

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 28 November 1995

Case Number: J 0043/92
Application Number: 87901616.0
Publication Number: 0258374
IPC: A47J 27/14, G07F 9/10
Language of the proceedings: EN

Title of invention:

Process for the fast cooking of pasta and the like and apparatus to put the process into practice.

Applicant:

ELECTRONICS FOR INDUSTRY LTD.

Opponent:

-

Headword:

Loss of rights/ELECTRONICS FOR INDUSTRY

Relevant legal provisions:

EPC Art. 65, 108
EPC R. 69

Keyword:

"Loss of rights - duty to give decision"
"Communication pursuant of R. 69 EPC - form"

Decisions cited:

J 0000/87; J 0029/86; J 0008/81; T 0222/85; J 0003/87

Headnote:

-



Europäisches
Patentamt

European
Patent Office

Office européen
des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number: J 0043/92

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 28 November 1995

Appellant: ELECTRONICS FOR INDUSTRY LTD.
10, New Square Lincoln's Inn
London WC2A 30QC (GB)

Representative: Laufhütte, Dieter
Lorenz, Seidler, Gossel
Widenmayerstrasse 23
D-80538 München (DE)

Decision under appeal: Decision of the Legal Division of the European
Patent Office given on 3 July 1992 rejecting the
request dated 3 May 1991 for registering the
transfer of the European patent application
No. 87 901 616.0.

Composition of the Board:

Chairman: R. Schulte
Members: B. Schachenmann
S. Perryman

Summary of Facts and Submissions

- I. The Examining Division of the European Patent Office issued a decision dated 29 April 1991 to grant a patent for the European patent application No. 87 901 616.0. It was indicated therein that the mention of the grant would be published in European Patent Bulletin 91/23 of 5 June 1991.
- II. On 3 May 1991 the applicants (appellants) informed the European Patent Office of several assignments of the above patent application and requested that these be recorded in the Register of European Patents "in order to have the publication of grant in the name of the new owner".
- III. In response the European Patent Office issued a communication dated 17 May 1991 pointing to several deficiencies in the request referred to above. The appellants were requested to remedy the deficiencies within a period of two months. At the bottom of the form used for this communication (EPO Form 2504 08.85) the following printed sentences were marked with a cross:
- "If the deficiency is not remedied in due time, the entry cannot be made in the Register of European Patents. The proceedings will then be continued with the present applicant/patent proprietor/ opponent."
- IV. The mention of the grant was published on 5 June 1991 in the name of the original applicants.
- V. In a letter dated 17 October 1991 the appellants expressed their surprise about the unexpected publication of the mention of the grant. The communication of 17 May 1991 had led them to believe

that the proceedings, including the publication of the mention of the grant, would not be continued before the end of the period set by the EPO in that communication. For this reason the appellants had failed to comply with the time limits prescribed by the Contracting States for filing translations of the patent specification.

- VI. In a brief communication dated 29 October 1991 the European Patent Office replied that the publication of the mention of the grant on 5 June 1991 could not have been avoided since the preparation for publication were already completed at the time when the appellants' letter of 3 May 1991 reached the file. The appellants were also reminded of the fact that the documents required for recording the transfer were still outstanding.
- VII. On 9 December 1991 the appellants applied for a decision on the matter pursuant to Rule 69(2) EPC. In their opinion the brief communication referred to above was a communication pursuant to Rule 69(1) EPC notifying the loss of a right which consisted in that, contrary to the communication of 17 May 1991, the publication of the mention of the grant was not postponed with the effect that the time limits prescribed by the Contracting States for supplying translations of the patent specification could not be observed.
- VIII. On 3 July 1992 the Legal Division of the European Patent Office issued a decision rejecting the appellants' request for registering the transfers on the grounds that the requirements of Rule 20 EPC were not complied with in time. The decision did not, however, deal with the issues raised by the appellants in their request for a decision pursuant to Rule 69(2) EPC.

IX. On 2 September 1992 an appeal was lodged against the decision of the Legal Division.

In the statement setting out the grounds of appeal filed on 3 November 1992 the reasons of the decision under appeal were neither discussed nor contested. Instead, the appellants referred to the issues already raised in their request for a decision pursuant to Rule 69(2) EPC. In particular, they submitted that, according to the principle of good faith governing the relations between the EPO and the applicants, they were entitled to rely on the EPO's communication of 17 May 1991 indicating that the proceedings would not be continued before the end of the period set in this communication. Any loss of rights which had occurred due to this misleading communication should therefore be reversed.

