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**Datasheet for the decision
of 3 December 2021**

Case Number: T 0853/16 - 3.5.04

Application Number: 09250478.6

Publication Number: 2106134

IPC: H04N5/761

Language of the proceedings: EN

Title of invention:

Receiving apparatus, receiving method, recording apparatus,
recording method, program, recording medium, and network
system

Applicant:

Saturn Licensing LLC

Headword:

Relevant legal provisions:

EPC Art. 112(1) (a)
EPC R. 103(2), 103(3) (c), 115(2), 135
RPBA 2020 Art. 15(3), 15(6)

Keyword:

Reimbursement of appeal fee at 75% upon withdrawal of the appeal without issuing a communication referred to in R. 103(2) - (no)
Referral to the Enlarged Board of Appeal - (no)

Decisions cited:

G 0008/91, G 0003/98, G 0002/99, G 0002/12, G 0001/18,
R 0003/16, J 0012/86, J 0009/10, J 0025/10, T 0041/82,
T 0390/90, T 1242/04, T 0365/05, T 1016/10

Catchword:



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Case Number: T 0853/16 - 3.5.04

D E C I S I O N
of Technical Board of Appeal 3.5.04
of 3 December 2021

Appellant: Saturn Licensing LLC
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New York, NY 10022-3211 (US)

Representative: Witte, Weller & Partner Patentanwälte mbB
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 16 November
2015 refusing European patent application
No. 09250478.6 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairwoman B. Willems
Members: T. Karamanli
M. Paci

Summary of Facts and Submissions

- I. The appeal is against the decision to refuse European patent application No. 09 250 478.6.
- II. Notice of appeal was filed on 22 December 2015. The applicant (appellant) filed its statement setting out the grounds of appeal on 22 March 2016.
- III. By letter dated 2 April 2020, received by the EPO on the same date, the appellant withdrew its appeal and stated: "*It is requested to refund 75% of the appeal fee.*"
- IV. In a communication dated 16 April 2020, the board gave its preliminary, non-binding opinion that, in the case at hand, Rule 103 EPC as amended by the decision of the Administrative Council of 12 December 2019 (see OJ EPO 2020, A5) applied and that the appellant's request for reimbursement of 75% of the appeal fee appeared unallowable under Rule 103(2) EPC, but that it was possible under Rule 103(3)(c) EPC to reimburse 50% of the appeal fee. The board stated that the main reason for this was that in the case at hand there had been no communication from the board indicating its intention to start substantive examination of the appeal, and therefore one of the conditions set out in Rule 103(2) EPC had not been fulfilled.
- V. By a letter of reply dated 15 June 2020, received by the EPO on the same date, the appellant provided reasons as to why it considered reimbursement under Rule 103(2) EPC justified. It also submitted a question for referral to the Enlarged Board of Appeal.

- VI. By communication pursuant to Rule 112(1) EPC dated 6 November 2020, the appellant was informed that the present application was deemed to be withdrawn under Article 86(1) EPC since neither the renewal fee for the 12th year nor the additional fee had been paid in due time.
- VII. On 16 February 2021, the appellant re-filed its letter dated 15 June 2020.
- VIII. In its communication under Rule 15(1) of the revised version of the Rules of Procedure of the Boards of Appeal (RPBA 2020, OJ EPO 2021, A35), annexed to a summons to oral proceedings dated 28 May 2021, the board reiterated why, in its preliminary opinion, the appellant's request for reimbursement of 75% of the appeal fee appeared unallowable but a 50% reimbursement of the appeal fee under Rule 103(3)(c) EPC would be possible. The board also explained why it was of the view that there was no need to refer the matter to the Enlarged Board of Appeal.
- IX. By letter dated 16 June 2021, the appellant informed the board that neither the appellant nor its representative would be attending the oral proceedings and that no further submissions would be filed.
- X. By communication of the Registry dated 1 December 2021, the appellant was informed that the oral proceedings would be held by videoconference.
- XI. The board held oral proceedings on 3 December 2021 by videoconference. As announced, the appellant did not attend.

