

BESCHWERDEKAMMERN
DES EUROPÄISCHEN
PATENTAMTS

BOARDS OF APPEAL OF
THE EUROPEAN PATENT
OFFICE

CHAMBRES DE RECOURS
DE L'OFFICE EUROPEEN
DES BREVETS

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 20 July 1993

Case Number: J 0032/97 - 3.1.1

Application Number: 95

Publication Number: -

IPC: -

Language of the proceedings: EN

Title of invention:
-

Applicant:
-

Opponent:
-

Headword:
Notification/-

Relevant legal provisions:
EPC Art. 119
EPC R. 67, 68(2), 78(2), 81(1), 82, 85a, 85b, 104b

Keyword:
"Notification by ordinary letter"
"Notification deemed to have been made when dispatch has taken place"
"Reimbursement of the appeal fee (no)"

Decisions cited:
J 0012/84, J 0001/89, J 0027/92, J 0009/96

Catchword:
-



Europäisches
Patentamt

European
Patent Office

Office européen
des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number: J 0032/97 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 20 July 1998

Appellant: -

Representative: -

Decision under appeal: Decision of the Receiving Section of the European Patent Office posted 29 May 1997 stating that European patent application No. 95 was deemed to be withdrawn.

Composition of the Board:

Chairman: J.-C. Saisset
Members: M. K. S. Aúz Castro
B. J. Schachenmann

Summary of Facts and Submissions

- I. The Appellant, who has his residence in Israel, is applicant of Euro-PCT application No. 95... (Int. publication No. WO 95/...).

By communication of 13 March 1997 the Appellant, who at that time had not appointed a European professional representative, was informed by the Receiving Section of the European Patent Office (EPO) according to Rule 69(1) EPC that his patent application was deemed to have been withdrawn because the national basic fee, the designation fees and the search fee had not been paid within the time limits specified in Rules 104b(1)(b) and (c) and 85a EPC.

- II. On 9 May 1997 the Appellant, who in the meantime had appointed professional representatives, applied for a decision pursuant to Rule 69(2) EPC.

The decision, that the application was deemed to be withdrawn, was issued on 29 May 1997 and notified to the Appellant's representatives.

- III. Against this decision the Appellant filed an appeal on 29 July 1997 paying the appeal fee on the same date. The Statement setting out the Grounds of Appeal was received on 19 September 1997.

- IV. The Appellant requested that

1. the decision of the Receiving Section be set aside,
2. new communications under Rules 85a(1) and 85b EPC be issued,

3. oral proceedings be appointed in case the Board should not allow the appeal,
4. the Appellant be allowed to present evidence in support of the appeal in the form of oral or written testimony by experts or witnesses should such evidence prove to be necessary,
5. the appeal fee be reimbursed.

V. The Appellant filed an affidavit in which he stated that he never received the communication pursuant to Rule 85a(1) EPC of the Receiving Section of 9 January 1997. He submitted that he resided at ... and not at ..., as incorrectly stated in the decision under appeal. Any communication sent to the Appellant using the code ... could have been delivered to an address in the area serviced by the mailing code

The Appellant indicated six grounds why the appeal should be allowed.

The first ground was that the decision under appeal did not indicate that the communication pursuant to Rule 85b EPC was issued to the Appellant. Also the communication under Rule 69(1) EPC did not refer to Rule 85b EPC.

The second ground was that, the Appellant's address given in the decision being incorrect, the decision did not indicate to what address the communication pursuant to Rule 85a(1) EPC was issued or by what means it was conveyed.

As third ground the Appellant put forward that the decision did not give any indication that the communication had been posted, that the proper fee to cover postage had been paid or that the German Postal Authority had received the communication into its postal system. In that respect there was a heavy onus of proof on the Receiving Section. The fact that the decision did not comply with this requirement constituted a procedural violation.

The fourth ground was that the EPO did not send a copy of the communication to the Appellant's international representative for information in accordance with a new procedure applicable to international applications with publication date on or after 31 October 1996, the Appellant's application's publication date being 9 November 1995. The Appellant considered the failure to carry out the new procedure already in his case to amount to a procedural violation, because the new EPO Forms 1217 and 1218 had been prepared prior to 9 January 1995 (not: 1997) and there was no reason why the new procedure could not be followed once the new forms were prepared.

The fifth ground was seen in the different ways of notifying post from the EPO to residents in the Contracting States and to those outside the Contracting States. This was considered to be unfair treatment of nationals of member countries of the Paris Convention for the Protection of Industrial Property and contravened its Article 2(1).

