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D E C I S I O N
of 25 March 2003

Case Number: T 0079/01 - 3.3.4

Application Number: 90917644.8

Publication Number: 0498851

IPC: G01N 33/574

Language of the proceedings: EN

Title of invention:
Urinary tumor associated antigen, antigenic subunits uses and methods of detection

Patentee:
Cancervax, Corp.

Opponent:
Boehringer Ingelheim GmbH

Headword:
Urinary tumor/CANCERVAX

Relevant legal provisions:
EPC Art. 108
EPC R. 65(1)
Article 9 of the Rules relating to fees

Keyword:
"Appeal admissible - (no)"
"Less than half of the appeal fee paid"

Decisions cited:
T 0152/82, T 0017/83, T 0170/83, T 0690/93, T 0923/95, T 0173/89, T 1072/93, T 0253/95 G 0002/97, G 0001/99, G 0009/91, G 0008/91,

Catchword:
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Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0079/01 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 25 March 2003

Appellant: (Opponent)
Boehringer Ingelheim GmbH
D-55216 Ingelheim (DE)

Representative:
-

Respondent: (Proprietor of the patent)
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Decision under appeal:
Decision of the Opposition Division of the European Patent Office posted 14 November 2000 rejecting the opposition filed against European patent No. 0 498 851 pursuant to Article 102(2) EPC.

Composition of the Board:

Chairwoman: U. M. Kinkeldey
Members: A. L. L. Marie
V. Di Cerbo

Summary of Facts and Submissions

I. The appeal lies from the Opposition Division's decision rejecting the opposition filed against the European Patent No. 0 498 851.

II. Against this decision (dated 14 November 2000) a notice of appeal has been filed by the appellant (opponent) on 12 January 2001. On the same day "the appeal fee" was paid. The amount thereof was EUR 356,-, as explicitly indicated by the appellant in the notice of appeal ("Die Beschwerdegebühr in Höhe von EUR 356,- soll von unserem Konto .... abgebucht werden"). The statement of grounds of appeal was filed on 19 March 2001.

The appellants requested that the decision under appeal be set aside and the patent be revoked. Oral proceedings were requested on an auxiliary basis.

III. By communication dated 10 January 2002 the Board drew the attention of the parties to the proceedings to the fact that the appeal fee actually paid by the appellant amounted to EUR 356,-, whereas, pursuant to Article 2 No. 11 of the Rules relating to fees, the amount of the fee for filing an appeal was EUR 1.022,-.

IV. Both the appellants and the (new) respondent (patent proprietor) (the rights of the patent in suit having been transferred on 13 December 2000 from Donald M. Morton to Cancervax Corp.) took position on this issue.

The appellants requested that the appeal be considered admissible and that the missing amount of the appeal fee be debited from their bank account. They maintained in particular that, despite the incorrect (referring to the amount of the appeal fee) debit order in the notice

of appeal, the intention was clear that said debit order be related to the appeal procedure. In assessing the admissibility of the appeal the indication of the intention is decisive, whereas a formal error in the debit order cannot be prejudicial. Reference was made to decisions T 152/82 (OJ EPO 1984, 301), T 17/83 (OJ EPO 1984, 307) and T 170/83 (OJ EPO 1984, 605). Furthermore, according to the appellants, the board, in pursuance of the principle of good faith, which applies between EPO and users, should have warned in due time the appellants that the debit order concerning the appeal fee was inadequate. Reference was made to decision T 923/95 dated 12 November 1996.

The respondents requested that the appeal be deemed as not having been filed and the patent be maintained as granted accordingly. In particular they maintained that since the difference between the due amount of the appeal fee (EUR 1022,-) and the sum actually paid (EUR 356,-) cannot be considered as a small amount (which could be overlooked pursuant to Article 9(1) of the Rules relating to fees, last sentence) the appeal fee could not be considered as paid within the time limit for the appeal. Furthermore they objected to the appellants assumptions based on the principle of good faith and quoted the decisions G 2/97 (OJ EPO 1999, 123), G 1/99 (OJ EPO 2001, 381) and T 690/93 dated 11 October 1994.

V. According to the requests filed on an auxiliary basis by both parties oral proceedings were scheduled to take place on 6 December 2002.

With letter dated 8 November 2002 the appellant declared that he will not take part to the oral proceedings and requested that a decision be taken on the basis of the documents on file.

With communication dated 4 December 2002 the Board informed the parties that oral proceedings were cancelled and that a decision will be issued in writing.

Reasons for the Decision

1. The preliminary issue to be taken into consideration is whether or not the incomplete payment of the appeal fee brings about consequences for the present appeal.

2. According to Article 108 EPC (second sentence) the notice of appeal shall not be deemed to have been filed until after the fee for appeal has been paid. Pursuant to Rule 65(1) EPC if the appeal does not comply *inter alia* with Article 108 EPC the Board of Appeal shall reject it as inadmissible, unless each deficiency has been remedied before the relevant time laid down in Article 108 EPC has expired.

3. The appeal fee amounts to EUR 1020,- (Article 2, point 11 of the Rules relating to fees). A time limit for payment shall in principle be deemed to have been observed **only if the full amount of the fee has been paid in due time** (Article 9 of the Rules relating to fees).

