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**Datasheet for the decision
of 21 March 2007**

Case Number: T 0971/06 - 3.3.08

Application Number: 99903464.8

Publication Number: 1051626

IPC: G01N 33/68

Language of the proceedings: EN

Title of invention:

Prognostic allergy or inflammation test

Applicant:

Allertein Therapeutics, LLC

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 9(2), 18(1), 97(2), 109(1)(2), 113(2)

EPC R. 51(4)(5)(6), 67, 86(2), 89

RPBA Art. 10

Keyword:

"Decision to grant in absence of approved text - nullity"

"Substantial procedural violation, reimbursement of appeal fee

- yes"

"Requests for re-establishment of rights - not necessary, fees reimbursed"

Decisions cited:

J 0012/83, J 0013/94, J 0027/94, J 0029/95, T 0647/93

Catchword:

-



Case Number: T 0971/06 - 3.3.08

D E C I S I O N
of the Technical Board of Appeal 3.3.08
of 21 March 2007

Appellant:

Allertein Therapeutics, LLC
640 Sasco Hill Road
Fairfield
CT 06824 (US)

Representative:

Cornish, Kristina Victoria Joy
Kilburn & Strode
20 Red Lion Street
London WC1R 4PJ (GB)

Decision under appeal:

Decision of the Examining Division of the
European Patent Office of 1 July 2004 to grant
European application No. 99903464.8 pursuant to
Article 97(2) EPC.

Composition of the Board:

Chairman: L. Galligani
Members: F. Davison-Brunel
C. Rennie-Smith

Summary of Facts and Submissions

- I. In this decision, which concerns the purported grant of a patent, the words "decision", "patent" and "grant" are, when used in relation to the first instance proceedings, used only as more convenient terms than the expressions "purported decision", "purported patent" and "purported grant". As appears from the "Reasons for the Decision" below, such use does not mean that the Board acknowledges that a valid decision leading to a granted patent was taken.
- II. European Patent Application No. 99903464.8 - entitled "Prognostic allergy or inflammation test" and based on International Application No. PCT/US99/01832 published as WO 1999/039211 - was the subject of a decision of the Examining Division of 1 July 2004 to grant a European Patent. That decision was the subject of a notice of appeal filed by the appellant (applicant) on 6 April 2005. The appeal fee was paid on 5 April 2005. The statement of grounds of appeal were contained in the notice of appeal and thus also filed on 6 April 2005. The appeal relates to the omission from the patent as granted of two claims, namely claims 31 and 32. The appellant's approval of the patent to be granted was conditional upon the inclusion of those two claims which were none the less omitted.
- III. After the case had entered the regional phase before the EPO, the appellant's representative requested a delay of examination until after a voluntary response to the International Preliminary Examination Report had been filed. That was done by a letter, dated 16 October 2001 and received on 17 October 2001, which enclosed

certain pages to replace part of the application as originally filed. Before any reply to that letter was made by the EPO, the appellant filed a further letter, dated 2 September 2003 and received on 3 September 2003, enclosing a further replacement page (page 22) which contained two new claims 31 and 32.

IV. On 4 November 2003 the Examining Division issued a communication under Rule 51(4) EPC which announced the intention to grant a patent and in which the proposed claims were referred to as "claims 1-30 received on 17.10.2001 with letter of 16.10.2001". After obtaining an extension of time, the appellant responded to the communication by a faxed letter to the EPO of 4 May 2004 which stated, in its first paragraph:

"In response to the Notice under Rule 51(4), we hereby approve the text of the patent specification in accordance with the amendments in the attached schedule."

The letter also *inter alia* enclosed translations into French and German of claims 1-30 and the schedule referred to above. The schedule consisted of two paragraphs of which the first read:

"It appears that, in issuing the Notice under Rule 51(4), the examiner may have overlooked our submission of 2 September 2003, which introduces Claims 31 and 32. A further copy of our submission of 2 September 2003 is enclosed and our approval of the text for grant is subject to the replacement of page 22 of the Druckexemplar with

page 22 as enclosed with our letter of 2 September 2003."

