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**Datasheet for the decision
of 23 September 2010**

Case Number: T 0331/08 - 3.3.03

Application Number: 99937629.6

Publication Number: 1101101

IPC: G01N 27/26

Language of the proceedings: EN

Title of invention:

Method for producing hydrophilic monomers and uses thereof

Applicant:

Lonza Rockland, Inc.

Headword:

-

Relevant legal provisions (EPC 1973):

EPC Art. 108, 122

EPC R. 36, 78

Keyword:

"Notice of appeal filed by non-permitted means - no legal effect"

"Good faith - responsibility of professional representative to ensure instructions of the EPO are followed"

"Restitution in integrum - no - not all due care"

Decisions cited:

Decision of the President of the European Patent Office dated 29 October 2002 on the electronic filing of patent applications and other documents (OJ EPO 2002, 543)

Notice from the European Patent Office dated 3 December 2003 concerning the electronic filing of documents within the meaning of Rule 36 EPC (OJ EPO 2003, 609)

Decision of the President of the European Patent Office dated 12 July 2007 concerning the electronic filing of patent applications and other documents (OJ EPO 2007, SE No. 3, Page 12).

T 0781/04, T 0991/04, T 0514/05, T 0971/05, T 1090/08

Catchword:

See Reasons 4, 5 and 6



Case Number: T 0331/08 - 3.3.03

D E C I S I O N
of the Technical Board of Appeal 3.3.03
of 23 September 2010

Appellant: Lonza Rockland, Inc.
191 Thomaston Street
Rockland, ME 04841 (US)

Representative: W.P. Thompson & Co.
Coopers Building
Church Street
Liverpool L1 3AB (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office dated 7 September 2007
and posted 19 September 2007 refusing European
patent application No. 99937629.6 pursuant to
Article 97(1) EPC 1973.

Composition of the Board:

Chairman: R. Young
Members: M. C. Gordon
H. Preglau

Summary of Facts and Submissions

- I. European Patent Application no. 99937629.6, filed on 30 July 1999 as international application number PCT/US99/17233, claiming priority dates of: 31 July 1998 from US serial number 09/127,770 and 29 July 1999 from US serial number 09/363,167 and published on 10 February 2000 as WO-A-00/07002 was refused by a decision of the examining division dated 7 September 2007 and posted 19 September 2007.
- II. On 12 November 2007 the applicant filed a submission by electronic means via the "epoline[®]" system. The cover sheet, bearing the title "LETTER ACCOMPANYING SUBSEQUENTLY FILED ITEMS" had under the heading "Description of document" the text "Letter relating to the search and examination procedure". The electronic cover sheet further bore the following "Statement" above the electronic signature of the representative:
- "The undersigned hereby declares that the subsequently filed items do NOT contain or are NOT intended to contain any communication relating either to an appeal or to an opposition (OJ EPO 2003, 609: "...This possibility is not yet available in opposition and appeal proceedings; in such proceedings, therefore, the electronic filing of documents is not admissible.")." (Emphasis of the original).
- The submitted document, i.e. the "Letter" (see above) on the letterhead of the representative firm contained as the heading, the text "APPEAL DUE: 19th NOVEMBER 2007". The first paragraph of the body of the letter read as follows:

"Biowhittaker Molecular Applications, INC. [...] hereby appeals against the Examining Division's Decision of 19th September 2007. Cancellation of the Decision, together with grant of a Patent is respectfully requested. A written statement setting out the grounds of Appeal will be filed in due course."

III. By telefax dated 28 January 2008 the applicant filed a document entitled "Statement of Grounds of Appeal". In the first sentence of this submission it was stated: "A formal Appeal against the Decision of 19th September 2007 was filed on 12th November 2007". Confirmation of this telefax was received by the EPO by post on 5 February 2008.

