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D E C I S I O N
of 30 July 2003

Case Number: T 0309/03 - 3.3.7

Application Number: 96945229.1

Publication Number: 0868496

IPC: C09J 7/04

Language of the proceedings: EN

Title of invention:
Adhesive tape and method of making

Applicant:
MINNESOTA MINING AND MANUFACTURING COMPANY

Opponent:
-

Headword:
Correction/3M

Relevant legal provisions:
EPC Art. 108
EPC R. 65(1), 88

Keyword:
"Missing Statement of Grounds"
"Correction of Notice of Appeal - (no)"
"Reimbursement of appeal fee - (no)"

Decisions cited:
J 0008/80, J 0006/91, J 0003/01, T 0824/00

Headnote:
The mere fact that a representative has filed a notice of appeal before taking note of the applicant's adverse instruction does not justify a correction to the effect that no appeal has been filed.

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0309/03 - 3.3.7

D E C I S I O N
of the Technical Board of Appeal 3.3.7
of 30 July 2003

Appellant: MINNESOTA MINING AND MANUFACTURING COMPANY
3M Center
P.O. Box 33427
St. Paul
Minnesota 55133-3427 (US)

Representative: Werner, Hans-Karsten, Dr.Dipl.-Chem.
Patentanwälte
Von Kreisler-Selting-Werner
Postfach 10 22 41
D-50462 Köln (DE)

Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 11 December 2002 refusing European application No. 96945229.1 pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: R. E. Teschemacher
Members: B. J. M. Struif
B. L. ter Laan

Summary of Facts and Submissions

I. European patent application No. 96 945 229.1, resulting from international patent application PCT/US 96/20298 published as WO 97/94222, was refused by decision of the Examining Division dated 11 December 2002.

II. On 11 February 2003 the applicant's representative filed a notice of appeal and paid the prescribed fee on the same date.

III. In a fax of 13 February 2003, the applicant's representative requested correction of the letter containing the notice of appeal in accordance with Rule 88 EPC and reimbursement of the appeal fee. He submitted that the letter contained a mistake since it had been the true intention of the applicant not to file an appeal. As evidence a letter of the applicant, dated 10 February 2003, was filed, instructing the representative to allow the case to be abandoned and not to take any further action or incur any further expense. In case a refund was available, the representative was advised to request such refund.

IV. In a communication from the Board sent during the time limit for filing the statement of grounds of appeal, the appellant was informed that his request amounted to a withdrawal of the appeal with retrospective effect, which was not foreseen in the EPC. More detailed objections to the request were made in a further communication, dated 17 April 2003.

V. The appellant did not file a statement of grounds of appeal. He specified his request for correction to the effect that, in the letter dated 11 February 2003, the word "appealed" should be replaced by "not appealed". In support he submitted in essence the following:

(a) Referring to decision J 6/91 (OJ EPO 1994, 349), he argued that the essential requirement for a correction to be allowed was that the document did not express the true intention of the person on whose behalf it had been filed. This had been shown by the instructing letter dated 10 February 2003.

(b) The request for correction did not result from a change of mind or subsequent development of plans since the instructing letter had been received by the representative's office on 10 February 2003, i.e. before the notice of appeal was filed.

(c) There was no reason for different requirements for a correction to designations or priority declarations on the one hand and to a notice of the appeal on the other hand. In this respect, the case law, in particular J 8/80 (OJ EPO 1980, 293), was relevant to the application of Rule 88, 1st sentence, EPC in general.

(d) The representative's decision to file the notice of appeal was not relevant for a correction pursuant to Rule 88, 1st sentence, EPC. It followed from decisions J 8/80 and J 6/91 that it was only the intention of the applicant that mattered.

(e) The interest of the public was not involved since, in the absence of an admissible appeal, patent protection could no longer be obtained. Therefore, there were no reasons of legal security to deviate from the criteria for corrections developed by the case law.

VI. In a communication dated 8 May 2003, the appellant was informed that a statement of grounds of appeal had not been filed and that it was to be expected that the appeal would be rejected as inadmissible.

VII. In a letter of 8 July 2003, the appellant withdrew his previous request for oral proceedings.

Reasons for the Decision

1. As no written statement setting out the grounds of appeal has been filed, the appeal has to be rejected as inadmissible (Article 108, 3rd sentence, EPC in conjunction with Rule 65(1) EPC).

