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D E C I S I O N
of 22 June 1996

Case Number: J 0030/96 - 3.1.1

Application Number: 94909600.2

Publication Number: WO 94/18803

IPC: H04Q 1/00

Language of the proceedings: EN

Title of invention:
Telemetry and control system

Applicant:
National Digital Electronics, Inc.

Opponent:
-

Headword:
Notification/NATIONAL DIGITAL ELECTRONICS, INC.

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

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

Decisions cited:
J 0009/96

Catchword:
-



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Boards of Appeal

Chambres de recours

Case Number: J 0030/96 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 22 June 1998

Appellant: National Digital Electronics, Inc.
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Dallas
Texas 75244-5136 (US)

Representative: Harris, Ian
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Decision under appeal: Decision of the Receiving Section of the European Patent Office posted on 5 August 1996 according to which the European patent application No. 94 909 600.2 was deemed to be withdrawn.

Composition of the Board:

Chairman: J.-C. Saisset
Members: B. Schachenmann
A. Lindqvist

Summary of Facts and Submissions

- I. On 10 February 1994 the appellants (applicants), a company located in the United States of America, filed international application No. WO 94/18803 at the US-PTO claiming a priority of 11 February 1993. The European Patent Office acted as a designated and elected office for the purposes of the PCT.

- II. On 10 October 1994 the EPO informed the US representatives of the applicants about the procedural steps to be taken under Rule 104b EPC within 31 months from the priority date for entry into the regional phase before the EPO. The communication was sent as ordinary letter.

- III. Since no such steps were taken within the period referred to above, it was the duty of the EPO to issue communications pursuant to Rule 85a(1) and 85b EPC.

- IV. On 11 December 1995 a European professional representative wrote to the EPO since, as he had been informed by his US associates, the 31 months period for entry into the regional phase had not been met. The representative asked the EPO for information as to whether the communications pursuant to Rule 85a and 85b EPC had already been issued, since "the applicant has not to date received a communication from the EPO indicating that the necessary steps for entry into the European regional phase have not been effected".

- V. In response to this inquiry the EPO informed the professional representative on 14 December 1995 that the communications referred to by him had been sent to the applicants already on 19 October 1995, the corresponding periods of grace having therefore expired on 20 November 1995. Consequently, the application was

deemed to be withdrawn according to Rule 104c(1) EPC. A formal communication noting a loss of rights pursuant to Rule 69 EPC was issued on 12 January 1996.

- VI. In a letter dated 21 February 1996, the professional representative asserted that the communications pursuant to Rule 85a(1) and 85b EPC had not been received by the applicants. Also, as could be seen from the file, the communications had not been returned to the EPO. In these circumstances, there was no evidence that actual despatch of the communications referred to above had taken place. However, where notification, as in the present case, was effected under Rule 78(2) EPC, actual dispatch must have taken place in order for the EPO to discharge its obligations under Rule 85a(1) and 85b EPC. In the absence of conclusive evidence to this effect, the noting of loss of rights of 12 January 1996 should be cancelled and the communications under Rule 85a and 85b EPC should now be dispatched. If the Receiving Section maintained the findings set out in the communication of 12 January 1996, the applicants requested that an appealable decision be issued.

At the same time the applicants performed the acts required under Rule 104b EPC and paid the surcharges provided for in Rule 85a(1) and 85b EPC.

- VII. In an affidavit dated 19 March 1996 Mr Ramon Jarrell, Chairman of the Board of Directors of the applicants, declared that no letter from the EPO informing them of the failure to nationalize the application in Europe had ever been received.
- VIII. By decision of 5 August 1996 the Receiving Section refused the applicants' requests and confirmed that the application was deemed to be withdrawn. There was no reason, in its view, to assume that the corresponding

communications to the applicants were not dispatched, which meant that notification was deemed to have taken place on the date indicated on the communications. Pursuant to Rule 78(2) EPC the EPO had no further burden of proof.