IV. By letter dated 16 March 2009 the applicant notified a change of name from "Biowhittaker Molecular Applications Inc." to "Cambrex Bio Science Rockland, Inc." and from "Cambrex Bio Science Rockland, Inc." to "Lonza Rockland, Inc.". It was accordingly requested that Lonza Rockland, Inc. be recorded as the applicant. This change was duly registered by the EPO, as notified in a communication dated 23 March 2009.

V. The Board issued a communication on 28 December 2009 in which it was noted:

- Electronic filing of appeals was not allowed at the relevant date, i.e. 12 November 2007;
- According to Art. 1 of the "Notice from the European Patent Office dated 3 December 2003 concerning the electronic filing of documents within the meaning of Rule 36 EPC", electronic filing of documents in appeal proceedings was

not available. This notice was published in the OJ EPO 2003, 609, i.e. is referred to on the cover sheet submitted by the applicant (see section II, above);

- According to Art. 2(3) of the Decision of the President of the EPO dated 12 July 2007 concerning the electronic filing of patent applications and other documents (OJ EPO 2007, Special Edition No. 3, A4) the provisions relating to electronic filing did not apply to documents in appeal proceedings;
- During the relevant period the "Hot News" section of the *epoline*[®] website contained an explicit statement that filing of appeals by electronic means was not admissible;
- No other means for filing an appeal had been used.
- Consequently the appeal was deemed not to have been filed (with reference to decision T 514/05, OJ EPO 2006, 526).

VI. The applicant replied with a letter dated 26 February 2010, requesting:

- That the Board deem the appeal to have been filed correctly, or in the alternative
- Re-establishment of rights under Art. 122 EPC.

(a) The reasoning in support of the request that the appeal be deemed to have been correctly filed can be summarised as follows:

- The decision of the examining division was issued on 19 September 2007;

- In accordance with legitimate expectations and good faith there had been sufficient time between the filing of the letter of 12th November 2007 and the deadline for filing an appeal (29 November 2007) for the EPO to advise the representative firm of the problem, thus enabling this to be remedied within the time period;
- Based on the principle of good faith it could be supposed that the deficiency could easily have been identified by the EPO and the applicant given the opportunity to correct this;
- The applicant had been led to believe that an appeal had been duly filed and a communication received from the EPO dated 19th February 2008 provided the appeal number and indicated commencement of proceedings before the Board of Appeal;
- There had been further correspondence between the representative firm and the EPO prior to 28th December 2009 and at no point had there been a suggestion that a problem existed with the filing of the appeal. Hence the legitimate expectation would be that the appeal had been duly filed and deemed acceptable by the Board.

(b) The arguments in support of the request for re-establishment of rights were as follows:

- The notice of appeal had "regrettably" been sent using the EPO's electronic filing system;

- The error had not been detected until the communication of the Board of 28 December 2009 (cf section V, above);
- Removal of the cause of non-compliance with the time limit for filing the "Grounds of Appeal" [*sic*] took place upon receipt of the Board's communication;
- The danger of using incorrect means of filing a document had been recognised and the firm had a system intended to ensure correct filing of such documents;
- In accordance with the usual procedure for filing documents at the EPO, assistants were under standing instructions not to prepare any documents for despatch by electronic mail which were identified in the Decision of the EPO President of 12 July 2007, OJ EPO 2007, SE No. 3, pages 12 to 16, stating *inter alia* that documents in appeal proceedings could not be filed in electronic form;
- Under the usual procedure, the partner responsible for a particular case would dictate a letter which was passed to an assistant. The assistant would transcribe the dictation and prepare the documents for filing. The assistant at this stage would check to ensure that the documents had been prepared in an appropriate format for despatch, be it sent electronically, by facsimile transmission or by post, and pass the documents to the professional for signature;