The Chairwoman noted that the appellant's final requests were as follows:

The appellant requested "to refund 75% of the appeal fee" and that the following question be referred to the Enlarged Board of Appeal:

"Considering a time window after the grounds of appeal have been submitted and before the Board of Appeal has issued the standard-form communication according to Rule 103 (2) EPC, without any exceptional circumstance and without any procedural or material progress in the appeal proceedings which either are known to the appellant or should have been known to the appellant, which of Rule 103 (2) EPC and Rule 103 (3)(c) EPC is applicable to determine the percentage of reimbursement when the appeal is withdrawn during that time window?"

At the end of the oral proceedings, the Chairwoman announced the board's decision.

XII. The appellant's arguments, where relevant to the present decision, may be summarised as follows:

(a) Rule 103 EPC as amended by the decision of the Administrative Council of 12 December 2019 applied. The decision was based on a proposal dated 4 October 2019 submitted by the President of the European Patent Office to the Administrative Council (document CA/80/19).

(b) The logic of Rule 103 EPC was tied to the stages of the appeal proceedings, with higher rates of reimbursement of the appeal fee for cases with less work by the boards of appeal. Points 60 to 62 and 68 of document CA/80/19 clearly indicated that the

amount of reimbursement of the appeal fee was dependent on the stage of the appeal proceedings at which the appeal was withdrawn, with the practical reasoning that the less time the board of appeal had spent on a case, the higher the amount of the appeal fee to be refunded. An early withdrawal of the appeal saved the boards of appeal a significant amount of work and allowed for more effective planning, and it also had a positive impact on their cost coverage. Thus, the financial incentive for an early withdrawal was higher.

- (c) It was clear from point 67 of document CA/80/19 that for Rule 103(2) EPC to apply, it was not a start date that was stipulated, but instead a clearly defined "latest by" date, i.e. two months from notification of the communication pursuant to Rule 103(2) EPC. In the case at hand, the 75% stage had not yet passed when the appeal was withdrawn, and therefore the rate of 75% was justified.

- (d) An exceptional situation for omitting the standard communication pursuant to Rule 103(2) EPC was not present in the case at hand. None of the exceptions mentioned in point 66 of document CA/80/19 applied here. Thus, the communication within the meaning of Rule 103(2) EPC should have been sent. Therefore, a reimbursement of the appeal fee according to Rule 103(2) EPC was applicable. Further, by analogy to decisions J 25/10 and J 9/10, referred to in point 62 of document CA/80/19, even if the board were to believe that an exceptional situation was present, this needed to be transparent to the appellant. As stated in point 62, appellants needed to *"know exactly at what stage(s) of the appeal proceedings they would be eligible for a reimbursement of the*

appeal fee." It was clear from the reasoning in point 12 of decision J 25/10 that if the board intended to deviate from the standard rule of sending the communication pursuant to Rule 103(2) EPC under exceptional circumstances, prior notification would have been required to make the appellant aware of the otherwise hidden reduction of the reimbursement rate from 75% to 50%. Otherwise, if there were no need for a transparent justification and timely notification, there could be arbitrary deviations from the rule of sending the communication pursuant to Rule 103(2) EPC.

- (e) Moreover, Rule 135 EPC served to provide the applicant with a time limit within which the required acts had to be effected. This time limit, i.e. the "latest by" date, was determined by the communication mentioned in Rule 135(1) EPC. Further processing could, however, be requested even without said communication having been received. The expression "within two months of the communication" in Rule 135(1) EPC was clearly equivalent to the wording of Rule 103(2) EPC and thus the same logic had to apply. Hence, there was no reason to make the 75% reimbursement of the appeal fee dependent on the communication from the board of appeal.

- (f) The board seemed to suggest that in this case the withdrawal fell into a period between the rate of 100% according to Rule 103(1) EPC and the rate of 75% according to Rule 103(2) EPC. No justification for such an intermediate period could be found. First, the rate of 50% according to Rule 103(3) EPC obviously followed Rule 103(2) EPC. It was clear from the logic of Rule 103 EPC that there was a

temporal sequence starting with Rule 103(1) EPC almost at the beginning of the appeal procedure and ending with Rule 103(4) EPC almost at the end of the appeal procedure. Applying Rule 103(3) EPC in between, timewise, Rule 103(1) EPC and Rule 103(2) EPC would break this logic.