The second paragraph of the schedule referred to an assignment of rights including the application from the inventor and original applicant Hugh A Sampson to Panacea Pharmaceuticals, LLC and a subsequent change of name by that company to SEER Pharmaceuticals, LLC. Finally, the schedule listed the further documents enclosed with it which were copies of the letter of 2 September 2003, the replacement page 22 with the text of claims 31 and 32 already filed with that earlier letter, the assignment and a change of name certificate. The file shows that the 4 May 2004 letter and its enclosures, including the schedule and all its enclosed copy documents, were all received by the EPO in the same fax transmission on that date.

V. On 1 July 2004 the EPO issued a letter entitled "Decision to Grant a European Patent pursuant to Article 97(2) EPC". This is a standard form letter (EPO Form 2006A). It referred to the Rule 51(4) EPC communication, stated the patent was thereby granted, and then contained the sentence:

"The modifications subsequently requested by the appellant and received at the EPO on 00.00.00 have been taken into account."

The letter then set out the patent number, the filing and priority dates, the designated states, the proprietor's name (still given as Hugh A Sampson), and concluded by stating the decision would take effect when the grant was mentioned in the European Patent

Bulletin on 11 August 2004. On 20 July 2004, the EPO issued a communication confirming that the registered proprietor of the application had been changed to SEER Pharmaceuticals, LLC with effect from 6 May 2004.

- VI. The patent as granted contains only claims 1-30. As became apparent from later submissions of the appellant (in its requests for re-establishment of rights - see XI below), the absence of claims 31 and 32 was first noticed by the appellant's US patent attorneys on 23 September 2004 when they considered a report of the grant from the European representative. In a letter of 27 September 2004, the appellant wrote to the EPO requesting a correction to the decision of 1 July 2004 under Rule 89 EPC. The letter concluded by requesting an opportunity to comment if the Examining Division disagreed and thereafter, if the correction should be refused, that the Examining Division give "a detailed decision on the matter in the sense of Articles 106 and 107 EPC" (which concern the right to appeal).
- VII. On 11 October 2004 a telephone conversation took place between the representative and the first examiner of which the only contemporary record is the representative's attendance note (Exhibit 2 to the subsequent requests for re-establishment of rights, see XI below). The note says the examiner thought the representative's letter of 27 September 2004 to be "over the top" (colloquial English for "excessive"), said the new claims were not submitted until after the Rule 51(4) EPC communication, pointed out the translations did not include claims 31 and 32 and proposed to re-open the examination and appoint oral proceedings. The representative observed that the new

claims were in fact filed earlier, that translations have no legal effect (which the examiner conceded), and argued that oral proceedings were inappropriate at this stage. The representative asked for clear reasoning of objections prior to oral proceedings and the examiner said this would be provided by the minutes of the telephone conversation and a summons to oral proceedings.

VIII. The appellant's reaction to that telephone conversation was contained in its representative's letter sent to the EPO by fax on 15 October 2004. This letter, after noting it was agreed that the decision to grant was a correctable error, objected to the re-opening of the examination procedure. That would require that the decision be cancelled not corrected. Claims 31 and 32 were submitted during a period when voluntary amendment was possible and should therefore have been taken into account. The appellant was entitled to expect that any objections to the additional claims would have been raised before the communication under Rule 51(4) EPC was issued. The appellant had responded to that communication by drawing attention to the claims in question and had thereby given the Examining Division another opportunity to examine them. After two such opportunities had produced no objections, the appellant was entitled to assume those claims were considered patentable and subsequent cost had been incurred on that basis. Thus to raise objections now was unreasonable. Further, if the examination was to be re-opened, oral proceedings were not the appropriate first step. The appellant had paid an examination fee but not received any correspondence under Article 96(2) EPC. Accordingly, and for cost reasons, there should be at

least one round of correspondence about any new objections.

IX. The Examining Division's views on the case at this stage (presumably reflecting the first examiner's stance in the telephone conversation of 11 October 2004) were subsequently set out in a communication of 26 October 2004. Paragraphs 1-5 of the communication contained a brief summary of the history of the case concluding with the observation that translations of only claims 1-30 were filed with the letter of 4 May 2004. In paragraph 6 it said the decision to grant was issued on the claims examined, namely claims 1-30 and:

"Inexplicably the amendments made to the claims with the letter of 02.09.03 were never re-examined (*sic*) or even apparently noticed. The problem was highlighted by the representative's letter of 27.09.04 in which it was requested that grant be made on claims 1-32 and that an error had been made by the EPO (Rule 89 EPC)."