- The partner professional would then check the content of the documents to ensure that they were in a fit state to be filed and would also check that the correct means of communication had been chosen for despatching the documents;
- Assuming all was in order, the partner would return the documents to the assistant for despatch;
- In the case of electronic filing of documents the documents would be loaded onto the *epoline*[®] online filing system for the partner to electronically sign and send. At this point a final check would be made by the partner to ensure that the documents were in good order and that the correct form of communication was being employed;
- In essence, three checks would be made to ensure proper filing and despatch of documents to the EPO: one by the assistant in preparing the documents, a second by the partner when checking the content of the documents prepared by the assistant and a third by the partner prior to electronically despatching the documents on the *epoline*[®] system.
- This procedure had been employed when filing the grounds of appeal;
- The failure to file the "grounds of appeal" (*sic* - meant was the notice of appeal) other than by electronic filing was the result of an isolated error in an otherwise reliable system;

- Having taken all reasonable steps to ensure that the Grounds were filed, the applicant should not be unfairly prejudiced as a result of an isolated error which was not of its own making.

VII. In a further communication dated 14 April 2010 the Board drew attention to decision T 1090/08 of 30 March 2009 (not published in the OJ EPO), reference being made to section V of the Facts and Submissions thereof. This was an *ex parte* case handled by the same representative firm in which the grounds of appeal had been filed electronically. This error was ascribed in submissions of the applicant in that case to be an "isolated error in an otherwise reliable system" (T 1090/08 part V of the facts and submissions).

VIII. In a letter dated 14 June 2010 the applicant submitted with respect to T 1090/08 (see section VII, above):

- The events in the case in suit took place a considerable time prior to those of T 1090/08;
- The situation in the case in suit was different to that underlying T 1090/08 since there the (electronic) filing - of the statement of grounds of appeal - had been carried out by a non-partner professional whereas in the present case the (electronic) filing - of the notice of appeal - had been carried out by a partner;
- Thus at the time the incident occurred in the case in suit, the filing of a notice of appeal by electronic means in the case in suit was an isolated error;
- The filing of a notice of appeal by electronic means remained an isolated error since in

T 1090/08 it was the statement of grounds of appeal which had been filed electronically.

With regard to the admissibility of the appeal in the case in suit:

- The appeal fee had been correctly paid and the statement of grounds filed in a permissible form (fax);
- There was a period of 17 days between filing of the notice of appeal and the time limit; thus there would have been a legitimate expectation that the deficiency could have been identified by the EPO, communicated to the applicant and be corrected within the time limit;
- The fact that the appeal had been filed in electronic form could have been appreciated in good time before the expiry of the two month limit;
- Since more than two years had passed since the appeal was filed and there had been various communications issued by the EPO in connection with the appeal the conduct of the EPO had led the applicant and the public to the legitimate belief that the appeal was valid and progressing;
- Form 2701 (dated 8 February 2008) bore the signatures of the members of the examining division and the formalities officer, all of whom had accepted that a notice of appeal had been filed within the time limit.

Oral proceedings were requested for the case that the Board intended to deem the appeal as not having been filed.

IX. On 9 July 2010 the Board issued a summons to attend oral proceedings.

X. In a letter dated 20 September 2010 the applicant submitted:

- Third parties would not be adversely affected if the Board were to deem the appeal admissible;
- It was entirely within the power of the Board to confirm that this was the case and for the appeal to proceed in the usual way;
- The applicant and third parties would be adversely affected if the appeal were deemed inadmissible since for a considerable period of time both had been acting in the knowledge that there was an admissible appeal;
- The means by which the Notice of Appeal had been communicated to the EPO was now a perfectly accepted means of filing such documents;
- It seemed inequitable that some considerable time after the filing of such notices electronically had been permitted that this issue was only now raised;
- This fact further empowered the Board to confirm that the appeal was admissible.

XI. Oral proceedings were held on 23 September 2010.

(a) With regard to the method by which the notice of appeal had been filed, the issue of good faith and legitimate expectations, the applicant essentially reiterated the submissions from the written procedure (see sections VI, VIII and X above).

