

Decision of Technical Board of Appeal 3.5.1

dated 20 October 1997

T 460/95 - 3.5.1

(Translation)

Composition of the board:

Chairman: P.K.J. van den Berg

Members: R.R.K. Zimmermann

G. Davies

Patent proprietor/Appellant: SOMAB S.A.

Opponent/Respondent I: GILDEMEISTER Aktiengesellschaft

Opponent/Respondent II: Dr JOHANNES HEIDENHEIN GmbH

Opponent/Respondent III: Fanuc Ltd

Headword: Notice of appeal/SOMAB

Article: 108, 110(1), 122 EPC

Rule: 64(b), 65 EPC

**Keyword: "Filing of an appeal - appeal filed (yes)" - "Notice of appeal -
admissible (no)" - "Res judicata"**

Headnote

A notice of appeal within the meaning of Rule 64 of the Implementing Regulations to the EPC is inadmissible if it does not contain an explicit and unequivocal statement expressing the definite intention to contest an appealable decision.

Summary of facts and submissions

I. European patent No. 0 299 046 (application No. 88 901 423.9) was granted on behalf of the appellant on 8 July 1992 (Bulletin 92/28) on the basis of international application PCT/FR 88/00048 (publication No. WO 88/05936). Respondents I to III filed notice of opposition against the patent in its entirety, relying on the grounds of Article 100(a) EPC. In a decision of the opposition division, posted on 30 March 1995, the patent was revoked.

II. On 30 May 1995, a sum of FRF 7 270 was credited to an EPO bank account, with reference being made to the application number.

III. On 2 June 1995 the Office received a communication from the professional representative acting for the appellant consisting of a letter dated 30 May 1995, a form for the payment of fees and costs (EPO Form 1010) and a receipt for the payment of the fee. The letter, which was addressed to the EPO's Treasury and Accounts Directorate, cites as references the number of the European patent application, the number of the patent, the name of the proprietor, the title of the invention and a reference number. The letter reads as follows:

"Please find enclosed the following documents relating to the aforementioned patent application:

- a form for the payment of the appeal fee relating to the aforementioned application;
- a receipt for the payment of the fee.

(Subscription form)

NB Please return the enclosed copy of this letter as acknowledgment of receipt

(an addressed envelope is enclosed)."

The form for the payment of fees and costs contained the name and address of the professional representative, the application number, the designation 011 Fee for appeal, the amount paid and details of the method of payment. The documents were dated and signed.

The Office informed the parties concerned that an appeal had been filed. On 26 July 1995 the appellant, referring to the "appeal we filed with our letter of 30 May 1995", requested a two-month period of grace within which to file a statement setting out the grounds of appeal.

Subsequently, on 23 August 1995, the Office informed the appellant that it had failed to observe the time limit for filing the statement of grounds and pointed out that the appeal would probably be rejected as inadmissible. On 23 September 1995 the appellant filed the statement of grounds and submitted a request to have its rights re-established (Article 122 EPC). In doing so, the appellant pointed out that following a telephone conversation with the registrar of the boards of appeal, it had understood that the time limit for filing the statement of grounds would be extended on request. On 5 October 1995 the Office informed the respondents that a request for re-establishment of rights had been filed. In interlocutory decision T 460/95 of 16 July 1996 (not published in the OJ EPO), the present board allowed the request for re-establishment of rights. The order contained in the decision reads as follows:

1. The rights of the appellant are re-established.
2. The statement of grounds is considered filed in due time.

IV. Subsequently, respondents II and III raised objections to the interlocutory decision relating to the request for re-establishment of rights, stating that the decision was not justified. Moreover, they alleged that the notice of appeal did not

comply with the formal requirements of the European Patent Convention and stated that the present appeal was therefore inadmissible.

In a communication issued in accordance with Article 11(2) of the Rules of procedure of the boards of appeal, the board stated that since the interlocutory decision had the force of *res judicata* it could override all the requirements concerning the admissibility of the appeal. Thus, the board would be prevented from re-examining any matter concerning the admissibility of the appeal.

