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**Chambres de recours**

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J 20/85

Anmeldenummer / Filing No / N<sup>o</sup> de la demande :

84 111 579.3

Veröffentlichungs-Nr. / Publication No / N<sup>o</sup> de la publication :

Bezeichnung der Erfindung :

Title of invention:

Color Cathode Ray Tube and component thereof  
and method of manufacturing same.

Titre de l'invention :

Klassifikation / Classification / Classement :

## **ENTSCHEIDUNG / DECISION**

vom / of / du

14 May 1986

Anmelder / Applicant / Demandeur :

**ZENITH ELECTRONICS CORPORATION**

Patentinhaber / Proprietor of the patent /

Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

Missing claims/ZENITH

EPO / EPC / CBE

Articles 113, 114, 117, 125 EPC

Rule 75 EPC

Missing application documents - Taking of evidence - Power of Receiving Section to take evidence - Fundamental right of party to comment on evidence - Burden of proof.

### **Leitsatz / Headnote / Sommaire**

1. In a case in which an issue of fact arises between the European Patent Office and a party to proceedings before it, for example as to whether or not a particular document was filed on a particular day, evidence relating to it should be taken as soon as the issue of fact arises.

2. Article 113(1) EPC is of fundamental importance for ensuring a fair procedure between the European Patent Office and a party to proceedings before it, especially when such an issue of fact arises. A decision against a party to proceedings upon such an issue of fact can only properly be made by the European Patent Office after all the evidence on which such decision is to be based has been identified and communicated to the party concerned.

3. Although Article 117 EPC does not refer specifically to proceedings before the Receiving Section, that Section has power to take evidence.

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**Case Number : J 20 /85**

**D E C I S I O N**  
**of the Legal Board of Appeal**  
**of 14 May 1986**

**Appellant :** Zenith Electronics Corporation  
Zenith Center  
1000 Milwaukee Avenue  
Glenview, Illinois 60025  
U.S.A.

**Representative :** Baillie, Iain C.  
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**Decision under appeal :** Decision of Receiving Section of the  
European Patent Office dated 26 April 1985

**Composition of the Board :**

**Chairman :** P. Ford  
**Member :** G. D. Paterson  
**Member :** C. Payraudeau

Summary of Facts and Submissions

- I. On 27 September 1984, the Appellant, through its representative, filed a number of documents which were intended to constitute a new European patent application (subsequently numbered 84 111 579.3) at the European Patent Office in Munich. A closed cardboard folder containing the documents, in an envelope also containing other documents for filing, in particular three other European patent applications, was delivered into the letter box at the European Patent Office by hand at the end of that day.
- II. On 28 September 1984, a filing receipt (EPO Form 1031) was prepared in the Post Room at the European Patent Office, and was sent to the Appellant. It contained typewritten entries in various spaces on the printed form to indicate the presence of all documents required by Article 78(1) EPC for the European patent application, including claims. Opposite the printed item "Claim(s)" the number "3" has been typed to indicate that three copies of the claims had been filed. However, the word "missing" was written between the printed item "Claim(s)" and the typed entry "3" to indicate that the claims were missing at the time it was written.
- III. The filing receipt was received at the office of the Appellant's representative in Munich, and on 2 October 1984 the Appellant's representative filed three copies of sets of pages containing 15 claims at the European Patent Office in Munich, under cover of a letter which stated that he could not understand why the claims should be missing from the documents received. He asked for the file to be checked again for the missing claims and, should it be necessary, for correction of the patent application under Rule 88 EPC to add the new copies.

- IV. The Request for Grant, filed on 27 September 1984, claimed priority from a previous application in the United States of America filed on 30 September 1983. In accordance with Article 87 EPC and Rule 85 EPC, the right to priority expired on Monday, 1 October 1984.
- V. On 10 October 1984, the Receiving Section of the European Patent Office sent a communication pursuant to Rule 39 EPC which crossed in the post with the representative's letter of 2 October 1984, informing the Appellant that the requirements of Article 80 EPC for accordance of a date of filing were not met, because "the application does not contain ... one or more claims", and further stating that the priority claimed was in any case lost, because if the claims were filed a new date of filing would have to be allocated.
- VI. On 18 October 1984, the Appellant's representative filed evidence in support of his contention that claims had in fact been filed on 27 September 1984, under cover of a letter which contested the Receiving Section's assertion that the claims were missing from the application when filed. In the alternative, he again asked for correction under Rule 88 EPC on the basis that it was immediately evident from the other papers filed on 27 September 1984 that nothing else would have been intended than the text of at least Claim 1.