4. The sum actually paid by the appellants as appeal fee amounts to EUR 356,- which is less than the half of the due amount. Therefore the provision of Article 9 of the Rules relating to fees, last sentence (according to which the Office may, where this is considered justified, overlook any small amounts lacking without prejudice to the rights of the person making the payment) does not apply.

5. In the Board's view neither the first argument put forward by the appellant, according to which the error in the debit order cannot be prejudicial, since the appellant's intention was clear that said debit order be related to the payment of the appeal fee, nor the second argument, that in any case, in pursuance of the principle of good faith, the board should have warned in due time the appellant about the inadequacy of the sum specified in the debit order, are convincing.

6. The clear wording of the above quoted provisions (in particular, Article 108 EPC and Article 9 of the Rules relating to fees) does not give any support (*in claris non fit interpretatio*) to the argument that in assessing the admissibility of the appeal the indication of the intention of the appellants is decisive and therefore shall prevail upon the circumstance that the amount of the appeal fee written in the debit order (and actually paid) was wrong due to a mistake. On the contrary it is clear from the text of these provisions that the *voluntas legis* expressed therein is in the sense that what really matters for the admissibility of the appeal is the mere fact of the payment of the full amount of the appeal fee.

7. Nor can be shared, in the light of the established case-law of the Enlarged Board of Appeal, the argument suggested in some early decisions of the Boards of Appeal (quoted by the appellants) according to which the EPO must execute a debit order in accordance with what is plainly the substance of that order, even though the amount specified therein is incorrect (see, in particular, T 152/82 above). The appeal procedure is to be considered as a judicial procedure (G 9/91 OJ EPO 1993, 408, point 18 of the reasons; see also G 8/91 OJ EPO 1993, 346, point 7 of the reasons and, more recently, G 1/99 above, point 6.6 of the reasons). This implies that the general principles of court procedure

apply to this procedure, such as, in the *inter partes* proceedings, the principle of impartiality or equal treatment of parties to the proceedings. According to this principle the Board of Appeal, as well as the all EPO staff, must refrain from any activity from which one of the parties could take an unwarranted advantage (see T 173/89 dated 29 August 1990, point 2 of the reasons; T 690/93 above, point 3.5 of the reasons; T 1072/93 dated 18 September 1997, point 5.3 of the reasons; T 253/95 dated 17 December 1997, point 3 of the reasons). It follows from above that, having the appellants specified in the notice of appeal the (wrong) amount of the sum that the EPO was authorized to debit for the payment of the appeal fee, the EPO could not debit a different, much higher amount, corresponding to the provision of Article 2 No. 11. of the Rules relating to fees without violating the above quoted principle.

8. The above reasons apply also to the last argument put forward by the appellants. Furthermore, as correctly maintained by the patent proprietor, reference has to be made to decision G 2/97 (see above), according to which there is no justification for the suggestion that the principle of good faith imposes on a board of appeal an obligation to warn a party of deficiencies within the area of the party own responsibility. The appellant's responsibility for fulfilling the conditions of an admissible appeal cannot be devolved to the board of appeal. There can be no legitimate expectation on the part of users of the European patent system that a board of appeal will issue warnings with respect to deficiencies in meeting such responsi-bilities. To take the principle of good faith that far

would imply, in practice, that the boards of appeal would have to systematically assume the responsibilities of the parties to the proceedings before them, a proposition for which there is no legal justification in the EPC or in general principles of law.

9. It follows from the above arguments that the appeal is to be rejected as inadmissible, pursuant to Rule 65(1) EPC, since the appeal fee has not been paid in its full amount within the time limit provided for in Article 108 EPC.

10. In the Board's view there is no contrast between the above quoted Rule, governing explicitly, *inter alia*, the cases of non-compliance of the appeal with Article 108 EPC, and the provision in the second sentence of Article 108 EPC, according to which the notice of appeal shall not be deemed to have been filed until after the fee for appeal has been paid. Given that in cases of potential contrast between two (or more) legislative provisions the interpretation thereof shall prevail which avoids said contrast, the Board is of the opinion that the last quoted provision shall be interpreted in the sense that the payment of the appeal fee is a necessary requirement for a notice of appeal to be considered as filed in due time. No procedural consequences derive from this provision. They are indeed governed exclusively in Rule 65(1) EPC. This conclusion is coherent with the *ratio legis*. There is no reason to provide the appellant with a more favourable treatment in case of late (or insufficient, as in the present case) payment of the appeal fee (ie the appeal is deemed not been filed and the appeal fee is reimbursed) as in case of, for example, late filed statement of grounds (inadmissibility of the appeal). Moreover the "travaux preparatoires" seem to support this interpretation. In the "Materialien zum EPÜ" (IV/6514/61-D) is provided for, with reference to the

"Entscheidungsmöglichkeiten der Beschwerdekammer" , that "Die Kammer kann feststellen, dass die Beschwerde wegen Nichtentrichtung der Gebühr unzulässig ist".

Order

For these reasons it is decided that:

The appeal is rejected as inadmissible.

The Registrar: The Chairwoman:

P. Cremona U. Kinkeldey