Second, the straightforward interpretation of Rule 103 EPC showed a monotonically decreasing sequence of rates, i.e. 100%, 75%, 50%, 25% and, implicitly, 0%. Following the board's logic would lead to a varying sequence of 100%, 50%, 75%, 50%, 25% and 0%. There is, however, no justification for this variation as the material situation did not change from the phase before the communication referred to in Rule 103(2) EPC was sent to after it had been sent.

- (g) Rule 103(3)(c) EPC was not a catch-all clause; rather, it was only applicable after the 75% window had closed (and before the 25% window opened). Rule 103(3)(c) EPC stayed in the timeline logic of individual stages as explained above and served to address particular cases at that particular stage. Otherwise, Rule 103(3)(c) EPC would always be in conflict with the 25% reimbursements, as, due to Rule 103(5) EPC, i.e. "where more than one rate of reimbursement applies, reimbursement shall be **at the higher rate**" (emphasis added), the broad wording of Rule 103(3)(c) EPC, i.e. "the appeal fee shall be reimbursed at 50% if the appeal is withdrawn **after expiry** of the period under paragraph 1(b), provided withdrawal occurs... **before the decision** is issued," (emphasis added), would always be applicable as well. In fact, even if the board were of the opinion that Rule 103(3)(c) EPC could also be applicable, the reimbursement

of the appeal fee would still be at 75% due to Rule 103(5) EPC.

- (h) According to Article 31 of the Vienna Convention, Rule 103 EPC "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" (emphasis added). Further, in view of Article 32 of the Vienna Convention, it became clear that the "supplementary means of interpretation, including the preparatory work of the treaty and the circumstances of its conclusion" had to be taken into account. On the one hand, the meaning seemed ambiguous within the meaning of Article 32(a) of the Vienna Convention, as exhibited by the different interpretations of the board and the appellant. On the other hand, the conclusion drawn by the board did not seem to have a justification, i.e. the result was unreasonable within the meaning of Article 32(b) of the Vienna Convention.
- (i) Should the board be in doubt as to whether, given the present situation, the reimbursement of 75% was correct, it should refer the question submitted by letter dated 15 June 2020 to the Enlarged Board of Appeal. It was necessary that the question raised by the board was uniformly answered for this and all future cases. The question was also of fundamental importance as it directly affected the transparency of and trust in the institution of the European Patent Office.

Reasons for the Decision

1. *Withdrawal of the appeal*

The appellant withdrew its appeal and at the same time filed a request for reimbursement of the appeal fee. Appeal procedures are terminated, as far as substantive issues are concerned, when the sole appellant withdraws the appeal (G 8/91, OJ EPO 1993, 346). However, the board, with its inherent power, is authorised to examine the appellant's request for reimbursement of the appeal fee and to issue a decision if the request for reimbursement cannot be granted (see e.g. decisions T 41/82, OJ EPO 1982, 256 and J 12/86, OJ EPO 1988, 83). Therefore, the present appeal is pending until the board has decided on the appellant's request for reimbursement of 75% of the appeal fee or until the appellant withdraws this request. This does not change even if, in the meantime, the applicant has been informed that the present application is deemed to be withdrawn due to non-payment of the renewal fee.

2. *Non-attendance of the appellant at the oral proceedings before the board*

In the case at hand, the board decided that it was appropriate to proceed by holding the oral proceedings as scheduled in the absence of the appellant, in accordance with Rule 115(2) EPC and Article 15(3) RPBA 2020 (which is applicable in accordance with Article 25(1) RPBA 2020). On 3 December 2021, the board held oral proceedings by videoconference pursuant to Article 15a(1) RPBA 2020, which is applicable to the oral proceedings in the present case pursuant to Article 3 of the decision of the Administrative Council of 23 March 2021 approving an amendment to the Rules of

Procedure of the Boards of Appeal (CA/D 3/21) (see OJ EPO 2021, A19).