It was further submitted:

- A significant difference between the case in suit and that underlying T 514/05 was that at the time the Board notified the applicant of the problem in the case in suit, the decision of the President permitting electronic filing of appeals had entered into force (decision of 26 February 2009, OJ EPO 2009, 182, which entered into force on 5 March 2009);
 - There might be a legitimate expectation, in view of the gap between the filing of the appeal and the communication of the Board of 28 December 2009 (see section V, above), i.e. after the 5 March 2009 decision of the President, that the law applicable at the time the problem was notified to the applicant would be applied, leading the Board to deem the appeal as having been admissibly filed;
- (b) With regard to the request for re-establishment of rights the Board initially observed that if it were decided that the appeal had not been validly filed then any request for re-establishment was unlikely to succeed since there would be nothing to re-establish. In this connection the Board drew attention to T 971/05 of 14 September 2007 (not published in the OJ EPO), an earlier case assigned to this Board in which the failure to pay the appeal fee had resulted in the appeal being deemed not to have been filed.
- In any case there was the aspect of due care to consider in view of:
- The warnings provided by means of the information in the OJ;

- The notice on the website and
- The statement on the electronically filed letter.

The applicant submitted:

- The case in suit concerned precisely the sort of situation with which Art. 122 EPC was designed to deal;
- In T 991/04 of 22 November 2005, (not published in the OJ EPO), another case concerning electronic filing of the notice of appeal re-establishment had been allowed;
- The representative had a system in place which was normally reliable. In this case it had failed;
- Nevertheless all due care had been taken.

XII. The applicant requested that:

- The Board deem the appeal to have been validly filed;
- Auxiliarily, the applicant requested that the Board grant it re-establishment of rights pursuant to Art. 122 EPC;
- With regard to the substance of the decision of the examining division it is requested that the decision of the examining division be set aside and that a patent be granted on the basis of the main request or of one of the first to seventh auxiliary requests, in that order, as filed together with the statement of grounds of appeal.

Reasons for the Decision

1. *Applicable Law*

1.1 *General*

The decision of the examining division was dated 7 September 2007 and posted on 19 September 2007. Thus the last date on which a notice of appeal could be filed was two months and ten days after 19 September 2007 (R. 78(2) EPC 1973). This is prior to the entry into force of the revised EPC (EPC 2000, entry into force 13 December 2007). Thus the applicable law is EPC 1973.

1.2 *Electronic Filing*

The pertinent provisions are those set out in the Decision of the President of the European Patent Office dated 29 October 2002 (OJ EPO 2002, 543) and the related Notice from the European Patent Office concerning the electronic filing of documents within the meaning of Rule 36 EPC 1973 dated 3 December 2003 (OJ EPO 2003, 609, referred to in section V, above). According to Art. 1 of the Notice of 3 December 2003 documents other than priority documents could be filed electronically in grant proceedings.

It is however explicitly stated therein that "This possibility is not yet available in opposition and appeal proceedings; in such proceedings, therefore the electronic filing of documents is **not** admissible." (De: "**nicht** zulässig", Fr: "**pas** permis" (emphasis of the Notice)).

2. According to R. 36(2) EPC 1973 all documents (other than the description, claims, drawing and abstract, i.e. those covered by R. 27, 29 and 32-35 EPC 1973) shall normally be typewritten or printed.

Rule 36(5) EPC 1973 provides that the President may nevertheless permit documents filed after filing of the European patent application to be transmitted to the EPO by other means of communication and to lay down conditions governing their use.

2.1 The Notice of December 2003 thus enacted provisions, as foreseen in R. 36(5) EPC 1973 for the filing of documents - other than priority documents - during the grant proceedings by "other" means, namely electronic means.