The Appellant's representative argued that the typed entry on the filing receipt "acknowledged the existence of three copies of the claims even though these were subsequently indicated as being missing". It was also suggested, on the basis of the evidence filed, "that the documents are more likely to have gone astray in the documents receipt section at the Patent Office than anywhere else".

As to the request for correction under Rule 88 EPC, this was put forward on the basis that page 6 of the description which was filed on 27 September 1984 set out a "consistory clause" which was in substantially identical terms to Claim 1 of the set of claims filed in 2 October 1984. It was submitted that it was immediately evident that nothing else would have been intended for Claim 1 than the text of the "consistory clause".

- VII. On 26 October 1984, in a communication which crossed with the letter of 18 October 1984, the Receiving Section of the European Patent Office informed the Appellant that no claims had been received, and furthermore that it intended to refuse the request under Rule 88 EPC.
- VIII. The Appellant filed further evidence, on 2 November 1984, in relation to the preparation of the documents which had been filed on 27 September 1984, under cover of a letter dated 30 October 1984, which also contained additional submissions in relation to the application under Rule 88 EPC.
- IX. On 16 November 1984, the Receiving Section informed the Appellant that the Legal Service for the Patent Grant Procedure had been asked to comment on the Appellant's letters dated 2, 18 and 30 October 1984, and that when any comments were received, a decision would be taken.
- X. The Appellant filed further letters dated 5 December 1984 and 2 January 1985, containing detailed submissions that, in the alternative, no correction under Rule 88 EPC was necessary because page 6 of the description included what could be regarded as a claim for the purpose of Article 80 EPC. Each letter ended with a request for informal discussion either by telephone or by personal

interview. Subsequently, discussions took place by telephone between the Appellant's representative and the Director of the Legal Service of the European Patent Office.

- XI. The Decision under appeal, issued by the Receiving Section on 26 April 1985, stated that the Post Room had explicitly confirmed that the claims were missing when the application was filed. An internal report was relied upon in this connection. The Decision rejected the application for correction under Rule 88 EPC and the contention that the passage of the text on page 6 of the description should be regarded as a claim within the meaning of Article 80 EPC, and held that the date of filing of the patent application was to be regarded as 2 October 1984, the date of receipt of the claims.
- XII. The Appellant gave notice of appeal by letter dated 25 June 1985, received on the same day, and the appeal fee was duly paid. A Statement of Grounds of Appeal was filed on 5 September 1985, in which it was contended that :
- (1) On 27 September 1984 three sets of claims, as well as the other items required by Article 80 EPC as a minimum to establish date of filing, were, on the balance of probabilities, filed in the letter box of the Post Room of the European Patent Office in Munich.
  - (2) Alternatively, page 6 of the description included a paragraph which should be considered as constituting a "claim", for the purpose of satisfying Article 80(d) EPC.

(3) Alternatively, having regard to the presence of that paragraph, the Appellant should be allowed to amend the patent application under Rule 88 EPC by addition of at least a claim having corresponding wording, on the basis that the omission of claims in conventionally numbered paragraphs indicated that a mistake had been made, and that such mistake should be corrected because "it is immediately evident that nothing else would have been intended" than a claim having such wording.

On each of these alternative contentions, the Appellant submitted that the European patent application should be allocated a date of filing of 27 September 1984.

Finally, the Appellant requested an oral hearing if the Board considered that the only option was to reject the contentions.

XIII. As stated in XI above, it was on the basis of an internal report from the Post Room that the Receiving Section decided that the claims were missing when the European patent application was filed. However, the contents of this report were not communicated to the Appellant's representative prior to the issue of the Decision under appeal.

#### Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC, and is therefore admissible.
2. The first question raised in the Grounds of Appeal is a question of considerable importance : it is whether the documents filed at the European Patent Office in Munich on 27 September 1984 included at least one set of claims. If this question is answered in the affirmative, the other

grounds of appeal do not require to be decided, the patent application must be allocated a date of filing of 27 September 1984 in accordance with Article 80 EPC and the claim to priority can be upheld.

This question is of considerable importance to the Appellant and its representative for two reasons: first, if answered in the negative (and if the other submissions in the Grounds of Appeal are decided against the Appellant) the result may be that the validity of the European patent application with an allocated filing date of 2 October 1984 cannot be maintained; and second, if answered in the negative (and regardless of the way in which the other submissions in the Grounds of Appeal are decided) doubt is thrown upon the competence of the professional representative of the Appellant and/or his staff.

As set out above, from 2 October 1984 onwards the Appellant and its representative have contested the European Patent Office's assertion that the sets of pages containing 15 claims were missing from the set of documents which was filed on 27 September 1984, at the time of filing. In support of his contention that pages of claims (separate from the description) were in fact then filed, the Appellant's representative filed on 18 October 1984 two signed Declarations, by persons who work at the Munich office of the law firm which represents the Appellant, and on 2 November 1984, two Affidavits by two other persons who work at the Chicago office of the same law firm.

