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Aktenzeichen / Case Number / N^o du recours : J 3/87

Anmeldenummer / Filing No / N^o de la demande : 84 903 426.9

Veröffentlichungs-Nr. / Publication No / N^o de la publication : 0 156 840

Bezeichnung der Erfindung: Treatment of porous membranes

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : B01D 13/04

ENTSCHEIDUNG / DECISION

vom / of / du 2 December 1987

Anmelder / Applicant / Demandeur : Memtec Limited

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Membranes/MEMTEC

EPO/EPC/CBE Rules 101(4), 85b, 67

Kennwort / Keyword / Mot clé : "Reimbursement of surcharge on examination fee"
- "Filing of authorisation in due time" -
"Clarity and unambiguity of communications" -
"Principles of good faith"

Leitsatz / Headnote / Sommaire

I. The principles of good faith governing relations between the EPO and applicants require communications to be clear and unambiguous to the applicant (J 2/87 of 20 July 1987). Communications must be worded so as to rule out any misunderstanding on the part of a reasonable addressee.

II. A party to proceedings before the EPO cannot suffer a disadvantage as a result of having been misled by a communication which could fairly be regarded as misleading to a reasonable addressee.

III. An examination fee surcharge which would not have become due in the absence of a misleading communication must accordingly be reimbursed in accordance with the principles of good faith.

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Europäisches
Patentamt

Beschwerdekammern

European Patent
Office

Boards of Appeal

Office européen
des brevets

Chambres de recours



Case Number : J 3/87

D E C I S I O N
of the Legal Board of Appeal
of 2 December 1987

Appellant : Memtec Limited
60 Macquarie Street
Parramatta
New South Wales 2150
Australia

Representative : Eyles, Christopher Thomas
BATCHELLOR, KIRK & EYLES
2 Pear Tree Court
Farringdon Road
London, EC1R 0DS

Decision under appeal : Decision of the Receiving Section
of the European Patent Office dated
9 July 1986

Composition of the Board :

Chairman : P. Ford

Members : R. Schulte

G.D. Paterson

Summary of Facts and Submissions

- I. The appellants, a company with its principal place of business in Australia, filed an international application designating the EPO on 12 September 1984.
- II. This application was assigned No. 84 903 426.9 in proceedings before the EPO and the international search report was published on 28 March 1985.
- III. Using Form 1200 (4.82) dated 10 May 1985 the applicant appointed representatives based in London, giving notice at the same time that the authorisation would be supplied in due time within the three-month time limit under Rule 101(4) EPC. The applicants also paid the fees due for the application, including the examination fee under Article 94(2) EPC, on 10 May 1985.
- IV. In a communication dated 29 July 1985 (EPO Form 1206) the applicants' representatives were informed that the requirements of Article 133(2) EPC had not been met. The applicants were requested to file the missing authorisation for their representatives within three months of receiving that communication, failing which the application would be refused under Article 91(3) EPC. At the same time the applicants' attention was drawn to the fact that under Rule 101(4) EPC procedural steps such as filing the request for examination (Form 1200) are deemed not to have been taken if the authorisation is not filed within three months of the representatives' appointment being communicated.

- V. In a letter dated 1 August 1985 the applicants' representatives stated that they would file their authorisation after receiving it from Australia.
- VI. In a letter dated 8 October 1985 and received on 10 October 1985 the applicants filed an authorisation for their UK representatives.
- VII. In a communication dated 7 November 1985 (EPO Form 1218) the applicants were informed that a valid request for examination had not been filed because an authorisation had not been filed within three months of the representatives' appointment on 14 May 1985, and that the request for examination was therefore deemed not to have been filed. The authorisation had not been received until 10 October 1985. The deficiency could be rectified within a period of two months from 30 September 1985 if a surcharge of 50% of the examination fee were paid under Rule 85b EPC. Otherwise the application would be deemed to have been withdrawn under Article 94(3) EPC.
- VIII. The applicants paid the 50% examination fee surcharge of £280 and in a letter dated 12 November 1985 requested that it be reimbursed. They argued that, although they were absolutely familiar with the three-month time limit under Rule 101(4) EPC, the communication dated 29 July 1985 had set a new three-month time limit for filing the authorisation, extending the time limit under Rule 101(4) EPC.

