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Datasheet for the decision of 23 March 2015

Case Number: J 0014/14 - 3.1.01

Application Number: 13194043.9

Publication Number: null

IPC:

Language of the proceedings: EN

Title of invention:
Method and composition to individualize levodopa/carbidopa therapy using a breath test

Applicant:
Otsuka America Pharmaceutical, Inc.

Headword:
Notification of a communication

Relevant legal provisions:
EPC R. 126(2)

Keyword:
Notification by registered letter - Proof of receipt of communication (no)

Decisions cited:
J 0009/05, J 0018/05, J 0003/14

Catchword:

Europäisches Patentamt
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Office européen des brevets

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Case Number: J 0014/14 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 23 March 2015

Appellant: (Applicant)	Otsuka America Pharmaceutical, Inc. 2440 Research Boulevard Rockville, MD 20850 (US)
Representative:	Rickard, David John Ipulse (IP) Ltd. 4 Bloomsbury Place GB-London WC1A 2QA (GB)
Decision under appeal:	**Decision of the Receiving Section of the European Patent Office posted on 28 March 2014 refusing European patent application No. 13194043.9 pursuant to Article 90(5) EPC.**

Composition of the Board:

Chairwoman	C. Vallet
Members:	D. T. Keeling
	C. Schmidt

Summary of Facts and Submissions

I. The appeal was filed by the applicant for a European patent (EP 13194043.9). The application in question is a divisional application, the parent application being EP 06780854.

II. The appeal is directed against a decision of the Receiving Section, dated 28 March 2014, whereby application EP 13194043.9 was rejected, pursuant to Article 90(5) EPC, on the ground that the applicant had failed to correct a deficiency noted by the Receiving Section in EPO Form 1050BC which had been sent to the appellant on 5 December 2013 pursuant to Rule 58 EPC.

III. The deficiency that was mentioned in the decision of 28 March 2014 related to "form of application/replacement documents (quality of the application documents)". Annex B to the form that had been sent to the appellant on 5 December 2013 stated, in relation to page 12 of the application, "The text matter in formula is blurred". Annex C indicated, with regard to Figures 2-4 and 7-14, that some or all of the drawings in question did not comply with the requirements of Rule 46(2)(a), (c) or (g) EPC.

IV. The decision under appeal was posted on 28 March 2014. The notice of appeal was filed on 22 May 2014. The appellant did not submit a separate written statement setting out the grounds of appeal. However, in the notice of appeal the appellant had raised the following arguments:

(i) The appellant's representative did not receive the communication of 5 December 2013 inviting him to correct a deficiency in the application.

(ii) The deficiency should not have been raised at all since no such deficiency had been mentioned in connection with the parent application.

V. The appellant requested that the decision under appeal "be overturned in its entirety and that the patent be maintained as granted". The appellant furthermore requested reimbursement of the appeal fee.

Reasons for the Decision

1. The appeal is admissible. The notice of appeal was filed on 22 May 2014 (i.e. within the two-month time limit prescribed in the first sentence of Article 108 EPC) and the appeal fee was paid on the same day. No separate statement setting out the grounds of appeal was filed. However, the notice of appeal itself indicated the grounds on which the appeal was based in a manner which, though brief, was sufficient to comply with the requirements of Rule 99(2)(c) EPC.

2. There is clearly no merit in the appellant's argument that the deficiency in the application documents should not have been raised at all since no such deficiency had been mentioned in connection with the parent application. It is well established that a divisional application is procedurally independent of its parent application. The Enlarged Board of Appeal (see G 4/98, at paragraph 5 of the reasons) has held that:

> "the procedure concerning the divisional application is in principle independent from the procedure concerning the parent application and (...) the divisional application is treated as a new application (...). Although there are some connections between the two procedures (e.g. concerning time limits), actions (or omissions) occurring in the procedure concerning the parent application after the filing of the divisional application should not influence the procedure concerning the latter."

3. The appellant's other argument is well founded. The communication of 5 December 2013 was sent by registered letter in accordance with Rule 126(1) EPC. That was the correct procedure since an invitation to correct a deficiency under Rule 58 EPC does not belong to the category of documents that have to be notified by means of registered letter with advice of delivery under Rule 126(1).

4. Rule 126(2) EPC provides as follows:

> "Where notification is effected by registered letter, whether or not with advice of delivery, such letter shall be deemed to be delivered to the addressee on the tenth day following its posting, unless it has failed to reach the addressee or has reached him at a later date; in the event of any dispute, it shall be incumbent on the European Patent Office to establish that the letter has reached its destination or to establish the date on which the letter was delivered to the addressee, as the case may be."

5. It is clear from the wording of Rule 126(2) EPC that, in the event of any dspute as to whether a notification has been received by the addressee, the onus is on the EPO to establish the fact and date of delivery. The only proof of delivery that the EPO has been able to obtain, in respect of the communication of 5 December 2013, is a letter from Deutsche Post which refers to a registered letter sent to "Rickard David John in SW11 1BP London / Grossbritannien" on 5 December 2013. The letter from Deutsche Post states:

> "Sehr geehrter Kunde,
>
> das ausländische Postunternehmen teilt uns jetzt mit, dass die Nachforschungen nach Ihrer Sendung abgeschlossen sind.

Die Sendung wurde am 10.12.2013 an einen Empfangsberechtigten ausgeliefert."

6. This does not fulfil the requirements of Rule 126(2) EPC. Deutsche Post does not appear to have provided the EPO with copies of any correspondence received from *das ausländische Postunternehmen* [the foreign postal undertaking] in connection with the delivery of the registered letter posted on 5 December 2013. In particular, there is no proof that Mr Rickard (the appellant's representative) or any other named individual signed a document acknowledging receipt of the letter. The letter from Deutsche Post merely makes an unsubstantiated statement to the effect that the letter was delivered to a person entitled to take receipt of it on 10 December 2013.

7. It is clear that the EPO has been unable to discharge the burden of proving that the appellant's representative received the communication of 5 December 2013. It is well established in the case law of the EPO Boards of Appeal that in such circumstances the appellant must be given the benefit of the doubt (see J9/05, J18/05 and J3/14). The appellant's divisional patent application could not therefore lawfully be rejected on the ground that the appellant had failed to correct the deficiency referred to in the communication of 5 December 2013.

8. It follows that the decision of 28 March 2014, whereby application EP 13194043.9 was rejected, must be set aside. The appellant's request for the patent to "be maintained as granted" is obviously due to an error, since the patent has not yet been granted. The appropriate course of action is for the Board to remit the case to the Receiving Section for further prosecution.

9. The appellant has requested reimbursement of the appeal fee. The facts of the present case are comparable to those of J3/14, in which the appeal fee was reimbursed (even though a

reimbursement had not been explicitly requested). In that case the Board observed that the issuing of a decision to refuse a patent application amounted to a substantial procedural violation, since the appellant had had no opportunity to present its comments before the refusal decision was issued, which was an objective fact even if the Receiving Section had made no mistake. The Board also noted that the violation of the appellant's right to be heard had been the only cause for the need to file an appeal. The reasoning followed in J3/14 applies with equal force in the present case. Therefore, Board considers that it is equitable to reimburse the appeal fee.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the Receiving Section for further prosecution.

3. The appeal fee is reimbursed.

The Registrar: The Chairwoman:

C. Eickhoff C. Vallet

Decision electronically authenticated