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Datasheet for the decision of 20 March 2020

Case Number: T 1000/19 - 3.3.03

Application Number: 11848633.1

Publication Number: 2651991

IPC: C08F20/06, C08L33/04, C08K3/34, D21H17/19, C08F220/06, C08F222/02, C08F222/04, C08F2/38

Language of the proceedings: EN

Title of invention:
STABLE POLYACRYLIC ACIDS, THEIR MANUFACTURE AND THEIR USE

Patent Proprietor:
BASF SE

Opponent:
NIPPON SHOKUBAI CO., LTD.

Relevant legal provisions:
EPC Art. 99(1)
EPC R. 139 sentence 1
RFees Art. 5(2), 7(2)
Arrangements for deposit accounts (ADA) 5.1.2, 5.4.1, 5.4.2

Keyword:
Correction of error - form for payment of opposition fee (yes)

Decisions cited:
G 0001/12, T 0152/82, T 0017/83, T 0152/85, T 0806/99, T 1265/10, T 0615/14, T 0198/16, T 0579/16, T 0317/19

Catchword:
An error in a duly filed form for paying the opposition fee may be corrected under Rule 139, first sentence, EPC (points 4.1 to 4.6 of the reasons).

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Case Number: T 1000/19 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 20 March 2020

Appellant: (Opponent)	NIPPON SHOKUBAI CO., LTD. 1-1, Koraibashi, 4-chome Chuo-ku, Osaka (JP)
Representative:	Cabinet Beau de Loménie 158, rue de l'Université 75340 Paris Cedex 07 (FR)
Respondent: (Patent Proprietor)	BASF SE Carl-Bosch-Str. 38 67056 Ludwigshafen (DE)
Representative:	BASF SE Global Intellectual Property GVX/A-C6 Carl-Bosch-Strasse 38 67056 Ludwigshafen (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 26 February 2019 holding that the opposition is deemed not to have been filed (Article 99(1) EPC), since the opposition fee was not validly paid within the time limit of nine months for opposition**

Composition of the Board:

Chairman	D. Semino
Members:	C. Brandt
	O. Dury

Summary of Facts and Submissions

I. The appeal lies against the decision of the Opposition Division holding that the opposition is deemed not to have been filed (Article 99(1) EPC), since the opposition fee was not validly paid within the time limit of nine months for opposition.

II. On 24 January 2018 Nippon Shokubai Co., Ltd. filed a notice of opposition against the grant of European patent EP 2651991. The notice of opposition was filed two days before expiry of the opposition time limit of nine months pursuant to Article 99(1) EPC.

EPO Form 2300E and the accompanying letter correctly identified the particulars of the opponent and of the opposed patent, the extent of the opposition and contained a statement of grounds indicating facts and evidence in support of these grounds in accordance with Rule 76(1) and (2) EPC. The notice of opposition also identified the representative of the opponent (Rule 76(2)d) EPC).

III. In the letter accompanying the notice of opposition it was indicated that: "we [the representative of the opponent, Cabinet Beau de Lomenie] have today authorized the Treasure and Account Department of the EPO to debit the due opposition fee of 785 € from our deposit account."

The electronic EPO Form 2300E, however, did not indicate any payment method in box X. "Payment". This Form rather displays in box X. the message "Not specified" for the method of payment.

IV. In the decision under appeal the Opposition Division held that according to the Arrangements for Deposit Accounts that entered into force on 1 December 2017 (ADA, published in supplementary publication 5 OJ EPO, September 2017), a debit order must be filed in an electronically processable format (XML). Debit orders submitted in any other way were invalid and were not carried out (cf. points 5.1.2 and 5.1.3 of the ADA). Thus, the mention of the payment in the letter comprising the grounds for opposition did not constitute a valid debit order and was not processed as such.

In addition the Opposition Division was of the opinion that Rule 139 EPC was not open in the present case, since the procedure of Rule 139 EPC was not time-barred and could therefore not be applied to the non-extendable time limit for filing a valid opposition.

The Opposition Division identified decisions T 1265/10 of 15 April 2011 and T 198/16 of 20 March 2018 as the most recent case law relevant to the (non-)payment of fees by debit order. T 198/16 considered "unacceptable" equalling the intention to pay to a payment contrary to T 1265/10, where the Board found that the established clear "intention to pay" an opposition fee must be treated by the EPO as an authorization to debit the deposit account of the opponent. In view of the relevant provisions of the ADA which entered into force on 1 December 2017, the Opposition Division agreed with the Board in T 198/16 and concluded that the mention of the authorization to debit a deposit account in the opponent's letter of 24 January 2018 was not foreseen in ADA as a valid method of payment.

The Opposition Division also held that the opponent could not successfully rely on the principle of legitimate expectations (good faith).

V. In its statement of grounds of appeal the opponent / appellant elaborated "on the difference between intention to pay, undertaking to pay and payment" and submitted arguments why the rationale of T 198/16 was not applicable to the present case.

