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I N T E R L O C U T O R Y D E C I S I O N
of 30 November 2005

Case Number: T 0781/04 - 3.5.03

Application Number: 00300249.0

Publication Number: 1022577

IPC: G01S 5/14

Language of the proceedings: EN

Title of invention:
On-board GPS sensor systems

Applicant:
Ford Global Technologies, Inc.

Opponent:
-

Headword:
Online filed appeal/FORD GLOBAL TECHNOLOGIES

Relevant legal provisions:
EPC Art. 108, 164(2), 10(2)
EPC R. 24(1), 36(5), 65(1)

Keyword:
"Requirement of written form pursuant to Article 108 EPC"
"Electronic filing (inadmissible)"

Decisions cited:
G 0002/97, T 0514/05, J 0014/89, J 0014/94

Catchword:

An appeal filed via electronic means - epoline® - does not comply with the requirement of Article 108 EPC that an appeal must be filed in writing. The appropriate sanction for non-compliance is inadmissibility.

If the electronic filing took place well before the end of the appeal period (in the present case nearly one month) and the appeal, although inadmissible, is treated by the Boards as having been duly filed, then the principle of good faith may require that a request for restitutio in integrum be granted.



Case Number: T 0781/04 - 3.5.03

I n t e r l o c u t o r y D e c i s i o n
of the Technical Board of Appeal 3.5.03
of 30 November 2005

Appellant:

Ford Global Technologies, Inc.
600 Parklane Towers East
Dearborn
Michigan 48126 (US)

Representative:

Messulam, Alec Moses
A. Messulam & Co. Ltd.
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Herts WD23 1EE (GB)

Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 27 February 2004
refusing European application No. 00300249.0
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. Clelland
Members: M.-B. Tardo-Dino
 A. Ritzka

Summary of Facts and Submissions

- I. The appeal is from a decision of the examining division to refuse European patent application number 00 300 249.0. The decision was dispatched on 27 February 2004.
- II. The notice of appeal and the statement of grounds were both sent to the EPO on 8 April 2004 by electronic mail using the EPO's proprietary online documentation system known as epoline[®]. A formalities check was made on 22 April 2004 which confirmed that the notice of appeal and statement of grounds were duly filed and the appeal fee paid within the respective time limits. On 19 May 2004 the examining division indicated that the appealed decision would not be rectified and referred the appeal to the boards of appeal. The appellant was informed on 2 July 2004 that the appeal had been referred to Technical Board of Appeal 3.5.3 and given the reference number T 781/04 - 3.5.3.
- III. In a communication of 20 December 2004 the board informed the appellant that his appeal was apparently not admissible since it had been filed by electronic mail and therefore did not comply with the written form required by Article 108 EPC. In response the appellant stated that he was not aware that the online filing procedure could not be used for opposition and appeal proceedings, and drew attention to the fact that the communication of 2 July 2004 suggested that the appeal had been accepted and referred to the board. A second communication from the board dated 20 January 2005 indicated that the arguments contained in the appellant's response were more relevant to a request

for re-establishment of rights than to the admissibility of the electronically filed appeal.

- IV. The appellant set out in a fax of 24 December 2004, confirmed by letter received on 7 January 2005, further arguments in support of the admissibility of the appeal and appended in paper form all the documents previously sent by electronic mail. A request for "restitutio in integrum of the application" (sic) was subsequently filed on 18 January 2005 and the appropriate fee paid.
- V. The appellant's main request (leaving aside the substantive requests arising from the impugned decision), is that the appeal be deemed to have been filed correctly; an auxiliary request is that the appellant be re-established in his rights. The appellant argues that he was not aware of the notice of the EPO dated 3 December 2003, and that he had been misled by the communication of 2 July 2004 by which he had been informed that his appeal was referred to the current board. In any case an electronic filing was tantamount to a paper form and the board's interpretation was outdated. To permit some documents to be filed electronically but not others was inconsistent and unnecessarily confusing.

