

**Interlocutory decision of Technical Board of Appeal 3.2.06 dated  
20 February 2014**

**T 1553/13**

(Translation)

**Composition of the board:**

Chairman: M. Harrison

Members: T. Rosenblatt

W. Sekretaruk

**Patent proprietor/appellant: Tenneco GmbH**

**Headword: Inadmissibility of an appeal where the appeal fee is paid after expiry of the appeal period**

**Relevant legal provisions:**

EPC Art. 108, 94(1), 94(2), 99(1), 105a(1), 112(1), 112a(4)

EPC R. 22(2), 89(2), 123(3), 126, 136(1)

RFees Art. 2, 11

EPC 1973 R. 65(1)

Notice from the European Patent Office dated 10 June 2010 concerning enclosure of a standard acknowledgement of receipt (EPO Form 2936) in the case of notifications by registered letter with advice of delivery

Vienna Convention on the Law of Treaties (1969)

**Keyword:** "Notice of appeal filed after expiry of appeal period" - "Appeal fee paid after expiry of appeal period" - "Referral to the Enlarged Board of Appeal"

**Headnote:**

*The following point of law is referred to the Enlarged Board of Appeal:*

*If, after expiry of the time limit under Article 108, first sentence, EPC a notice of appeal is filed and the fee for appeal is paid, is the appeal inadmissible or is it deemed not to have been filed?*

**Summary of facts and submissions**

I. The decision of the opposition division revoking European patent No. 2 122 134 was posted on 25 April 2013. It was delivered to the representative's office by post on 26 April 2013, and accepted there by a person named "Weber". On 7 May 2013, the patent proprietor's representative signed an acknowledgement of receipt of the decision and filed it with the European Patent Office (EPO). His appeal was received by the EPO on 8 July 2013 and the appeal fee was paid the same day.

II. In a letter dated 15 July 2013, the board registrar pointed out that the notice of appeal had not been filed with the EPO until after expiry of the appeal period.

III. Responding to this letter, the appellant's representative contended that the two-month appeal period had to be considered to have started on the date of signature of the acknowledgement of receipt, this being the date on which he had taken cognisance of the decision, and that the notice of appeal had therefore been filed in time. Rule 126(2) EPC provided that, where notification was effected by registered letter, such letter was deemed to be delivered to the addressee on the tenth day following its posting, unless it had reached him at a later date. Since, under Rule 126(4) EPC, German law applied to the extent that notification by post was not covered by that rule's paragraphs 1 to 3, the provisions of Germany's Code of Civil Procedure (*Zivilprozessordnung* – "ZPO") and its law on notification of administrative acts (*Verwaltungszustellungsgesetz* – "VwZG") had to be applied. Section 4(2) VwZG applied a similar delivery fiction for notifications by registered letter; under it, the letter was deemed to be delivered after three days. But that did not apply where the registered letter was combined with acknowledgement of receipt under Section 5(2) VwZG. In that case, the date specified in the acknowledgement was regarded as the date of delivery. This showed that acknowledgement of receipt took precedence. The ZPO distinguished between service (Sections 166 to 174 ZPO) and substituted service ("*Ersatzzustellung*"; Section 175 et seq. ZPO). Delivery to business premises came under the latter category. The term "substituted" likewise showed that acknowledgement of receipt took precedence. Should the appeal be found inadmissible, a refund of the appeal fee was requested.

IV. The board informed the appellant that it still considered the appeal to be late-filed and, since oral proceedings had not been requested, it intended to decide the case without holding any. Depending on how Article 108, second sentence, EPC was interpreted, it could either dismiss the appeal as inadmissible or deem it not to have been filed. Only in the latter case could the appeal fee be refunded.

V. The appellant observed that in G 9/92 the Enlarged Board of Appeal, ruling on a referral in T 742/96, had decided that, where the appeal fee had not been paid in time, the appeal had to be deemed not to have been filed. The board in T 445/98 had reached the same conclusion.

VI. In a letter dated 26 November 2013, the board informed the appellant that it intended to refer the issue to the Enlarged Board of Appeal. The appellant welcomed that, while the respondent observed that it shared the EPO's view that the appeal was invalid.

### **Reasons for the decision**

1. The appeal was not filed by the time limit prescribed in Article 108, first sentence, EPC.

The opposition division's decision was posted on 25 April 2013. Under Rule 126(2) EPC, a letter is deemed to have been delivered on the tenth day following its posting, unless it is received on a later date.

2. Since the decision was posted on 25 April 2013, making 5 May 2013 the date of delivery (Rule 126(2) EPC), the appeal period expired on Friday, 5 July 2013. Although the representative was absent, his office was clearly open on 26 April 2013 and delivery of the contested decision was accepted by a person named "Weber" who was undisputedly authorised to do so.