2.2 Opposition and appeal proceedings were however explicitly excluded from these provisions.

2.3 Therefore the applicant employed a non-permitted means to file the notice of appeal.

2.4 Furthermore no confirmation of this electronically filed submission by other (permitted) means was provided.

3. This situation is in the Board's view comparable with that forming the basis of T 514/05 (referred to in the communication of the Board of 28 December 2009 - see section V, above).

3.1 This decision, which was taken during the period that the Notice of December 2003 was in force, after a detailed analysis, came to the conclusion that pursuant

- to R. 36(5) EPC 1973 an appeal filed by non-permitted means of communication, specifically via the *epoline*[®] system, could not have any legal effect, absent explicit permission of the President (T 514/05, Reasons, in particular section 10).
- 3.2 Further the payment of an appeal fee did not constitute constructive notice of appeal (T 514/05 reasons 11 with reference to J 19/90 of 30 April 1992, not published in the OJ EPO).
- 3.3 Accordingly the consequence of the use of a non-permitted means for filing the notice of appeal was that no appeal had been filed.
- 3.4 By the same logic, the notice of appeal in the case in suit is deemed not to have been filed.
- 3.5 This conclusion is analogous to the situation underlying T 971/05, discussed at the oral proceedings (see section XI.(b), above).
- 3.5.1 In that case although a notice of appeal had been filed (by permitted means), the appeal fee was not paid and hence no appeal was in existence (T 971/05, reasons 8).
- 3.5.2 Specifically, this Board held in T 971/05 that according to Art. 108 EPC 1973 for an appeal to come into an existence two prerequisites had to be met:
- The valid filing of a notice of appeal and
 - Payment of the appeal fee.

3.5.3 The consequence of the failure to meet one of these conditions - in the case of T 971/05 payment of the appeal fee - was that there was no appeal in existence.

3.5.4 In the case in suit the failure to meet the other condition - valid filing of a notice of appeal - leads therefore to the same conclusion.

4. *Request for the Board to confirm that the appeal had nevertheless been filed*

In its pleadings (cf letter of 20 September 2010 and at the oral proceedings-before the Board - sections X and XI.(a), above) - *inter alia* the applicant noted that electronic filing of appeals was now permitted and hence that the Board should, in the light of this deem the appeal to have been correctly filed.

4.1 This request of the applicant cannot be complied with since the Board does not have the power to do this.

4.2 As explained in part 7 of the reasons of the afore-cited T 514/05 a Board of Appeal is not entitled to exercise discretionary power to consider whether the appeal, filed by *epoline*[®] might be deemed to have been filed since:

- To do so would be tantamount to exercising a legislative power;
- Such legislative power is however clearly delegated in Rule 36(5) EPC 1973, i.e. that provision to which the Notice of 3 December 2003 relates, to another authority within the European Patent Organisation, namely the President;

- Thus pursuant to Art. 23(3) EPC the Board is precluded from examining whether this purported notice of appeal could be deemed to have been received, since such a procedure would be *ultra vires*;
- It is immaterial that this means of communication is now permitted for the filing of appeals. At the time in question, i.e. 12 November 2007 this was not permitted, and it is the law and instructions in place at this time which have to be applied to this case.

5. *Aspect of "good faith" or "legitimate expectations"*

5.1 It is true that a number of communications were sent by the office - either from the examining division or the Board relating to the purported appeal.

5.2 Such communications are however of merely administrative nature and the existence thereof does not prejudice substantive examination of the facts of the case by the Board (T 781/04 of 30 November 2005, not published in the OJ EPO, reasons 2, and the aforementioned T 991/04, reasons 28). Furthermore parties cannot shift responsibility for complying with the provisions of the EPC to the EPO (T 991/04, reasons 28 second paragraph).

5.3 This Board is of course aware that the Board responsible for T 781/04 held it to be appropriate to exercise the principle of good faith and thus allowed *restitutio in integrum*, whilst in T 991/04 the Board held that the principle of good faith required that the Board deem the appeal to have been validly filed.

