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Decision of Technical Board of Appeal 3.4.3 dated 8 September 2005

T 514/05 - 3.4.3

(Language of the proceedings)

Composition of the board:

Chairman: R. G. O'Connell
Members: T. Bokor
V. L. P. Frank

Applicant: TEXAS INSTRUMENTS INCORPORATED

Headword: Online filed appeal/TEXAS INSTRUMENTS

Article: 21(1), 23(3), 10(2), 108 EPC

Rule: 36(5), 36(1), 36(2), 36(4), 35, 35(4), 24(1), 10(1), 10(3) EPC

Keyword: "Legal effect of appeal filed via *epoline*[®]; formal requirements of documents filed by other means of communication"

Headnote

I. The use of "other means of communication" (Rules 24(1) and 36(5) EPC) must be expressly permitted by the President of the EPO, before parties may use those means of communication for filing documents with a department of the EPO, including the EPO Boards of Appeal; cf point 3.

*II. An appeal filed via *epoline*[®] cannot have any legal effect absent explicit permission of the President of the EPO; cf point 10.*

Summary of facts and submissions

I. This is a purported appeal from the decision of the examining division, posted 22 October 2004, refusing European patent application 99 204 298.6.

II. A document purporting to be a notice of appeal was transmitted electronically to the European Patent Office on 22 December 2004, making use of the so-called *epoline*[®] online filing system ("*epoline*[®]"). This is a facility provided pursuant to a Decision of the President of the EPO dated 29 October 2002 OJ EPO 11/2002, 543 ("the Decision") in conjunction with a Notice from the EPO dated 3 December 2003 OJ EPO 12/2003, 609 ("the Notice"). The applicant's account was debited with the appeal fee on the same day.

III. On 21 February 2005 the formalities officer for the examining division informed the applicant in a brief communication (EPO Form 2911) that the filing of an appeal via *epoline*[®] was not permitted by the EPO, and advised the applicant to file the appeal "in normal way before expiry of deadline", without indicating any specific date as deadline

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or citing any specific legal provision stipulating a deadline. This communication was faxed, and later also posted to the applicant on 24 February 2005.

IV. No grounds of appeal were filed either in paper or in electronic form, nor was any further reaction from the applicant received by the EPO.

Reasons for the decision

1. The first question to be decided here is whether a notice of appeal has been received, this being a precondition for the existence of an appeal; cf Article 108 EPC, first sentence. This question of law is not trivial given the electronic form of transmission and given that the EPC provides that electronic transmission may constitute a valid filing for certain classes of documents.

2. In terms of the EPC a notice of appeal is classified as a document filed subsequently, ie after filing of the European patent application, which is not a document replacing documents making up the European patent application. The filing of such documents is regulated by Rule 36 EPC and in particular subrules 2 to 4, which - in the boards' interpretation - relate solely to paper documents transmitted in paper form, and subrule 5 which relates to documents transmitted by "other means of communication". It seems clear that the force of the term "other" is to refer specifically to the transmission of a **representation or encoding** of the content of a paper document in contradistinction to the transmission of the physical paper document itself. This subrule is the legal basis for enabling the filing of certain documents via telex, facsimile, and indeed *epoline*®.

3. The specific legislative purpose of Rule 36(5) EPC is accordingly to provide a legal basis for using such non-paper "means of communication" to file subsequent documents validly at the EPO - a corresponding provision for patent applications being found in Rule 24(1) EPC. Rule 36(5) EPC provides that the President of the EPO ("the President") is empowered to permit such use and that it is also the President who is appointed to "lay down conditions" governing the use of such "other means of communication". It follows also, on this interpretation, that it is not necessary to examine whether a document transmitted using the means of communication in question complies with the provisions of Rule 36(2) to (4) EPC, since Rule 36(5) EPC is an express derogation from these provisions. On the other hand, according to this interpretation not just some, but all types of non-paper "means of communication" are subject to the provisions of Rule 36(5) EPC. In other words, the use of "other means of communication" must be expressly permitted by the President before parties may use those means of communication in correspondence with a department of the European Patent Office, including the boards of appeal.

4. The Decision is an exercise by the President of the subordinate legislative power vested in him by delegation from the Administrative Council by virtue of Rule 36(5) EPC; it regulates the use of *epoline*®, the details being elaborated in the Notice. The Decision does not specify which kinds of documents may be filed via *epoline*®, but rather subdelegates the power to decide that issue as an administrative detail to the EPO itself; cf Article 2 of the Decision. Based on this subdelegation, paragraph 1 of the Notice explicitly warns applicants that the use of *epoline*® is not permitted for opposition and appeal proceedings. In fact the English text of the Notice infelicitously uses the ambiguous term "**not** admissible" (original emphasis); similarly the German text uses the equivalent "**nicht** zulässig". These terms are problematic because they evoke the legal consequence of inadmissibility of an appeal. The board judges, however, that a valid notice of the legal consequence of inadmissibility - which in any case would be applicable only to particular classes of documents - would have to be couched in more formal terms. Consequently the relatively informal wording of the Notice would not reward painstaking exegesis. Only the French text, which uses the more appropriate and precise term "**pas** permis" (not permitted), appears to have been drafted with due regard for the legal niceties involved.

4.1 The board notes that the exclusion of opposition and appeal proceedings in paragraph 1 of the Notice, last sentence, was not an arbitrary or unreasonable exercise of the discretionary power subdelegated to the EPO by Article 2 of the Decision. The latter proceedings involve complications which are not found in the examination procedure and it was eminently reasonable to introduce *epoline*® in a staged fashion commencing with the simplest procedure.

