

Publication in the Official Journal Yes / ~~No~~

File Number: T 485/89 - 3.2.2

Application No.: 83 300 268.6

Publication No.: 0 086 567

Title of invention: Pipe replacement

Classification: E03F 3/06

D E C I S I O N  
of 14 August 1991

Proprietor of the patent: WATER RESEARCH CENTRE

Opponent: Tracto-Technik - Paul Schmidt-  
Maschinenfabrik GmbH

Headword: Telecopy filings/Tracto-Technik

EPC Art. 99(1) EPC

Keyword: "Time limit for opposition" - "Admissibility of notice of  
opposition deliberately filed by telecopy at the German Patent  
Office, Munich" - "Applicability of Administrative Agreement  
of 29 June 1981"

Headnote

Headnote follows



Case Number : T 485/89 - 3.2.2

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.2  
of 14 August 1991

**Appellant :**  
(Opponent)  
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**Decision under appeal :**  
Decision of the Opposition Division of the  
European Patent Office dated 5 May 1989 rejecting  
the opposition filed against European patent  
No. 0 086 567 pursuant to Rule 56 EPC.

**Composition of the Board :**

**Chairman :** G. Szabo  
**Members :** C. Holtz  
P. Dropmann

## Summary of Facts and Submissions

- I. On 3 June 1987, the Appellant/Opponent lodged a Notice of Opposition against the grant of European patent 0 086 567, which had been published on 3 September 1986. The Notice of Opposition was submitted by telecopy at the German Patent Office in Munich. The notice was forwarded to the European Patent Office on the next day, 4 June 1987. The opposition fee was paid on 1 June 1987. The first pages of the telecopy contained references to the European patent and the addressee was given as the European Patent Office ("An das Europäische Patentamt") with the correct address.
  
- II. In a decision issued on 5 May 1989 the Opposition Division of the European Patent Office dismissed the Notice of Opposition as inadmissible because it had been submitted to the EPO after expiry of the nine month opposition period. The Appellant filed an appeal against this decision and paid the appeal fee on 21 June 1989. A Statement of Grounds for the appeal was filed on 5. September 1989.
  
- III. The Appellant referred in his arguments to the Administrative Agreement concerning procedure on receipt of documents and payments, concluded on 29 June 1981 between the Presidents of the European Patent Office and the German Patent Office, respectively ("Administrative Agreement", OJ EPO 1981, 381). It was submitted that the applicability of the 1981 Agreement should not be excluded in cases where the delivery to the incorrect address was not made by mistake. Furthermore, the principle of good faith required that the deliberate sending of the Notice of Opposition to the German Patent Office was accepted.

- IV. On 16 November 1990, the Enlarged Board of Appeal of the European Patent Office issued a decision in three cases (G 5/88, G 7/88 and G 8/88), which all concerned issues related to the validity and interpretation of the Administrative Agreement (OJ EPO 1991, 137). On 26 March 1991, the Board of Appeal for the present case issued a Communication to the parties referring to the Enlarged Board decision, indicating its intention to apply certain principles thereof to the present case, inviting the parties to comment. No comments have been submitted, however.
- V. The Appellant has requested that the decision of the Opposition Division be set aside and the opposition declared admissible. The Respondent/Proprietor has declared that he fully agrees with the decision under appeal, thereby implying a request for dismissal of the appeal.

#### Reasons for the Decision

1. The appeal is admissible.
2. The Administrative Agreement clearly relates to any document intended for the EPO and received by the German Patent Office in Munich or Berlin. These should according to its provisions be forwarded directly to the nearest European patent Office, whereby certain formal requirements, such as recording the date of receipt and making sure that the document was not delivered by hand, must be complied with (cf. Art. 1(1), (2) and (4) of the Agreement).
3. In its decision the Enlarged Board held that the President of the EPO did not have the power to enter into the Administrative Agreement of 1981, to the extent that this

Agreement contained terms regulating the treatment of documents intended for the EPO and received by the German Patent Office in Berlin. As regards Munich, the decision stated that in the given case "So far as the Agreement is concerned with the problem of incorrect delivery of documents at Munich (at the EPO and the German Patent Office premises there), in the view of the Enlarged Board it could reasonably be concluded that the making of the Agreement with the German Patent Office was a necessary step for the President to take in order to avoid unjustified loss of rights to parties, and thus to ensure the proper functioning of the EPO" (point 2.6 and Art. 10(2)(a) EPC). The Enlarged Board further held that it was clear from its text that the object and purpose underlying the Agreement was to provide a solution to the problem of delivery of documents to the wrong office by error (point 2.9).

4. There is no reason to doubt the validity of the Agreement to deliveries in Munich, provided the required formalities and conditions are satisfied. The reasons in the decision concerning the special circumstances of Berlin are not relevant to Munich. The Board thus assumes that the President of the EPO had the power to conclude a valid agreement on the matter in respect of office premises in Munich.
5. Although the Enlarged Board presumed that the Agreement would cover erroneous deliveries, the Agreement itself does not expressly exclude documents which had been delivered on purpose to an office other than that of the addressee, which concurs with the Enlarged Board opinion with regard to deliberate filing in Berlin, see point 3.4. The express inclusion of telecopies under the Agreement, which had been published in the Official Journal of the EPO, supports this finding. Firstly, the use of telecopy

as a means for communication would rather presume a deliberate choice of place of delivery, given the fact that the sender controls the delivery means himself by way of the telecopy number of the intended receiver. Secondly, and perhaps more important, the inclusion of telecopy deliveries would naturally encourage parties in the given circumstances to file with the German patent Office, as long as this technical means of delivery was not yet offered at the European Patent Office.

The principle of good faith acts to the benefit also of those who accordingly made use of the possibility to file by telecopy at the German Office, even if this particular situation had not been expressly foreseen by the Agreement.

In this context it is finally to be noted that the Agreement does in no way extend the time limit for opposition of nine months.

Any opponent must file his Notice of Opposition on the last day of this period at the latest, irrespective of which of the two available alternatives he chooses.

6. In view of the above, the Board has arrived at the opinion that oppositions filed within the prescribed time by telecopy at the German Patent Office in Munich while intended for the EPO are validly covered by the Administrative Agreement of 29 June 1981 concerning procedure on receipt of documents and payments and should be treated by the European Patent Office as if it had received them directly, irrespective of whether these were erroneously delivered or not.

The present Notice of Opposition also satisfies the further conditions under the Administrative Agreement, since the date accorded by the German Patent Office on this Notice is 3 June 1987, which was the last day for opposition, and the Notice was not delivered by hand. The Notice was therefore validly submitted.

7. There having been no examination in substance of the opposition by the department of first instance, the Board makes use of its power under Article 111(1) EPC to remit the case back to that instance.

**Order**

**For these reasons, it is decided that:**

1. The decision under appeal is set aside.
2. The Notice of Opposition regarding European patent 0 086 567 filed by the Appellant on 3 June 1987 with the German Patent Office in Munich is declared admissible.
3. The case is remitted to the Opposition Division for further prosecution.

The Registrar:

The Chairman:



S. Fabiani



G. Szabo