V. During the oral proceedings, held on 20 October 1997, respondents II and III requested that the appeal be rejected as inadmissible. In particular, respondent II argued that the notice of appeal was inadmissible because it did not comply with the formal conditions of Rule 64(b) EPC. In support of its argument, the respondent referred to several decisions of the boards of appeal, in particular J 16/94 (OJ EPO 1997, 331), J 19/90 (of 30 April 1992, not published in the OJ EPO), T 371/92 (OJ EPO 1995, 324), T 167/93 (OJ EPO 1997, 229), T 843/91 (OJ EPO 1994, 832). Regarding the extent to which the interlocutory decision could be considered *res judicata*, the respondent maintained that the interlocutory decision only related to the time limit set out in Article 108, third sentence, EPC, and that the decision therefore did not prevent the board from examining whether the notice of appeal complied with the requirements of Rule 64(b) EPC. Moreover, the objections previously raised by respondents II and III to the interlocutory decision were no longer maintained.

VI. The respondent pointed out that, in its letter of 30 May 1995, it had expressed a definite intention to file an appeal against the decision of the opposition division. It argued that in view of the steps it had taken, its intention could not be in doubt: when it had paid the appeal fee it had clearly indicated the aim of the payment, mentioning the patent number and stating that the purpose of the payment was the appeal fee. As the contested decision simply related to the revocation of the patent,

it was clear that the decision should be set aside in its entirety. Thus all the formal conditions for filing a notice of appeal had been fulfilled, if not explicitly at least in a conclusive manner.

VII. The following requests were filed during the oral proceedings:

The appellant (patent proprietor) requested that the contested decision be set aside and that the patent be maintained as granted.

The respondents (opponents) requested that the appeal be rejected as inadmissible in accordance with Rule 65 EPC. In an auxiliary request, the respondents asked that the following questions be referred to the Enlarged Board of Appeal:

(a) Does a letter accompanying a form for the payment of fees and a receipt for the payment of the appeal fee constitute a valid notice of appeal within the meaning of Article 108 and Rule 64 EPC?

(b) After the patent proprietor has had his rights re-established with regard to the time limit for filing the statement of grounds for appeal, can a board of appeal verify whether the appeal period has been observed irrespective of the grant of re-establishment of rights, or is the question of the observance of the appeal period automatically regarded as *res judicata* and considered to be resolved because of the grant of re-establishment of rights with regard to the time limit for filing the statement of grounds for appeal, irrespective of the facts of the case?

(c) Is it consistent with the generally accepted principle of the protection of legitimate expectations that re-establishment of rights be granted, after the loss of rights, on the basis of this principle, where the loss of rights is due to a misinterpretation - caused by linguistic problems encountered by a professional representative - of a

precise piece of information provided over the telephone by the Office in respect of the extension of the time limit for filing a statement of grounds?

Reasons for the decision

1. The substantive examination of the appeal is only possible in so far as the appeal is admissible (Article 110(1) EPC). The question whether the appeal complies with the requirements of Article 108, first sentence, EPC and Rule 64(b) EPC has in fact been cast in doubt by respondents II and III. However, in the present case, the board has already taken interlocutory decision T 460/95 of 16 July 1996 (not published in the OJ EPO). The question therefore arises as to whether the admissibility of the appeal has still to be determined.

2. Res judicata

In fact, in accordance with the case law of the boards of appeal (see T 79/89, OJ EPO 1992, 283; T 843/91, OJ EPO 1994, 832; T 167/93, OJ EPO 1997, 229; J 3/95, OJ EPO 1996, 169), the principle of res judicata is considered applicable within the scope of the Convention and essentially covers the order and the reasons for the decision.

In keeping with the principle of removing a case from a judge (J 3/95), which is also applicable to the judicial procedures of the EPO, and in accordance with the provisions of the Convention relating to means of redress, the decisions of the boards of appeal are final, except for the possibility offered by Rule 89 EPC which provides for the correction of errors in decisions - but only linguistic errors, errors of transcription and obvious mistakes.

However, as a result of the interlocutory decision of the present board, the appellant was granted re-establishment of rights (Article 122 EPC) with regard to the time limit

defined in Article 108, third sentence, EPC for filing the statement of grounds, with the legal consequence that the appeal was deemed to have been filed in due time. Hence, this deemed filing of the statement of grounds in due time became final.