It seems clear that the words "was highlighted" were intended to mean "came to light". Paragraphs 7 and 8 of the communication then stated:

"7. Bearing in mind the confusion that may have been caused by the incorrect copies of the French and German translations plus the fact that the amended claims arrived after the first examiner had already agreed to the grant an obvious error within the definitions of Rule 89 EPC are (*sic*) assumed to have occurred by the E.D.

8. The decision to grant is thus corrected and the (re)examination of the claims of the 02.09.03 must be made as if claims 31 and 32 were never examined. The decision to grant is thus corrected according to Rule 89 EPC and if necessary the correction of the decision will be to that of refusal."

Paragraphs 9-13 of the communication commented on and raised objections to claims 31 and 32. Paragraph 14 said:

"Consequently, and as the examination are (*sic*) herewith (re)opened, the next step will be oral proceedings (Article 97(1) EPC). It is considered that this communication along with the lengthy telephone conversation concerning this case constitutes a legally binding first communication."

- X. After the appellant changed representative, the new representative telephoned the EPO on 8 February 2005. The reason was to ascertain whether the grant date was maintained since this was of importance for a corresponding filing in Hong Kong by a time limit of 11 February 2005. According to the account in the subsequent applications for re-establishment of rights (see XI below), he had two conversations with the first examiner and one with a member of the Legal Division. The content and outcome of those conversations was summarised in the telephone minute from the Examining Division of 14 February 2005 as follows:

"After consultation with various parties within the EPO the appellant was informed that in all likelihood the current situation in which the inclusion of claims 31 and 32, along with a new date for grant, was impossible. The form 2006, notice to grant, should have been appealed (reasoned decision, fees etc) within a 2 month and 10 day time limit. The 2006 was issued on 01.07.04 and no appeal was subsequently filled (*sic*). Whether a correction to the grant as it stands with no change in the actual date of grant under Rule 89 might have been made is in doubt. In any case such a position is hypothetical as addition of two claims that the examining division has refused can't be regarded as a correction. The appellant thus appears to have only one clear option and that is to accept the grant as it stands and file in Hong Kong asap before the time limit in said jurisdiction runs out." (*"Asap" is an abbreviation, sometimes used in colloquial English, of "as soon as possible".*)

- XI. By a letter faxed to the EPO on 6 April 2005, the appellant filed two applications for re-establishment of rights, one in respect of the time limit for filing a notice of appeal against the decision of 1 July 2004 and one in respect of the time limit for filing a statement of grounds of appeal. The appellant's arguments in support of the re-establishment applications consisted of a summary of the history of the case, a statement that it was only when the new representative discussed the case with the EPO on 8 February 2005 that it was realised that the route taken by the previous representative and subsequently

approved by the EPO was incorrect, and the submission that the date of removal of the cause for non-compliance was therefore 8 February 2005. The appellant also filed by fax on 6 April 2005 a letter containing both the notice of appeal and the statement of grounds of appeal. The appeal fee and two fees for re-establishment of rights were paid on 5 April 2005.

XII. In documents available to the Board in the electronic file but not apparently open to public inspection, it appears that on 15 June 2005 the Examining Division requested an opinion from the Legal Division on the re-establishment requests and appeal. In that request it is acknowledged that claims 31 and 32 filed on 29 September 2003 were not considered because they were "overlooked by the Formalities Officer and not forwarded to the Examining Division". It is also said "The error was noticed by the Appellant on 23.09.04", thus apparently suggesting that the EPO was not aware of its own error until receipt of the appellant's letter of 27 September 2003 referring to a letter its representative had received from its US attorneys on 23 September 2003 (see Exhibit 2 to the re-establishment requests). The opinion supplied by the Legal Division on 29 June 2005 was to the effect that re-establishment into the time limit for filing an appeal should be granted, the decision to grant could be set aside then and the Register of Patents should reflect that, a substantial procedural violation had occurred and the appeal fee should be reimbursed. The appellant was informed by a letter of 5 December 2005 that its re-establishment requests were allowed and its appeal was considered to have been submitted in due time. The letter also said that the grounds of appeal

and appeal fee were considered to have been submitted in due time and concluded:

"Accordingly the case has been referred to the Examining Division for further prosecution."

