

Europäisches
Patentamt

European Patent
Office

Office européen
des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number : T 522/88 - 3.3.1



D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 19 December 1989

Appellant : Shell Internationale Research Maatschappij B.V.
(Proprietor of the patent) Garel von Bylandtlaan 30
NL-2596 HR The Hague

Representative : Aalbers, Onno
P.O. Box 302
NL-2501 CH The Hague

Respondent : "Dumag" OHG., Dr. techn.
(Opponent) Ludwig Kaluza & Co.
Schwarzenbergplatz 7
A-1030 Wien

Representative : Atzwanger, Richard Dipl.Ing.
Patentanwälte Dipl.-Ing. Anton Atzwanger,
Dipl.-Ing. Richard Atzwanger
Mariahilfer Strasse 1c
A-1060 Wien

Composition of the Board :

Chairman : K. Jahn
Members : F. Antony
G. Paterson

Veröffentlichung im Amtsblatt	Ja/Nein
Publication in the Official Journal	Yes/No
Publication au Journal Officiel	Oui/Non

Aktenzeichen / Case Number / N^o du recours : T 522/88 - 3.3.1

Anmeldenummer / Filing No / N^o de la demande : 80 200 355.8

Veröffentlichungs-Nr. / Publication No / N^o de la publication : 0 021 461

Bezeichnung der Erfindung:

Title of invention: Process and burner for the gasification of solid fuel

Titre de l'invention :

Klassifikation / Classification / Classement : C10 J 3/46

ENTSCHEIDUNG / DECISION

vom / of / du 19 December 1989

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Shell Internationale Research Maatschappij
B.V.

Einsprechender / Opponent / Opposant :

"Dumag" OHG., Dr. techn. Ludwig Kaluza &
Co.

Stichwort / Headword / Référence :

EPÜ / EPC / CBE Articles 102, 106, 108, 111(1), 122, Rule 58(5)

Schlagwort / Keyword / Mot clé :

"Patent maintained in amended form" -
"translation not duly filed - patent
automatically revoked - non-existent appeal -
application for re-establishment admissible -
remitted to first instance - appeal fee
refunded".

Leitsatz / Headnote / Sommaire

Summary of Facts and Submissions

I. A notice of opposition to European patent No. 21 461 was filed on 12 May 1984. In due course the Opposition Division issued an Interlocutory Decision within Article 106(3) EPC on 16 July 1986, by which the patent was maintained in amended form. Following an appeal by the Opponent, the Board of Appeal issued a Decision on 14 December 1987, by which the patent was maintained on the basis of amended claims and a description to be adapted. On 4 May 1988 a communication under Rule 58(5) EPC was issued, in which the patent proprietor was requested to pay the printing fee and to file a translation of the claims within three months. By letter dated 20 June 1988 filed on 21 June 1988 the Patentee paid the printing fee.

However, by 14 August 1988 a translation of the amended claims had not been filed. On 30 September 1988 the Formalities Officer of the Opposition Division issued a document headed "Revocation of the European patent pursuant to Article 102(5) EPC", which stated that "the European patent is revoked." "Grounds for the decision" were set out, stating that "The translation of amended claims was not filed", and that "The European patent therefore has to be revoked."

This document also went on to state that "This decision is open to appeal (Article 106(1) EPC)", and gave details as to how to appeal, in accordance with Rule 68(2) EPC to which reference was made.

II. By letter dated 10 October 1988, filed on 11 October 1988, the Patentee filed a notice of appeal and a statement of grounds of appeal and paid the appeal fee. As grounds for the appeal, it was stated essentially as follows:

(a) Following issue of the Rule 58(5) communication dated 4 May 1988, the Patentee had every intention (and still had) to maintain the patent as amended. Details of the measures taken to that effect were set out, namely:

- (i) the printing fee was duly paid;
- (ii) instructions for the obtaining of translations were sent out.

Evidence in support was also filed.

