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**D E C I S I O N**  
of 27 November 1997

**Case Number:** J 0009/96  
**Application Number:** 93904620.7  
**Publication Number:** WO93/15280  
**IPC:** E02F 9/28

**Language of the proceedings:** EN

**Title of invention:**  
Attachment assembly for excavation teeth

**Applicant/Patentee:**  
H & L TOOTH COMPANY

**Opponent:**  
-

**Headword:**  
Notification/H & L TOOTH COMPANY

**Relevant legal provisions:**  
EPC Art. 119  
EPC R. 78(2), 82, 85a, 85b, 104b

**Keyword:**  
"Notification by ordinary letter"  
"Notification deemed to have been made when despatch has taken place"

**Decisions cited:**  
G 0003/91

**Headnote:**  
Notification of a communication posted as an ordinary letter in accordance with Rule 78(2) EPC is deemed to have been made when despatch has taken place. If such a communication has not reached the addressee and is not returned to the EPO, the legal fiction of deemed notification cannot be applied, unless it is established that the communication was duly despatched by the EPO.



Europäisches  
Patentamt

European  
Patent Office

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des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number: J 0009/96 - 3.3.1

**D E C I S I O N**  
of the Legal Board of Appeal 3.3.1  
of 27 November 1997

**Appellant:**

H & L TOOTH COMPANY  
1540 South Greenwood Avenue  
Montebello  
USA - CA 90640 (US)

**Representative:**

Viering, Hans-Martin  
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**Decision under appeal:**

Decision of the Receiving Section of the European Patent Office posted on 25 October 1995 according to which the European patent application No. 93 904 620.7 was deemed to be withdrawn.

**Composition of the Board:**

**Chairman:** J.-C. Saisset  
**Members:** B. Schachenmann  
S. Perryman

## Summary of Facts and Submissions

- I. The appellants, a company having its place of business in the USA, are applicants of Euro-PCT application No. 93 904 620.7 (Int. publication No. WO 93/15280). On 30 November 1994 the appellants which, at that time, still had not appointed a European professional representative were informed by the EPO that their patent application was deemed to have been withdrawn since the fees due according to Rule 104b(1) EPC were neither paid within the normal period nor the grace periods of Rules 85a and 85b EPC.
- II. With letter of 30 January 1995 the appellants applied for a decision pursuant to Rule 69(2) EPC and, as first auxiliary request, for restitutio in integrum with respect to the periods of grace of Rule 85a and 85b EPC. Simultaneously they paid all the fees payable. As second auxiliary request, conversion under Article 135(1)(b) EPC was requested in accordance with the provisions of Article 136 EPC.

The appellants submitted that they had never received the communications pursuant to Rule 85a and 85b EPC which, pursuant to Rule 78(2) EPC, were to be posted as ordinary letters. It could not be excluded that the internal postal service of the EPO had never despatched them. Since, according to this Rule, notification was deemed to have been made when despatch has taken place, the burden of proof that the communications were indeed duly despatched rested on the EPO. Unless the EPO could establish this, it had to be assumed that despatch, which was the relevant event for triggering the periods of grace, never occurred.

III. In its decision of 25 October 1995 the Receiving Section rejected these arguments. It held that, contrary to notifications effected by registered letter where it was incumbent on the EPO to establish that the letter had reached its destination (Rule 78(3) EPC), there was no such burden on the EPO for notifications under Rule 78(2) EPC, i.e. notifications to addressees outside of the Contracting States. Since, in the circumstances of the present case, no irregularities were apparent from the file, there was no reason to assume that the communications pursuant to Rule 85a and 85b EPC of 23 September 1994 had not been duly despatched. Thus, notification was deemed to have taken place on that date.

The request for re-establishment was rejected on the grounds that according to the decision G 3/91 of the Enlarged Board of Appeal the period of grace of Rule 85a EPC was closely linked with the normal periods laid down in Articles 78(2) and 79(2) EPC and in Rule 104b(1) EPC and was accordingly excluded, as they are, from re-establishment under Article 122(5) EPC. The request for conversion was transmitted to the Contracting States referred to therein.

IV. The appellants filed an appeal against this decision seeking as main request the setting aside of the decision under appeal and the cancellation of the notification of loss of rights. As auxiliary request they asked for restitutio in integrum with respect to the periods of Rule 85a and 85b EPC. In the event that neither of these requests could be granted, the appellants requested that "the present legal question" be referred to the Enlarged Board of Appeal and that oral proceedings be held.

In support of their main request the appellants submitted that according to Rule 78(3) EPC concerning notifications from the EPO effected by registered letter the burden of proof rested on the EPO, whereas Rule 78(2) EPC did not contain such provisions. However, from this fact it could not be concluded that for notifications under Rule 78(2) EPC the burden of proof should be on the side of the applicants. This was all the more so since in the case of Rule 78(2) EPC the applicants would never be able, already from a theoretical point of view, to prove that the despatch of a document to be notified as an ordinary letter had **not** taken place. Thus, if the burden of proof rested on them, they would, in the event of any dispute, be totally at the mercy of the EPO.

Concerning the request for re-establishment the appellants denied the applicability of decision G 3/91 to their case.