On 2 May 2006 the Examining Division decided not to rectify its own decision and on 10 May 2006 forwarded the case to the Boards of Appeal.

XIII. The statement of grounds of appeal contains, first, a summary of the history of the case concluding with the submission that there was a substantial procedural violation and, second, arguments directed to refuting the objections of the Examining Division to claims 31 and 32 set out in paragraphs 9-13 of the communication of 26 October 2004 (see IX above). Since neither those objections nor the appellant's arguments have any bearing on this decision, they need not be summarised here. On 2 October 2006 the appellant sent a request by fax for acceleration of the appeal proceedings. Since the Board was already dealing with the case, it was unnecessary to consider that request so the arguments in support need not be summarised here. On 6 November 2006 the Board sent a communication expressing its preliminary opinion pursuant to Articles 11(1) and 12(2) RPBA. In a reply to the Board's communication dated 13 December 2006 and received by fax on 15 December 2006, the appellant amended its requests and subsequently, by an e-mail dated 15 February 2007, confirmed that its request for oral proceedings was withdrawn on the basis that the Board allows the appeal based on the only request then pending, namely that the decision under appeal be cancelled and the examination be re-opened, and that the appeal fee be reimbursed.

Reasons for the Decision

Admissibility

1. The appeal is admissible (cf. J 12/83 (OJ EPO 1985, 6) Reasons, paragraph 3). For the reasons set out in 17-20 below as to why the appellant's re-establishment requests were unnecessary, the appeal was filed within the time limit in Article 108 EPC.

The Decision under Appeal

2. Article 97(2) EPC provides that a European patent shall be granted if **both** the requirements of the EPC have been met **and** certain provisos have also been met of which (a) is relevant:

"...provided that:

(a) it is established, in accordance with the provisions of the Implementing Regulations, that the applicant approves the text in which the Examining Division intends to grant the patent;..."

Such approval by an applicant or patent proprietor is a principle underlying all decisions of the EPO (see Article 113(2) EPC). Accordingly, it is perfectly clear that it is an absolute pre-condition of any decision of the Examining Division to grant a patent that an applicant must have consented to the proposed text. If that pre-condition is not fulfilled, the only courses of action open to the Examining Division are to refuse

the application under Article 97(1) EPC or, if possible amendments or corrections remain to be considered, to continue the examination (see 3 below). So strict is the approval condition that, as the case law shows, the only valid approval is that which is unconditional, unambiguous and clear (see J 13/94 of 4 October 1996, unpublished in OJ EPO, Reasons, paragraph 4; J 27/94, OJ EPO 1995, 831, Reasons, paragraphs 8-9; and J 29/95, OJ EPO 1996, 489, Reasons, paragraph 8). In the absence of a valid approval, the Examining Division has no power to make a decision to grant and any decision to grant purportedly made without the applicant's valid approval can have no legal effect. Any such purported decision is therefore a nullity.

3. It is equally clear that ascertaining an applicant's approval in accordance with the Implementing Regulations is not difficult. The relevant provisions of the Implementing Regulations are to be found in Rule 51(4)-(6) EPC (which took a slightly different form at the time of the Rule 51(4) communication in this case, in that the current non-extendable time limit in Rule 51(4) EPC could be extended once up to two months - see OJ EPO 2001, 488-491 and OJ EPO 2005, 8-9). Approval is deemed to be given if the appellant pays the necessary fees and files claim translations during the period set by the Rule 51(4) communication, possibly after amendments or corrections have been allowed during that period; but, if such amendments or corrections are not allowed, the applicant is to be given a further period in which to make observations, to agree amendments proposed by the Examining Division, and to file amended translations. In that last eventuality, although Rule 51(6) EPC does not say so in

