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Aktenzeichen:
Case Number: J 19/82
N° du recours :

ENTSCHEIDUNG / DECISION
vom / of / du 28 July 1983

Anmelder:
Applicant: TORAY INDUSTRIES, INC.
Demandeur :

Stichwort:
Headword: Decisions by Formalities Officers/Toray
Référence :

EPU/EPC/CBE Article 114(1); Rules 9(3), 67, 69, 85(a), 85(b), 88
"Decisions by Formalities Officers" - "Exceeding entrusted powers" - "Substantial procedural violation" - "Reimbursement of appeal fee" - "Withdrawal of part of appeal".

Leitsatz / Headnote / Sommaire

In general, an appeal pending before a Board of Appeal of the EPO can be withdrawn without the consent of the Board concerned. Part of an appeal can be withdrawn in a case in which the part in question relates to a specific issue which formed a distinct part of the decision under appeal.

Europäisches
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European Patent
Office

Boards of Appeal

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Chambres de recours



Case Number: J 19/ 82

DECISION
of the Legal Board of Appeal
of 28 July 1983

Appellant: TORAY INDUSTRIES INC.
2 Nihonbashi Muromachi 2-chome
Chuo-ku
Tokyo 103
Japan

Representative: J.C.H. Ellis and others
Mewburn Ellis & Co.
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England

Decision under appeal: Decision of the Head of Formalities of Directorate General 2 of the European Patent Office dated 13 July 1982 rejecting a request for re-establishment of rights, or in the alternative for correction of a mistake in a letter dated 16 April 1981 filed on European patent application No. 81301388.5.

Composition of the Board:

Chairman: R. Singer
Member: P. Ford
Member: O. Bossung

SUMMARY OF FACTS AND SUBMISSIONS

- I. On 31 March 1981, the appellants filed European patent application No. 8130388.5 which was published on 21 October 1981 under No. 0038143. They claimed priority from three prior applications in Japan and designated ten Contracting States.
- II. The application as published indicated that all ten States had been designated, although on 22 April 1981 the appellants had paid the designation fees for four named Contracting States only, having indicated by letter dated 16 April 1981 that the fees for other States might be paid later. No additional designation fees were paid within the prescribed time limit (cf. Art. 79(2) and Rule 85 a EPC). The European Patent Bulletin dated 6 January 1982 gave corrected information about the four designations. A request for examination of the application was filed on 4 March 1982.
- III. By letter dated 27 April 1982, the appellants applied for re-establishment of rights in respect of the failure to observe the time limit for payment of the designation fee for a fifth Contracting State. The fee for re-establishment of rights, the additional designation fee and the surcharge under Rule 85 a EPC were paid on 28 April 1982. In the alternative, the appellants applied in their said letter for correction of a mistake in the letter of 16 April 1981 under Rule 88 EPC by the addition of a designation of the fifth Contracting State.
- IV. On 13 July 1982, the Head of Formalities of Directorate General 2 issued a decision rejecting the request for re-establishment of rights as inadmissible and purporting to reject the request for correction of the alleged mistake in the letter of 16 April 1981. The decision authorized the refund of the designation fee, plus the surcharge under Rule 85(a) EPC, paid in respect of the fifth Contracting State.
- V. The appellants gave notice of appeal by letter dated 7 September 1982. The appeal fee was duly paid and a Statement of the Grounds of the Appeal dated 21 October 1982 was duly filed.

- VI. The appellants requested cancellation of the decision and allowance of their application for re-establishment of rights or alternatively of their request for correction. In their Statement of Grounds of the Appeal, they made submissions concerning the substantive issues on the appeal but they did not contend that the Head of Formalities of Directorate General 2 was not entitled to give the decision under appeal, in so far as it related to the request for correction, nor did they request reimbursement of the appeal fee.
- VII. By letter dated 25 March 1983, the Legal Board of Appeal drew the attention of the appellants to its decisions in Case No. J 12/82 (Official Journal EPO 6/1983, 221) and Case No. J 10/82 (Official Journal EPA 3/1983, 94). In the latter case, the Legal Board of Appeal had set aside, for lack of power to give it, a decision of the Head of Formalities of Directorate General 2 purporting to decide a question under Rule 88 EPC and had remitted the matter to an Examining Division, ordering reimbursement of the appeal fee.
- VIII. By letter dated 17 May 1983, the appellants asked to be allowed to withdraw their appeal insofar as it related to the application for re-establishment of rights but maintained the appeal insofar as it related to the request for correction. They did not submit any arguments on the question whether the issue of the request for correction should be remitted to an Examining Division but asked for reimbursement of the appeal fee if the case were so remitted.
- IX. By letter dated 1 June 1983, the appellants confirmed their withdrawal of an earlier request for oral proceedings.

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GROUNDNS FOR THE DECISION

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. In Case No. J 12/82, (Official Journal EPO 6/1983, 221) the Legal Board of Appeal held that there could be no re-establishment of rights in the case of a failure to observe the time limits set by Rule 85(b) EPC. The appellants in the present case have asked to be allowed to withdraw their appeal insofar as it concerns re-establishment of rights, on the basis that they cannot convincingly argue that different considerations could apply to their case, which concerns time limits set by Rule 85(a) EPC.
3. In general, an appeal pending before a Board of Appeal of the EPO can be withdrawn without the consent of the Board concerned. This follows from the Convention itself which states specifically when the withdrawal of a request is not permitted: cf. the prohibition of withdrawal of the request for examination in Article 94(2) EPC. In the case of an opposition, ~~some~~ consequences of withdrawal are provided for (cf. Rule 60(2) EPC), although there is no express provision for withdrawal.
4. If an appeal can be withdrawn in its entirety, the Board sees no reason why an appellant cannot withdraw part of his appeal, at least in a case such as the present one, in which the part sought to be withdrawn relates to a specific issue which formed a distinct part of the decision under appeal. If they had wished to do so, the appellants could have easily excluded that part, when stating, in their notice of appeal, in conformity with Rule 64(b) EPC, the extent to which amendment or cancellation of the decision under appeal was requested.

It follows that there is no objection to withdrawal of part of the appeal in the present case.

5. The Legal Board of Appeal has held in Case No. J 10/82 (Official Journal EPO 3/1983, 94) that as the giving of decisions on requests

for correction of mistakes under Rule 88 EPC has not been entrusted to Formalities Officers in pursuance of Rule 9(3) EPC, all such requests must be dealt with by an Examining Division if and so long as the European patent application to which they relate is undergoing substantive examination. The decision in that case is applicable to the present case and it follows that the Board must set aside that part of the decision under appeal which relates to the request for correction and remit that request to the Examining Division concerned with the examination of the European patent application.

6. Since the decision given on the request for correction must be set aside on the ground that the Head of Formalities of Directorate-General 2 exceeded his powers in issuing it, the Board finds that there has been a substantial procedural violation within the meaning of Rule 67 EPC. In all the circumstances of the case, including the appellants' commendably prompt withdrawal of their alternative ground of appeal, it is equitable to order reimbursement of the appeal fee in accordance with that Rule.

Order

For these reasons,

it is decided that:

1. Insofar as decision of the Head of Formalities of Directorate General 2 dated 13 July 1982 rejected the appellants' request for correction of a mistake under Rule 88 EPC, it is set aside.
2. The case is remitted to Examining Division 121 for further prosecution.
3. Reimbursement of the appeal fee is ordered.