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Aktenzeichen / Case Number / N° du recours : J 11/88 - 3.1.1

Anmeldenummer / Filing No / N° de la demande : 84 306 417.1

Veröffentlichungs-Nr. / Publication No / N° de la publication : 0 138 411

Bezeichnung der Erfindung: Fiber optic amplifier

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : H01S 3/06

ENTSCHEIDUNG / DECISION

vom / of / du 30 August 1988

Anmelder / Applicant / Demandeur : The Board of Trustees of the
Leland Stanford Junior University

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Postal strike/Leland Stanford

EPU / EPC / CBE Rule 85(2), 85b, Article 114(1)

Schlagwort / Keyword / Mot clé : "General interruption in delivery of mail" -
"evidence, need for"

Leitsatz / Headnote / Sommaire

I. Whether or not an interruption in the delivery of mail or subsequent dislocation qualifies as a "general interruption" within the meaning of Rule 85(2) EPC is a question of fact which has to be decided upon the basis of any credible information available. In case of doubt, the EPO should make official enquiries of its own motion, in application of Article 114(1) EPC.

II. Rule 85(2) EPC is so drafted ("shall extend") that if a "general interruption" occurs, any time limit which expires within the period of interruption or dislocation is extended by operation of law.

Europäisches
Patentamt

Beschwerdekammern

European Patent
Office

Boards of Appeal

Office européen
des brevets

Chambres de recours



Case Number : J 11/88

D E C I S I O N
of the Legal Board of Appeal
of 30 August 1988

Appellant : The Board of Trustees of the Leland Stanford
Junior University
Stanford
California 94 305
USA

Representative : Rushton, Ronald
SOMMERVILLE & RUSHTON
11 Holywell Hill
St. Albans
Hertfordshire AL1 1EZ

Decision under appeal : Decision of the Head of the
Formalities Section of Directorate
General 2 of the European Patent
Office dated 28 October 1987 refusing
the request for refund of the
surcharge on the examination fee.

Composition of the Board :

Chairman : P. Ford
Members : J. Stephens-Ofner
E. Persson

Summary of Facts and Submissions

- I. European patent application No. 84 306 417 was filed on behalf of a U.S. applicant on 20 September 1984 by a professional representative having his place of business in England. The European Patent Bulletin published the search report on 17 September 1986, and by communication pursuant to Rule 50 EPC dated 23 September 1986 the representative's attention was drawn to the requirement to file the request for examination and pay the examination fee within the period laid down in Article 94(2) EPC.

- II. The receipt by the EPO of the requisite examination fee took place on 18 March 1987, one day after the expiry of the six-month time limit laid down by Article 94(2) EPC. The applicant, on being invited to do so by the EPO, then took advantage of Rule 85b EPC, by remedying the deficiency through the payment of the prescribed surcharge. It is this surcharge that the applicant now seeks to have refunded.

- III. In a letter dated 24 March 1987, the applicant's representative explained to the EPO that a strike by post office workers in the area in which he has his place of business between 10 and 13 March 1987, followed by dislocation in the delivery of mail until 17 March 1987 inclusive, had been the sole cause of the delay in the receipt by the EPO of the examination fee. The representative also filed, as evidence of the above-mentioned strike, a letter from the UK Post Office confirming the existence and the location as well as the dates of the strike. The EPO wrote to the representative on 10 April 1987, informing him that the postal strike did not constitute a "general interruption or subsequent dislocation in the delivery of mail in a Contracting

State", within the meaning of Rule 85(2) EPC, and thus did not have the effect of extending the time limit to 18 March 1987, which was the date on which the examination fee was in fact received. Accordingly, in the view of the EPO, the need to pay a surcharge under Rule 85b EPC was not obviated.

- IV. In a letter dated 5 June 1987 to the EPO the representative contested the EPO's interpretation of Rule 85(2) EPC, contending that the nature of any postal interruption was a question of fact, to be decided upon the evidence in each case and that the application of the Rule was not, accordingly, limited to a full national strike.
- V. During the year 1987, the President of the EPO, in accordance with Rule 85(2) EPC, had issued three separate notices concerning extension of time limits upon the ground of interruptions of postal services in the UK. All these notices were duly advertised in the Official Journal of the EPO, but none of them covered the period during which the strike in question took place.
- VI. On 28 October 1987 the Formalities Section of Directorate General 2 issued a decision rejecting the applicant's claim to have his surcharge refunded, relying on the evidence at that time available to it, and also upon a decision of the Legal Board of Appeal (J 4/87 OJ EPO 1988, 172), laying down that the EPO has no general discretion to extend a time limit and that any discretion it has must be derived from the EPC. Since the wording of Rule 85(2) EPC specifically requires there to be a general interruption in the delivery of mail and since the EPO has not been instructed that there was such an interruption, the time limit for paying the examination fee could not be

extended, and therefore the surcharge could not be refunded.

VII. The appellant duly filed an appeal against this decision. In the Statement of Grounds of the appeal the appellant submits that the above-mentioned three notices by the President of the EPO were made in respect of interruptions whose circumstances were identical with, or analogous to, those of the interruption in this case. The appellant further contends that in the absence of specific criteria within Rule 85(2) EPC as to what may, or may not, constitute a general interruption or subsequent dislocation in the delivery of mail in a Contracting State, the EPO was under an obligation to examine the evidence set out in the representative's letter of 24 March 1987 and in the letter from the UK Post Office, which confirmed the existence of a strike. Had it done so, the EPO would have had to conclude that the strike in question was indeed analogous to the strikes, in magnitude and consequence, in respect of which the President had, during 1987, issued three notices.