A party is free to choose not to attend oral proceedings but this choice is at its own risk since, in view of Rule 115 EPC and Article 15(3) RPBA 2020, a board is never obliged to postpone or cancel oral proceedings simply because a duly summoned party has announced that it would not appear, provided that it bases its decision on the facts and arguments on file (see also decision R 3/16). According to Article 15(3) RPBA 2020, a duly summoned party who does not attend oral proceedings may then be treated as relying only on its written case.

In the case at hand, by not attending the oral proceedings, the appellant effectively chose not to avail itself of the opportunity to present its observations and counter-arguments orally but instead to rely on its written submissions. The board was in a position to announce a decision at the conclusion of the oral proceedings, as provided for in Article 15(6) RPBA 2020. The reasons on which this decision was based do not constitute a departure from grounds or evidence previously put forward, which would require that the appellant be given a further opportunity to comment.

3. *Reimbursement of the appeal fee*

Since the present appeal was withdrawn after 1 April 2020, Rule 103 EPC as amended according to the decision of the Administrative Council of 12 December 2019 (see OJ EPO 2020, A5) applies (Article 2 of the decision of the Administrative Council) with respect to the issue of the reimbursement of the appeal fee.

4. The question as to whether, and to what extent, the appeal fee must be reimbursed depends on whether the respective requirements of the applicable provision of Rule 103 EPC are fulfilled.
5. Only Rule 103(2) EPC could offer a legal basis for a 75% reimbursement of the appeal fee and this reads as follows: "*The appeal fee shall be reimbursed at 75% if, in response to a communication from the Board of Appeal indicating its intention to start substantive examination of the appeal, the appeal is withdrawn within two months of notification of that communication.*"
6. According to the established case law of the Enlarged Board of Appeal and the boards of appeal, although the European Patent Organisation is not a party to the Vienna Convention on the Law of Treaties of 23 May 1969 ("the Vienna Convention"), the European Patent Convention (EPC) is to be interpreted in accordance with the principles set out in Articles 31 and 32 of the Vienna Convention (see G 1/18, OJ EPO 2020, A26, B. REASONS FOR THE OPINION, No. III, first paragraph, with numerous references to further case law). According to Article 31 (1) of the Vienna Convention, 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.*" In application of Article 32 of the Vienna Convention, the **preparatory work ("travaux préparatoires")** and the circumstances of the conclusion of the EPC serve merely **as supplementary sources confirming the result of the interpretation**, or they are **consulted** if **no meaningful meaning** can be determined **by applying the general rule of interpretation** (see, e.g., G 2/12, OJ EPO 2016, 27, No.

V. (4) of the Reasons for the decision; G 1/18, *supra*, B. REASONS FOR THE OPINION, No. III, last paragraph) (emphasis added by the board).

7. In the board's view, it follows from the clear wording of Rule 103(2) EPC that the appeal must be withdrawn "*in response to a communication from the Board of Appeal indicating its intention to start substantive examination of the appeal*". This communication from the board is therefore a mandatory requirement for the 75% refund of the appeal fee under Rule 103(2) EPC. There is no indication in the wording of Rule 103(2) EPC that there is also the possibility of reimbursement of 75% of the appeal fee if the communication referred to in this provision has not been notified. Therefore, with a **literal interpretation** of Rule 103(2) EPC, there is no refund of 75% of the appeal fee to an appellant where, as in the present case, no such communication has been issued.
8. This result of a literal interpretation of Rule 103(2) EPC is confirmed by document CA/80/19, which is a **supplementary** source pursuant to Article 32 of the Vienna Convention.

The title of section VII.B.a)(i) reads: "*Withdrawal of the appeal **in response to a communication** from the Board indicating its intention to start substantive examination of the appeal (reimbursement at 75%)*" (emphasis added by the board).

It is already clear from the wording of this title that for a 75% refund of the appeal fee, the withdrawal of the appeal must be a reaction to a communication from the board of appeal within the meaning of Rule 103(2) EPC. Thus, for reimbursement at 75%, the withdrawal of

the appeal is dependent on the issue of such a communication.

