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**Datasheet for the decision
of 4 February 2009**

Case Number: T 0765/08 - 3.4.03

Application Number: 00974472.3

Publication Number: 1147550

IPC: H01L 21/331

Language of the proceedings: EN

Title of invention:

Method of manufacturing a semiconductor device comprising SiGe HBTs

Applicant:

NXP B.V.

Opponent:

-

Headword:

Appeal filed online/NXP B.V.

Relevant legal provisions:

EPC Art. 109(1)
EPC R. 1, 2, 50(2)

Relevant legal provisions (EPC 1973):

EPC R. 36(2), (5), 65(1)
EPC Art. 108

Keyword:

"Legal effect of appeal filed via epoline; formal requirements of documents filed by other means of communication"

Decisions cited:

T 0781/04, T 0991/04, T 0514/05

Catchword:

Documents purporting to be documents filed subsequently for the purposes of Rule 2(1) EPC must be deemed not to have been

received if they are filed with technical means not approved by the President of the EPO (point 9 of the reasons).



Case Number: T 0765/08 - 3.4.03

D E C I S I O N
of the Technical Board of Appeal 3.4.03
of 4 February 2009

Appellant:

NXP B.V.
High Tech Campus 60
NL-5656 AG Eindhoven (NL)

Representative:

Williamson, Paul Lewis
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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 10 January 2008
refusing European application No. 00974472.3
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: G. Eliasson
Members: T. Bokor
E. Wolff

Summary of Facts and Submissions

- I. This is a purported appeal from the refusal of application 00 974 472.
- II. A document described as *Request for a decision* and having the file name *Document.pdf* was transmitted electronically to the EPO on 21 January 2008, making use of facilities authorised for certain restricted purposes by the Decision of the President of the European Patent Office dated 12 July 2007 (OJ EPO Special Edition No. 3, 2007, 12)(hereinafter Decision), ie the so-called epoline® online filing system. The document so transmitted will be referred to hereinafter as *the appeal filed online*.
- III. Based on its content, the document appeared to be a notice of appeal. The appeal fee was debited to the appellant's account on the day the appeal filed online was transmitted, as ordered by the appellant.
- IV. Another document described as *Request for further processing* and having the file name *letter.pdf*, accompanied by a further document described as *amended claims* and having the file name *claims.pdf* was transmitted to the EPO on 3 April in the same manner, ie via the epoline® online filing system. Based on their content, the documents appeared to be respectively the statement of grounds of appeal for the above mentioned appeal filed online and main and auxiliary claim requests.

- V. Rectification of the decision pursuant to Article 109(1) EPC was not ordered by the examining division, and the case was referred to this board.
- VI. In a first brief communication the board informed the appellant as to the expected legal effect of the appeal filed online.
- VII. In a second reasoned communication the board opined that the appeal was either non-existent or inadmissible, on grounds substantially corresponding to the reasons below. The purported statement of grounds of appeal had included a request for oral proceedings - albeit not specifically on the existential issue - for the case that the board should be minded to refuse the appeal. The appellant was asked whether this request was maintained.
- VIII. Thereupon the appellant withdrew their request for oral proceedings.

Reasons for the decision

1. A precondition for the admissibility of an appeal is that a notice of appeal be filed and a precondition for the latter is that the document mediating the notice be deemed to have been (legally) received.
2. It is established jurisprudence of the boards of appeal that documents of an appeal procedure are to be considered as "documents other than those making up the application" in the sense of Rule 50(2) EPC (Rule 36(2) EPC 1973); see for example the interlocutory decision

in T 991/04 of 22 November 2005, (not published in OJ), points 7 to 21 of the reasons. Article 1 in conjunction with Article 2(3) of the Decision makes it clear that the electronic filing of documents in appeal proceedings is not authorised. However, the Decision leaves open the legal effects of such documents if they should nevertheless be transmitted electronically.

3. The possible legal effects of appeals filed online were treated by previous decisions of the boards of appeal. Decisions T 991/04 (*supra*) and T 781/04 of 30 November 2005 (not published in OJ) found that such appeals do not fulfil the requirement of a written appeal as stipulated in Article 108 EPC 1973, first sentence, and therefore must be rejected as inadmissible pursuant to Rule 65(1) EPC 1973. Decision T 514/05 of 8 September 2005 (OJ EPO 2006, 526) ruled that an appeal filed online must be deemed not to have been received, absent the explicit permission of the President of the EPO to use this way of filing documents for appeal proceedings. This ruling was based on the wording of Rule 36(5) EPC 1973.

