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D E C I S I O N
of 7 September 2001

Case Number: T 0295/01 - 3.3.4

Application Number: 94907826.5

Publication Number: 0680517

IPC: C12Q 1/68

Language of the proceedings: EN

Title of invention:
Methods and diagnostic kits utilizing mammalian stress promoters to determine toxicity of a compound

Applicant:
PRESIDENT AND FELLOWS OF HARVARD COLLEGE, et al

Opponent:
-

Headword:
Formalities officer duties/GLAXO

Relevant legal provisions:
EPC Art. 99(1), 164(2)
EPC R. 9(3), 56(1)
RPBA Art. 10
Point 6 Notice of the DG2 Vice President of the EPO concerning the entrustment to formalities officers of certain duties normally the responsibility of the opposition procedure dated on the 28 March 1999 (OJ EPO 1999, 506)

Keyword:
"Opposition procedure"
"Admissibility of opposition"
"Competence to decide"

"Formalities officer"

Decisions cited:
T 1062/99, T 1101/99

Headnote:

Since the provision of point 6 of the Notice of the Vice-President of Directorate-General 2 of the EPO concerning "the entrustment to formalities officers of certain duties normally the responsibility of the Opposition Division of the EPO", dated 28 April 1999 (OJ EPO 1999, 506), conflicts with provisions of a higher level, ie Rules 9(3) and 56(1) EPC, the latter prevail in analogy with the provision of Article 164(2) EPC. Therefore the competence to decide on the inadmissibility of the notice of opposition lies with the opposition division and cannot be entrusted to a formalities officer.

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0295/01 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 7 September 2001

Appellant: (Opponent)
GLAXO GROUP LIMITED
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Greenford
Middlesex UB6 ONN (GB)

Representative:
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GlaxoSmithKline
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Two New Horizons Court
Brentford, Middlesex TW8 9EP (GB)

Respondent: (Proprietor of the patent)
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Representative:
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Decision under appeal: **Decision of the Formalities Officer of the European Patent Office pursuant to Rule 69(2) EPC, dated 23 June 2000, relating to the inadmissibility of the notice of opposition filed by the appellant.**

Composition of the Board:

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

Summary of Facts and Submissions

I. Mention of the grant of European patent No. 0 680 517 was published in the European Patent Bulletin on 12 November 1997. The nine-month period pursuant to Article 99(1) EPC for filing notice of opposition to the patent expired on 12 August 1998.

II. A notice of opposition dated 12 August 1998 and filed by facsimile by Glaxo Group Limited, GB (opponents 08) was received by the EPO on 13 August 1998 between 00.01 and 00:17 hrs according to the time of receipt printed on the paper by the EPO's fax machine. A debit order (Form 1010) for the amount of DM 1200 to cover the opposition fee was sent at the same time. A confirmation copy of the notice of opposition was received by the EPO on 27 August 1998.

III. The EPO formalities officer sent opponents 08 a communication pursuant to Rule 56(1) EPC dated 29 October 1998, stating that the opposition had not been received within the nine-month period specified in Article 99(1) EPC. The opponents did not file any comments on this communication.

IV. By a communication dated 9 December 1998 the formalities officer sent the opponents a notice of loss of rights under Rule 69(1) EPC, according to which the opposition was deemed not to have been filed pursuant to Article 99(1) EPC since the opposition fee had been paid too late.

V. By letter dated 5 February 1999 (received by the EPO on 19 February 1999) the opponents submitted that the opposition had been filed in good time and the

opposition fee paid in good time on 12 August 1998. In particular, the opponents maintained that the clock on the EPO's fax machine, which indicated that the notice of opposition had not been received until one minute past midnight, was inaccurate. A request for a decision pursuant to Rule 69(2) EPC was made. Following a communication from the formalities officer pursuant to Article 113 EPC dated 8 December 1999 explaining the reasons why the opposition was deemed not to have been filed, the opponents confirmed their request by letter dated 18 February 2000.

VI. By letter received by the EPO on 17 March 2000, the patentees filed their observations under Rule 57(1) EPC on the nine oppositions filed against the patent in suit. With reference to opponents 08 they requested that the opposition be deemed not to have been filed.

VII. On 23 June 2000 the formalities officer issued the following decision pursuant to Rule 69(2) EPC:

"1. The request of GLAXO GROUP LIMITED, Greenford, GB (opponents 08) of 05.02.99 (received 19.02.99) that the communication of 09.12.98 under Rule 69(1) EPC be set aside is refused.

2. The notice of opposition by opponents 08 received on 13.08.98 is deemed not to have been filed pursuant to Article 99(1) EPC since the opposition fee was not paid in time.

