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**Datasheet for the decision
of 30 May 2016**

Case Number: J 0019/13 - 3.1.01

Application Number: 10161088.9

Publication Number: 2246802

IPC: G06K7/10

Language of the proceedings: EN

Title of invention:

Laser scanner with deformable lens

Applicant:

HAND HELD PRODUCTS, INC.

Headword:

Deficiency concerning the signature on the request for grant

Relevant legal provisions:

EPC Art. 67(4), 76(1), 78(1)(a), 80, 90, 94(3), 97(2), 100,
133(2), 135(1)(b), 138, 143(1), 147

EPC R. 40, 41, 57, 58, 62a(1), 67(2), 103(1)(a), 130(1)

RFees Art. 9, 11

Keyword:

Deficiency concerning the signature on the request for grant
Application invalid ab initio - no
Application of the principle of legitimate expectations - no

Decisions cited:

G 0001/90, G 0003/99, G 0001/05, G 0001/06, J 0022/86,
J 0018/96, J 0017/98, J 0022/03, T 0665/89, T 1048/00,
T 1409/05, T 1427/09, T 1495/09

Catchword:



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Case Number: J 0019/13 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 30 May 2016

Appellant: Hand Held Products, Inc.
(Applicant) 700 Visions Drive
Skaneateles Falls, NY 13153 (US)

Representative: Houghton, Mark Phillip
Patent Outsourcing Limited
1 King Street
Bakewell, Derbyshire DE45 1DZ (GB)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 14 June 2013
concerning a refund of fees in respect of
European patent application No. 10161088.9.**

Composition of the Board:

Chairwoman P. Schmitz
Members: M. Blasi
E. Kossonakou

Summary of Facts and Submissions

- I. The appeal lies against the interlocutory decision of the examining division of 14 June 2013. The examining division held that European patent application No. 10161088.9 was filed on 26 April 2010 using the EPO online software and met the requirements for according a date of filing pursuant to Article 80 and Rule 40 EPC. The applicant's requests that the application be considered invalidly filed and that the fees paid in relation to the application be refunded were rejected.
- II. The facts underlying the decision of the examining division were in essence the following:

On 26 April 2010, European patent application No. 10161088.9 was filed on behalf of Hand Held Products Inc. (applicant) in electronic form. European patent attorney Mr Buckley of the attorney firm Patent Outsourcing Ltd. was indicated as the applicant's representative in the request for grant form (EPO Form 1001E, sections 15 to 17). Form 1001E was electronically signed by Mr Hoiriis from Honeywell International Inc., US, using his smart card and indicating that the application was signed for Hand Held Products Inc.

In accordance with the debit order in Form 1001E, the filing, search, examination and designation fees were debited from the deposit account of Honeywell International Inc.

On 30 August 2010, an invitation pursuant to Rule 62a(1) EPC was dispatched to the applicant's representative as the search division had identified multiple independent claims in the same category. On 6 October 2010, the information on the forthcoming

publication of the application and on the publication number allotted to the application was sent to the representative, and, on 28 January 2011, the search report was transmitted.

After the examining division had issued its first communication pursuant to Article 94(3) EPC dated 15 February 2011, the representative contacted the examining division asking why he had received the first communication twice, namely for the application in suit and for application No. 10161221.6. He had believed that the application in suit was not pending. He requested that the European Patent Office (in the following "Office") acknowledge that the application had not been validly filed because the request for grant Form 1001E was not validly signed and that the relevant fees be refunded.

By a communication dated 7 October 2011, the representative was informed that the application had been validly filed since the requirements for the accordance of a date of filing had been fulfilled on 26 April 2010, and that therefore the fees were not refundable. Simultaneously, an invitation to remedy deficiencies in the application documents pursuant to Rule 58 EPC was dispatched, indicating that the request for grant form had not been signed and setting a two-month time limit for reply.

In his reply, the representative maintained the view that the application had not been validly filed and that no fees could be charged. He stated specifically that the deficiency concerning the signature would not be remedied. He also argued that principles of procedure had been violated as the deficiency was only notified on 7 October 2011.