This application of different posting procedures equally infringed Article 4 of the Agreement on Trade Related Aspects of Intellectual Property Rights, which was forwarded as the sixth ground for allowing the appeal.

Reasons for the Decision

1. The appeal is admissible.
2. According to Rule 104b(1)(b) and (c) EPC in relation with Article 39(1) PCT the national fee, comprising in this case the national basic fee and the designation fees, and the search fee have to be paid within a period of 31 months from the priority date of the application.

The fees were not paid within this period, which expired on 2 December 1996.

3. In that case Rule 85a(1) EPC provides for a period of grace for the payment of the fees. It stipulates that they may still be validly paid within a period of grace of one month of notification of a communication pointing out the failure to observe the time limit, provided that within this period a surcharge is paid.
4. The Appellant not having a residence in one of the Contracting States and not having appointed a European professional representative at that time the communication pursuant to Rule 85a(1) EPC had to be notified by posting it as an ordinary letter bearing the last address of the addressee known to the EPO, Rule 78(2) EPC, first sentence. According to the second sentence of this provision 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.

In the case under consideration the letter was not returned to the EPO.

5. The Appellant, however, affirms that he never received the communication. The allegations he forwards with respect to his affirmation are, though, not pertinent.

It is true that the Appellant's address is wrongly indicated in the impugned decision, to be precise, in the part "Summary of Facts". This is of no relevance as the decision was notified to the Appellant's professional representative.

As can be seen from the file, all the communications previous to the decision, i.e. the information about "Entry into the Regional Phase before the EPO", the communications pursuant to Rules 85a(1) and 85b EPC bear the correct address of the Appellant, namely the same as indicated in the PCT-application and as confirmed by the Appellant himself in his affidavit and by the Appellant's representative in the Statement of Grounds of Appeal.

The Appellant's representative was in a position to verify this as copies of all the communications were sent to him by the Receiving Section. The address is indicated on top of the left hand side of the sheet containing the relevant communication. The EPO using envelopes with window, the address had not to be written again thus excluding the possibility of making errors of transcription.

Therefore, it is without doubt that all communications, in particular that one pursuant to Rule 85a(1) EPC bore the correct address of the Appellant.

6. Nevertheless, the Board has to allow the appeal for the following reasons:

In the circumstances under consideration the notification of the communication pursuant to Rule 85a(1) EPC had to be made by ordinary letter according to Rule 78(2) EPC. This rule stipulates that notification shall be deemed to have been made when dispatch has taken place. It follows from that that dispatch is a prerequisite for the notification to be deemed to have been made. If dispatch has not taken place, the notification cannot be deemed to have been made. For notifications effected by posting the documents to be notified as an ordinary letter the responsibility of the EPO ends with, **but includes** dispatching the relevant document. This means that in case of doubt the Office must be in a position to prove that the letter was duly dispatched.

The only evidence available here is the date-stamped file copy of the communication. This can, however, not serve as a proof that the communication itself had indeed been duly forwarded to the post office as explained already in detail in the Board's decision J 9/96 of 27 November 1997 (not published). Furthermore, there is no evidence that the file copy has been put on file only after dispatch of the communication.

7. The above cited decision compares the notification to addressees having their residence or place of business outside one of the Contracting States according to Rule 78(2) EPC to the German provisions, i.e. paragraph 127(1), No. 2 of the German Patent Law which, on its part, refers to paragraphs 175, 213 of the German Code of Civil Procedure. While apparently paragraph 175(1) has served as a model for the provision of Rule 78(2) EPC, paragraph 213 of that law

does not seem to have been taken into account. This provision stipulates that it has to be recorded in the file at what time and to which address the dispatch has been effected (see Schulte PatG 5. Aufl. § 127 Rdn 43-48).

Although no such provision was included in the EPC, the EPC must be able to prove that the dispatch of an ordinary letter according to Rule 78(2) EPC has actually taken place.

8. According to Article 119 the Office is responsible for the notification of any notice of communication from which a time limit is reckoned and Rule 82 lays down that where the Office is unable to prove the due notification of a document, the document is deemed to have been notified on the date established by the Office as the date of receipt.

The same must apply in cases where notification does not consist in the receipt of a document, but in its dispatch. Unless the Office can prove the dispatch of the document to be notified, the notification according to Rule 78(2) EPC may therefore not be deemed to have been made.

9. In the case under consideration there is no evidence that dispatch of the communication according to Rule 85a EPC has indeed been performed. Therefore, the notification of the communication may not be deemed to have taken place, with the consequence that a new communication has to be notified, this time according to Rule 78(1) EPC, second sentence by registered letter to the Appellant's representatives pursuant to Rule 81(1) EPC.