3. The opposition fee will be reimbursed once this decision has become final."

According to the reasons for this decision, given that,

pursuant to Article 99(1) EPC, the notice of opposition, which has to be filed within nine months from the publication of the mention of the grant of the European patent, is not deemed to have been filed until the opposition fee has been paid, the payment in the present case, which was effected by debit order, was not made until 13 August 1998, ie after the expiry of the nine-month period. Indeed, according to Article 5(2) of the Rules relating to Fees and the Notice of the President of the EPO dated 20 November 1981 concerning the publication of the consolidated version of the arrangements for deposit accounts (OJ EPO 1982, 15, point 6.3, republished in the supplement to OJ EPO 2/1999, point 6.3) the date of receipt of the debit order is considered as the date on which payment is made. Moreover, since the payment order was sent by facsimile, the provisions for the use of technical means apply, ie the Decision of the President of the EPO dated 26 May 1992 on the use of technical means of communication for filing patent applications and other documents (OJ EPO 1992, 299) and the Notice from the EPO dated 2 June 1992 concerning the filing of patent applications and other documents (OJ EPO 1992, 306). According to these provisions, documents filed by facsimile at one of the EPO filing offices are accorded as the date of filing the date on which they are received at the EPO. In the present case, the opposition period expired on 12 August 1998 and the facsimile with the debit order for the opposition fee was received by the Office on 13 August 1998, transmission having started at 00.01 hrs on that date.

VIII. Notice of appeal against the above decision was filed by Glaxo Group Limited on 14 August 2000. The appeal

fee was paid on the same date. The appellants requested that the communication under Rule 69(1) EPC dated 9 December 1998 be set aside and the notice of opposition deemed to be admissible as it had been filed in good time.

In the statement of grounds filed by facsimile on 19 October 2000 the appellants maintained, inter alia, that at least the first nine pages of the opposition had been filed before midnight on 12 August 1998 and that these pages fulfilled the conditions of Article 99(1) EPC in conjunction with Rule 55(c) EPC.

IX. By letter received by the EPO on 10 July 2001 the patentees requested that the decision under appeal be confirmed.

X. Oral proceedings were not requested.

Reasons for the Decision

1. The appeal is admissible.

2. A preliminary issue to be considered by the Board is whether the decision under appeal was taken by someone competent to do so. It arises from the fact that, within the context of opposition proceedings, a decision on the inadmissibility of an opposition filed by one of several opponents has been taken by the formalities officer and not by the opposition division.

The Board must deal with this issue ex officio as part of its duty of checking that there is formally a proper legal basis for the decision under appeal.

3. The legal justification for the formalities officer to take the decision is Rule 9(3) EPC. According to this provision, the President of the EPO may entrust to employees who are not technically or legally qualified examiners the execution of individual duties falling to the examining divisions or opposition divisions and involving no technical or legal difficulties.

On 6 March 1979 the President of the EPO transferred the above powers under Rule 9(3) EPC to the Vice-President of Directorate-General 2 of the EPO who, accordingly, on 8 January 1982 issued a "Notice" ("Mitteilung", "Communiqué") concerning the entrustment to formalities officers of the execution of individual duties falling to the opposition divisions of the EPO (OJ EPO 1982, 61). This "Notice" was subsequently amended by Notices dated 15 June 1984 (OJ EPO 1984, 319), 1 February 1989 (OJ EPO 1989, 179) and, finally, 28 April 1999 (OJ EPO 1999, 506).

The wording of those parts of the Notices which relate to the issue under consideration remained unchanged. According to this wording, within the framework of the responsibilities vested in the opposition divisions of the EPO, certain employees (formalities officers) who are not technically or legally qualified examiners may be entrusted inter alia with the following duties: "Decisions in **ex parte** proceedings on the inadmissibility of the **opposition** ..." (point 6, Board's emphasis).

This provision is ambiguous, since it uses the expression "**ex parte** proceedings" with reference to the opposition procedure, which is by definition an **inter partes** procedure. The only possible interpretation for

the use of these contradictory terms seems to be that decisions concerning the inadmissibility of an opposition shall be taken by formalities officers within proceedings where the opponent is the only party.

4. This provision conflicts with Rule 9(3) EPC as well as general principles governing the opposition procedure in that it deprives the opposition division of the competence to decide on the inadmissibility of the opposition, as happened in the case in suit.