The appellants requested that the decision dated 3 July 1992 be set aside and that the publication of the mention of the grant of the patent be repeated. As an auxiliary request it was requested that the mention of the grant be deemed not to have been published before 17 July 1991.

Reasons for the Decision

1. The present appeal lies from the decision of 3 July 1992 of the Legal Department rejecting the appellants' request for registering the transfers of their patent application. It was issued after the appellants having applied for a decision pursuant to Rule 69(2) EPC regarding the findings contained in the brief communication of 29 October 1991 (see point VII, above).

Although the statement setting out the grounds of appeal does not deal with the reasons given in the impugned decision, it clearly emerges from the appellants' submissions that the decision under appeal is contested on the grounds that the first instance did not hear the case brought forward by the appellants in their request for a decision pursuant to Rule 69(2) EPC. Thus, the statement of the grounds of appeal refers to a circumstance which, if confirmed, would invalidate the contested decision (see point 3, below). The appeal is therefore considered to be sufficiently well-founded to satisfy the requirements of Article 108, third sentence (see decision J .. /87, OJ EPO 1988, 323). Since it also complies with the other requirements of Articles 106 to 108 and of Rule 1(1) and 64 EPC, it is admissible.

2. As mentioned above, the first instance only dealt with the recording of the transfers of the patent application rather than considering the issues raised by the appellants in their request for a decision pursuant to Rule 69 EPC.

The question therefore arises, whether the European Patent Office had the duty to hear and determine the case raised by the appellants in their request for a decision of 9 December 1991.

3. According to the jurisdiction of the Boards of Appeal a party who applies for a decision under Rule 69(2) EPC is entitled to receive one (see decision J 29/86, headnote published in OJ EPO 1988, 84).

However, a decision pursuant to Rule 69(2) EPC can only validly be applied for in the circumstances defined in Rule 69(1) EPC. Thus, it is a necessary condition for such an application that the European Patent Office previously noted the loss of a right resulting from the

Convention without any decision and communicated this to the party concerned. Otherwise, there is no basis for the European Patent Office to give a decision pursuant to Rule 69(2) EPC.

The appellants' submissions start from the assumption that the brief communication of 29 October 1991 was a communication pursuant to Rule 69 EPC informing the appellants of the loss a right resulting from the Convention. However, the appellants remain rather vague as to the nature of the right which, in their view, was referred to in the communication as being concerned by a loss.

Thus, it is further to be considered whether the brief communication of 29 October 1991 was indeed a communication pursuant to Rule 69 EPC.

4. Rule 69(1) EPC does not prescribe any particular form for the communications provided therein distinguishing them from other communications or notifications under the Convention. Even if, according to the Legal Advice by the EPO No. 16/85, OJ EPO 1985, 141, communications in which the European Patent Office notes the loss of any right normally contain a reference to the time limit for an application for a decision on the matter under Rule 69(2) EPC, such reference does not appear to be necessarily decisive as to the true nature of the communication. Whether a document constitutes a communication pursuant to Rule 69(1) EPC should be derived from its substantive content and its context (see decisions J 8/81, OJ EPO 1982, 10, and T 222/85, OJ EPO 1988, 128, regarding the form of decisions). Obviously, a communication of the type referred to above

has at least to indicate which of the party's rights under the Convention was, in the opinion of the European Patent Office, concerned by a loss resulting from the Convention.

5. In the circumstances of the present case the brief communication of 29 October 1991 did not bear any reference to Rule 69 EPC. It contained substantially the following statements:

- (a) The Formalities Officer confirmed that the publication of the mention of the grant could not be avoided.
- (b) It was pointed out that according to the state of the file the time limits vis-à-vis the National Offices could have been met, if the necessary supporting evidence for the transfers of the application had been filed within the time limit set in the communication of 17 May 1991.
- (c) Finally, the appellants were informed that neither the documents required for registering the transfers nor a request for extension of the time limit referred to above had reached the file.

The appellants' submissions mainly deal with the issue referred to in the first statement, whereas the third statement was not contested.

6. With regard to the first statement referred to above (see point 5(a)) the appellants argue that the loss of rights notified by the Office consisted in the fact that, contrary to the indication in its communication of 17 May 1991, the publication of the mention of the grant was not postponed. In their opinion they were entitled to expect, due to the principle of good faith governing

the relations between the European Patent Office and its users, that the publication of the mention of the grant was postponed (see point IX, above). In this context the appellants referred to the decision J 3/87, OJ EPO 1989, 3, according to which a party cannot suffer a disadvantage as having been misled by a communication which could fairly be regarded as misleading to a reasonable addressee.