Reasons for the Decision

Admissibility of the appeal

1. It is at best irrelevant that the appellant did not know of the existence of the notice of the EPO dated 3 December 2003, given that users of the EPO system and

- particularly professional representatives must be expected to be acquainted with all notices published by the EPO which are relevant to patent practice.
2. As regards the letter of 2 July 2004 sent by the EPO informing the appellant that his appeal had been referred to this board, the board observes that this is merely administrative information which cannot prejudice the substantive admissibility of the appeal, a matter for the board. The board accepts however that the fact that the appeal was initially treated by the EPO as duly filed may be relevant in assessing good faith (see the discussion below on *restitutio in integrum*).
 3. The appellant argues that electronic filing is tantamount to the written form required by Article 108 EPC. For the reasons given below the board cannot share this view. Firstly, it seems clear that the EPC as originally drafted equated the filing of documents in written form with the filing of paper copies; reference is directed to Rules 24, 35 and 36 EPC, which as originally drafted consistently assume this. On such an interpretation Article 108 EPC, which specifies the time limit and form of appeal and states that "Notice of appeal must be **filed in writing...**" (board's emphasis), must also be understood as referring to paper copies. With the advance of technology and in particular the widespread adoption of fax machines, Rules 24(1) and 36(5) EPC were revised to authorise the President of the European Patent Office, as a derogation from the written form, to permit documents to be filed "by other means of communication" and to lay down conditions governing their use. This is to be understood in the context of the power vested in the

- President by virtue of Article 10(2)(a) EPC to take all necessary steps to ensure the functioning of the EPO and is the basis for the Decision of the President dated 29 October 2002, in particular Article 2: "Filing of other documents", for the notice from the EPO of the same date, for the notice from the EPO dated 3 December 2003, all concerning the electronic filing of patent applications and other documents, and for the notice of 9 December 2003 concerning the my.epoline[®] portal.
4. The question could arise however as to whether the reference in Rule 36(5) EPC to "documents filed after filing of the European patent application" can be extended to embrace the filing of an appeal, given the explicit requirement in Article 108 EPC for the written form. The Boards of appeal have never in the past had cause to consider the compliance with the EPC of the "other means of communication" implemented by the President of the EPO within the framework of the tasks assigned by Article 10(2) EPC, in particular compliance with the provisions of Article 108 EPC, since this has never been challenged. The board does not consider it necessary to decide on this question, since in the present case no conflict arises. In the notice dated 3 December 2003 extending the functionality of epoline[®] it was clearly stated in relation to opposition and appeal proceedings that "in such proceedings... the electronic filing of documents is **not** admissible" (*board's emphasis*). There is therefore no legal basis for such a filing in either the EPC or the implementing rules.
5. The board notes that whereas Article 75 EPC, "Filing of the European Patent application", does not specify any

particular form for an application and Article 91(1)(b) EPC refers to physical requirements laid down in the Implementing Regulations, Article 99 EPC - in analogous manner to Article 108 EPC - requires that an opposition be filed "in a written reasoned statement". It is therefore apparent that the refusal to allow electronic filing in opposition and appeal proceedings is not arbitrary but based on the requirements of the EPC.

6. Finally, the board wishes to observe that even if for the sake of argument it were assumed to have the legal power to decide that an electronic filing complies with the requirement of the written form in the sense of Article 108 EPC, it would not exercise such power in the present case since it is not convinced that electronic filing complies with the written form, given the requirements of the EPC as discussed above and the clear indication that opposition and appeal proceedings were deliberately excluded from electronic filing.
7. The board accordingly concludes that the appeal as filed electronically by *epoline*[®] does not fulfil the requirement of written form under Article 108 EPC and therefore in accordance with Rule 65(1) EPC rejects the appeal as electronically filed as inadmissible. The main request is accordingly refused.
8. In decision T 514/05 (to be published in OJ EPO) which also relates to the electronic filing of an appeal the board concluded that the consequence of the deficiency in question was that the appeal should be deemed not to have been filed. In that case, also an *ex parte* appeal, the formalities officer noted that the appeal had been filed electronically, informed the party that this was

not permitted and advised the party to file the appeal "in normal way before expiry of deadline". No reaction was received from the applicant. However, in the particular circumstances of the present case, in which the appellant could have filed the appeal in written form within the appeal period had the formalities officer informed him (see below), the board has come to a different conclusion as regards the consequence of the deficiency.

9. Decision T 991/04 (not published) is an interlocutory decision on an appeal by the present appellant also filed electronically and in the same circumstances as the present appeal. In that appeal the board held that the expression "filed in writing" in Article 108 EPC was not of itself clear but that even when interpreted in the light of the original or the present version of Rule 36(5) EPC could not be held to embrace electronic filing. The appeal was therefore formally inadmissible.