### **Reasons for the Decision**

1. The appeal is admissible.
2. The first question to be considered is whether the periods of grace pursuant to Rule 85a and 85b EPC indeed had expired before the appellants paid the fees provided for in Rule 104b(1) EPC. Only if this question is denied, the request for re-establishment has to be dealt with.
3. The relevant event for triggering the start of the periods of grace pursuant to Rule 85a and 85b EPC is the notification of a communication pointing out the failure to observe the time limit. Since the appellants, a company having its place of business in

the USA, had not yet appointed a European professional representative at that time, such notification had to be effected, according to Rule 78(2) EPC, by posting as an ordinary letter. Moreover, by this Rule notification was deemed to have been made "when despatch has taken place", even if the letter is returned to the sender owing to the impossibility of delivering it to the addressee.

4. The appellants always affirmed that they had never received any of the communications pursuant to Rule 85a(1) and 85b EPC, respectively. Although, as they stated, they had spent substantial time and effort reviewing their records, they could not find any hint at a receipt of these documents. The Receiving Section never disputed these submissions but took the view that there was no reason to assume that the corresponding communications were not despatched and that, pursuant to Rule 78(2) EPC, the EPO had no further burden of proof.
5. The Board does not have any reason either to doubt the appellants submissions. While the addressee bears the whole risk for the correct delivery of the letter by the post, it follows from Rule 78(2) EPC, that deemed notification depends on the pre-condition that despatch has indeed taken place. If despatch has not taken place, the notification cannot be deemed to have been made.
6. According to the general provision of Article 119 EPC the European Patent Office shall, as a matter of course ("von Amts wegen", "d'office"), notify those concerned of decisions, summonses and other communication from which a time limit is reckoned. Thus, as confirmed by Rule 82 EPC, the European Patent Office is responsible for the notification of communications such as those of Rule 85a and 85b EPC.

For notifications effected by posting as an ordinary letter according to Rule 78(2) EPC the responsibility of the European Patent Office ends with **but includes** the despatch of the letter. This means that, in the event of any doubt, the European Patent Office has to prove that the letter was duly despatched. If this cannot be ascertained, it has to be assumed in favour of the addressee that the pre-condition for deemed notification was not met with the effect that notification cannot be considered to have been made.

7. In the decision under appeal the normal procedure of the European Patent Office for sending off communications is described in some detail. Therefrom it follows that communications sent by ordinary letter are generated in the Receiving Section in duplicate. These are date-stamped at the same time. One of them, the original, is given to the internal postal service of the European Patent Office which will despatch it to the post-office on the stamped date. The other is used as a file copy. The internal postal service does not keep any list or record of the communications despatched as ordinary letters.

The only evidence available in cases of notifications effected by ordinary letter is therefore the date-stamped file copy of the communication. However, the presence of this date-stamped copy on the file proves no more than that it was correctly generated by the computer and date-stamped by the Receiving Section. Its presence cannot of itself be treated as proof that the original communication was indeed handed to the internal postal service, or that the internal postal service duly despatched it to the post office. These are events that appear on the evidence to take place subsequent to or in parallel with the generation, date-stamping and placing on file of the file copy. There is no evidence that the file copy is only put on file

after positive confirmation of despatch. Nor does Rule 78(2) EPC contain any provision that the presence of a date-stamped copy of the communication on the file can be deemed to be proof of despatch.

8. In the decision under appeal the Receiving Section compared the provisions of Rule 78(2) EPC with those of Rule 92.3 PCT. An even more meaningful comparison could be made with § 127(1) No.2 of the German Patent Law. According to this provision (which appears to have been the model for the solution under the EPC) notifications from the Patent Office to persons not having a residence in Germany and who have not appointed a representative are deemed to have been made when despatch has taken place, even if the letter is returned to the sender owing to the impossibility of delivering it to the addressee. However, such notifications are only effective if the address to which a communication was sent and the date on which it was despatched were **recorded by the internal postal service** (see Schulte, PatG, 5. Aufl., § 127 Rdn 46-48 and §§ 175 and 213 of the German Code of Civil Procedure).

While it is clear that there is no such requirement under the EPC, some evidence of despatch must be provided. A procedure like that outlined above could be useful for providing the necessary proof in the event of any dispute with regard to the despatch of a communication to be notified according to Rule 78(2) EPC.

9. In the circumstances of the present case there is no evidence, for the reasons set out above, that despatch of the communications under Rule 85a and 85b EPC has indeed taken place, and so notification of these communications cannot be deemed to have taken place. It has therefore to be assumed in favour of the appellants



that these communications have not been notified up to now. It is not necessary for the European Patent Office to repeat notification of these communications, but the fees can be deemed paid in time since in the meantime the fees due under Rule 104b(1) EPC and the surcharges provided for in Rules 85a and 85b EPC have been paid.

10. In view of these findings the other requests of the appellants, in particular their request for re-establishment of rights, need not to be dealt with.

### Order

#### For these reasons it is decided that:

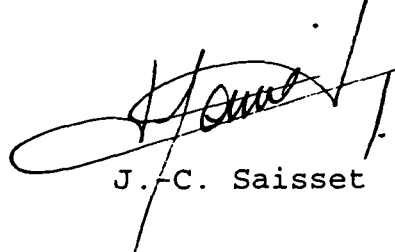
1. The decision under appeal is set aside.
2. The case is remitted to the Receiving Section for further prosecution.

The Registrar:



M. Beer

The Chairman:



J.-C. Saisset

B. Sch  
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