Following further exchanges of letters, the examining division issued the above-mentioned decision.

- III. The applicant (appellant) duly lodged an appeal against this decision. In the statement of grounds of appeal, the appellant requested that the application fees be refunded. Moreover, the Board was requested to consider if a procedural irregularity had occurred and to reimburse the appeal fee, and to publish its decision.
- IV. The Board sent a communication pursuant to Article 17(1) RPBA setting out its preliminary opinion. In response, the appellant provided additional comments and confirmed the request for reimbursement of the fees.
- V. As far as relevant for the present decision, the appellant's arguments can be summarised as follows:

The application in suit is invalid *ab initio* because of the deficiency concerning the signature on the request for grant Form 1001E. In order for an application to constitute a valid and regular filing, the requirements of Article 78 EPC must be fulfilled.

Due to the deficiency concerning the signature, the application should not have proceeded, and in particular should not have been published.

As the representative did not confirm the filing of the application by counter-signing the request for grant form or by remedying the deficiency under Rule 58 EPC, the requirements of Article 133(2) EPC were not met either.

The appellant had relied on a communication pursuant to Rule 58 EPC noting the deficiency being issued by the

Office in a timely manner. The non-issuance of such a communication had deprived the appellant of the ability to timely abandon the application and recover fees. This was intended by the appellant in light of the fact that the application with a revised text was properly filed on the following day.

The Office should have been aware that two applications were filed within a day of each other with the same applicant, same title and for substantially the same subject-matter, and that for one of these the request for grant form was re-filed with the signature of the representative whilst for the other it was not. The Office therefore should have contacted the applicant to seek clarification.

Reasons for the Decision

The appeal is admissible.

1. Refund of the application fees

1.1 The filing, search, examination and designation fees for the application in suit were paid by Honeywell International Inc. on behalf of the appellant.

The appellant requests that these fees be refunded.

1.2 Fees are refunded if they were paid without a legal basis or if the requirements of a legal provision ordering a refund are met. The requirements of specific provisions which provide for a refund of at least part of the fees paid in respect of the application in suit, namely Articles 9 and 11 of the Rules relating to Fees providing for a refund of the search and examination

fees, respectively, are not fulfilled since the search report was drawn up and substantive examination has begun. Therefore, the decision hinges on whether the application for which the fees were paid was a validly filed European patent application.

2. *Deficiency concerning the signature on the request for grant*

- 2.1 The appellant's main line of argument is that the deficiency concerning the signature on the request for grant has the legal consequence that the application does not constitute a "valid and regular filing" and is therefore invalid *ab initio* because the requirements of Article 78 EPC were not met. The Board, however, does not share this view.
- 2.2 According to Article 78(1)(a) and Rule 41(2)(h) EPC, the request for grant, a form drawn up by the Office in accordance with Rule 41(1) EPC, must be signed by the applicant or his representative.
- 2.3 Mr Hoiriis from Honeywell International Inc., who electronically signed the request for grant EPO Form 1001E, was not a valid signatory for the applicant. A procedural act performed by a non-entitled person is to be treated in the same way as a missing signature (cf. G 3/99, OJ EPO 2002, 347, Reasons 20, T 665/89, Reasons 1.4, T 1048/00, Reasons 7.3). For the electronic filing of a document accompanied by the electronic signature of an unauthorised person, the same principle applies, as confirmed, for instance, in decision T 1427/09 (cf. Reasons 8). Therefore, the request for grant form is to be considered not signed.