(b) Due to an oversight, the administrative staff concerned omitted to file the translations. It was not until the issue of the document dated 30 September 1988 that it was learnt that the translations had not been filed.

(c) On the above facts the grant of a further term for filing the translations was requested.

III. In a communication dated 1 June 1989, on behalf of the Board of Appeal, provisional views on the procedural aspects of the case were expressed. It was pointed out that Article 102(5) EPC provides that if the translations are not filed in due time, revocation is mandatory, and that there is no provision for extending the three-month period provided in Rule 58(5) EPC, either by way of appeal or otherwise.

It was suggested that Article 102(5) EPC should be interpreted as providing that upon expiry of the three-month time limit the patent immediately becomes revoked automatically, and that accordingly no decision within Article 106(1) EPC is required in order that revocation

shall occur. On such an interpretation, the loss of rights resulting from such automatic revocation could in principle be re-established under Article 122 EPC if the relevant conditions were met. It was suggested that the Patentee should therefore consider formally filing an application under Article 122 EPC (the Board being neutral as to the outcome of any such application).

- IV. In reply to this Communication, the Patentee, by letter dated 12 June 1989 and filed on 15 June 1989, formally applied for re-establishment under Article 122 EPC and paid the required fee. The grounds for re-establishment were the same as the grounds of appeal.

No other observations were filed by the Patentee, or by the Opponent, in response to the communication dated 1 June 1989 within the stated time limit.

- V. In a further communication on behalf of the Board dated 14 September 1989, provisional views were expressed to the effect that on the basis of Decisions T 26/88 dated 7 July 1989 and J 3/87 (OJ EPO 1989, 3), the application for re-establishment could be held admissible, and remitted to the Formalities Officer of the Opposition Division for examination and decision thereon. In reply, the Patentee noted the Board's provisional views and made no further comments. The Opponent did not respond to the communication within the stated time limit.

Reasons for the Decision

1. For the reasons set out in Decision T 26/88 ("AKZO") dated 7 July 1989 (to be published), in the Board's judgment, according to the proper interpretation of Article 102(5) EPC, a patent becomes immediately and automatically revoked

- upon expiry of the relevant three-month time limit under Rule 58(5) EPC, if the required translation is not filed within such time limit. Such immediate automatic revocation upon expiry of the relevant time limit is mandatory under Article 102(5) EPC. No decision of revocation is therefore necessary in order that revocation should occur, nor is such a decision of revocation appropriate, since there is nothing to be decided.
2. In the present case, it is accepted by the Patentee that no translation was filed before expiry of the relevant time limit on 14 August 1988. Thus the patent was automatically revoked on 15 August 1988. In view of the mandatory nature of such revocation as stated above, there is nothing left to be decided, either by the Opposition Division or by way of appeal. In particular, there is no possibility under the EPC of extending the time limit under Rule 58(5) EPC (except under Rule 85 EPC which is not applicable in the present case).
 3. Accordingly, for the reasons set out in Decision T 26/88, in the Board's view the document which was issued by the Formalities Officer of the Opposition Division on 30 September 1988 should be interpreted as a notification under Rule 69(1) EPC of the revocation of the patent which had already occurred on 15 August 1988. On this basis, there has been no decision within Article 106(1) EPC, and the appeal should therefore be regarded as not having existed. The appeal fee should therefore be refunded.
 4. The Board notes that the grounds of appeal, being in reality grounds which are appropriate for an application for re-establishment under Article 122 EPC, are effectively confirming that the patent should be revoked under Article 102(5) EPC. In all normal cases, the filing of an application for re-establishment of rights is equivalent to

an acceptance that the relevant time limit has not been observed, with consequent loss of rights as a direct consequence by virtue of the Convention. Rights cannot be re-established unless they have previously been lost.

As pointed out in Decision T 26/88, the essential feature of an appeal is to consider whether a decision at first instance is correct on its merits. Grounds of appeal are, as a matter of principle, the antithesis of grounds for re-establishment, since the former should be setting out a case why the appellant should not have lost rights or otherwise been "adversely affected", and the latter should be setting out a case why in the particular circumstances rights which have been lost should be re-established.