3. Decisions triggering a time limit for appeal are to be notified by registered letter with advice of delivery (Rule 126(1), first sentence, EPC). The European Patent Register shows that advice of delivery is on file, in the form of "tracking information". It can also be presumed, depending on the circumstances, that persons in an addressee's premises are authorised to accept post.

4. The appellant's representative's position – that the two-month appeal period is to be calculated from 7 May 2013, that being when he signed the acknowledgement of receipt and thus actually became aware of the decision, and that the notice of appeal was therefore filed in time – cannot be reconciled with the applicable law.

5. He errs in contending that the German ZPO and VwZG apply by virtue of Rule 126(4) EPC because notification by post is not covered by the latter's paragraphs 1 to 3. Rather, the decision was notified in accordance with Rule 126(1) EPC and there is therefore no need to draw on national law.

6. In any event, the board doubts that the German notification rules cited could actually support the appellant's line of argument. There would have to be special reasons for applying the ZPO to notification by an administrative authority. In addition, the term "substituted service" relates to cases where an addressee is not there, and notification can then be made instead to the persons specified in the relevant provisions. There is nothing in those provisions to support more far-reaching conclusions as to which form of service takes precedence. Even if the VwZG were applied, it is not apparent that notification accompanied by acknowledgment of receipt takes precedence, as the appellant would have it. Rather, notification by registered letter and notification with acknowledgment of receipt are alternatives. The board does not share the view that the German Federal Court of Justice's decision published in NJW-RR 1992, page 1150, is relevant here, especially as it concerns delivery under the ZPO.

7. The basis for EPO acknowledgements of receipt is its notice dated 10 June 2010 concerning enclosure of a standard acknowledgement of receipt (EPO Form 2936) in the case of notifications by registered letter with advice of delivery (OJ EPO 2010, 377). The aim is to simplify administration where there are problems with the advice of delivery. It has no bearing on notification successfully effected by registered letter with

advice of delivery under Rule 126(1) EPC.

## 8. Referral to the Enlarged Board of Appeal

Under Article 112(1) EPC, a board refers a question to the Enlarged Board if it considers this necessary to ensure uniform application of the law or if a point of law of fundamental importance arises.

### 8.1 Uniform application of the law

Under Article 108, second sentence, EPC, notice of appeal is not deemed to have been filed until the appeal fee has been paid.

#### 8.1.1 Interpretation of the provision in the majority of board decisions

In a large body of case law, the boards have interpreted Article 108, second sentence, EPC to mean that an appeal does not exist unless the appeal fee is paid within the two-month appeal period and that, consequently, the fee must be refunded if it is paid late. Much of this case law concerns requests for re-establishment of rights following belated payment of the appeal fee. But the boards in question, besides refusing these requests, have said little about the appeals' non-existence.

The starting point is J 21/80, in which the board found that, since no valid appeal existed, the belatedly paid appeal fee had to be refunded, but did not give any other reasons. The order, in the original French, read: "*Le recours contre la décision de la Section de dépôt du 12 mai 1980 est considéré comme non formé.*" ("The appeal ... is deemed not to have been filed.")

In J 16/82, the board followed J 21/80, holding (see Reasons 2, 9 and 10):

"2. One of the conditions for a valid appeal is that the appeal fee must be paid within the two-month time limit laid down by Article 108 EPC. Otherwise, pursuant to Article 108, second sentence, EPC the appeal is deemed not to have been filed (see Decision of the Legal Board of Appeal J 21/80 dated 26 February 1981, OJ EPO 1981, p. 101).

9. Since re-establishment of rights is thus not possible, the appeal must be deemed not to have been filed pursuant to Article 108, second sentence, EPC. In the light of its origins, Article 108, second sentence, EPC, together with the first sentence, must be interpreted as meaning that the appeal is deemed not to have been filed if the appeal fee is not paid within the time limit for appeal specified in the first sentence (see also Decision J 21/80 dated 26 February 1981, OJ EPO 1981, 101).

10. If an appeal is deemed not to have been filed, pursuant to Article 108, second sentence, EPC, because the appeal fee was not paid until after the expiry of the time limit for appeal, the purpose of the fee payment can no longer be achieved."

So, aside from a reference to "origins" which is not explained in any greater detail, none of the decisions explains why Article 108, second sentence, EPC has been interpreted as it has. Nothing has been added by later decisions, including T 445/98 cited by the appellant and distinguishing, in Reasons 5 to 8, between non-existing and existing appeals.

