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D E C I S I O N
of 22 June 1999

Case Number: J 0038/97 - 3.1.1

Application Number: 88909905.7

Publication Number: 0394296

IPC: G01N 33/68

Language of the proceedings: EN

Title of invention:

Assay of a body fluid for measuring bone resorption

Appellant:

Octrooibureau Vriesendorp & Gaade

Patentee:

Washington Research Foundation

Opponent:

Osteometer Biotech A/S
F. Hoffmann-La Roche & Co. Aktiengesellschaft
Metra Biosystems Inc.

Headword:

Competence of DG2 director to decide on inspection of
file/OCTROOIBUREAU VRIESENDORP

Relevant legal provisions:

EPC Art. 25, 106(1), 128
EPC R. 9(3), 64, 67

Keyword:

"Competence of DG2 director to decide on inspection of file -
no"
"Admissibility of appeal - no"
"Reimbursement of appeal fee - yes"

Decisions cited:

G 0005/88, G 0007/88, G 0008/88, J 0002/87, J 0017/84,
J 0003/87, J 0001/89, J 0013/90, J 0030/94, T 0382/92

Catchword:

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Case Number: J 0038/97 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 22 June 1999

Appellant: Octrooibureau Vriesendorp & Gaade
P.O. Box 266
2501 AW Den Haag (NL)

Representative: -

Decision under appeal: Decision of the Examining Division of the
European Patent Office dated 10 February 1997
refusing inspection of documents under Article 25
EPC.

Composition of the Board:

Chairman: J.-C. Saisset
Members: M. Vogel
B. Schachenmann

Summary of Facts and Submissions

I. With letter dated 10 May 1996 the Appellant requested inspection of the complete file of European patent No. 0 394 296. After inspection of file on 6 June 1996 the Appellant complained that a technical opinion pursuant to Article 25 EPC requested by the Court of the Hague was not included in the file available to him. Technical opinions should form part of the file of the patent concerned and consequently should be open to the public under Article 128 EPC.

In his communication dated 17 October 1996 the Formalities Officer replied that technical opinions were not part of the procedure under Articles 75 to 112 EPC and therefore not open to public inspection pursuant to Article 128(4) EPC.

II. Subsequently the Appellant expressly applied for an appealable decision. With letter dated 10 February 1997 an "Office's Decision relating to inspection of Technical Opinions under Article 25 EPC" was issued. It was signed by Mr. "... , Director, Directorate 2116". This decision referred to the arguments of the Formalities Officer and pointed out that the request under Article 25 EPC was a procedural act before the national court. As an expert opinion was given for the purposes of national proceedings the right of inspection of file was governed by the national law.

III. Against this decision the Appellant gave notice of appeal on 9 April 1997. They paid the appeal fee at the same day and filed the statement of the grounds of appeal on 9 June 1997. The Appellant argued that the technical opinion under Article 25 EPC obviously related to a European patent. It was given by the Examining Division responsible for the examination and

the grant of the patent. For these reasons it was part of the file of the patent in question which was open to public inspection according to Article 128(4) EPC. Furthermore the technical opinion was of equal interest to the public as the rest of the patent file.

- IV. On inquiry the board was informed by DG2 of the EPO that the requested technical opinion had never been given by the Examining Division, and by the Court of the Hague (Arrondissementsrechtbank) that the pending case (KG 95/747) ended by settlement.

Reasons for the Decision

1. Both the notice and the grounds of appeal were filed and the appeal fee was paid within due time. The notice of appeal meets the requirements of Rule 64 EPC. Moreover it has been filed by the party affected by the impugned decision.

2. Jurisdiction to decide on a request for inspection of file under Article 128 EPC lies with the Receiving Section, the Examining Division or the Opposition Division as far as they are competent to decide on a patent application or the maintenance or revocation of a patent. The competence in each case depends on where the case is pending. Pursuant to Rule 9(3) EPC the Vice-President of EPO DG2 has entrusted this duty normally within the responsibility of the Examining Division to formality officers (OJ 1984, 317, revised and supplemented in OJ 1989, 178). However, this transfer of duties does not change the character of the decision. The decision to be taken by the Formalities

Officer on matters mentioned in this Notice, like inspection of file under Article 128 EPC are appealable decisions according to Article 106(1) EPC. The Formalities Officer acts as a representative of the Division.

3. Inspection of file of a technical opinion under Article 25 EPC given by the Examining Division is not covered by the wording of Article 128 EPC which only concerns patent files and patent application files. Nevertheless there is no reason to assume that the Examining Division is not competent to decide such cases. The competence to decide on inspection of file under the EPC derives - as pointed out above - in any case from the competence of the respective department to decide on patent applications or patents.
4. In the case under appeal only the Examining Division charged with the technical opinion or the Formalities Officer pursuant to the cited Notice of the DG2 Vice-President (see OJ 1984, 317) had the competence to decide on the request for inspection of file. The decision under appeal does not meet this requirement, since it was taken by the director of Directorate 2116. This person is not entitled under the EPC to take any decision on inspection of file as requested by the Appellant. His decision is therefore void *ab initio* (T 0382/92).
5. Not lying from one of the departments exhaustively enumerated in Article 106(1) EPC the appeal is inadmissible. Although the appeal is inadmissible reimbursement of the appeal fee has to be ordered.

5.1 Rule 67 EPC on reimbursement of appeal fees is not applicable since in this case the requirements of this provision are not met. There is neither the event of interlocutory revision nor the Board of Appeal deems an appeal to be allowable.

5.2 However, in the particular circumstances of the present case, the board is of the opinion that the question of reimbursement of the appeal fee has to be examined on the basis of equity which guarantees any party a right to a fair procedure. This principle includes the obligation of the EPO to handle requests relating to inspection of files in accordance with the procedures laid down in the EPO with due care. That means that decisions on inspection of files must be taken by the departments or persons legally entitled by the EPC to do so.

5.3 In the view of the Board, Article 25 and Article 128 EPC create a legitimate expectation of any person that a decision on inspection of file concerning a technical opinion would be taken by the competent Examining Division and would consequently be appealable pursuant Article 106(1) EPC. The EPO clearly offended against this legitimate expectation in the present case. After having requested an appealable decision the appellant could legitimately expect that the decision under attack was given by the competent department and not by a person lacking legal authority. In conformity with the principles of good-faith governing the relations between the EPO and the applicants of European patents (see Enlarged Board G 5, G 7, G 8/88, OJ 1991, 137 (point 3.2. of Reasons); J 2/87, OJ 1988, 330; J xxx/87, OJ 1988 323; J 10/84, OJ 1985, 71; J 3/87, OJ 1989, 3, J 1/89, OJ 1992, 17; J 13/90, OJ 1994, 456; J 30/94)) it is equitable in these circumstances to order the reimbursement of the appeal fee.

6. Normally lack of jurisdiction is a procedural deficiency that requires remittal of the case to the competent instance. However, in this case the technical opinion requested by the Dutch Court was in fact never given by the Examining Division. Thus, no purpose is served in remitting the case.

Order

For these reasons it is decided that:

1. The appeal is rejected as inadmissible.
2. The reimbursement of the appeal fee is ordered.

The Registrar:


J. Rückerl

The Chairman:


J.-C. Saisset