- 2.4 The signature of the applicant or his representative forms one of the requirements for the content of the request for grant (cf. Rule 41(2)(h) EPC). The request for grant is one of the formal requirements for the European patent application laid down in Article 78(1) EPC. The signature on the request for grant is, however, not one of the requirements for the accordancy of a date of filing pursuant to Article 80 EPC and Rule 40 EPC.
- 2.5 The Board holds that a deficiency concerning the signature on the request for grant form has no bearing on the application's validity *per se*, so that the application concerned remains a pending patent application until the grant proceedings are finally terminated. A legal consequence which could be described as invalidity *ab initio* exists with respect to non-fulfillment of the requirements for a date of filing, but not in respect of a deficiency concerning the signature on the request for grant.
- 2.6 Article 80 and Rule 40 EPC contain the minimum requirements which must be met in order for a date of filing to be accorded. It is uncontested that these requirements were fulfilled in the present case on 26 April 2010.
- 2.7 If a date of filing cannot be accorded, the application is not dealt with as a European patent application pursuant to Article 90(2) EPC. Thus, in such a case, no valid application exists (cf. J 18/96, OJ EPO 1998, 403, Reasons 3.1) and, as confirmed by the Enlarged Board of Appeal in decisions G 1/05 and G 1/06, an application which cannot receive a date of filing does

not have legal effect (OJ EPO 2008, 271 and 307, Reasons 2.3).

- 2.8 It also follows from Article 90(2) EPC, *a contrario*, that, if the requirements for the accordancy of a date of filing have been met, the European patent application does come into existence. Accordingly, the date of filing has the effect that it marks the beginning of the pendency of a European patent application (see also e.g. T 1409/05, Reasons 3.2.6 for the various legal effects). Thus, the coming into existence of a European patent application does not depend on the fulfilment of all the requirements under Article 78 EPC, but on the fulfilment of the requirements for the accordancy of a date of filing. A deficiency as regards the request for grant form, not forming part of these minimum requirements, can therefore not result in the European patent application being invalid *ab initio*.
- 2.9 A deficiency concerning the signature on the request for grant has, rather, the following legal consequences. Where this deficiency is noted by the Office when carrying out the examination as to formal requirements in accordance with Article 90(3) EPC, Article 90(4) EPC provides that the applicant is to be given an opportunity to correct it as the deficiency is a correctable one (cf. Rules 57(b) and 58 EPC). If the deficiency is not corrected, the European patent application will be refused in accordance with Article 90(5) EPC, and only then is the application no longer pending. Invalidity with retrospective effect is not foreseen by these provisions.
- 2.10 Where a deficiency concerning the signature on the request for grant is identified or established at a later stage during the grant proceedings, this cannot

lead either to the suggested effect of retroactive invalidity.

- 2.11 The ways in which the proceedings relating to a pending European patent application can come to an end are laid down in the EPC in an exhaustive manner: refusal of the application, withdrawal of the application by the applicant, deemed withdrawal of the application or grant of a European patent. The first three alternatives, which represent the possible negative outcomes of the grant proceedings, are mentioned together at various points in the EPC, for example, Article 67(4), Article 135(1)(b), Rule 67(2), Rule 143(1)(n) and Rule 147(4)(a) EPC.
- 2.12 Besides these outcomes, no other "negative" termination of the grant proceedings, such as a declaration that an application is invalid *ab initio*, is provided for by the EPC and, consequently, no other scenarios than those mentioned above were referred to by the Enlarged Board in its opinion G 1/90 during its analysis of the termination of the grant procedure (OJ EPO 1991, 275, Reasons 5 et seq.). None of these legal consequences has a retroactive effect in the way suggested by the appellant, i.e. non-existence of the European patent application *ab initio*.
- 2.13 Thus, subject to the application being withdrawn or the deficiency being duly remedied, until a decision has been taken in the case of a formal deficiency concerning the signature on the request for grant, there is a pending, albeit deficient, application. The application in suit therefore had to be processed, and in particular be searched, published and examined, by the Office.

2.14 The appellant also argued that the creation of a date of filing under Rule 40 EPC was not synonymous with creating a European patent application and referred to the filing of divisional applications. They were applications which were created at a later date than that resulting from Rule 40 EPC. However, the Board is not convinced by this argument: a divisional application must also fulfil the requirements of Rule 40 EPC in order to come into existence. It is only that, by way of exception according to Article 76(1) EPC, it is deemed to have an earlier date of filing than the date on which the documents received met the requirements under Rule 40 EPC.

