

DECISIONS OF THE BOARDS OF APPEAL

Decision of Technical Board of Appeal 3.2.4 dated 6 July 2001

T 778/00 - 3.2.4

(Translation)

Composition of the board:

Chairman: C. A. J. Andries

Members: R. E. Teschemacher

M. G. Hatherly

T. K. H. Kriner

C. Holtz

Patent proprietor/Appellant: INAUEN MASCHINEN AG

Opponent/Respondent:

(1) WEBOMATIC Maschinenfabrik GmbH

(2) W. R. Grace & Co.-Conn.

Headword: Notice of appeal/INAUEN

Article: 108 EPC

Rule: 64, 65 EPC

Keyword: "Notice of appeal - debit order not sufficient" - "Communication of possibility of appeal - deficient (no)" - "Protection of legitimate expectations (no)" - "Period of grace (no)"

Headnote:

I. Article 108, second sentence, EPC is not to be interpreted as meaning that merely sending the EPO a debit order for the appeal fee constitutes a valid means of filing the appeal (following J 19/90).

II. The absence of a reference to Rule 65 EPC in the annex to the communication of the possibility of appeal does not make the communication incomplete or misleading.

Summary of facts and submissions

I. European patent No. 0 593 748, granted in respect of application No. 93 911 720.6, was revoked by the opposition division at oral proceedings on 14 March 2000. The written decision was posted on 3 April 2000. A communication dated 7 July 2000 notified the parties to the proceedings that no appeal had been filed within the time limit for appeal and that opposition proceedings had been validly completed.

II. In a fax dated 11 July 2000 the patent proprietor's representative sent evidence of payment of the appeal fee and announced that a statement of grounds for the appeal would be filed by 3 August 2000. In a communication dated 18 July 2000, the opposition division's formalities officer revoked the previous communication because, only after it had been sent, could it be established that an appeal fee to the full amount had been paid on time. The officer also indicated that the file had been submitted to the board of appeal.

III. In a communication dated 11 August 2000, the registry of the board of appeal informed the appellant (patent proprietor) that no notice of the filing of an appeal pursuant to Article 108, first sentence, EPC had yet been placed on file. A statement of the grounds for appeal, dated 3 August 2000, was received by fax on 13 August 2000.

IV. In a communication dated 30 August 2000, the board reminded the parties that an appeal not filed in writing within two months of notification of the contested

decision had to be rejected as inadmissible. Mere payment of the appeal fee did not constitute effective filing of an appeal. In a fax dated 10 November 2000, the appellant filed notice of appeal in two essentially identical documents, one dated 31 May 2000, the other dated 9 November 2000.

V. In a further communication dated 28 November 2000, the board notified the parties that the subsequent filing of the notice of appeal did not alter the legal situation in any way, as no notice of appeal had been received before the time limit for appeal had expired.

VI. In a further written submission and at oral proceedings on 6 July 2001, the appellant argued that the appeal should be deemed to have been filed on payment of the appeal fee. The respondent (opponent 1) countered that the debit order which had been filed could not replace the mandatory written appeal, not least because it did not include an identifying statement.

VII. The appellant requested that the appeal be deemed to have been filed and be declared admissible, and that the appeal fee be reimbursed.

VIII. The respondent (opponent 1) requested that the appeal be rejected as inadmissible. The respondent (opponent 2) declined to comment.

Reasons for the decision

1. The decision posted on 3 April 2000 is deemed to have been delivered on 13 April 2000 (Rule 78(2) EPC); accordingly, the time limits under Article 108, first and second sentences, EPC for filing the appeal and paying the appeal fee expired on 13 June 2000 (Rule 83(4) EPC). No notice of appeal was received within that period, only a debit order (EPO Form 1010) recording payment of an appeal fee.

2. In the appellant's view, the appeal should be deemed to have been filed on payment of the appeal fee; all other requirements for a correct notice of appeal could be satisfied after invitation by the board of appeal for this to be done. This view is inconsistent with the provisions of the Convention.

2.1 The filing of an appeal is a declaration, directed to the EPO in writing, of the intention to challenge a first-instance decision. If there is no such declaration, the first-instance decision is not open to review by the board of appeal. Under Article 108, first sentence, in conjunction with Rule 64(b) EPC, an appeal must be filed in the form of a notice of appeal, which among other things must contain an identifying statement.