- IX. On 18 September 1996 a notice of appeal was filed against the decision referred to above. The appellants requested that the decision under appeal be set aside and that it be confirmed that all necessary steps for entry into the regional phase before the EPO were validly effected for the present application. In their statement of grounds of 2 December 1996 the appellants reiterated their earlier arguments and requested oral proceedings in the event that the Board of Appeal did not allow their requests.

Reasons for the Decision

1. The appeal is admissible.
2. According to Article 119 and Rule 78(2) EPC notifications in respect of addressees not having their place of business within the territory of a Contracting State and who have not appointed a European professional representative shall be effected by posting the document to be notified as ordinary letter. In such a case notification shall be deemed to have been made when dispatch has taken place, even if the letter is returned to the sender owing to the impossibility of delivering it to the addressee.
3. Since the appellants, a company located in the USA, had not appointed a European professional representative when the acts for entry into the regional phase were to be performed, the EPO could correctly, at that time,

effect notifications according to the provisions of Rule 78(2) EPC, i.e. by posting the documents to be notified as ordinary letters.

This was not disputed by the appellants. However, they submitted that they had not received the communications under Rule 85a(1) and 85b EPC and that there was no proof that dispatch had actually taken place. Since, according to Rule 78(2) EPC, notification shall be deemed to have been made when dispatch has taken place, it was incumbent on the EPO to ensure that documents to be notified in accordance with Rule 78(2) EPC were not only drawn up, but also posted including actual dispatch of those documents.

4. The Legal Board of Appeal does not have any reason to doubt the appellants' assertion that they did not receive the communications under Rule 85a(1) and 85b EPC. In particular, it is supported by the fact that, on 11 December 1995, an inquiry was sent to the EPO to find out whether such communications had already been issued. The appellants' submissions are further confirmed by the affidavit dated 19 March 1996 of Mr Ramon Jarrell and were never questioned or disproved by the Receiving Section.

5. The Receiving Section instead took the position that, where notifications to addressees outside the Contracting States were concerned, the EPO had only to ascertain whether there were any irregularities apparent from the file as concerns the dispatch. The Convention did not impose on the EPO any burden to prove that dispatch had actually taken place. In the circumstances of the present case there was no reason to assume that the notifications to the appellants had not been dispatched.

6. The legal issue presently at stake is virtually identical to that of case J 9/96 decided by the Legal Board of Appeal on 27 November 1997. In that decision it was found that the legal fiction of deemed notification pursuant to Rule 78(2) EPC could not be applied, unless it was established that a communication was duly dispatched by the EPO. Thus, in the event of any doubt, the European Patent Office had to prove that such a letter was actually dispatched. If this could not be ascertained, it had to be assumed in favour of the addressee that the pre-condition for deemed notification was not met with the effect that the notification could not be considered to have been made (see point 6 of the reasons). The Board concurs with these findings which appear to be immediately applicable to the present case.

7. In the circumstances of the present case the only available evidence regarding the drawing up of the communications pursuant to Rule 85a(1) and 85b EPC by the EPO are date-stamped file copies of these communications. However, there is no indication that the original communications were actually dispatched. As stated in decision J 9/96 referred to above, the presence of file copies cannot in itself be treated as proof that the original communications were indeed handed to the internal postal service, or that the internal postal service duly dispatched them to the post office.

8. Since it cannot be established that the communications under Rule 85a(1) and 85b EPC have indeed been dispatched by the EPO as required by Rule 78(2) EPC, 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. Since, in the meantime,

the appellants paid the fees due to Rule 104b EPC together with the surcharges provided for in Rules 85a(1) and 85b EPC, it is not necessary for the EPO to issue communications pursuant to the latter Rules.

Order

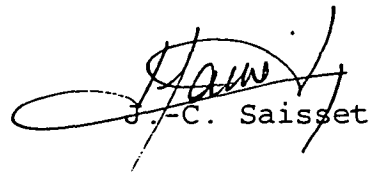
For these reasons it is decided that:

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. Scl.
Lgt