3. Article 114(1) EPC provides that "In proceedings before it, the European Patent Office shall examine the facts of its own motion". In the present case, faced with the contention and evidence identified above, it was necessary for the Receiving Section to investigate, in detail, what had happened to the set of documents inside the European Patent



Office, from the moment when the envelope containing the documents was opened in the Post Room. And, in fact, the Receiving Section did request that it be provided with a detailed report from the Post Room, the substance of the reply to that request being set out in the Decision of the Receiving Section at page 7.

4. However, the Board, which is also obliged by Article 111(1) and 114(1) EPC to examine the facts of its own motion, is unable to support that part of the Decision which is concerned with the question as to whether or not a set of claims was in fact filed, for the following reasons :

- a) Article 113(1) EPC requires that a decision "may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments".

This provision of the European Patent Convention is of fundamental importance for ensuring a fair procedure between the European Patent Office and parties conducting proceedings before it, and is of particular importance when an issue of fact arises, for example as to whether or not a document was filed on a particular day, and where the contentions of fact of the European Patent Office are in conflict with those of a party involved in proceedings before the Office.

Furthermore, in accordance with general principles, it may be appropriate in some cases that that party should not only have the right to comment upon such evidence, but also to request the hearing of relevant witnesses of fact, for example, as provided by Article 117 EPC, prior to issuance of a decision.

The Board has noted that Article 117 EPC, entitled "Taking of evidence", refers to "proceedings before an Examining Division, an Opposition Division, the Legal Division or a Board of Appeal", but does not specifically refer to proceedings before the Receiving Section. On this basis, it might be thought that the Receiving Section has no power to take evidence. In the Board's view, however, even though it does not specifically include a reference to the Receiving Section, the Article should not be interpreted so as to exclude the Receiving Section from having power to take evidence by any appropriate means before issuing a decision in any particular case. Since the Receiving Section can take decisions, such a power of the Receiving Section is necessarily implicit in Article 113(1) EPC, and is in any event in accordance with "the principles of procedural law generally recognised in the Contracting States" (Article 125 EPC). Furthermore, a request under Rule 75 EPC, which relates to the conservation of evidence of facts liable to affect a decision which the European Patent Office may be called upon to take, could clearly be made inter alia to the Receiving Section. In the present case no such request was made, but the existence of Rule 75 EPC supports the above interpretation of Article 117 EPC.

In the present context, the effect of Article 113(1) EPC is that the Receiving Section could only properly issue a decision containing a finding that the date of filing of this patent application is later than 27 September 1984 if all the evidence on which such finding was to be based had been identified and communicated to the Applicant Company or its representative for comment, before issuance of the decision.

In fact, although as stated in paragraph 3 above, a report was received by the Receiving Section from the Post Room prior to issuance of the Decision, as noted in paragraph XIII above, the contents of the report were not communicated to the Appellant at all prior to issuance of the Decision. This is in itself clearly a violation of Article 113(1) EPC, and is a sufficient reason for the Board to set aside the Decision.

- b) As mentioned previously, the filing receipt which was sent to the Appellant had a typed entry "3", indicating prima facie that at the time of typing three copies of the claims had been received. In addition, the manuscript word "missing" indicates, prima facie that the claims were missing from the file at the time of the manuscript entry. These two entries are obviously inconsistent, at any particular instance in time, and there is no way of knowing from examination of the receipt in which order the entries were made. Prima facie each was correct at the time it was made. Thus, on its face, the filing receipt indicates, by a deliberate entry upon it, that three sets of claims were in fact filed at the European Patent Office on 27 September 1984 together with the other documents relating to this patent application. On its face, therefore, the filing receipt supports the contention of the Appellant.

In the Board's view, the whole of the evidence in support of the Appellant's contention that claims were in fact filed on 27 September 1984 (i.e. the written evidence on behalf of the Appellant, in combination with the filing receipt) is certainly sufficient to establish the probability that three sets of claims were in fact filed on that day, in the absence of a greater weight of evidence to the contrary. In other

words, such evidence shifted the burden to the European Patent Office to provide a greater weight of evidence to the contrary, before a finding that no sets of claims were in fact filed could properly be made.

The Decision under appeal (page 9) states that "The European Patent Office must, in the first instance, consider that the claims were not filed on 27.09.84. The explanations and statements by the representatives do not prove that the claims were in fact filed with the European Patent Office on 27.09.84 ...". This is followed by criticisms of the Appellant's evidence: "The representatives' secretary who was responsible for compiling the application documents has only stated that she does not record that the claims were missing; the professional representative of the Munich office who was responsible for the filing of the European patent application has only stated that he did not note the complete absence of claims".