10. Reimbursement of the appeal fee shall be ordered according to Rule 67 EPC where the Board deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation.

11. The first condition that the appeal be allowed, is fulfilled.

The second condition is that a **substantial** procedural violation has occurred. The Appellant himself does not allege this. The Board, however, has to examine of its own motion whether a procedural violation has taken place and whether it was substantial.

12. The Appellant's contention in Ground of Appeal No. 1 that the Receiving Section committed a procedural violation by basing its communication under Rule 69(1) EPC and its decision only on the failure of the Appellant to comply with Rule 85a(1) EPC and not also on his failure to comply with Rule 85b EPC is rejected as irrelevant. It suffices to give one reason why the application is deemed to be withdrawn.

13. Ground of the Appeal No. 2 and No. 3 having been dealt with in substance under points 5 to 10 above, only the complaint of procedural violation by the Receiving Section raised in this connection has still to be examined.

The decision under appeal complies with Rule 68(2) EPC and is in itself consistent. The reason why it does not refer to the notification of the communication pursuant to Rule 85a(1) EPC in detail is probably that, in contrast to the German law, no explicit provision for keeping a record of dispatch of documents exists under the EPC and that the date-stamped file copy was considered sufficient proof for the dispatch.

Be that as it may, the Receiving Section, following the rules for notification stipulated by the EPC, needed not enumerate all the necessary steps for performing the notification. Therefore, no procedural violation was committed in the decision under appeal.

14. Also Ground of Appeal No. 4 consisting of the contention that a procedural violation was committed by not sending a copy of the communications pursuant to Rules 85a(1) and 85b EPC to the international representative of the Appellant, a new procedure applicable only to international applications with publication date on or after 31 October 1996, has to be rejected. This new procedure is a courtesy service not required by the EPC. Therefore, the Appellant cannot rely on the EPO systematically providing these courtesy services and is not entitled to base a claim on their omission or to claim that they should start earlier than actually foreseen (J 12/89, OJ EPO 1985, 108; J 1/89, OJ EPO 1992, 17; J 27/92 OJ EPO 1995, 288).

15. Ground of Appeal No. 5, alleging that the different procedures for notifying documents to persons with residence in the Contracting States and to those residing outside the Contracting States contravened Article 2(1) of the Paris Convention for the Protection of Industrial Property can also not be accepted by the Board. According to paragraph (3) of this article the provisions of the laws of each of the countries of the Paris Union relating to judicial and administrative procedure are expressly reserved. The European Patent Convention being a Special Agreement pursuant to Article 19 of the Paris Convention, this provision also applies to the procedure under the EPC. Therefore, unfair treatment cannot be claimed by the Appellant.

16. As to Ground of Appeal No. 6 submitting the same complaint of unfair treatment in view of Article 4 of

the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) it has to be rejected for the following reasons.

Article 4 of the TRIPS Agreement concerning the Most-Favoured-Nation Treatment provides in its first sentence that with regard to the protection of intellectual property, any advantage, favour, privilege or immunity granted by a Member to the nationals of any other country shall be accorded immediately and unconditionally to the nationals of all other Members. In the second sentence the exemptions from this obligation are enumerated. Under letter (d) are exempted any advantage, favour, privilege or immunity accorded by a member deriving from international agreements related to the protection of intellectual property which entered in force prior to the entry into force of the WTO Agreement provided that such agreements are notified to the council for TRIPS and do not constitute an arbitrary or unjustifiable discrimination against nationals of other Members. This applies to the Paris Convention as well as to the EPC.

17. Therefore, the Board comes to the conclusion, that no procedural violation, let alone a substantial procedural violation has been committed by the Receiving Section with the consequence that the requirements for the reimbursement of the appeal fee are not fulfilled.
18. The Appellant's auxiliary request for oral proceedings relating only to the allowability of the appeal, no oral proceedings are necessary with regard to the request for reimbursement of the appeal fee.

Order

For these reasons it is decided that:

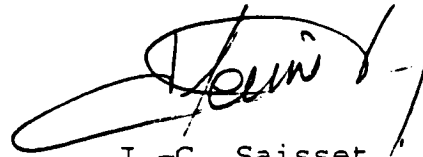
1. The decision under appeal is set aside.
2. The case is remitted to the Receiving Section for further prosecution.
3. The reimbursement of the appeal fee is refused.

The Registrar:



M. Beer

The Chairman:



J.-C. Saisset

B. Sch.

HE 1646.D