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**Datasheet for the decision
of 18 February 2022**

Case Number: T 0637/21 - 3.3.09

Application Number: 16701911.6

Publication Number: 3245247

IPC: C08J9/00, C08J9/14, C08L25/04,
C08J9/16, C08K3/04, C08K3/36

Language of the proceedings: EN

Title of invention:

COMBINATION OF SILICA AND GRAPHITE AND ITS USE FOR DECREASING
THE THERMAL CONDUCTIVITY OF VINYL AROMATIC POLYMER FOAM

Patent Proprietor:

Synthos S.A.

Opponent:

Versalis S.p.A.

Headword:

Underpayment of appeal fee /SYNTHOS

Relevant legal provisions:

EPC Art. 108

RFees Art. 2(1) 11, Art. 8, Art. 12

Keyword:

Admissibility of appeal - appeal fee (not paid) - appeal
deemed not to have been filed

Decisions cited:

G 0001/18, T 0905/90, T 0642/12, T 3023/18

Catchword:



Beschwerdekammern

Boards of Appeal

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Case Number: T 0637/21 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 18 February 2022

Appellant: Versalis S.p.A.
(Opponent) Piazza Boldrini, 1
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Representative: Bottero, Carlo
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Respondent: Synthos S.A.
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Representative: Eisenführ Speiser
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 10 March 2021
rejecting the opposition filed against European
patent No. 3245247 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman A. Haderlein
Members: C. Meiners
D. Rogers

Summary of Facts and Submissions

- I. The opponent (hereafter "appellant"), appeals against the opposition division's decision to reject its opposition against the patent in suit.
- II. The Notice of Appeal was filed, and the reduced appeal fee was paid on 7 May 2021. Express reference was made in the appellant's "letter accompanying subsequently filed items" (EPO Form 1038) to the "appeal fee for an appeal filed by a natural person or an entity referred to in Rule 6(4) and (5) EPC". The last day upon which the Notice of Appeal could have been filed, and the appeal fee paid, was 20 May 2021.
- III. On 25 June 2021, the Board sent its first communication in this case to the parties. In this communication the Board pointed out that the appellant had paid the reduced fee for appeal, but had not filed the declaration necessary for this reduction. The Board invited the appellant to file such a declaration.
- IV. The appellant paid the full appeal fee on 20 July 2021.
- V. The appellant replied to this first communication in a letter dated 23 August 2021. The appellant confirmed that it was not entitled to a reduced fee. The appellant stated that the reduced fee was paid due to a clerical error by a paralegal and that the representative had not been able to check the debit order prior to filing, mainly due to difficulties caused by remote working following the COVID-19 pandemic. The appellant addressed what it perceived as shortcomings in decision T 3023/18 and the serious consequences of the Decision of the Administrative

Council of 13 December 2017 amending Articles 2 and 14 of RFees, which allowed the payment of a reduced appeal fee for an appeal filed by a natural person or an entity referred to in Rule 6(4) EPC" (hereafter the "AC Decision").

- VI. In its letter of 23 August 2021 the appellant argued that the missing part of the appeal fee should be considered a small amount, and that such an underpayment should be rectifiable. The appellant also argued that in order to apply the principles of good faith and the protection of legitimate expectations, Article 8 RFees should be interpreted in a more extensive fashion than in decision T 3023/18 in order to allow the remedy of the error in the appeal fee payment. The appellant further suggested that Article 8 RFees should be amended to prevent the unfair consequences deriving from the implementation of the AC Decision.
- VII. The appellant pointed out that if the decision T 3023/18 was followed, then there was no remedy available to correct an error in the payment of the appeal fee. In addition, the appellant argued that it was improper that a failure to comply with the 4 month time limit under Article 108 EPC could be remedied under Article 122(1) EPC, whereas an error to comply with the 2 month time limit for paying the appeal fee could not. The appellant criticised this as no harm was caused to the patent proprietor who was aware that the opponent was appealing, and allowing a remedy for correcting a failure to comply with the 2 month time limit for paying the appeal fee would produce no more uncertainty for the patent proprietor than the allowed correction of failures to comply with the 4 month time limit.

VIII. The Board sent a communication to the parties summoning them to oral proceedings and indicating that the sole issue to be discussed and decided upon at the oral proceedings would be the deemed non-filing of the opponent-appellant's appeal.

IX. In a letter dated 11 January 2022 the appellant withdrew its request for oral proceedings.

Reasons for the Decision

Is the underpayment a small amount?

1. Under Article 8, fourth sentence, RFees, the EPO may overlook an insufficient amount paid without prejudice to the rights of the person making the payment, if the following two requirements are met:

The amount lacking must be "small"; and the legal consequence of overlooking the amount lacking must be "considered justified".