In relation to such criticisms, the Board is satisfied that in the circumstances of the case, the secretary and the professional representative could not be reasonably expected to say any more than they did, in fulfilment of their obligation to state the relevant facts so far as they could recollect them about three weeks later.

The substance of the report from the person in charge of the Post Room at the relevant date is set out at page 7 of the Decision as follows :

"The Munich Post Room explained that a cross in the Box "Claim(s)" and the comment "Missing" did not represent any contradiction. The Applicant had not enclosed an acknowledgement of receipt. As is the practice in such

a case, the printed form for the acknowledgement receipt had been first of all typed out using the check-list contained in the Request for Grant Form and only after that were the enclosures checked for their completeness. It was then established that the claims were missing and therefore the comment "Missing" was written by hand. There is no doubt that the claims were not enclosed."

In relation to this report, the Board comments as follows :

- i) The purpose of completing a receipt is to provide a record of the items actually received. In the present case a filing receipt has been sent to the Applicant which on its face indicates that three sets of claims were filed on 27 September 1984, but that at some time before despatch of the receipt they were found to be missing.
  
- ii) In order to carry sufficient weight as evidence to establish, contrary to the weight of evidence provided by the filing receipt itself corroborated by the written statements and affidavits signed by individual persons on behalf of the Appellant, that no sets of claims were filed on 27 September 1984, such a report ought to have been detailed and precise and to have identified the individual employees of the European Patent Office who handled the file of this case on and after 27 September 1984. Furthermore, it should have been made available to the party affected immediately.

The report from the Post Room in the present case, signed by the head of the Post Room and containing only an assertion that there was "no doubt" that the claims were not enclosed, clearly carries insufficient weight as evidence to displace the evidence on behalf of the Appellant to the effect that the claims were, as a matter of probability, filed on 27 September 1984. The report, as cited in the Decision under appeal, is not inconsistent with the claims being received but mislaid in the European Patent Office.

Thus, for the reasons set out above, even if the report from the Post Room had been sent to the Appellant for comment prior to issuance of the Decision in accordance with Article 113(1) EPC, in the Board's view such report had insufficient weight as evidence to support a finding that no sets of claims were filed on 27 September 1984.

5. Having regard to the provisions of Article 114(1) EPC quoted in paragraph 3 above, the Board has considered whether the case should be remitted to the Receiving Section for further investigation, or whether it should itself investigate the facts of the case in relation to the handling of the documents which were filed in the Post Room on 27 September 1984. However, although it was filed in due time, the Statement of Grounds of Appeal was not filed until September 1985, so that any such investigation and taking of evidence would necessarily have to have taken place more than a year after the relevant events. It could not be expected in those circumstances that the personnel in the Post Room would have a clear recollection of what

happened to the documents of this particular case, and therefore to conduct such an investigation now would not be fair either to the Appellant or to the European Patent Office.

This consideration emphasises the importance of what is stated in paragraph 4 above, to the effect that in a case such as the present the department or section concerned should initiate the taking of evidence as soon as it is apparent that there is a dispute as to facts between the European Patent Office and a party to proceedings before it.

6. It should be clearly understood that, on the available information, the Board has no reason to doubt the obviously genuine beliefs of the Appellant and of the head of the Post Room, respectively, that sets of claims were/ were not filed with the other documents on 27 September 1984. However, having regard to the procedure which was followed by the Receiving Section and having regard to the impracticability of making new enquiries into the facts of the case so long after the events in question, the Board considers that it would be unfair to decide this case against the Appellant.
7. In these circumstances, there is no need for the Board to decide the remaining two questions raised in the Statement of Grounds of Appeal.
8. For the above reasons, the Board has decided to allow this appeal.
9. The Board has considered whether, in accordance with Rule 67 EPC, the reimbursement of the appeal fee should be ordered. As stated in paragraph 4(a) above, there was a substantial procedural violation of Article 113(1) EPC by

the Receiving Section, which forms the basis for the Board's decision to allow the appeal. Reimbursement of the appeal fee is clearly equitable by reason of this violation in all the circumstances of the case.

Order

10. For these reasons,

it is decided that :

- (1) The Decision of the Receiving Section dated 26 April 1985 is set aside.
- (2) The date of filing of European patent application No. 84 111 579.3 is considered as 27 September 1984.
- (3) Reimbursement of the appeal fee is ordered.

The Registrar:

J. Rückerl

The Chairman:

Peter Ford