This is also confirmed in points 66 and 67 of document CA/80/19, which read:

"66. As a specific measure to reduce the backlog, it is proposed that in long-pending appeal cases the Board of Appeal **will as a rule issue a standard-form communication informing the parties of the intended start of the substantive examination of the appeal and drawing attention to the time-limited possibility of withdrawing the appeal and receiving a partial reimbursement of the appeal fee of 75%**" (emphasis added by the board)

and

"67. In order to benefit from this enhanced rate of reimbursement, the appellant will have to withdraw the appeal within a non-extendable statutory period of two months from **notification of said standard-form communication**" (emphasis added by the board).

9. However, there is no provision in the EPC, the RPBA or elsewhere that the board of appeal must issue a communication within the meaning of Rule 103(2) EPC in each appeal case before it commences substantive examination of the appeal.

This is also confirmed in point 66 of document CA/80/19, which reads as follows:

"66. As a specific measure to reduce the backlog, it is proposed that in long-pending appeal cases the Board of Appeal will **as a rule** issue a standard-form

*communication informing the parties of the intended start of the substantive examination of the appeal and drawing attention to the time-limited possibility of withdrawing the appeal and receiving a partial reimbursement of the appeal fee of 75%. A Board of Appeal **may decide to dispense with such a standard-form communication** because the appeal proceedings are progressing swiftly, in particular where they have been accelerated pursuant to Article 10(3) to (5) RPBA, revised version, or where the Board intends to issue the summons to oral proceedings or a substantive communication soon" (emphasis added by the board).*

In the board's view, however, a board of appeal does not have to give reasons as to why it wishes to dispense with said standard-form communication or whether an exceptional situation for omitting the standard-form communication is present. Moreover, the reasons listed as examples in point 66 are not to be considered decisive in every appeal case.

10. In view of the above, the appellant's argument that none of the exceptions mentioned in point 66 of document CA/80/19 applied in the present case and that therefore the communication within the meaning of Rule 103(2) EPC should have been sent is not convincing.
11. Furthermore, decisions J 9/10 and J 25/10, referred to by the appellant, are not applicable in the present case, even by analogy.

These decisions concerned Articles 9(1) and 11(b) of the Rules relating to Fees (RFees), which were in force at that time. Under these provisions, the 75% and 100% refund of the examination and search fee respectively could be refused only if the EPO had started

substantive examination or had started drawing up the search report. In view of decisions J 25/10 and J 9/10 and their implications for practice with regard to search and examination fee refunds, the EPO implemented a technical and administrative solution which defined specific, transparent search- or examination-related acts, thereby fulfilling the requirements of these two decisions without having to amend the RFees (see Notice from the European Patent Office dated 29 January 2013 (OJ EPO 2013, 153)).

However, Rule 103(2) EPC is different. The reimbursement of the appeal fee at 75% is not made dependent on whether the board of appeal has already started substantive examination of the appeal, but rather on the notification of the communication from the board of appeal "*indicating its intention to start substantive examination of the appeal*". After receiving this information, the appellant then has two months to withdraw the appeal, if it wishes to do so, to benefit from the 75% rate of reimbursement. This makes the factual situation of the case transparent and clear to the appellant.

12. Further, the appellant argued that Rule 135 EPC served to provide the applicant with a time limit within which the required acts had to be effected and that the expression "within two months of the communication" in Rule 135(1) EPC was clearly equivalent to the wording of Rule 103(2) EPC and, since the same logic had to apply, there was no reason to make the 75% reimbursement of the appeal fee dependent on a communication from the board.

In the board's view, the situation under Rule 135(1) EPC is not comparable to that under Rule 103(2) EPC,

for several reasons. The board sees an important difference in the fact that in the case of further processing under Article 121 EPC, the applicant itself can determine whether a time limit has been missed. Therefore, even without having to wait for a communication from the EPO that a time limit had been missed, the applicant can resume the proceedings with a request for further processing as swiftly and quickly as possible. In the case of Rule 103(2) EPC, on the other hand, appellants cannot assess whether and when the board of appeal intends to commence substantive examination of the appeal and therefore rely on the board of appeal to inform them accordingly.