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5. It follows from the above considerations that the legal precondition, namely a positive regulation of the issue by the President - or by the EPO, by virtue of the power subdelegated to it by Article 2 of the Decision - is absent for the valid filing of an **appeal** via *epoline*®. This is not affected by the fact that the manner in which this delegated regulatory power of the President was subdelegated is somewhat unusual, given that not even the relevant department of the European Patent Office is mentioned.

5.1 It is clear that the President has the power to adopt internal administrative instructions by virtue of Article 10(2) EPC, sub-paragraph (a), and Article 10(2) EPC, sub-paragraph (i) expressly permits the President to (sub)delegate his powers. On the other hand, setting conditions as to how applicants should correspond with the Office extends beyond the concept of an **internal** administrative instruction. Therefore, it appears that the President, by virtue of various rules of the convention does in fact possess even further power which is not mentioned in the non-exhaustive listing of Article 10(2) EPC, and which is rightly considered as a legislative power, since it directly affects the legal validity of the actions of applicants and other parties. Therefore, as mentioned above at point 4, this power is in fact based on a delegation of the power of the Administrative Council. Now it is questionable whether such **delegated legislative** power of the President - ie one which is not based on Article 10(2) EPC, but on some other provision of the convention, such as Rule 36(5) EPC - may be subdelegated at all. However, even if this subdelegation were defective for any reason, it would not change the legal situation that a positive regulation of the filing of documents via *epoline*® for the purposes of an appeal has not been effected.

5.2 Even if Article 2 of the Decision were to be construed to mean that it empowered the autonomous authority mentioned in Rule 10(1) EPC to authorise the filing of appeals via *epoline*® by virtue of Rule 10(3) EPC, this authority, the so-called Presidium of the Boards of Appeal, has not yet made use of its powers either, ie it has not expressly permitted the filing of documents for appeals proceedings via *epoline*®.

6. Having established that an *epoline*® transmission of a purported notice of appeal does not fulfil the formal conditions for the filing of a notice of appeal (in its quality as a document filed subsequently pursuant to Rule 36(5) EPC), as explained at points 1 to 5 above, it remains to be decided what the legal effect of such a purported notice of appeal is, since Rule 36(5) EPC does not contain any directly applicable provision to this end.

7. Article 21(1) EPC in conjunction with Article 23(3) EPC empowers a board to examine appeals free from any external influence. But no provision of the convention suggests to the present board that it is entitled to exercise discretionary power to deem this purported notice of appeal via *epoline*® to have been validly filed, when there are clear indications in the convention itself that this issue is not one which was either deliberately or accidentally not regulated in the convention, in which case a board might be entitled to fill a lacuna in the legislation. On the contrary, if the board went into the details of examining if this purportedly filed notice of appeal could possibly fulfil the requirements of the convention, and thereby possibly could be deemed to have been received, this would be tantamount to exercising a legislative power which is clearly delegated in Rule 36(5) EPC to another authority within the European Patent Organisation, namely the President. Therefore, pursuant to Article 23(3) EPC, the board finds that it is precluded from **directly** examining whether this purported notice of appeal can be deemed to have been received, as such a procedure would be *ultra vires*.

8. Indeed it could lead to an absurd result if different EPO Boards of Appeal were to examine the filing status of purported notices of appeal transmitted by possibly different "means of communication", such as *epoline*®, e-mail, maybe even SMS, and thus be forced to establish correspondence between various technical criteria and questions of law, and to do so without any legal basis therefor in the EPC. The quite plausible possibility that different boards might arrive at different conclusions does not make this scenario less absurd, but certainly less useful - if not useless - from the applicant's point of view. For example, there is little doubt that different boards might quite easily come to widely differing opinions on the issue whether these means of communication satisfy the requirements of signature, and if so, what are the applicable technical criteria, just to mention one of the most salient questions. This appears all the more absurd in the light of the fact that Rule 36(5) EPC explicitly suggests that this requirement need not be fulfilled at all, if the President should so decide.

9. While it is clear therefore that the board is not called upon here to don the mantle of the legislator and lay down *motu proprio* what legal effect a purported notice of appeal filed **specifically** via *epoline*® is to have, nevertheless, absent a

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directly applicable provision of the convention, the board still has a duty to deduce **in general** the **intended** legal effect on the basis of the convention of a document which has been transmitted to the EPO by a non-regulated physical means. As explained above, the board considers *epoline*® merely as an instance of a non-regulated physical means for transmitting documents for the purposes of appeal proceedings.

10. Rule 36(5) EPC foresees that even documents filed with permitted "means of communication" can be considered as not to have been received, if they are not confirmed in paper form. *A fortiori*, a document filed with a non-permitted "means of communication" (and without any following paper confirmation, as in the present case) can hardly acquire a higher legal status than one which was filed using a permitted means of communication, but subsequently failed to fulfil possible further requirements prescribed by the President pursuant to Rule 36(5) EPC, where these further requirements also concern the physical conditions of the filing. Hence the board finds that an appeal filed via *epoline*® cannot have any legal effect either, absent explicit permission of the President.

11. Following decision J 19/90 of 30 April 1992 (not published in the OJ EPO), the mere payment of an appeal fee does not constitute constructive notice of appeal even when the application is identified. Accordingly, the board finds that an appeal does not exist in the present case, because the purported notice of appeal is deemed not to have been filed.

12. As noted at IV above the applicant did not avail of the opportunity to comment on the communication informing him that the filing of an appeal via *epoline*® was not permitted.

Order

For these reasons it is decided that:

1. The purported appeal is deemed not to have been filed.
2. The appeal fee shall be reimbursed.