Nevertheless, the question whether the notice of appeal complies with the requirements of Rule 64(b) was not addressed in the statement of grounds nor in the order part of the interlocutory decision. At this stage, the admissibility of the notice of appeal had not been cast in doubt. The board had not deemed it to be manifestly inadmissible but had not come to a decision on its admissibility. For this reason, the force of *res judicata* which applies to the interlocutory decision does not relate to the admissibility of the notice of appeal itself. Thus, the board has the authority and indeed the duty to examine the formal admissibility of the notice of appeal.

3. Conditions which must be fulfilled if an appeal is to be deemed to have been filed

Article 108 EPC stipulates the time limit within which notice of appeal must be filed and the form in which it must be filed. It must be filed in writing within two months of the date of notification of the decision appealed from; it is not deemed to have been filed until after the fee for appeal has been filed. Within four months of the date of notification of the decision, a written statement setting out the grounds of appeal must be filed. Moreover, Rule 64 EPC provides that the written notice of appeal, as referred to in Article 108, must include:

(a) the name and address of the appellant, and

(b) a statement identifying the decision which is impugned and the extent to which amendment or cancellation of the decision is requested.

4. Existence of an appeal in this particular case

The contested decision was posted on 30 March 1995 and was notified to the appellant by registered letter in accordance with Rule 78(1) EPC. Hence, taking into account Rules 78(3) and 85(1) EPC, the time limit of two months stipulated in Article 108, first and second sentences, EPC expired on 9 June 1995. In view of this date, the appeal fee was paid in due time. The Office also received the letter addressed to the Treasury and Accounts Directorate of the EPO within this period. It emerges from the subsequent correspondence and the statements made during the oral proceedings that the appellant considered this letter to be the actual notice of appeal.

However, the content of the aforementioned letter relates only to the payment of the appeal fee and the letter gives the impression of being merely an accompanying letter. Apart from mentioning the "appeal fee relating to the aforementioned application", the letter does not contain any request identifying the contested decision and indicating the extent to which the amendment or cancellation of the decision is requested (see Rule 64(b) EPC). Nor does it explicitly indicate any firm intention to contest a given decision. Two questions must therefore be asked: has an appeal been filed in the present case and, if so, does the notice of appeal comply with the requirements of Rule 64 EPC?

The Convention does not expressly define the essential elements characterising an appeal which has been validly filed. It merely states that the appeal must be filed in writing and is not deemed to have been filed until after the fee for appeal has been paid (Article 108, second sentence, EPC). Furthermore, Rule 65 EPC indicates that all the requirements of Articles 106 to 108 and Rules 1(1) and 64 EPC must be fulfilled if the appeal is to be deemed admissible. Thus, these articles and rules assume the prior existence of an appeal. As a result, if one of the conditions laid down in Rule 65 were not to be fulfilled, the appeal would automatically be deemed

inadmissible. It would not, however, be considered non-existent except for the legal fiction under Article 108, second sentence, EPC which does not concern the present case.

It is clear that the distinction between the inadmissibility and the non-existence of an appeal is not only theoretical in nature but also has legal consequences. In particular, an appeal only acquires suspensive effect in so far as an appeal exists. Moreover, a board of appeal is only required to decide on an appeal, as stipulated in Article 111 EPC, if an appeal has been referred to it, which therefore implies that an appeal exists. Where an appeal does not exist, the appeal fee is reimbursed automatically, which does not occur when an appeal is deemed inadmissible. The distinction between an appeal which is inadmissible and an action which does not constitute an appeal has already been the subject of several decisions of the boards of appeal. In decisions J 19/90 of 30 April 1992, points 2.1 ff of the reasons (not published in the OJ EPO), T 371/92, point 3.5 of the reasons (OJ EPO 1995, 324) and J 16/94, points 3 and 4 of the reasons (OJ EPO 1997, 331), the boards of appeal noted that the payment of the appeal fee did not in itself constitute the valid filing of an appeal. One of the main reasons for this was that no explicit and unequivocal statement had been made of the intention to contest a given decision by appealing against it.