However, in the Board's judgement, the communication of 17 May 1991 cannot, on an objective basis, be regarded as misleading. It was issued in order to draw the appellants' attention to certain deficiencies in the request for recording the transfers of the patent application. The printed sentences marked at the bottom of the communication (see point III, above) obviously were to clarify **which person** was entitled to conduct the proceedings before the European Patent Office in the event the transfer could not be registered. "Then" (= in this case) the proceedings would be continued with the present applicant (see Article 60(3) EPC).

No indication of any suspension of the proceedings can reasonably be derived from this passage. The appellants should have been aware in this context that the Convention only provides for a suspension of proceedings in the particular circumstances of Rule 13 EPC which, however, did not apply in the present case.

Moreover, after receipt of the decision to grant announcing the date and the number of the bulletin in which the mention of the grant would be published, the appellants should have been aware of the fact that the technical preparations for publication were completed

and that the announced publication of the mention of the grant could no longer be influenced (see Rule 53 EPC in combination with Rule 48 and the Statement by the President of the EPO of 18 July 1978, OJ EPO 1978, 312).

Thus, the appellants were not entitled, under the principle of good faith or any provision of the Convention, to a postponement of the scheduled publication of the mention of the grant. However, a non-existing right cannot be the subject of a loss of rights. For this reason alone, the statement referred to in point 5(a), above, cannot be considered as communicating the loss of a right.

7. However, the appellants further submit that their failure to comply with the time limits vis-à-vis the National Offices, which was due to the fact that the publication of the mention of the grant had not been postponed, resulted in a loss of their patent rights in the Contracting States constituting a loss of rights within the meaning of Rule 69 EPC.

It was argued in this context, that the time limits for filing translations in the Contracting States depended, pursuant to Article 65(1) EPC, on procedural steps of the European Patent Office, and that any failure to comply with the same was sanctioned, according to Article 65(3) EPC, by an immediate loss of the patent rights, thus being a loss of rights resulting "from the Convention".

In the Board's judgement, the appellants' reasoning summarized above is not well-founded, either. Article 65 EPC is a provision which, according to its wording, is not directly applicable to European patents but rather needs implementation by the national laws of the Contracting States ("Any Contracting State may

prescribe..."). Unless the implementing national laws so require, the filing of a translation of the specification of the European patent is not a condition for the protection in the Contracting States (see Legal Advice from the EPO L 02/79, OJ 1979, 63). Even if a translation is required in a Contracting State, the sanctions of failure to supply such a translation are still to be determined by the implementing national law.

Despite the fact that the time limits for supplying the translation may depend, pursuant to Article 65(1) EPC, on certain procedural steps of the European Patent Office, they remain time limits to be observed vis-à-vis the national patent authorities of the Contracting State rather than the European Patent Office.

Accordingly, any loss of a right due to failure to observe the provisions adopted by a Contracting State pursuant to Article 65 EPC is a loss **resulting from the national law** rather than from the Convention. However, Rule 69 EPC only concerns losses of rights **resulting from the Convention**, i.e. cases in which the Convention provides for the direct effect of a loss of rights (see Legal Advice by the EPO No. 16/85, OJ EPO 1985, 141).

Thus, even if the brief communication of 29 October 1991 referred to the failure to observe the time limits vis-à-vis the National Offices (see point 5(b) above), it did not constitute a communication of a loss of rights within the meaning of Rule 69 EPC.

8. In conclusion, the Board finds that none of the challenged statements of the brief communication of 29 October 1991 can be considered as referring to the loss of a right within the meaning of Rule 69 EPC. The brief communication of 29 October 1991 was no communication pursuant to Rule 69 EPC. Thus, the first

instance was correct in abstaining from giving a decision concerning the issues raised by the appellants in their request for a decision.

9. Nevertheless, after expiry of the time limit set in the communication of 17 May 1991, the first instance was entitled, pursuant to Rule 20(2) EPC, second sentence, to decide on the appellants' request for registering the transfers.

Since the appellant never contested the findings of the appealed decision as such, there is no reason for the Board to extend its considerations to those findings.

10. For the reasons set out above, the appellants' requests referred to in point IX of the summary of facts and submissions cannot be allowed. In particular, there is no legal basis for repeating the publication of the mention of the grant or for deeming it not to have been published before 17 July 1991.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

J. Ruckerl

R. Schulte