2.15 Hence, the Board comes to the conclusion that the application in suit cannot be considered invalid *ab initio*. Rather, it is a pending European patent application which suffers from the formal deficiency that the request for grant was not duly signed.

3. *Applicant not duly represented*

3.1 The appellant further argued that the application should not have proceeded since the representative had not confirmed his appointment for the application. This appears to be an allegation of a further formal deficiency, which, however, could not change the Board's conclusion regarding the status of the application.

3.2 In the present case, the name and place of business of Mr Buckley, a European professional representative, were indicated on the request for grant Form 1001E in accordance with Rule 41(2)(d) EPC. By this indication, the Office was informed that Mr Buckley was appointed as the representative for this application (see also J 17/98, OJ EPO 2000, 399, Reasons 4.2). A requirement,

as suggested by the appellant, to the effect that the representative who is specified in the request for grant but who did not sign the form would need to confirm his appointment by a later (counter)signature of the request for grant form cannot be derived from the provisions of the EPC.

- 3.3 Following the indications in Form 1001E, Office notifications were addressed to the representative in accordance with Rule 130(1) EPC, including the invitation pursuant to Rule 62a(1) EPC, the information on the upcoming publication of the application and the search report.
- 3.4 If the representative's appointment had not been correct, he could have informed the Office accordingly. However, this would not have resulted either in the application being invalid *ab initio*. Instead, if the Office had become aware of such a deficiency, the applicant, obliged to be represented pursuant to Article 133(2) EPC, would have been invited under Rule 58 EPC to correct the deficiency by appointing a new representative. However, due to the fact that representation by a professional representative is not mandatory for the filing of a European patent application, non-appointment of such a representative despite the invitation to do so could only have led to one of the "negative" terminations of the grant proceedings mentioned above (see point 2.11), namely the refusal of the application.
- 3.5 In fact, as clarified by the appellant, the representative has ongoing dealings with the appellant. Accordingly, a deficiency concerning the appellant's representation does not seem to have existed.

4. *Principle of legitimate expectations/good faith*

4.1 In a further line of argument, the appellant submitted that it had reasonable expectations that a communication under Rule 58 EPC would be duly issued by the Office. This would have avoided the present situation, namely that the application in suit was published and that it proceeded to the examination stage. Also, a recovery of fees would have been possible.

4.2 This argument thus relates to the protection of legitimate expectations, which is a well-established and generally recognised principle (see Case Law of the Boards of Appeal, 7th edition, September 2013, III.A.3). Its application to procedures before the Office implies that measures taken by the Office should not violate the reasonable expectations of parties to such proceedings. The term "good faith" is also used to describe this concept.

4.3 In the present case, however, the Board does not find that these general principles could be applied to the benefit of the appellant.

4.4 First, the Board notes that the EPC does not set a time limit by which the examination on filing and as to formal requirements provided for in Article 90 EPC is to be carried out or concluded, even though it must have been clear to the legislator that the applicant has an interest in learning as quickly as possible about any issue which might prevent the accordance of a date of filing (cf. also J 22/03, Reasons 3.1). The absence of a specific time frame is reflected in the Guidelines for Examination in the European Patent Office, which make it clear that the search is carried out in parallel with the formalities examination and that the examiner draws

the attention of the Receiving Section to any formal shortcomings he/she notes which would require appropriate action (cf. Guidelines, B-IV, 1.2).

- 4.5 A deficiency concerning the signature on the request for grant form might also be noticed at a later stage, during the phase of substantive examination of the application, and, as the deficiency is a correctable one, the applicant will in such a case also be invited to remedy it at this stage.
- 4.6 In the exceptional event that a deficiency concerning the signature on the request for grant form is overlooked and the application proceeds to grant, the defect in the granting procedure, being of a formal character, would be regarded as cured by the act of grant (see also J 22/86, OJ EPO 1987, 280, Reasons 18, T 1495/09, Reasons 7). This is supported by the limited scope of the grounds laid down in Articles 100 and 138 EPC for challenging granted European patents.
- 4.7 Thus, although the appellant could have expected an invitation to remedy the deficiency concerning the signature on the request for grant be issued, the appellant could not rely on this happening by a particular point in time which would still allow for a recovery of application fees.
- 4.8 Secondly, the aim of the principle of protection of legitimate expectations is that any disadvantages for the applicant through actions or omissions of the Office are avoided.
- 4.9 In the present case, the appellant has not suffered a disadvantage because, as the deficiency remained unnoticed, the application remained pending. To submit

that the appellant should have received a formal invitation to rectify the deficiency (of which it was well aware from the outset) in order not to remedy it and thereby terminate the proceedings, is to stand the concept of good faith on its head.