IX. In a telex dated 29 November 1985, which was confirmed, the applicants' representatives repeated the request for examination.

X. In a decision dated 9 July 1986 the Receiving Section held that the written request for examination dated 10 May 1985 was deemed not to have been filed under Rule 101(4) EPC and that the request for reimbursement of the examination fee surcharge was to be rejected. The reason given was that the Receiving Section was obliged by Article 91(1)(a) EPC concerning formal requirements to examine whether the Australian applicants were represented by a professional representative as laid down in Article 133(2) EPC. That included the filing of an authorisation. Since the latter had not been received, attention was drawn to this deficiency in a communication dated 29 July 1985 and a three-month time limit set. An authorisation had been filed within this time limit, so that it had not been possible to refuse the application under Article 91(3) EPC.

Independently from this three-month time limit which had been set, Rule 101(4) EPC laid down a non-extendable three-month time limit for filing the authorisation which began when the appointment of the representative was communicated. This three-month time limit expired on 14 August 1985 because the appointment of the representative had been communicated on 14 May 1985. No authorisation was filed within this time limit and all the representative's procedural steps were therefore deemed not to have been taken under Rule 101(4), second sentence, EPC. Accordingly, the request for examination dated 10 May 1985, filed by the representative on behalf of the applicants and received on 14 May 1985 was deemed not to have been filed. Thus, since no valid request for examination had been made

when the time limit for that request under Article 150(2) EPC expired on 30 September 1985 and the request for examination dated 29 November 1985 had been made within the two-month period of grace under Rule 85b EPC, the surcharge under Rule 85b EPC had become due and could therefore not be reimbursed.

XI. The applicants have appealed against this decision, desiring reimbursement of the surcharge on the examination fee. They argue that their representative was misled by the European Patent Office's communication of 29 July 1985, which he received before the three-month time limit under Rule 101(4) EPC had expired. As he understood this communication, it set a new time limit of three months for filing the authorisation. This time limit had been specially highlighted in the communication by means of underlining. That and the arrangement of the paragraphs gave the impression that the original three-month time limit had been replaced by the new three-month time limit. This impression was reinforced by the fact that it appeared perfectly reasonable for only one single date to be assigned for the filing of one single document (in this case the authorisation).

As a matter of general principle, moreover, deficiencies corrected within the prescribed time limit were regarded as never having existed. Accordingly, the authorisation filed on 29 November 1985 was to be regarded as having been filed on 14 May 1985. Furthermore, a time limit laid down under Rule 41(1) EPC had the effect of extending a time limit under Rule 101(4) EPC.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. The request for reimbursement of the surcharge on the examination fee was correctly refused under the contested decision if the applicants were obliged to pay that surcharge. This presupposes that under Rule 85b EPC the request for examination was not filed within the time limit provided for in Article 94(2) EPC but only within the period of grace of two months after the expiry of the time limit for the request for examination provided for in Rule 85b EPC.
3. As the department of first instance correctly established, the time limit for the request for examination expired on 30 September 1985. The applicants filed that request through their UK representatives using Form 1200, which was dated 10 May 1985 and received on 14 May 1985. No authorisation for the representatives was attached. Instead, the representatives stated on Form 1200 that the authorisation would be supplied in due time within the three-month time limit under Rule 101(4) EPC.
4. No authorisation was filed by the end of the three-month time limit under Rule 101(4) EPC, i.e. by 14 August 1985; a letter containing an authorisation, dated 8 October 1985, was not received until 10 October 1985. Under Rule 101(4), second sentence, EPC the request for examination is deemed not to have been filed if the authorisation is not filed in due

time, since any procedural steps taken by a representative are deemed not to have been taken if that condition has not been fulfilled.

5. The applicants' representatives were informed in the communication dated 29 July 1985 that the requirements of Article 133(2) EPC had not been met and that the application would be refused under Article 91(3) EPC if the missing authorisation were not filed within three months of that communication's being received. The same communication drew the applicants' attention to Rule 101(4) EPC and its consequences, namely that any procedural steps such as the filing of the translation and of the written request for examination (Form 1200) were deemed not to have been taken if the authorisation had not been filed within three months of the representatives' appointment being communicated.