- terms, it must be the case that the Examining Division gives the applicant reasons for refusing any amendments or corrections sought, since otherwise there would be no purpose in allowing the applicant time and opportunity to make observations.
4. The implications of the legal position for the present case are also perfectly clear. By referring only to the appellant's submission of 16 October 2001 and not to that of 2 September 2003, the Rule 51(4) EPC communication did not refer to the complete text previously proposed by the appellant; in particular, claims 31 and 32 were omitted. There was therefore no prospect that the appellant could give unconditional approval to the text enclosed with the communication. In fact, as only appears from the non-public request of 15 June 2005 for a legal opinion (see XII above), claims 31 and 32 were overlooked by the Formalities Officer and not forwarded to the Examining Division, so the Rule 51(4) communication could not make reference to them. (Of all the extraordinary acts and omissions in this case, the apparent failure until now to disclose that true cause of the mistake to the appellant, and to make an appropriate apology, is perhaps the most extraordinary.)
 5. The appellant replied in terms which made its position clear and unambiguous - its letter of 4 May 2004 gave approval to the text "in accordance with the amendments in the attached schedule": it thus made its approval conditional on inclusion of the omitted claims (see IV above). It is beyond doubt that this letter and the enclosed schedule were received and read at the EPO since, in addition to the omitted claims, the schedule

- referred to, and enclosed documents relating to, a change of applicant and subsequent change of name and those changes were acted upon promptly as the EPO letter of 20 July 2004 shows (see V above).
6. Had the procedure in Rule 51 EPC been followed at this point then it is conceivable that, despite the earlier failure to consider claims 31 and 32, an unconditional and valid approval of the appellant might have been obtained. However, the procedure in Rule 51 EPC was not followed - the amendments re-submitted with the schedule were neither allowed nor refused, let alone refused with reasons. It appears the appellant's letter with its schedule were, as regards the additional claims 31 and 32, simply ignored and the purported decision to grant was issued as if those amendments had never been filed, and thus as if the appellant had in fact consented to the text enclosed with the Rule 51(4) communication. The reference in the decision to "modifications subsequently requested by the appellant and received at the EPO" is seemingly just part of a standard form letter in which the date "00.00.00" can only have been meant to indicate that no modifications to the text had been requested since the Rule 51(4) communication had been sent (see V above). That was of course not merely incorrect but, since the appellant's letter of 4 May 2004 had been read and otherwise acted on, it was also known to the Examining Division to be incorrect.
7. Accordingly, the decision announced in the letter of 1 July 2004 did not comply with Article 97(2) EPC and was never valid. It was a decision which, in the absence of the appellant's unconditional approval of

the proposed text, the Examining Division quite simply had no power to take. It is and always has been a nullity. The decision must be set aside or, to use the more appropriate term of the appellant's request, cancelled.

8. The result is that the case must be treated as if the decision was never made and thus, as the appellant now requests, the examination, which should not have been discontinued, must be re-opened. While the appellant's initial reaction to the prospect of unnecessarily belated further examination is readily understandable (see X above), the fact remains that even now the examination of claims 31 and 32 has not been completed. The appellant correctly observed in its letter of 15 October 2004 that even then the Examining Division had had two opportunities to examine those claims and it is also highly likely, as the appellant submitted, that it had incurred costs on the assumption that those claims had been examined and accepted. The first of those matters - failures to follow procedure - is dealt with in the context of substantial procedural violations (see 9-16 below), and the second - wasted costs - would have to be the subject of other proceedings (see 24 below).

*Request for Reimbursement of the Appeal Fee -
Substantial Procedural Violations*

9. There remains the appellant's allegation of a substantial procedural violation and request for reimbursement of the appeal fee. Before considering those issues, the Board makes two observations. First, there is a marked lack of explanation as to why the

Examining Division came to make the decision and why it subsequently acted as it did. While the non-public document of 15 May 2005 does at least explain the original error, it does not explain why the error was knowingly repeated when the 2 September 2003 letter and claims 31 and 32 were re-filed in reply to the Rule 51(4) communication: while there was clearly no second "overlooking", there was clearly a conscious failure to consider the additional claims. Second, it does not explain why, when the true position emerged, the Examining Division did not immediately acknowledge that its decision was a nullity and proceed to deal expeditiously with the unexamined claims. Instead however, the Examining Division plunged into a maelstrom of maladroit manoeuvres, none of which could change the nature of the erroneous decision, namely that it was a nullity. As William Shakespeare correctly wrote, "Nothing will come of nothing" (*King Lear*, Act I, Scene 1), but the Examining Division made strenuous efforts to prove Shakespeare wrong.