Nor, as the board sees it, do the other decisions cited by the appellant – G 9/92 (actually G 2/97) and T 742/96 – provide any additional guidance on interpreting Article 108, second sentence, EPC.

The board in T 489/93, holding the appeal to be inadmissible owing to late payment of the appeal fee, explained that "The appeal therefore had to be rejected as inadmissible (Rule 65(1) EPC). The wording 'as inadmissible' used in Rule 65(1) EPC [1973] is to be understood broadly, i.e. as covering both existing (but 'inadmissible') and non-existing appeals." It took the view that in the case before it the appeal did not exist and, citing J 21/80, ordered that the appeal fee be refunded.

#### 8.1.2 Decisions deviating from the above interpretation

In T 1289/10, T 1535/10 and T 2210/10, the boards dismissed appeals as inadmissible without ordering a refund of the appeal fee, even though the appeals had not been filed and the fees not paid until after expiry of the appeal period. They did not address this point in their reasons.

In T 79/01, the appeal was dismissed as inadmissible because the appeal fee had not been paid in full. The board took the view that this was a logical interpretation of Rule 65(1) EPC 1973, explaining in Reasons 10 that:

"There is no reason to provide the appellant with a more favourable treatment in case of late (or insufficient, as in the present case) payment of the appeal fee (i.e. the appeal is deemed not ... filed and the appeal fee is reimbursed) as in case of, for example, late filed statement of grounds (inadmissibility of the appeal). Moreover the '*travaux préparatoires*' seem to support this interpretation. In the '*Materialien zum EPÜ*' [Historical documentation relating to the EPC] (IV/6514/61-D) is provided for, with reference to the '*Entscheidungsmöglichkeiten der Beschwerdekammer*' [possible board decisions] that '*Die Kammer kann feststellen, dass die Beschwerde wegen Nichtentrichtung der Gebühr unzulässig ist*' [The board may find the appeal inadmissible owing to failure to pay the fee]."

#### 8.2 Point of law of fundamental importance

Since the wording used in Article 108, second sentence, EPC is also to be found in Article 94(1), second sentence, EPC (request for examination), Article 99(1), second sentence, EPC (opposition), Article 105a(1), second sentence, EPC (request for

limitation), Article 112a(4), third sentence, EPC (petition for review), Rule 22(2), first sentence, EPC (request for registration of a transfer), Rule 89(2), second sentence, EPC (notice of intervention), Rule 123(3) EPC (request for conservation of evidence) and Rule 136(1), third sentence, EPC (request for re-establishment of rights), its interpretation could have implications beyond the present case.

### 8.3 Diverging decisions on a related point

These implications become apparent if T 1026/06 and T 1486/11 are compared. These decisions differ on whether the result of failing to pay the fee for re-establishment of rights within the two-month period under Rule 136(1) EPC is that the request for re-establishment is inadmissible or deemed not to have been filed.

Both cases concerned re-establishment of rights following late filing of the appeal and late payment of the appeal fee (and also of the fee for re-establishment).

The boards in both cases refused the request for re-establishment of rights, deemed the appeal not to have been filed and ordered that the appeal fee be refunded.

The board in T 1486/11 concluded that, having regard to Rule 136(1), third sentence, EPC, the request for re-establishment of rights had to be deemed not filed and the fee for it refunded (see Reasons 1.8 and 3). In contrast, the board in T 1026/06 did not mention that rule, instead refusing the request for a refund on the basis that, since the request's validity depended on paying the fee, there had been legal grounds for making that payment (see Reasons 7).

### 8.4 Need for a decision of the Enlarged Board of Appeal

In the present case, whether the appeal fee has to be refunded depends on how Article 108, second sentence, EPC is interpreted. It will only be refundable if the appeal is deemed not to have been filed. If the appeal is inadmissible, it cannot be refunded. The board inclines to the latter view.

#### 8.4.1 Rules of interpretation

In G 5/83 (OJ EPO 1985, 60; see "Preliminary Observations: Interpretation of the European Patent Convention"), the Enlarged Board held that the European Patent Convention must be interpreted in accordance with Articles 31 and 32 of the Vienna Convention on the Law of Treaties, which read as follows:

"Article 31 General rule of interpretation

1. A treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose.

2. The context for the purpose of the interpretation of a treaty shall comprise, in addition to the text, including its preamble and annexes:

(a) any agreement relating to the treaty which was made between all the parties in connection with the conclusion of the treaty;

(b) any instrument which was made by one or more parties in connection with the conclusion of the treaty and accepted by the other parties as an instrument related to the treaty.