In decisions J 19/90 and T 371/92, the applicants simply paid the appeal fee using EPO Form 1010 in which it was stated that the purpose of the payment was a "fee for appeal". A notice of appeal as defined in Rule 64 EPC had not been filed. The boards therefore concluded that an appeal had not been filed and directed that the appeal fee be reimbursed. In case J 16/94, a notice of appeal had been filed in due time but the appeal had been introduced in the form of an auxiliary request and thus conditionally. The Board took the view that a notice of appeal which does not express the definite intention to contest an appealable decision therefore does not comply with Article 108, first sentence, and Rule 64(b) EPC and will result in the

appeal being deemed inadmissible. Moreover, the Board refused to reimburse the appeal fee. In a number of decisions (see for example T 925/91, OJ EPO 1995, 469) it was necessary to examine notices of appeal which contained various formal deficiencies. In these cases, however, the statement of the intention to file an appeal had not even been called into question.

The present board accepts the principle that an appeal can only be considered validly filed if it includes a statement of the intention to file an appeal. In fact, such a statement is generally considered to be one of the conditions determining the validity of legal actions. Nevertheless, none of the decisions mentioned above applies directly to the present case. The above-mentioned decisions J 19/90 and T 371/92 differ from the present case in that only a form for the payment of the fee was submitted and not a letter. The other decisions mentioned above related to cases where an appeal had clearly been filed but was subject to certain conditions or was affected by other formal deficiencies.

In the present case, the appellant stated during the oral proceedings that its letter had been written with the intention of filing an appeal against the decision revoking its patent. According to the appellant, there was no doubt that the notice of appeal was valid and it ought to have been clear that the purpose of the appeal was to achieve the revocation of the decision in its entirety. None of the respondents had contested this evidence given by the appellant. As a result the board finds that the appellant effectively intended to file an appeal and the said letter should be considered as evidence of this intention. Thus the board considers that the letter constitutes a notice of appeal and that an appeal has therefore been filed.

5. Admissibility of the appeal

Nevertheless, although the appeal has been filed it must fulfil all the formal requirements of Articles 106 to 108 and Rules 1(1) and 64 EPC. Since the wording of the letter which constitutes the notice of appeal refers exclusively to the payment of the appeal fee, the problem arises as to whether the appeal complies with Rule 64(b) EPC which stipulates that the notice of appeal should contain a statement identifying the decision which is impugned and the extent to which amendment or cancellation of the decision is requested.

According to the case law of the boards of appeal, it is possible to identify the contested decision from the file and to infer the extent to which amendment or cancellation of the decision is requested from the nature of the decision in question. However, it is not appropriate to apply this case law to the present case because the case law of the boards of appeal assumes that an explicit and unequivocal statement of a definite (ie firm) intention to contest the decision is made in the notice of appeal. This is where the present case differs from the other decisions of the boards of appeal. In these decisions the boards of appeal inferred from the file the intention to file an appeal and the notice of appeal was deemed admissible although the scope of the appeal was not indicated explicitly (see for example T 925/91, OJ EPO 1995, 469).

In its defence, the appellant argued that there was only one possible interpretation, namely that it intended to file an appeal with the aim of revoking the decision in its entirety. However, this argument ignores the fact that the letter, when viewed objectively, can be interpreted otherwise. The letter could merely be considered as a letter accompanying the form for the payment of fees and costs, written without any intention of filing simultaneously a notice of appeal. Adopting such a course of action could be appropriate for various reasons. For instance, it gives the appellant the

opportunity of having the appeal fee reimbursed up to the last day of the time limit for filing the notice of appeal.

The present case is in fact similar to a situation where an appeal is filed conditionally. As such it is not admissible under Rule 64(b) EPC (see J 16/94) because the letter only alludes to an appeal, does not contain an explicit and unequivocal statement expressing a definite intention to contest an appealable decision and does not indicate the extent to which amendment or cancellation of the decision is requested. Owing to the form and content of the notice of appeal, the aim of the appeal is unclear. The appeal is therefore inadmissible for the same reasons as in case J 16/94.

6. Conclusion

Although the appeal is deemed to have been filed, the notice of appeal does not comply with the requirements of Rule 64(b) EPC. Where a formal deficiency of this kind arises, Rule 65(1) EPC provides that the appeal be rejected as inadmissible. The decision must therefore allow the requests of the respondents with regard to the inadmissibility of the appeal. The auxiliary request concerning the referral of the matter to the Enlarged Board of Appeal is accordingly rendered invalid.

Order

For these reasons it is decided as follows:

The appeal is rejected as inadmissible.