10. The appellant has argued that issuing the decision to grant in the absence of an approved text was a substantial procedural violation and the Board agrees. As already observed (see 2 above), approval by an applicant or patent proprietor of the text of a patent is a principle underlying all decisions of the EPO (Article 113(2) EPC) and a mandatory pre-condition of a decision to grant (Article 97(2) EPC). If procedural principles considered sufficiently important to be enshrined in legislation could be disregarded with impunity by those entrusted to make decisions, there would be no reliability in the legal order established

by the EPC. In T 647/93 (OJ EPO 1995, 132, Reasons, paragraph 2.6) it was said:

"In the opinion of the board, this involves an infringement of Article 113(2) EPC, according to which the European Patent Office shall consider and decide upon the European patent application only in the text submitted to it, or agreed, by the appellant. This is a fundamental procedural principle, being part of the right to be heard, and is of such prime importance that any infringement of it, even as the result of a mistaken interpretation of a request, must, in principle, be considered to be a substantial procedural violation."

The Board agrees. Accordingly, a substantial procedural violation as argued by the appellant occurred.

11. Although not advanced by the appellant as substantial procedural violations as such, the Board also notes a number of other substantial procedural violations occurred in the present case as follows. First, the original mistake - the failure to consider claims 31 and 32 when they were first filed with the appellant's letter of 2 September 2003 - disregarded the appellant's right to file voluntary amendments pursuant to Rule 86(2) EPC. Second, the failure to consider those claims when re-filed with the letter of 4 May 2004 and its accompanying schedule disregarded the appellant's rights under Rule 51(5) and (6) EPC to have its amendments considered and to be given reasons for any refusal (see 3 above). Both those failures were substantial procedural violations.

12. Third, the Examining Division should not have stated categorically that an error capable of correction under Rule 89 EPC had occurred and (as it did twice within paragraph 8 of its communication of 26 October 2004 - see IX above) that the decision was accordingly corrected. That this was wrong was demonstrated by the Examining Division's own subsequent statements, in its telephone minute of 14 February 2005, that a correction under Rule 89 EPC was "in doubt" and "in any case hypothetical" - such "doubt" and "hypothesis" apparently being the nearest the Examining Division could bring itself to admit its own error. In fact, the seeds of doubt on the part of the Examining Division itself can be traced to the earlier communication which said "**if necessary** the correction of the decision will be to one of refusal" (see IX above - *emphasis added*). It appears from the file that the Examining Division never decided the exact form it considered the correction took and that in turn prompted the appellant's inquiry of 8 February 2005 about the date of grant. The appellant was clearly affected by this treatment in that the Examining Division unnecessarily misled it for over three months as to the procedure for remedying a mistake for which the Examining Division itself was responsible.

13. Fourth, after the Examining Division's volte-face in February 2005 - abandoning its own correction under Rule 89 EPC in favour of an appeal which it considered by then could only be out of time; after the appellant apparently accepted the advice to appeal and filed its re-establishment requests; and after the Examining Division requested a legal opinion in which, on 29 June

2005, it was advised categorically to allow re-establishment and to set aside the decision to grant - then the Examining Division none the less took no further action for over five months until 5 December 2005, the date of its letter to the appellant informing it that its re-establishment requests were allowed. Moreover, the letter of 5 December 2005 concluded with the statement: "Accordingly the case has been referred to the Examining Division for further prosecution." That was a clear indication that the Examining Division would continue examination of the patent application and could thus only have been taken by the appellant to mean that the case would be, or already had been, the subject of interlocutory revision (as indeed the legal opinion had advised but as did not in fact happen - see 14 below). This letter was thus thoroughly misleading, both as to the immediate past and the immediate future. Misleading the appellant (yet again) as to procedure must again be considered a substantial procedural violation.