3. There shall be taken into account, together with the context:

(a) any subsequent agreement between the parties regarding the interpretation of the treaty or the application of its provisions;

(b) any subsequent practice in the application of the treaty which establishes the agreement of the parties regarding its interpretation;

(c) any relevant rules of international law applicable in the relations between the parties.

4. A special meaning shall be given to a term if it is established that the parties so intended.

#### Article 32 Supplementary means of interpretation

Recourse may be had to supplementary means of interpretation, including the preparatory work of the treaty and the circumstances of its conclusion, in order to confirm the meaning resulting from the application of Article 31, or to determine the meaning when the interpretation according to Article 31:

(a) leaves the meaning ambiguous or obscure; or

(b) leads to a result which is manifestly absurd or unreasonable."

#### 8.4.2 Applying the general rule of interpretation

Under Article 31(1) of the Vienna Convention, then, a treaty is to be interpreted in good faith in accordance with the ordinary meaning to be given to its terms in their context and in the light of its object and purpose. Article 31(4) adds that a term is to be given a special meaning if it is established that the parties to the treaty so intended. The ordinary meaning of Article 108, second sentence, EPC ("Notice of appeal shall not be deemed to have been filed until the fee for appeal has been paid.") seems to be that, so long as the appeal fee has not been paid, the appeal is considered not to have been

filed, and the provision is no longer relevant once the fee has been paid, from which point the appeal is considered filed. It contains no suggestion of a link between payment of the fee and the time limit for filing an appeal, or that the wording "notice of appeal shall not be deemed to have been filed until the fee for appeal has been paid" is to be understood to mean "notice of appeal shall not be deemed to have been filed until the fee for appeal has been paid in time".

Nor can the board accept the argument in T 324/90 (OJ EPO 1993, 33) that the appeal fee must be refunded because if paid late it is paid without a legal reason. It accepts the underlying premise that fees paid without a legal basis must be refunded. However, that does not mean that the fee in this case is refundable; the legal basis for paying it is that appeal proceedings are under way. Article 108, second sentence, EPC, read together with Article 2, item 11, of the Rules relating to Fees ("RFees"), does not distinguish between decisions on an appeal's admissibility and on its merits.

#### 8.4.3 Supplementary means of interpretation

Under Article 32 of the Vienna Convention, recourse may be had to supplementary means of interpretation, including the preparatory work of the treaty, in order to confirm the meaning resulting from the application of Article 31, or to determine the meaning when interpretation under Article 31 leaves it ambiguous or obscure or leads to a result which is manifestly absurd or unreasonable. The meaning arrived at under Article 31 is neither ambiguous nor "obscure" in the sense of unclear; nor does it lead to an absurd or unreasonable result. Thus, the preparatory work can at best be used to confirm the meaning already established.

The board could not find in the *travaux préparatoires* anything directly relevant for interpretation of Article 108, second sentence, EPC, but the following sources may indirectly confirm the interpretation already established:

#### IV/6.514/61-D

Part IV/6.514/61-D of the *travaux préparatoires* concerns a draft of Article 93, which later became Article 108 EPC. Paragraph 2 reads: "If the appeal fee is not paid within the prescribed period, the appeal shall be deemed not to have been filed." On page 3 of the "Discussion of Article 93 of the Preliminary Draft of the Convention", it is reported that "Mr van Benthem asked whether the Convention provided for a remedy against a finding that the appeal was to be deemed not filed owing to failure to pay the fee. The chairman responded that, in such cases, a remedy would have to be available from the European Patent Court." On page 9, it also says: "The appellant will have to be notified in a likewise appealable decision of any finding that his appeal has been deemed not to have been filed owing to a failure to pay the fee in time. It does not seem necessary to insert this rule into the Convention itself. Whether a provision to this effect should be included in the implementing regulations to this Convention can be decided later."



This shows that, although consideration was given to deeming an appeal not filed if the appeal fee was paid late, neither a wording nor a procedure to that effect found its way into the final text of the EPC.

Elsewhere, moreover, the parties to the EPC certainly did opt for wording governing the consequences of belated procedural acts. For instance, Article 94(2) EPC expressly provides that the application is deemed to be withdrawn if no request for examination is made in due time, and Article 11 RFees expressly specifies when and how much of the examination fee is to be refunded. Article 108, second sentence, EPC says nothing of that nature. It therefore seems inconsistent to read into it wording it does not contain (see point 8.4.2, first paragraph, above).

### **Order**

For these reasons it is decided that:

The following point of law is referred to the Enlarged Board of Appeal:

If, after expiry of the time limit under Article 108, first sentence, EPC a notice of appeal is filed and the fee for appeal is paid, is the appeal inadmissible or is it deemed not to have been filed?