC, and

hence its appeal must be rejected as inadmissible in accordance with Rule 101 EPC.

5. In the light of this conclusion, none of the further requests of the parties, other than the Appellant's proposed questions to the Enlarged Board of Appeal and the Respondent-Proprietor's request for an apportionment of costs, need to be addressed as they depend on an admissible appeal having been filed.

*Questions for the Enlarged Board of Appeal*

6. The Appellant has formulated two questions for referral to the Enlarged Board of Appeal (set out in point XVI above). The Board will not refer these questions to the Enlarged Board of Appeal as the Board has been able to resolve the relevant points of law in this case without any doubt, thus making a referral unnecessary (see J 5/81, OJ 1982, 155, headnote 2 and point 11 of the Reasons; T 708/90, point 5 of the Reasons).

*Apportionment of costs*

7. The Board has the power to order an apportionment of costs under Article 104 EPC if it is equitable to do so. Article 16(1)(e) Rules of Procedure of the Boards of Appeal (Supplement to OJ EPO 1/2013, 38) refers to abuse of procedure by a party as a circumstance that may justify an apportionment of costs. The Board considers that the conduct of the Appellant, that is the filing of an opposition and of a subsequent appeal, cannot be considered as such an abuse as they are actions which use the provisions of the EPC for the ends envisaged by these provisions. Thus the Board considers it appropriate that in this case each party shall bear its own costs.

**Order**

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

The appeal is rejected as inadmissible.

The Respondent-Proprietor's request for an apportionment of costs is rejected.

The Registrar:

The Chairman:



C. Eickhoff

R. Menapace

Decision electronically authenticated