14. Fifth, although the legal opinion could hardly have made clearer to the Examining Division that it should rectify its decision by way of interlocutory revision under Article 109(1) EPC, the Examining Division did not do so. In T 647/93, following the passage cited in 10 above stating that any infringement of the fundamental procedural principle of Article 113(2) EPC must be considered to be a substantial procedural violation, it was said:

"In any case, such violation occurs when, as in the present case, the examining division does not make use of the possibility of granting

interlocutory revision under Article 109 EPC, after the mistake has been pointed out in the grounds of appeal."

The Board agrees with those observations and adds that, in the present case, they have if anything more force for two reasons. First, in this case, the appellant pointed out the mistake (namely, the disregarding of claims 31 and 32) much earlier than in the grounds of appeal; and, second, the appellant only filed an appeal because, in effect, it was told by the Examining Division that an appeal was its only remedy. Accordingly, not granting interlocutory revision under Article 109 EPC was a further substantial procedural violation.

15. Sixth, Article 109(2) EPC provides that, in the absence of interlocutory revision within three months after receipt of the statement of grounds of appeal, an appeal shall be remitted to the Board of Appeal without delay. The latest date on which it could be said the statement of grounds of appeal was filed was 5 December 2005, the date of the Examining Division's decision to allow the appellant's re-establishment requests. Accordingly, the Examining Division should have decided whether or not to rectify its decision by 5 March 2006. However, the case was not remitted to the Board until 2 May 2006. The expression "without delay" cannot be stretched to make three months mean five months. Yet again, there is no explanation for this failure of the Examining Division to comply with the procedure provided for in the EPC which accordingly was a further substantial procedural violation.

16. The Board has the power, in the case of an allowable appeal, to order reimbursement of the appeal fee if it finds that would be equitable by reason of a substantial procedural violation - that is, by reason of one single substantial procedural violation (Rule 67 EPC). It follows that, in view of the concatenation of such violations in the present case, it is beyond doubt equitable to order reimbursement of the appeal fee.

Re-establishment Requests

17. As observed earlier, the decision under appeal is and always was a nullity and it was open to the Examining Division, from the moment the purported decision was taken, to acknowledge its invalidity and proceed with the substantive examination. Even if an appeal was necessary, the reason such an appeal was not filed following receipt of the decision to grant was that, in reply to the appellant's request for a correction of the decision under Rule 89 EPC in its letter of 27 September 2004, the Examining Division confirmed, in its communication of 26 October 2004 that such a correction had been made.
18. Whether a document issued by the EPO is a decision or communication depends on the substance of its contents and not on its form (see "Case Law of the Boards of Appeal of the European Patent Office", 5th edition 2006, section VI.M.5.1, pages 464-465). Accordingly, although headed "Communication/Minutes", enclosed with a cover sheet entitled "Consultation by telephone with the applicant/representative" and sent under cover of a letter headed "Invitation pursuant to Article 96(2) and Rule 51(2) EPC", the 26 October 2004 communication

quite clearly contained a decision in its paragraph 8 which twice stated "The decision to grant is thus corrected". The appellant thereby achieved what its letter of 27 October 2004 had requested and had no reason to consider an appeal. However, that letter had concluded by a request, repeated in the later letter of 15 October 2004, that if the request to correct under Rule 89 EPC should be declined, the Examining Division give detailed reasons for use on appeal (see VI above).

19. When the Examining Division subsequently performed its procedural somersault and announced, in its telephone minute of 14 February 2005, that a correction under Rule 89 EPC was inappropriate and the correct course of action would have been an appeal, it made a new and different decision in response to the appellant's request of 27 September 2004 and, in fact, gave reasons therefor (see X above). Accordingly, the minute of 14 February 2005 was, despite being headed "Communication/Minute" and being enclosed with a letter entitled "Result of consultation", just as much a decision as paragraph 8 of the communication of 26 October 2004. Therefore, on the date of receipt of that minute (24 February 2005 - see Rule 78(2) EPC), the appellant received a reasoned (albeit very badly reasoned) decision refusing its request of 27 September 2004 to correct the decision to grant of 1 July 2004 and its subsequent combined notice and grounds of appeal sent by fax on 6 April 2005 was accordingly filed within the time limit provided for in Article 108 EPC. Thus the appellant's re-establishment requests were unnecessary although their filing was an understandable reaction to the reasons given by the Examining Division (quoted in X above).