The appellant further provided arguments why Rule 139 EPC applied in the case at issue.

VI. In a communication dated 13 September 2019 setting out the Board's provisional opinion on the case the Board considered that the opposition fee had to be regarded as having been validly paid and that the opposition was deemed to have been filed in accordance with Article 99(1) EPC. The Board also informed the parties that a final decision on the admissibility of the opposition would be issued after expiry of the 4 months time limit according to Article 12(1)(b) and (3) RPBA 2007, unless the parties requested or submitted otherwise.

No written response by the parties to the Board's communication nor any written submission of the respondent / patent proprietor on the merits of the present appeal case was received by the Board.

VII. The appellant requests the reversal of the decision of the Opposition Division and the recognition of the admissibility of the opposition filed on 24 January 2018 with transfer of the opposition fee of 785 € from CABINET BEAU DE LOMENIE deposit account n°28040005 to the EPO, the date of payment being deemed to be 24 January 2018.

Oral proceedings are requested in the event that the petition above should not be granted.

Reasons for the Decision

1. The appeal is admissible.

2. Since the appeal is also allowable the decision can be issued in the written proceedings without oral proceedings.

3. The present Board considers it as highly questionable whether the case law according to which under certain circumstances the "intention to pay" a fee by order to debit the amount from a deposit account with the EPO can still be regarded as a valid payment, even if the debit order is deficient, still applies under the version of the ADA in force since 1 December 2017 which is applicable to the case at issue. This case law is represented e.g. by T 1265/10, which is one of the most recent decisions and in particular discussed in the present appeal proceedings, as well as by T 152/82 of 5 September 1983 and T 806/99 of 24 October 2000.

3.1 In these decisions the "intention to pay" was accepted as valid payment of a fee under the proviso that the ADA in the version underlying the respective decision "do not preclude such a step", i.e., to carry out the debit order (T 152/82 point 4 of the reasons), "the debit order is not subject to any further formal requirement" (T 806/99 point 3.1 of the reasons), or "the ADA do not indicate what should happen in case one of the formal requirements are not complied with" (T 1265/10 point 8.1 of the reasons).

3.2 Contrary to the previous versions of the ADA underlying those cases the ADA in force since 1 December 2017 and applicable to the case at issue clearly and expressly define that the EPO will accept and process debit orders only if they are filed in an electronically processable format (point 5.1.2 ADA) using the electronic means listed therein. Furthermore, point 5.4.2 ADA explicitly provides: "If a debit order is submitted via a non-accepted means of filing or an invalid format, the date of receipt will not be regarded as the payment date."

3.3 Therefore, the ADA in force since 1 December 2017 have decisively changed the legal situation regarding the requirements for a valid payment by order to debit a fee from a deposit account at the EPO which entails that the "intention to pay"-case law developed under different previous versions of the ADA does no longer appear to be applicable. To this extent the Board cannot find fault with the Opposition Division's findings following decision T 198/16.

3.4 However, this legal question as well as the question whether the principle of legitimate expectations (good faith) applies do not need to be finally decided upon in the case at issue, since the Board considers not only that Rule 139 EPC (correction of errors in documents filed with the EPO) is principally applicable but also that its requirements are complied with.

4. Rule 139 EPC

Under Rule 139, first sentence, EPC linguistic errors of transcription and mistakes in any document filed with the EPC may be corrected on request.

Applicability of Rule 139 EPC

4.1 The Opposition Division's decision that Rule 139 EPC was not applicable in the present case, since the procedure of Rule 139 EPC was not time-barred and could therefore not be applied to the non-extendable time limit for filing a valid opposition is legally incorrect. The Enlarged Board of Appeal in decision G 1/12 (OJ EPO 2014, A 114) held that the general procedure for correcting errors under Rule 139, first sentence EPC was available in cases of an error in the appellant's name in a notice of appeal. Whether a notice of appeal in compliance with Rule 99(1)(a) EPC contains the name and address of the appellant is inextricably related to the question whether the appeal has been validly filed within the 2-months (non-extendable) time limit according to Article 108, first sentence EPC as one of the conditions for the admissibility of the appeal. There can be no doubt that the ratio of G 1/12 also applies if the admissibility of an opposition, or the question, whether an opposition is deemed to have been filed according to Article 99(1) EPC is concerned (T 615/14 of 27 October 2015, T 579/16 of 18 January 2017). Hence, Article 139, first sentence EPC is applicable in the case at issue.