4.10 In the light of the appellant's submissions that the situation of the request for grant being deficient had arisen previously in other cases of the appellant and resolved either by the representative filing a confirmation or by awaiting the communication under Rule 58 EPC, it is apparently part of the appellant's strategy to file applications without a valid signature and to remedy the deficiency later. This was a deliberate choice and the appellant was fully aware of it. While it is true that the appellant could expect issuance of an invitation to remedy the deficiency in a timely manner, the fact that this communication was not issued earlier did not prevent it from taking the necessary action. The appellant was still in a position to take the necessary steps and the procedure was completely under its control.

4.11 It is not the responsibility of the Office to assess an applicant's true intentions. The Office has to proceed on the assumption that, once an applicant has filed an application, he is interested in pursuing it. That two quasi identical applications are filed by an applicant may have various reasons, which, however, are not the concern of the Office and identifying them is not an objective of either the examination on filing or the formalities examination. Issuing an invitation to correct a deficiency, even at a late stage, and keeping the application alive is normally in the applicant's interest.

- 4.12 The Board further notes that the Office dispatched various communications, thereby signalling that the application was proceeding as if without any formal deficiency. Thus, the appellant must have been aware that the Office was processing the application and could have withdrawn it at any stage if it did not wish to pursue it. There was no necessity to wait for the invitation to correct the deficiency. That the representative had in fact not been made aware of the communications issued by the Office due to the way in which routine documents are processed in the representative's firm may explain why the proceedings continued, but it does not change the conclusion that the procedure was still under the appellant's control.
- 4.13 It therefore does not appear to be justified to apply the principle of legitimate expectations in the present circumstances, in which the appellant was not only aware of the deficiency from the outset but also intentionally brought it about and where therefore application of the principle of good faith would serve as a remedy for a party's (failed) strategy.
- 4.14 The appellant further argued that the two-month period for responding to a communication under Rule 58 EPC is for the purposes of providing legal certainty to third parties and that late issuance of a communication under Rule 58 EPC is contrary to the legitimate expectations of third parties as to the practice and procedure of the EPO. As set out above, there is no provision in the EPC which forbids the correction of the formal deficiency concerning the signature on the request for grant form at a late stage in the proceedings, and third parties must always expect that, if an invitation to remedy a deficiency is issued by the Office, the deficiency in question will be remedied.

4.15 Therefore, invoking the principle of legitimate expectations does not support the appellant's case.

5. *Conclusions*

5.1 As the application in suit is not an application which is invalid *ab initio*, the Board agrees with the finding in the decision under appeal that the filing, search, examination and designation fees were validly paid. Hence, the request for a refund of the fees paid in respect of the application in suit is to be refused. The appeal is therefore not allowable.

5.2 As the deficiency concerning the signature was not remedied by the appellant within the time limit set in the communication a refusal of the application is to be expected.

6. *Requests for reimbursement of the appeal fee and publication of the decision*

6.1 The appellant further requested the Board to consider if a procedural irregularity has occurred and reimburse the appeal fee.

6.2 Since the appeal cannot be allowed, the appeal fee cannot be reimbursed pursuant to Rule 103(1)(a) EPC.

6.3 The appellant's request for publication of this decision is taken by the Board to mean a publication in the Official Journal of the Office. Whether or not a decision should be published in the Official Journal is within the Board's discretion. In the present case, the Board does not see a need for this. However, the decision will in any case be published on the Office's website.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairwoman:



C. Eickhoff

P. Schmitz

Decision electronically authenticated