4.1. As a matter of principle, it has to be stressed that the powers of the President of the EPO under Rule 9(3) EPC cannot include the entrustment to EPO employees of duties (or powers) which, pursuant to other provisions of equal ranking in the hierarchy of the law, fall within the competence of someone else. It follows that the above Notices of the Vice-President of Directorate-General 2, which specify the duties entrusted to formalities officers, could not include within said duties the exercise of powers which pertain, pursuant to provisions of a higher level (such as the Rules), to someone else. It is not by chance that the legislator used the expression "execution of individual duties falling to the ... Opposition Divisions" in Rule 9(3) EPC. It means that only individual tasks ("einzelne Geschäfte"; "certaines tâches") can be entrusted to formalities officers, and not the exercise of powers such as the power to decide on the inadmissibility of an opposition. In other words, given that the ratio legis of the provision of Rule 9(3) EPC is to reduce the workload of the opposition divisions, the legislator did not (and indeed could not) transfer to formalities officers the power to take a decision on an

essential issue such as the inadmissibility of an opposition, but only subsidiary tasks within the competence of the opposition divisions. The above interpretation is supported by the fact that, according to the last part of the provision under consideration, only (individual) duties involving inter alia no legal difficulties can be entrusted to formalities officers. Decisions on the inadmissibility of an opposition cannot be considered as falling within this category of duties, since the admissibility of an opposition may involve the solution of complex legal problems, as illustrated by the present case (see reasons for the decision of the formalities officer, Section VI above).

According to Rule 56(1) EPC, if the Opposition Division notes that the notice of opposition does not comply with the provisions, among others, of Article 99(1) EPC (ie the provision governing, inter alia, the time limit for filing a notice of opposition), it must reject the notice of opposition as inadmissible. According to this provision, the competence to decide on the admissibility of a notice of opposition lies with the opposition division and cannot be entrusted to formalities officers.

It follows that, since the provision of point 6 of the Notice of Vice-President DG2 conflicts with provisions of a higher level (Rules 9(3) and 56(1) EPC), the latter prevail, in analogy with the provision of Article 164(2) EPC.

4.2. Entrusting formalities officers with the competence to decide on the inadmissibility of an opposition can give rise to violations of the general principles of procedure which apply to the opposition procedure.

It has already been pointed out (see point 3, last sentence) that the procedure provided for in point 6 of the Notice of Vice-President DG2 is called ex parte proceedings, where the opponent is apparently considered to be the only party. This implies that neither the patent proprietor, nor in case any other opponents take part to these particular proceedings. A further consequence of the above is that from a decision by a formalities officer under point 6 can derive a res judicata which brings about an undue limitation of the competence of the opposition division to decide on all the controversial issues relating to a single procedure, as well as an undue limitation of the right to be heard of the other parties in the procedure, who, given the inter partes nature of the opposition procedure, have the right to comment on any problems, both procedural and substantive relating to the opposition.

5. Finally it must be stressed that the provision in point 6 clearly conflicts with the provision in section III of the Notice under discussion (see the 1989 and 1999 versions), according to which the "delegation of such a duty ... shall not affect the competence of the ... opposition division to take decisions itself". The latter provision confirms the principle that the opposition division's competence cannot be derogated from, and that the power to decide on the inadmissibility of an opposition may not therefore be delegated to some other individual.

6. The Board is aware that in a recent decision (T 1062/99 of 4 May 2000) the competence of the formalities officer under point 6 of the Notice of Vice-President DG2 was considered lawful. However, this finding must

be considered as an obiter dictum, since the main issue of the decision was whether a letter from a formalities officer announcing the inadmissibility of an opposition could be considered an "appealable" decision, and the Board therefore focused essentially on the admissibility of the appeal. Indeed, while considering the latter provision as a measure pertaining merely to the internal business distribution, the decision did not take into consideration either the issue of the conflict between said provision and the above-quoted Rules 9(3) and 56(1) EPC as well as the provision quoted under point 6 above, or the (negative) implications that it has with reference to the opposition procedure.

7. It follows from the statement under point 4.1, last sentence, according to which the provisions of Rules 9(3) and 56(1) EPC prevail over the provision under point 6, that the latter cannot apply to the case in suit. It further follows that the decision under appeal has to be considered as a nullity, having been taken by someone not competent to do so (the formality officer). Pursuant to Article 10 of the Rules of Procedure of the Boards of Appeal the case is to be remitted to the opposition division (see T 1101/99, point 3 of the reasons), which is competent to decide on the whole opposition and therefore also on the issue of the admissibility of the opposition under Article 99(1) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside as null.

2. The case is remitted to the opposition division.

The Registrar: The Chairwoman

U. Bultmann U. Kinkeldey