4.2 Furthermore, the Board fails to discern why the lines of argument set out in G 1/12 regarding the applicability of Rule 139 EPC should not equally apply to a correction of an erroneously filled payment form (T 317/19 of 22 October 2019, point 2.3.3(c) of the reasons). Rather, the applicability of Rule 139, first sentence EPC (Rule 88, first sentence EPC 1973 respectively) to debit orders has been acknowledged or at least not ruled out by the Boards of Appeal, e.g.,

in T 152/82 (point 7. of the reasons: "The application of Rule 88 EPC, which is possible per se...") and in T 17/83 of 20 September 1983 (point 6. of the reasons: "it cannot be ruled out that Rule 88, first sentence EPC also applies to debit orders").

4.3 In case T 152/85 of 28 May 1986 the notice of opposition contained no reference to payment of the opposition fee and the fee was not paid in time. The Board held that the payment of an opposition fee was a factual requirement and thus the failure to pay the fee a factual mistake (point 2 of the reasons). It appeared to be clear from the wording of Rule 88 EPC that this rule only applied to mistakes made in a document but not to other kinds of mistakes (l.c.).

4.4 The present Board fully agrees with the findings in T 152/85, which however does not preclude the application of Rule 139, first sentence EPC in the case at issue. According to the clear wording of Rule 139, first sentence EPC and as pointed out in T 152/85 this provision requires that the mistake to be corrected was made in any document filed with the EPO. In contrast to T 152/85 where no document containing an error was filed, the opponent in the present case filed the electronic form EPO 2300E and hence a document in the sense of Rule 139, first sentence EPC (T 317/19, point 2.4.2.(c) of the reasons). Furthermore, the mistake was made in this document by not activating the payment method in box X. "Payment" of said EPO Form 2300E.

Requirements for corrections according to Rule 139, first sentence, EPC

4.5 In its decision G 1/12 (point 37. of the reasons) the Enlarged Board referred to the large body of case law

of the Boards of Appeal on corrections under Rule 139, first sentence EPC according to which the following principles were established:

4.5.1 The correction must introduce what was originally intended (l.c., point 37(a) of the reasons). In the absence of any contrary requirement in Rule 139 EPC, the Board is not prevented from using indications of the appellant's original intention outside the document to be corrected. This is fully in line with G 1/12, where it is stated in point 28 of the reasons: "in the event of a deficiency as to the appellant's identity the Board must establish the true intention of the appellant on the basis of the information in the appeal or otherwise on file".

The Board has no doubt and finds it as sufficiently proven (G 1/12, point 37(b) of the reasons) that from the passage "we [the representative of the Opponent, Cabinet Beau de Lomenie] have today authorized the Treasure and Account Department of the EPO to debit the due opposition fee of 785 € from our deposit account" in the letter accompanying the notice of opposition the clear intention of the opponent's representatives can be derived to pay the opposition fee by means of the attached EPO Form 2300E thereby taking into account the whole content of said opposition letter (see II. above).

4.5.2 The error to be remedied may be an incorrect statement or an omission (G 1/12, point 37(c) of the reasons). In the present case the mistake can be seen in an omission to activate the intended payment method in box X. of the electronic Form 2300E which by default displays the message "Not specified".

4.5.3 Finally, the request for correction must be filed without delay (G 1/12, point 37(d) of the reasons). The EPO informed the opponent/appellant with communication of 20 February 2018 (noting of loss of rights, Rule 112(1) EPC) that the opposition was deemed not to have been filed on the grounds that the opposition fee had not been paid. With letter dated 7 March 2018 the opponent requested an appealable decision on this matter and requested "that the EPO withdraw the corresponding sum from our deposit account" (page 16, second paragraph). This request, which is to be interpreted as a request for correction according to Rule 139, first sentence EPC, was hence filed about two weeks after the opponent was informed of the mistake. The request for correction is therefore considered to have been filed without delay. If, in addition, a corrected electronic debit order (new EPO Form 2300E) had been regarded as necessary by the EPO for formal purposes, the appellant should have been informed accordingly. However, it is not apparent from the file that such a demand or invitation has been sent by the EPO to the opponent/appellant.

4.6 Since an allowable correction has retroactive effect (G 1/12, point 37 of the reasons, last sentence) the opposition fee is found to have been validly paid within the period of nine months on 24 January 2018 when EPO Form 2300E and the accompanying letter were received by the EPO, and the opposition is deemed to have been filed pursuant to Article 99(1) EPC. The Board notes that on the basis of the file there is no reason to doubt that the professional representative's deposit account was sufficient on that date (Articles 5(2), 7(2) RFees in conjunction with point 5.4.1 of the ADA).

5. The board concludes that the requirements for the correction requested by the appellant are met, and thus that the correction of the error made in EPO Form 2300E regarding the payment of the opposition fee according to the ADA is to be allowed. Consequently, the correction under Rule 139 EPC having effect ex tunc, the opposition is retroactively deemed to have been filed.

Order

For these reasons it is decided that:

1. The request for correction under Rule 139, first sentence, EPC is allowed.

2. The opposition is deemed to have been filed.

The Registrar: The Chairman:

B. ter Heijden D. Semino

Decision electronically authenticated