Thus, the grounds of appeal in the present case would in any event be inadmissible as such.

5. For the above reasons, grounds of appeal should not be confused with grounds for re-establishment. An appeal is quite different from an application for re-establishment. The procedure is different (Article 108 EPC, cf. Article 122(2) and (3) EPC). The fee is different. The object is different. The grounds should be different. In all normal cases an appeal under Article 106 EPC cannot be considered as equivalent to an application for re-establishment under Article 122 EPC.
6. Nevertheless, in the Board's view the present case is not a normal case. As discussed in paragraphs 1 to 3 above, the Formalities Officer of the Opposition Division issued a document which appeared to be a decision in circumstances when loss of rights (revocation) was the direct, automatic and mandatory consequence of non-observance of the relevant time limit by virtue of the Convention. In the Board's view, the issuing of such a document with its accompanying

communication stating that the decision was open to appeal was inevitably a direct cause of confusion to the Patentee as to the procedure which should be followed if he wished to contend that the conditions for re-establishment set out in Article 122(1) EPC were satisfied. In this circumstance it is understandable that the Patentee did not formally file an application under Article 122 EPC at that time. In the event, the Patentee filed an appeal (this having been indicated in the Formality Officer's communication as a possible course for the Patentee to take), and did not file an application under Article 122 EPC until this was suggested to him in the communication on behalf of the Board of Appeal which was issued on 1 June 1989.

On its face, therefore, the application for re-establishment was not filed "within two months from the removal of the cause of non-compliance with the time limit" under Rule 58(5) EPC, since the Patentee admits that he knew that the time limit had not been complied with upon receipt of the document issued on 30 September 1988.

Nevertheless, in the Board's view, in the exceptional circumstances of this case, the letter from the Patentee dated 10 October 1988 (filed 11 October 1988), which set out the notice and grounds of appeal (these being exactly the same as the grounds for re-establishment, which were formally filed on 15 June 1989), should be considered as constituting an application for re-establishment under Article 122 EPC. Furthermore, the fee for the application for re-establishment (being less than the fee for appeal) should be considered as having been paid on 11 October 1988, when the appeal fee was paid. Consequently, the application for re-establishment should be treated as if it had been filed within two months from the removal of the cause of non-compliance with the time limit. This course is consistent with the application of

the principles of good faith between the EPO and parties before it, as discussed in particular in Decision J 3/87 (Membranes/Memtee) (OJ EPO 1989, 3) in its Reasons, paragraph 7.

The application for re-establishment being therefore admissible (the Board having exercised its powers under Article 111(1) EPC to decide upon such admissibility), this application under Article 122 EPC should be decided by "the department competent to decide on the omitted act" (Article 122(4) EPC), namely the Formalities Officer of the Opposition Division. This is also in accordance with the principle of two instances of decision discussed in Decision T 26/88.

7. The Board is aware of Decision T 14/89 dated 12 June 1989 (to be published), in which in similar circumstances the Board of Appeal in that case also held that an application for re-establishment, which was filed at the suggestion of the Board of Appeal, was admissible on the basis of the principles of good faith referred to above, but on the basis of different reasoning: the Board of Appeal in that case also went on to decide the application for re-establishment.

Having regard to Decision T 26/88, especially paragraphs 7.4 and 13 thereof, and the reasoning set out above, the present Board makes the following decision.

Order

For these reasons, it is decided that:

1. The appeal fee shall be refunded.

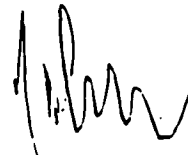
2. The application for re-establishment filed on 12 June 1989 shall be treated as having been filed on 11 October 1988 and is therefore admissible, and is remitted to the Formalities Officer of the Opposition Division for examination and decision.

The Registrar:



S. Fabiani

The Chairman:



K. Jahn