However the then prevailing situation with respect to *epoline*[®] was different from that existing at the time of the case in suit. As noted in sections 10.1 to 10.3 of the reasons of T 781/04 and section 31 of the reasons of T 991/04 there was - at the relevant time in those cases - no on-screen warning in *epoline*[®] that filing of appeals by electronic means was not permitted. Such a warning was however introduced subsequently in the light of a number of problems, as reported in paragraph 10.3 of the reasons of T 781/04, i.e. as a consequence of a "lacuna" in the system (see also T 991/04 reasons 31).

- 5.4 This consideration however does not apply in the present case since at the time the applicant submitted the "notice of appeal" the warnings the absence of which was referred to in T 781/04 and T 991/04 were in place both on the website and also on the electronic form to be filed with the submission. These warnings explicitly alerted the users of the system that this was not permitted for filing appeals.
- 5.5 Accordingly in view of the manifold steps taken by the EPO to ensure users would be aware of the restrictions placed on the use of the *epoline*[®] system, not only by means of the announcements in the OJ, of which it could be expected that a professional representative would be aware but also, as a further precaution, by means of warnings on the website, the Board can identify no justification for application of the principle of "good faith" or "legitimate expectations" to lead the Board to deem the "appeal", filed by non-permitted means, nevertheless to have been filed, notwithstanding the

fact that the Board does not have the competence to do so (cf discussion of T 514/05 in section 4, above). On the contrary, as held in T 781/04, paragraph 10.3 of the reasons and T 991/04 paragraph 28 of the reasons it is the responsibility of the professional representative to ensure the relevant instructions of the Office are followed and that the appropriate means for making submissions is employed and this responsibility cannot be transferred to the EPO.

5.6 These considerations are not changed by the fact that in the intervening period electronic filing of appeals has become possible. As explained in section 4.2 above, the relevant provisions are those in force at the relevant time, not those that came into force at a later time, or which had been in force at an earlier time.

6. *Request for restitutio in integrum.*

6.1 As explained above with regard in particular to T 971/05, since no valid appeal was filed within the time limit (see sections 2 and 3.5, above) an appeal procedure was never initiated and consequently there are no rights to be re-established.

6.2 This notwithstanding the Board recalls that according to Art. 122(1) EPC this provision is applicable to an applicant or proprietor who "in spite of **all due care** required by the circumstances having been taken" fails to observe a time limit (emphasis of the Board).

6.3 Although in a number of cases involving electronic filing of documents in the appeal proceedings e.g. that

underlying the aforementioned T 781/04 the Board was prepared to grant *restitutio in integrum*, as explained in section 5.3 above, these findings relied on the observation that that at the relevant time there was a "lacuna" in the EPO system since the *epoline*[®] website contained no warning or reminder that electronic filing of appeals was not permitted (T 781/04 reasons 10.1). T 781/04 (and T 991/04) - both dating from the latter half of 2005 - note that the problem had in the meantime been addressed by introduction of a warning on the website.

- 6.4 However in the case in suit the applicant was made aware of the restrictions on the use of the *epoline*[®] system - over and above the announcements in the Official Journal:
- By means of the warning on the website and
 - was also required as a prerequisite for making the submission to sign - electronically - a document which stated unequivocally that the submission was not in relation to an appeal (see section II, above).
- 6.5 Accordingly the evidence is that the applicant in electing to file a notice of appeal by non-permitted (i.e. electronic) means overlooked not only the information published in the official journal but also ignored two warnings, one of which was on the electronic document signed by the representative.
- 6.6 The Board is unable to consider this conduct, involving as it does a triple failure, to be evidence of the exercise of "all due care" in filing the appeal, and thus finds that the availability of the provisions of

Art 122(1) EPC in respect of the filing of the notice of appeal is precluded.

Order

For these reasons it is decided that:

1. The Appeal is deemed not to have been filed.
2. The request for *restitutio in integrum* is rejected.
3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

E. Görgmaier

R. Young