The Board notes that "small" in the first requirement needs to be interpreted.

2. The boards have held in decisions T 905/90, OJ EPO 1994, 306, point 10, and T 642/12, point 20, that "small amounts" is rather to be read as "very small", "slight", "trifling", "insignificant", or "negligible" underpayments, e.g. differences caused by unexpected bank transfer costs, currency exchange rates and the like. Consequently a shortfall of 20% was not regarded as "small" within the meaning of the above Article. It

follows that a literal interpretation of the wording does not lead to an unambiguous result.

3. A teleological interpretation of Article 8, fourth sentence, RFees, sheds light on the correct understanding of this article. In this context, it must be borne in mind that Article 8, fourth sentence, RFees, does not provide for the small amount lacking to be paid at a later date. In other words "overlooking" within the meaning of the said provision entails that the EPO accepts the payment of an insufficient amount without the user being obliged to make good the shortfall. This procedure clearly aims at avoiding unnecessary bureaucracy and serves the purpose of procedural economy. It is only compatible with this aim if "small amounts" under Article 8, fourth sentence, RFees, are regarded as "insignificant", i.e. amounts not exceeding a few euros.
4. This result is confirmed by the travaux préparatoires where it is stated with regard to Article 9(1) RFees 1973 (the predecessor to Article 8 RFees) that "[f]or reasons of economy, however, the European Patent Office may, in the payer's favour, disregard minor amounts owing." (see document BR 93 e/71, point II.6. "Miscellaneous Provisions", p. 6).
5. This result is further corroborated by Article 12, first sentence, RFees, which is the complementary provision in the case of a fee overpayment. According to this provision, the excess is not refunded if the amount is "insignificant". At present, the President of the EPO has fixed the insignificant amount referred to in Article 12 RFees at EUR 16 (see Article 12, second sentence, RFees in conjunction with Article 1 of the decision of the President of the EPO dated 14 February

2020 implementing Article 12 RFees, OJ EPO 2020, A17). The procedure laid down in Article 12, first sentence, RFees, is analogous to the procedure set out in Article 8, fourth sentence, RFees, as it also aims at avoiding unnecessary bureaucracy and serving the purpose of procedural economy. This is confirmed by the travaux préparatoires where the following is stated with regard to Article 10c RFees 1973 (the predecessor to Article 12 RFees): "To avoid unnecessary work for both the EPO and the parties to the proceedings it is considered sensible not to refund insignificant amounts and to give this a legal basis in the Rules relating to Fees." (see document CA/52/90, p. 72).

6. Consequently, the Board does not consider the amount lacking in the present case to be "small" within the meaning of Article 8, fourth sentence, RFees.
7. In addition to the above considerations, the Board also notes that with Article 2(1), item 11 of the Rules relating to Fees, the legislator introduced a reduced fee for certain categories of appellant. It seems reasonable to assume that the legislator saw this reduction as being of genuine financial assistance to the listed categories of persons, and not as a merely symbolic reduction. Thus the Board does not consider, for this reason as well, the shortfall to be "small".
8. Given the above finding, there is no necessity for the Board to examine the further requirement under Article 8, fourth sentence, RFees, that overlooking the amount lacking must be considered justified.
9. In the above, the Board has followed decision T 3023/18.

10. As regards the appellant's suggestion that T 3023/18 should not be followed, the appellant has argued that this decision "...flies in the face of the principle of good faith and the protection of legitimate expectations of user of the EPO system". The protection of the legitimate expectations of users of the European patent system has two main principles: It requires that the user must not suffer a disadvantage as a result of having relied on erroneous information or a misleading communication received from the EPO; and it also requires the EPO to warn the applicant of any loss of right if such a warning can be expected in good faith. This presupposes that the deficiency can be readily identified by the EPO (see CLBA, III.A.3). In this case the appellant has not relied on any erroneous information from the EPO and the deficiency was not readily identifiable by the EPO. The Board thus does not find any basis for not following decision T 3023/18.

11. To conclude, the Board considers that the appeal is to be deemed not filed.

Reimbursement of appeal fee

12. Following the opinion of the Enlarged Board of Appeal in G 1/18, Headnote 1 a), an appeal is deemed not to have been filed when:

The Notice of Appeal is filed on time; and
the appeal fee is paid after the expiry of the two month time limit of Article 108 EPC, first sentence.

13. Consequently both of the appeal fees (the reduced one paid on 7 May 2021 and the full one paid on 20 July

2021) are to be reimbursed. This is ordered ex officio (see G 1/18, Headnote 2).

Order

For these reasons it is decided that:

1. The appeal is deemed not to have been filed.
2. The appeal fees are reimbursed.

The Registrar:

The Chairman:



A. Nielsen-Hannerup

A. Haderlein

Decision electronically authenticated