VIII. On appeal, the appellant has adduced further evidence in support of his contentions, namely a letter dated 10 December 1987 from the Assistant Comptroller, Patents and Designs (UK Patent Office), addressed to the Vice-President, Legal and International Affairs EPO, in which he states that in his view the strike in question was of such magnitude that had the UK Patent Office been requested to issue an appropriate certificate in respect of UK proceedings, it would have done so. The Assistant-Comptroller, in his letter, nonetheless indicates his reluctance to grant a retrospective certificate for the purposes of these proceedings, inter alia, because of the long period of time that had elapsed since March 1987.

- IX. The appellant also submits that the President of the EPO has inherent power to issue notices under Rule 85(2) EPC without any instruction or communication relating to postal interruptions from the appropriate patent authority of a Contracting State. He requests that the decision under appeal be set aside and that a refund of the surcharge paid under Rule 85b EPC be ordered.

Reasons for the Decision

1. The appeal complies with Articles 106-108 and Rule 64 EPC and is, therefore, admissible.
2. Rule 85(2) EPC provides inter alia, that if a time limit expires on a day on which there is a general interruption or subsequent dislocation in the delivery of mail in a Contracting State or between a Contracting State and the EPO, the time limit shall extend to the first day following the end of the period of interruption or dislocation. The duration of the period shall be as stated by the President of the EPO.

In the present case it is indisputable that the period of interruption and subsequent dislocation, was between 10 and 17 March 1987, so that receipt of the examination fee on 18 March would clearly be permissible under Rule 85(2) EPC, if the strike qualified under that Rule as a general interruption in the delivery of mail.

3. Whether or not a postal interruption or subsequent dislocation in mail delivery so qualifies, is a question of fact, which has to be decided upon the basis of information available to the EPO, whether as the result of evidence submitted or enquiries made, or both. It is the normal practice of the EPO to rely upon statements made by

or on behalf of the national industrial property office of the Contracting State concerned but there is nothing in the EPC to support the view that the EPO can only consider evidence of that kind. It may and indeed should take into account any credible information available, including official statements made on behalf of the relevant postal authorities. In case of doubt it should make official enquiries of its own motion - Article 114(1) EPC forming, as it does, part of the "Common provisions governing procedure" for the purpose of implementation of the EPC as a whole.

4. In the present case, the Assistant Comptroller Patents and Designs of the U.K. Patent Office has stated in his letter dated 10 December 1987 that "we are satisfied from the evidence available to us that there was a period of general interruption and subsequent disruption in the delivery of mail in the U.K. from 10 to 17 March 1987 and had any national application been involved we would have issued a certificate to this effect." In the view of the Board this is a strong and clear official statement on the basis of which the President of the Office would not have failed to act under Rule 85(2) EPC if the statement had been available to the Office in, or shortly after, March 1987.

5. Rule 85(2) EPC is so drafted ("shall extend") that if a general interruption or subsequent dislocation in the delivery of mail within the meaning of the Rule occurs, any time limit under the EPC which expires within the period of interruption or dislocation is extended by operation of law. Accordingly, if the President of the Office does not issue a statement as to the duration or that period, because he did not have the relevant information at the right time, this cannot affect the

rights of a person adversely affected by the interruption or dislocation.

6. The decision under appeal was given before the U.K. Patent Office issued its letter. It is not to be supposed that the decision under appeal would have been negative if the letter had been before the Formalities Section of Directorate General 2. But it is before the Board of Appeal and it clearly displaces the finding of the Formalities Section that there had been no "general interruption" in the delivery of mail within the meaning of Rule 85(2) EPC. The Formalities Section's reliance on the decision in J 4/87 is, in any event, misplaced. In that case it was only decided that when the President of the EPO has duly fixed the duration of an interruption in the delivery of mail in accordance with Rule 85(2) EPC, there cannot be any extension of the period so fixed by the exercise of any discretion. For these reasons, the decision under appeal must be set aside.

7. The question remains as to the appropriate procedure to be adopted in all the circumstances of this appeal. If the present case had been before the Board shortly after March 1987, it might have been appropriate to refer it, together with the evidence as to the general nature of the interruption in the delivery of mail and the relevant dates, to the Administration of the EPO, so that a retrospective statement applying generally might be made under Rule 85(2) EPC. But, particularly in view of the time that has elapsed, this seems inappropriate. After due consideration, the Board has come to the conclusion that it should simply declare for the purposes of the present case only, that by reason of the general interruption in the delivery of mail in the U.K. from 10 to 17 March 1987, the appellant was entitled to pay the examination fee without surcharge on 18 March 1987 under Rule 85(2) EPC.

In this respect, the Board adopts an approach comparable to that adopted by Graham J. in similar circumstances in the English High Court of Justice in the case of Omron Tateisi Electronics Company's Application (1981) R.P.C. 125 at 136-8, a case to which the U.K. Patent Office has specifically drawn the attention of the EPO in the present proceedings.

Order

For these reasons, it is decided that:

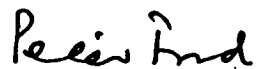
1. The appeal is allowed and the decision of the Formalities Section of Directorate General 2 dated 28 October 1987 is set aside.
2. Reimbursement of the surcharge paid under Rule 85b EPC is ordered.

The Registrar:

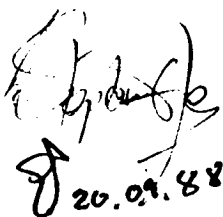


J. Rückerl

The Chairman:



P. Ford



20.09.88