4. The provisions governing the electronic filing of documents have been substantially amended in the EPC as presently in force. Rule 1 EPC now explicitly states that in written proceedings before the European Patent Office the requirement to use the written form shall be satisfied if the content of the documents can be reproduced in a legible form on paper. It is worth noting that the rule makes no exceptions, but simply refers to "written proceedings", thus also encompassing opposition and appeal proceedings. Without analysing in detail the meaning of "reproduced in a legible form on

- paper", the board acknowledges that this condition is fulfilled by documents sent via the epoline system.
5. However, in the board's view the *ratio decidendi* of the decisions mentioned above has not been affected by these changes. Rules 1 and 2 EPC now together regulate the requirements to be fulfilled for the written form, and it is still within the powers of the President to allow the use of specific technical means of communication for the purpose of filing documents in various procedures before the EPO. The legislative intent behind Rule 2(1) that documents filed using technical means not permitted by the President of the EPO cannot be considered to be "written" for the purposes of the EPC may be gleaned from document CA/PL 29/06 Add. 1e; see point 2. On the other hand, the key provisions of Rule 36(5) EPC 1973 were adopted in Rule 2(1) EPC without change in substance, specifying the powers of the President in this regard, and also the possible legal effect that documents filed subsequently and not fulfilling the formal or technical requirements as might be prescribed by the President, for example a paper confirmation, shall be deemed not to have been received.
6. Under these circumstances the board does not see any possibility of examining the substantive merits of the appeal, as it is either nonexistent or at least not admissible. The distinction between these may still be important for parties as long as potential legal effects of an inadmissible appeal (beyond the non-reimbursement of the appeal fee) are recognised in the jurisprudence of the boards of appeal, even if the

jurisprudence is not fully consistent concerning such legal effects.

7. Rule 1 EPC sets only one condition for recognising the written form, namely that the contents of the document be reproducible in a legible form on paper. This provision thus allows the President by virtue of Rule 2(1) EPC, to specify the use of suitable technical means, without having to consider the legal issue whether the suitable technical means will satisfy the written form. Instead, the President needs only to consider the purely technical issues, such as the technical suitability of the possible technical means to reproduce the content of the document on paper and the general feasibility of any given system to be integrated into the infrastructure of the EPO. On the other hand, Rule 2(1) EPC also specifies a possible legal effect foreseen for the irregular use of a technical means which is approved by the President, namely that such a document shall be deemed not to have been received (or is to be refused if the document is a patent application). It is worth noting that pursuant to Rule 2(1)EPC the President may specify whether or not to require a confirmation copy, but is not given any freedom in choosing the possible legal consequences if parties do not comply with the requirement.
8. On the other hand, the President's Decision makes it clear that parties are not permitted to use the epoline system for the filing of documents for opposition or appeal proceedings, even if the system is inherently technically capable of handling such documents. For the purposes of such documents the epoline system must be considered as non-existent.

9. Given the above, the board holds that documents purporting to be documents filed subsequently for the purposes of Rule 2(1) EPC must be deemed not to have been received if they are filed with non-approved technical means. Whether or not they fulfil the requirements of being in written form and possible legal effects arising therefrom need not be considered. This solution appears to reflect the legislative intent (see also T 514/05 (*supra*), point 10 of the reasons). It avoids the legal problems that may arise from manifestly inadmissible oppositions or appeals, where in each case the pending status of an application or any proceedings would otherwise need to be examined. The latter would be necessary because the pending status has a bearing on the possible legal effects of procedural steps taken in the interim period before the inadmissibility has been legally established by a declaratory decision.
10. Further, the finding that such appeals or oppositions are deemed not to have been received forestalls parties being able to impose on the Office the use of technical means for purposes not intended, which would amount to overriding the powers of the President. Reference is also made to T 514/05 (*supra*), point 7 of the reasons, holding that the boards of appeal have no power themselves to exercise the powers of the President.

11. It may of course seem paradoxical that the legal non-existence of a document can only be determined after having received and read the document, thereby apparently defying its non-existence. However, the paradox is inherent in the very notion of the legal effect "deemed not to have been received", since some proceedings must be in existence before such a legal effect can be established, where - as in the present case - the proceedings were actually initiated by the document in question. The legal effect "deemed not to have been received" is merely the expression of a legal fiction, meaning that the document cannot achieve any **substantive** legal effect, even if it was capable of initiating some formal proceedings. In other words, the document exists physically, but not legally, in the sense that it is not capable of affecting substantive rights in any manner, apart from the fact that the legal fate of the document and the related substantive rights may have to be established with an *ex tunc* effect.

Order

For these reasons it is decided that:

The appeal is deemed not to have been received.

The appeal fee shall be reimbursed.

Registrar

Chair

S. Sánchez Chiquero

G. Eliasson