2. The request for correction of the letter dated 11 February 2003 is not founded.

2.1 Rule 88, 1st sentence, EPC allows the correction of "linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office". This enumeration and the heading of the provision (Correction of errors in documents filed with the European Patent Office) make clear that the provision deals with cases in which an error of

expression in a declaration has occurred or a mistake in a document is the consequence of an error.

2.2 Decision J 8/80 (*supra*) deals with the situation that a representative makes a declaration on behalf of the applicant that is not in conformity with the applicant's instructions. The Board decided that a mistake in a document may be said to exist if the document does not express the true intention of the person on whose behalf it was filed, and that the correction can take the form of putting right an incorrect statement or adding omitted matter (Reasons, point 4). In that case, a designation had been omitted due to confusion between the affairs of several clients when transmitting the instructions (Summary of Facts and Submissions, point V). This shows that an error occurred in the course of events between the sending of the instructions by the client and their execution by the representative.

2.3 The present case is quite different. When the representative filed the notice of appeal, he was not yet aware of the letter instructing him to allow the case to be abandoned. The representative has not explained the basis on which he filed the notice of appeal. However, it does not matter whether he acted on the basis of an explicit instruction to file an appeal or whether he filed it without such an instruction as a precautionary measure in the interest of the applicant. In any case, the representative has not submitted that there was an error on the basis of the facts known to him when sending the letter with the notice of appeal.

2.4 It is true that the representative would not have filed the notice of appeal if he had known of the letter of the appellant, dated 10 February 2003. However, the fact that he was not aware of this letter is not a relevant error within the meaning of Rule 88, 1st sentence, EPC. An instruction of which a representative is not yet aware cannot be the basis for the representative's actions vis-à-vis the EPO. If a party to the proceedings wants its representative to act in a certain way, it has to make sure that the representative has the necessary instructions early enough in order to implement them. Conversely, if a representative wants to be sure that a specific course of action is in agreement with the party's intentions, he has to check this with the party before taking action. Party and representative cannot expect that late instructions will avoid legal consequences. J 6/91, also cited by the appellant, expressly states that the possibility of correction cannot be used to enable a person to give effect to a change of mind or development of plans (*supra*, Reasons, point 2.2, referring to J 8/80, *supra*). What counts for the validity and the content of a declaration is the receipt at the EPO. Parties to the proceedings have to take their decisions early enough in order to transmit their procedural declarations to the EPO not only in due time but also with the content corresponding to their intention. If instructions are given late, there is no error within the meaning of Rule 88, 1st sentence, EPC. In the present case it should have been made sure that the representative became aware of the change of mind or development of plans on the applicant's side early enough to take account of it in his course of actions.

2.5 Several decisions have emphasized that due respect has to be paid to higher legal principles when applying Rule 88, 1st sentence, EPC. Already decision J 8/80 mentions that Rule 88 cannot be used to evade the requirements of Article 79 EPC (*supra*, Reasons, point 7). More recently, decision J 3/01 of 17 June 2002 (not published in OJ EPO, Reasons, point 7) drew attention to the discretionary character of the provision and stated that corrections could be made dependent on conditions or might not be allowed with regard to other, compelling principles of the Convention. Finally, according to decision T 824/00 of 24 March 2003, "Rule 88 EPC acknowledges the legal procedural value of having regard to true as opposed to ostensible party intention". However, the fact that the provision is framed as a discretionary power in a rule rather than an article was seen as evidence that this value should not prevail in a serious conflict with other superordinate values such as procedural certainty (to be published in OJ EPO, Reasons, point 6).

2.6 There is a general interest in the reliability of procedural declarations of the parties. This applies, in particular, to declarations which open a new procedure. If someone fulfils the prescribed acts, he acquires the status and the procedural rights of a party, e.g. as applicant, opponent or appellant. This effect arises with the date of completion of the necessary requirements. Periods thereafter, during which it remained unclear whether or not the procedure actually has started, would be in conflict with legal certainty. The significance of the relevant time limits laid down in the EPC would be weakened if procedural

declarations were allowed to be negated on the basis of instructions which were not yet known to the representative when acting vis-à-vis the EPO.

3. Since for the above reasons the letter containing the notice of appeal cannot be corrected, the appeal fee has become due and cannot be reimbursed.

Order

For these reasons it is decided that:

1. The appeal is rejected as inadmissible.

2. The request for correction of the letter containing the notice of appeal is refused.

3. The request for reimbursement of the appeal fee is refused.

The Registrar: The Chairman:

C. Eickhoff R. Teschemacher