2.2 Accordingly, filing the appeal and paying the appeal fee are treated as two separate requirements for an appeal in Article 108, first and second sentences, EPC. According to these provisions, paying the appeal fee cannot be substituted for filing the appeal. Otherwise it would have been enough to stipulate payment of the appeal fee, and there would have been no need for the further requirement to file the appeal. This structure of the provision is also reflected by its wording. The second sentence is linked to the first by the subordinating conjunction "until after" and thus relates to a filed appeal which becomes effective only if the condition laid down in the second sentence, ie payment of the fee, is satisfied. This relationship is also made clear by Article 4(1) RFees, under which, unless otherwise stipulated, a fee falls due on the date of receipt of the associated request (see *Gall*, Münchner Gemeinschaftskommentar, vol. 10/1986, Article 51 EPC, point 86, 105). However, another consequence of this is that the appeal fee does not fall due until the appeal is filed. If no appeal is received, the appeal fee has been paid without reason and must therefore be reimbursed (established case law since T 41/82, OJ EPO 1982, 256, Reasons 1).

2.3 Hence a party which merely pays the appeal fee still has the choice of whether or not to file an appeal. For example, a representative who, shortly before the time limit expires, still has no instructions from his client may pay the appeal fee as a precaution so as not to miss the time limit, and then wait to see if he is instructed to file the appeal before the time limit expires. This entails no financial risk, as the appeal fee will be reimbursed if no appeal is filed. Yet obviously, on expiry of the time limit for appeal it must be clear whether an appeal has been filed. The mere payment of the fee would not provide that certainty. Thus, for an appeal to be valid under Article 108, first sentence, EPC, the appellant must declare that the appeal is

intended to challenge a particular decision (T 371/92, OJ EPO 1995, 324, Reasons 3.5).

2.4 Another reason why mere fee payment is no substitute for filing the appeal is that it is not a procedural step, but a material act, *viz.* the transfer of a sum of money to the EPO (T 170/83, OJ EPO 1984, 605, Reasons 8). The declarations normally associated with a payment need not even be directed to the EPO, but may for example be addressed to a credit institute (see the various methods of payment in Article 5(1) RFees). The appellant does indeed rightly refer to T 275/86 (cited in Case Law of the Boards of Appeal of the EPO, 3rd edn. 1998, VII.D.7), where a completed debit order (Form 4212) was accepted as a valid notice of appeal. All that was at issue in that decision, however, was that the information required in any case within the meaning of Rule 64(a) in conjunction with Rule 65(2) EPC was present on the debit order. The cited decision does not concern the irremediable absence (see Rule 65(1) EPC) of the information referred to in Rule 64(b) EPC, particularly the extent to which amendment or cancellation of the challenged decision is requested. For that reason it remains an isolated ruling, and subsequent case law has followed J 19/90 (also cited in Case Law, *loc. cit.*), which ruled that sending a fee payment form did not in itself constitute the filing of an appeal (T 371/92, *loc. cit.*; T 266/97 and T 1100/97, both cited in EPO Board of Appeal Case Law in 1998, Special Edition of the OJ 1999, p. 72; T 947/94 of 13 November 1998, T 696/95 of 16 November 1995 and T 445/98 of 10 July 2000, none of them published in OJ EPO). In T 460/95 (OJ EPO 1998, 587) a letter accompanying the debit order was referred to as the notice of appeal; yet the appeal was deemed inadmissible because the letter, lacking a statement identifying the appeal, did not meet the statutory requirements. Besides, the debit order filed in the present case would not even satisfy the conditions held to be sufficient in T 275/86 (*loc. cit.*), as it also lacks the information referred to in Rule 64(a) EPC.

3. The appellant's assertion that the communication of the possibility of appeal was deficient or misleading is incorrect.

3.1 The wording of Article 108 EPC as annexed to the challenged decision on Form 2019 expressly refers to the three formal requirements that are to be met. A party which considers any of the three acts superfluous does so at its own risk.

Furthermore, Form 2019 expressly refers to the need for a notice of appeal and also, contrary to what the appellant originally claimed, to Rule 64 EPC.