10. *Restitutio in integrum*

10.1 The board notes that at the date of filing it was both technically possible for the appellant to send to the Office his appeal documents through epoline®, there being no mechanism to stop such a filing, and there was no on-screen warning that such filing was excluded. Indeed, in the present case the board had no way of telling that the papers had been filed electronically, the file being indistinguishable from every other file; only through an internal audit of the system several months after filing was it established that the appeal was filed electronically. During that time the board treated the appeal as having been duly filed.

10.2 This does not alter the fact that, even if possible, electronic filing of an appeal was not permitted. It does however lead the board to consider the question of whether the principle of good faith requires that the appellant's failure to observe the written form should in principle be rectifiable. The appellant has in this connection made an auxiliary request for *restitutio in integrum*.

10.3 Although the users of the EPC cannot shift their responsibility for complying with the provisions of the European Patent Convention onto the EPO (see G 2/97 OJ EPO 1997, 123, point 3.2), the parties can expect a warning from the EPO when a deficiency is readily identifiable (T 14/89, OJ EPO 1990, 432) and can be easily corrected within the time limit. In the present case the appeal was filed nearly one month before expiry of the two month time limit. Thus the fact that the electronic form in which the notice of appeal was sent did not comply with the notice of 3 December 2004, which expressly ruled out use of the epoline® system in appeal proceedings, could have been appreciated in good time before the expiry of the two month time limit. This means that the possibility offered by Rule 65(1) EPC to remedy the deficiencies was still running and could have been employed. Moreover, subsequent to the filing of a number of appeal cases via epoline® the EPO issued an additional warning on the epoline® homepage under the title "important reminder" addressed to the users in order to prevent them from a misuse of epoline®. The fact that such an additional warning was necessary shows that there was a lacuna in the system.

- 10.4 The principle that if the EPO by its conduct leads the parties and the public to the legitimate belief that no loss of rights has taken place then the EPO cannot later refer to a loss of rights without contravening the principle of good faith, was established in decision J 14/94 (OJ EPO 1995, 825). In that decision the EPO continued the examination procedure despite the applicant's failure to pay a renewal fee and failed to inform him that the fee had not been paid; subsequent renewal fees were accepted.
- 10.5 Since the appellant was misled into believing that the appeal had been duly filed, the board concludes that the principle of good faith demands that the appellant's error in filing by *epoline*[®] be in principle rectifiable. The correct mechanism for the failure to observe a time limit is, in this board's view and in the circumstances of the case, that of *restitutio in integrum*. The board notes that in response to the communication of 20 December 2004 the appellant filed paper copies of the appeal documents on 7 January 2005, and on 18 January 2005 made an application for *restitutio in integrum*. The application was thus made within the year immediately following the expiry of the unobserved time limit and within the two-month period from the removal of the cause of non-compliance, as specified by Article 122(2) EPC. The board therefore holds that the appellant should be re-established in his rights in respect of the requirements of Article 108 EPC. The notice of appeal and statement of grounds of appeal filed on 7 January 2005 are accordingly substituted for the documents filed in electronic form.

10.6 The board thus comes to a different conclusion as to the consequences of electronic filing from the board in Decision T 991/04. There the board held that although formally inadmissible for reasons not dissimilar to those discussed above (see point 9), the principle of good faith required that since it had been accepted by the formalities officer it should nevertheless be deemed to be admissible, so that there was no need to grant *restitutio*. The present board takes the view however that the finding of inadmissibility should not be linked to the formalities officer's omission of a warning that an easily correctable deficiency had occurred (see point 10.3 above). It was rather the appellant's own mistake which led to the finding of inadmissibility. Nevertheless, the formalities officer's omission deprived the appellant of an opportunity to correct the deficiency and the board holds that given the circumstances of the case the appropriate remedy is to allow the appellant's request for *restitutio in integrum*.

Order

For these reasons it is decided that:

1. The main request, that the electronically filed appeal be deemed to have been filed correctly, is refused.
2. The auxiliary request, that the appellant be re-established in his rights, is allowed.

The Registrar:

The Chairman:

D. Magliano

A. Clelland