20. The re-establishment requests being redundant, the fees paid in respect of those requests were paid *per incuriam* (though through no fault attributable to the appellant) and must be refunded. (The Board also notes that, even if necessary, one re-establishment request would have sufficed, namely that to restore the appellant's time for filing an appeal; once that date had been secured, the time for filing the statement of grounds of appeal would have followed two months later under Article 108 EPC. However, after all it had experienced hitherto, the appellant's additional precaution was entirely understandable.)

Further Observations

21. The Board would add a number of further observations in the hope that cases as unfortunate as this one may be avoided in future. First, it seems that a contributory factor to the confusion in the present case was a lack of, or breakdown in, communication between the nominated members of the Examining Division responsible for the case and the Formalities Officer (or Officers) who actually dealt with it in part. The Board understands that, contrary to previous practice, the Examining Divisions and the Formalities Officers who deal with the same cases are, both physically and administratively, separated from each other and that this can cause delays and misunderstandings. While if true that is regrettable, neither such separation nor the distinction between Formalities Officer and the Examining Division can be allowed to affect the treatment, or indeed the rights, of applicants. Certain tasks of the Examining Division are, as a matter of

administrative convenience, delegated to Formalities Officers by a Notice made under Rule 9(3) EPC (see OJ EPO 1999, 504). However, the performance by Formalities Officers of those delegated tasks remains, in the words of Rule 9(3) EPC, "the execution of individual duties falling to the Examining Divisions"; and Article 18(1) EPC makes clear that "The Examining Divisions shall be **responsible** for the examination of European patent applications." (*Emphasis added*)

22. Second, any such problems of internal communication or division of labour cannot excuse the failure to accord an applicant the service it has applied and paid for, let alone any failure to respect an applicant's procedural rights. In the present case however, the Examining Division went even further than that by treating the appellant, through its representatives, as if it were itself responsible in part for the error for which the Examining Division was, in the sense of Article 18(1) EPC, wholly and exclusively responsible - for example, the communication of 26 October 2004 (see IX above) quite wrongly called the translations filed by the appellant incorrect, blamed those translations for causing confusion, elevated the arrival by the first examiner at his own opinion to the status of an agreement to grant, and alleged the appellant only filed the new claims after such agreement. To use a word overworked in this case, the Examining Division "overlooked" the fact that the appellant was the victim not the culprit.

23. The whole sorry history of this case can be traced to one simple omission - the Examining Division did not recognise and admit its initial mistake, namely making

an invalid decision. If it had confronted the consequences of that mistake there and then, issued a prompt cancellation and apology and proceeded to deal with the case correctly, it would have avoided many of the procedural solecisms noted above and saved the appellant nearly three years of wasted time and probably much wasted cost. Some mistakes may happen but, when they do, honesty is the best policy.

24. Third and last, the Board notes the various references in the appellant's submissions to costs incurred in respect of the decision and other such costs may well have arisen - to take but one example, if the corresponding protection in Hong Kong which the appellant would have hoped to obtain with effect from the date of grant of its European patent was delayed or lost. In view of the period of nearly two years and nine months it has taken to resolve a mistake which should never have happened, and which was capable of almost immediate solution after it did happen, the appellant's losses could be very substantial. However, the Board has no power to consider issues of liability for losses as a result of misfeasance in the course of the EPO's proceedings. The EPC reserves such matters of liability to the competence of appropriate national courts (see Article 9(2) EPC). No doubt the appellant has taken or will take legal advice in that respect.

Summary

25. To summarise, the decision under appeal being a nullity, it must be set aside and the case remitted to the first instance. Article 10 RPBA, which requires the Board to remit a case to the first instance if fundamental

deficiencies are apparent in the first instance proceedings, also applies - there can be no deficiency more fundamental than a decision made in the absence of any power to make it. In view of the substantial number of procedural violations, the appeal fee must be reimbursed. The re-establishment requests being unnecessary, although understandable, the fees paid in respect of them must also be reimbursed.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.
3. The appeal fee is to be reimbursed.
4. The two fees paid in respect of the requests for re-establishment of rights are to be reimbursed.

The Registrar:

The Chairman:

A. Wolinski

L. Galligani