3.2 Contrary to the appellant's view, there was no need for an express reference to Rule 65 EPC. The purpose of the communication of the possibility of appeal is to inform the unsuccessful party as to the appealability of the decision. It is certainly not intended to provide comprehensive information about the appeals procedure and the consequences of failure to meet the formal requirements. The instructions on Form 2019 are clear and unambiguous. The appellant did not observe these instructions and failed to file a notice of appeal, which it did at its own risk. The EPO was not obliged to supply detailed legal explanations (see J 17/98, OJ EPO 2000, 399); it was up to the appellant to find out about possible legal consequences of failing to follow the instructions provided. Had it done so, it would inevitably have come across Rule 65 EPC, which draws a distinction between remediable and irreparable deficiencies in the notice of appeal. There would not even have been any need to refer to special information such as the Guidance for parties to appeal proceedings and their representatives (OJ EPO 1996, 342), previously published board of appeal case law or the standard commentaries. The appellant's representative could have found the allegedly missing reference to Rule 65 EPC by simply looking at a paper copy of the EPC, as it is one of the implementing rules referred to next to Article 108 EPC.

3.3 The appellant argues that this is by no means the first time that misleading and deceptive guidance from the EPO has stopped parties to proceedings from filing appeals on time; but no evidence of this has been forthcoming. Anyway, in the boards' many years of practice there is no sign of a case in which a party has claimed that information from the EPO has led it to believe no notice of appeal was required.

3.4 The appellant's further reference to allegedly incorrect handling of the request for examination is irrelevant. The written request for examination is in no way superfluous as the appellant seems to think. The request is in fact included on the Request for Grant form or, as in the present case, on the form for entry into the regional phase (Form 1200, Section 4).

3.5 Furthermore, the request to extend the time limit for filing the statement of grounds, which is statutory and therefore cannot be extended, shows that the appellant's representative has failed to find out about fundamental requirements for the observance of time limits and possible loss of rights if they are missed, simply relying on the EPO informing him of any potential loss of rights. Thus in the present situation he cannot rely on the principle of the protection of legitimate expectations. That principle does not mean that the appellant's responsibility for fulfilling the conditions of an admissible appeal can be devolved to the EPO (G 2/97, OJ EPO 1999, 123, Reasons 4.2). Indeed, a professional representative acting as an adviser on questions of EPC procedure must be expected to be aware of the fundamental requirements for the performance of procedural steps or at least to find out about them if the need arises.

4. The appellant is wrong to see a contradiction between Article 108, first sentence, EPC and Rule 64 EPC. In its view, an appellant is not in a position to formulate the statement prescribed for the notice of appeal in Rule 64(b) EPC until after the statement of grounds has been completed; hence the notice of appeal cannot be required before the statement of grounds but has to be subject to the four-month time limit referred to in Article 108, third sentence, EPC. That was not the legislator's intention. An appellant is not intended to leave detailed consideration of his grounds for contesting the decision until after the time limit for appeal has expired. Article 108 EPC represents a compromise between various interests. Article 107 of the 1972 draft Convention provided for a uniform time limit of three months for filing and stating the grounds for an appeal, but the legislator decided to differentiate. On the one hand he saw that the interests of legal certainty made it essential to establish as quickly as possible whether a decision would be challenged. On the other hand he wanted to give the appellant enough time to prepare a full statement of the grounds (*Moser*, in *Münchener Gemeinschaftskommentar*, vol. 20, 1997, Article 108, point 11).

Thus it is clear that a distinction must indeed be made between the objective of the appeal - which can be defined immediately, after assessment of the chances of success and the economic circumstances - and a detailed statement of grounds, which may require more time for careful preparation and possibly also for additional research and testing. This distinction is clear from the requirement for an identifying

statement in Rule 64(b) EPC, which was already available to the EPC legislator in its present wording at the Munich Diplomatic Conference. Besides, the appellant was free to file a statement of grounds within two months if he was unwilling to submit an identifying statement without a full statement of the grounds.

5. Finally, on legal grounds the board was also unable to give the appellant a period of grace for filing the notice of appeal. The time limit for filing an appeal cannot be extended, as it is fixed by law (Rule 84 EPC), not by the EPO. The provision in Rule 65(2) EPC for remedying deficiencies applies only to the remediable requirements of Rule 64(a) EPC; and the requirement for filing the appeal on time pursuant to Article 108, first sentence, in conjunction with Rule 64(b) EPC is not remediable (see Rule 65(1) EPC).

6. As no appeal was filed within the time limit referred to in Article 108, first sentence, EPC, the appeal fee never fell due and must therefore be reimbursed (T 41/82, *loc. cit.*).

7. The failure to file the appeal on time means that the challenged decision is now final and is therefore not open to review by the board.

Order

For these reasons it is decided that:

1. No appeal was filed within the time limit for appeal.
2. The appeal fee is to be reimbursed.