6. The communication of 29 July 1985 and the requirements of Rule 101(4), second sentence, EPC consequently caused two different three-month time limits beginning on different dates and involving different penalties to apply to the same procedural step, namely the filing of the authorisation. This situation was inevitably likely to cause confusion and mistakes. The Board has always regarded the European Patent Office as being obliged to ensure that the state of affairs in relation to a particular case is at all times stated clearly and unambiguously, thus ruling out any misunderstanding on the part of those to whom communications are addressed (cf. the Board's Decision J 13/84 of 16 November 1984, OJ EPO 2/1985, p. 34 and its Decision J 2/87 of 20 July 1987, due for publication). This obligation is especially important when, as in the present case, a communication is dealing with complex provisions of the EPC which may lead to loss of rights if they are not complied with.

7. The Appellant has alleged that the communication dated 29 July 1985 was so confusing that it misled the representative as to the true procedural situation in law, with the result that the authorisation was not filed in due time as required by Rule 101(4) EPC; and he submits that the legal consequences which normally follow from non-compliance with Rule 101(4) EPC should not be applied in these circumstances.

In all normal circumstances, parties to proceedings before the EPO - and their professional representatives - are expected to know the relevant provisions of the EPC, even when, as in the present case, such provisions are intricate. In the Board's view, the Appellant's submission can only be accepted if the Board is satisfied in respect of two matters which are pre-conditions:

- (a) it must be established that the communication from the EPO was the direct cause of the Appellant failing to comply with Rule 101(4) EPC;
- (b) it must also be established that, on an objective basis, it was reasonable that the Appellant was misled by the communication into a failure to comply with Rule 101(4) EPC.

As to (a), in the present case the Appellant filed a letter dated 12 November 1985, which was signed personally by the professional representative, and which clearly states that the representative did in fact understand the communication dated 29 July 1985 as setting "a new 3 month period for filing the authorisation which goes beyond the period of 3 months laid down by Rule 101(4) EPC and thereby extended the "due time" of the second sentence of Rule 101(4) EPC". The letter also states that as a result of this understanding the

representative "noted that the authorisation was due to be filed by a revised date of 29 October 1985 and so advised my Australian correspondent when I wrote to him on 1 August 1985 and in a reminder on 4 September 1985". The Board is fully satisfied by this evidence that the representative was in fact misled by the communication.

As to (b), as already stated above there is an intricate combination of provisions of the EPC which led in the present case to two different three-month periods beginning on different dates and involving different penalties for non compliance. In the Board's view it is unfortunate that the EPC currently provides such complexity in relation to such a simple procedural step as the filing of an authorisation. The Board notes that the communication dated 29 July 1985 was in fact a standard form - Form 1206, which is understandable having regard to the scale of operations within the EPO. This form does in fact correctly refer to the different provisions which were concurrently applicable to the circumstances of the present case. In this situation, the Board has carefully considered whether it was reasonable for the Appellant's representative to have been misled by reading this communication - having regard to the knowledge of the law expected from parties before the EPO and their representatives (and in the present case the representative has stated that before receipt of the communication he was fully aware of the provisions of Rule 101(4) EPC). Having regard to the exceptional combination of the complex provisions of the EPC and the way in which the contents of the communication were presented and formulated, in the Board's judgement it was reasonable in the present case for the recipient of that communication to infer that a new three-month time limit for filing the authorisation under Rule 78(3) EPC, namely up to 8 November 1985 had been set. The missing authorisation was filed within this time limit.

Under the principles of good faith governing relations between the EPO and applicants (cf. Decision J 2/87 of 20 July 1987), the authorisation is therefore to be regarded as having been filed in due time on the strength of the communication dated 29 July 1987. In this case, therefore, there are no grounds for levying the surcharge on the examination fee under Rule 85b EPC, so that fee must be reimbursed.

8. The appeal fee is to be reimbursed under Rule 67 EPC because the appeal is allowable and reimbursement is equitable by reason of a substantial procedural violation. If an EPO communication is not as clear and unambiguous as it ought to be, and leads a reasonable recipient into error, that amounts to a substantial procedural violation, even if the ambiguity of the communication is partly due to an unfortunate provision of the law.

Order

For these reasons, it is decided that:

1. The contested decision is set aside.
2. Reimbursement of the examination fee surcharge and the appeal fee is ordered.

The Registrar:

J. Riba

The Chairman:

Peter Lind