In addition, the manner of computation of the two-month period of Rule 103(2) EPC is governed by Article 120(b) EPC and Rule 131(2) and (4) EPC. According to Rule 131(2), first sentence, EPC, computation starts on the day following the day on which the relevant event occurred, the event being either a procedural step or the expiry of another period. Where the procedural step is a notification, the relevant event is the receipt of the document notified, unless otherwise provided. Consequently, the two-month period under Rule 103(2) EPC can only start if the communication mentioned in that provision has been notified. When a period is expressed as a certain number of months, it expires in the relevant subsequent month on the day which has the same number as the day on which said event occurred (Rule 131(4) EPC).

13. Further, the appellant presented plausibility considerations. In its view, it was clear from the logic of Rule 103 EPC that there was a temporal sequence starting with Rule 103(1) EPC almost at the beginning of the appeal procedure and ending with

Rule 103(4) EPC almost at the end of the appeal procedure. Applying Rule 103(3) EPC in between, timewise, Rule 103(1) EPC and Rule 103(2) EPC would break this logic. Further, the straightforward interpretation of Rule 103 EPC showed a monotonically decreasing sequence of rates, i.e. 100%, 75%, 50%, 25% and, implicitly, 0%.

These arguments are not convincing. Paragraphs (1) to (4) of Rule 103 EPC contain various provisions for a full or partial refund of the appeal fee in the event of a withdrawal of the appeal. Whether and to what extent the appeal fee must be reimbursed depends on whether the requirements of one of these provisions are met. This means that the reimbursement of the full or partial appeal fee does not depend on a temporal sequence. Thus, it may well be that no communication within the meaning of Rule 103(2) EPC is issued in an appeal case and that therefore a 75% reimbursement of the appeal fee is not available at all.

14. For the reasons above, in the case at hand the requirements of Rule 103(2) EPC are not fulfilled and only those of Rule 103(3)(c) EPC are fulfilled. Consequently, only a 50% reimbursement of the appeal fee is available in the case at hand and thus Rule 103(5), second sentence, EPC does not apply here.
15. The appellant further argued that Rule 103(3)(c) EPC was not a catch-all clause but rather was only applicable after the 75% window had closed (and before the 25% window opened). For the above-mentioned reasons (point 13), this argument is not convincing.
16. *Appellant's request for a referral to the Enlarged Board of Appeal*

It is established case law that referring a question under Article 112(1)(a) EPC lies within the discretion of the boards of appeal (see e.g. T 1242/04, OJ EPO 2007, 421; T 365/05; T 1016/10). In decision T 390/90 (OJ EPO 1994, 808), the board stated that the boards of appeal have discretionary power to refer any question to the Enlarged Board of Appeal, either if a request for such reference has been made by a party, or if an important point of law arises and, in both cases, if the board considers that a decision by the Enlarged Board is required to ensure uniform application of the law or to decide upon the point of law that had arisen.

In G 3/98 (OJ EPO 2001, 62), the Enlarged Board stated that while the view of the referring board is decisive for assessing whether a referral is required, such assessment should be made on objective criteria and should be plausible (see also G 2/99, OJ EPO 2001, 83).

Since the question formulated by the appellant can be answered beyond doubt by the board itself by reference to the EPC (see points 3 to 15 above), there is no need to refer the matter to the Enlarged Board of Appeal in this case (see also Case Law of the Boards of Appeal, ninth edition, 2019, V.B.2.3.7). The appellant's request must therefore be refused.

17. *Conclusion*

In view of the above, the requirements of Rule 103(2) EPC are not met in the present case since the board has not issued a communication within the meaning of said provision before the withdrawal of the appeal in the case at hand. Therefore, the appellant's request for reimbursement of the appeal fee at 75% must be refused.

However, according to Rule 103(3)(c) EPC, the appeal fee is to be reimbursed at 50%.

Order

For these reasons it is decided that:

1. The request for referral to the Enlarged Board of Appeal is refused.
2. The request for reimbursement of the appeal fee at 75% is refused.
3. Reimbursement of the appeal fee at 50% is ordered.

The Registrar:

The Chairwoman:



K. Boelicke

B. Willems

Decision electronically authenticated