

Decision of the Enlarged Board of Appeal dated 19 November 2015 G 1/14

(Translation)

Composition of the board:

Chairman: W. van der Eijk
Members: M.-B. Tardo-Dino
I. Beckedorf
E. Dufrasne
H. Meinders
U. Oswald
G. Weiss

Patent proprietor/appellant: Tenneco GmbH

Opponent/respondent: J. Eberspächer GmbH & Co. KG

Relevant legal provisions:

Art. 112(1)(a) EPC
R. 126(1) EPC (as in force until 31 March 2015)
R. 126(2), (4) EPC
Art. 22(2) RPBA

Keyword:

Referral to the Enlarged Board of Appeal

Headnotes:

- 1. If a board of appeal refers a point of law to the Enlarged Board under Article 112(1)(a) EPC, it is primarily up to the former to explain, in its referral decision, that – and why – it believes it needs an Enlarged Board ruling on the point arising in the case before it. This is also clear from Article 22(2), second sentence, RPBA, requiring the referring board to state the context in which the point originated.*
- 2. In any event, the Enlarged Board must examine whether the referral fulfils the criteria of Article 112(1)(a) EPC (including that a "decision is required") and is thus admissible.*
- 3. But if the referral is clearly the result of misapplying the law, and on a correct application an answer from the Enlarged Board is no longer necessary for the decision in the appeal proceedings, it is to be dismissed as inadmissible.*

Summary of facts and submissions

I. By interlocutory decision T 1553/13 dated 20 February 2014, Technical Board of Appeal 3.2.06 referred the following point of law to the Enlarged Board of Appeal (language of the proceedings: German; case No. G 1/14):

"If, after expiry of the time limit under Article 108, first sentence, EPC, a notice of appeal is filed and the fee for appeal is paid, is the appeal inadmissible or is it deemed not to have been filed?"

II. By interlocutory decision T 2017/12 dated 24 February 2014, Technical Board of Appeal 3.5.06 referred the following point of law to the Enlarged Board of Appeal (language of the proceedings: English; case No. G 2/14):

"Where a notice of appeal is filed but the appeal fee is paid after expiry of the time limit of Article 108, first sentence, EPC, is the appeal inadmissible or is it deemed not to have been filed?"

III. On 6 May 2014 the Enlarged Board decided under Article 8 RPEBA to consider both referrals (T 1553/13 and T 2017/12) in consolidated proceedings.

IV. In T 2017/12, the 13th-year renewal fee was not paid. As a result, the European application was deemed withdrawn, and the appeal proceedings were closed without a decision. That also brought the proceedings before the Enlarged Board (G 2/14) to an end.

V. Thus only referral G 1/14 remains pending before the Enlarged Board.

VI. Referral G 1/14 came about as follows:

The opposition division's decision revoking European patent No. 2 122 134 was handed over to the EPO's internal post on 25 April 2013, for delivery by United Parcel Service (UPS), a postal service provider.

The decision was delivered on 26 April 2013 to the office of the proprietor's professional representative, where according to the tracking information it was accepted by a person called Weber. On 7 May 2013, the proprietor's representative signed the acknowledgement of receipt (EPO Form 2936) enclosed with the decision, and on 8 May 2013 he faxed it back to the European Patent Office (EPO).

The appeal was received by the EPO on 8 July 2013 (Monday); the appeal fee was paid the same day.

VII. The appellant took the view that the two-month appeal period was to be calculated from the date of signature of the acknowledgement of receipt, this being the date on which its representative had become aware of the decision; the appeal had therefore been filed in time. Under Rule 126(2) EPC, notifications effected by registered letter were deemed to have been delivered to the addressee on the tenth day after posting, unless they reached him at a later date. Since, under Rule 126(4) EPC, German law applied to the extent that notification by post was not covered by that rule's paragraphs 1 to 3, the provisions of

Germany's Code of Civil Procedure (*Zivilprozessordnung* – "ZPO") and its law on notification of administrative acts (*Verwaltungszustellungsgesetz* – "VwZG") applied.

VIII. The referring board observed that decisions triggering a time limit for appeal had to be notified by registered letter with advice of delivery (Rule 126(1), first sentence, EPC as in force until 31 March 2015; hereinafter "old" Rule 126(1) EPC). The European Patent Register showed that advice of delivery was on file, in the form of tracking information. Depending on the circumstances, it could be assumed that persons in the addressee's office were authorised to accept post.

It disagreed with the appellant's view that the German ZPO and VwZG applied by virtue of Rule 126(4) EPC. The decision had been duly notified in accordance with old Rule 126(1) EPC and there was therefore no need to draw on national law.

Consequently, the appeal period had started on the date on which the person in the representative's business premises had signed the advice of delivery (tracking information). It could be inferred from the signer's presence there that he was authorised to accept post.

IX. At the Enlarged Board's invitation, the EPO President submitted comments on the referral; three *amicus curiae* briefs were also received (Articles 9 and 10 RPEBA).

X. One of those briefs cast doubt on the admissibility of the referral on the following grounds:

The opposition division's decision had been notified not by registered letter with advice of delivery pursuant to old Rule 126(1), first sentence, EPC, but by UPS. The tracking information on file was not advice of delivery within the meaning of the rules governing registered mail with advice of delivery. The board had not explained why it considered the tracking information to constitute advice of delivery within the meaning of old Rule 126(1), first sentence, EPC, and why it took the view that notification under that provision had been effected.

As delivery by UPS could not have been regarded as notification in due form, the question arose as to whether this had been remedied under Rule 125(4) EPC.

Under old Rule 126(1), first sentence, EPC, cited by the board in T 1553/13, notification by registered letter with advice of delivery was the only official form of notification at the time. But the decision in point had been notified not by post, but by UPS. This did not offer the same level of security as postal notification by registered letter with advice of delivery, and the referring board had not explained why it considered tracking information to constitute advice of delivery within the meaning of old Rule 126(1), first sentence, EPC and thus to fulfil its notification requirements. The defect in notification could not be remedied. Under Rule 125(4) EPC, the day on which the proprietor's representative had signed Form 2936 and sent it back to the EPO, i.e. 7 May 2013, was to be deemed the date of notification.

Reasons for the decision

Admissibility of the referral

1. Under Article 112(1)(a) EPC a board of appeal may, during proceedings on a case and either of its own motion or following a request from a party to the appeal, refer to the Enlarged Board questions on which it considers a decision is required.

2. From that it follows that it is primarily the referring board that decides whether referral to the Enlarged Board is necessary, and that must therefore explain in its referral decision that – and why – it believes it needs an Enlarged Board ruling on the point arising in the case before it. This is also clear from Article 22(2), second sentence, RPBA, requiring the referring board to state the context in which the point originated.

Nonetheless, the Enlarged Board must examine whether the referral fulfils the criteria of Article 112(1)(a) EPC (including that "a decision is required") and is thus admissible.

On the few occasions when this question has arisen it has been duly dealt with in the written decision. See e.g. G 3/98 (OJ EPO 2001, 62), G 2/99 (OJ EPO 2001, 83) and G 2/03 (OJ EPO 2004, 448) – decisions which discussed whether the referral fulfilled the "required" criterion.

3. The question in the present case is whether the referral concerns a point of law actually arising, or rather is clearly the result of misapplying the law and therefore not to be admitted.

4. The referring board took the view that it needed the Enlarged Board to answer a question of fundamental importance for its decision to reject the appeal as inadmissible or to deem it not to have been filed (Reasons, point 8.4).

5. It reached that conclusion after calculating the appeal period on the basis that the decision had been duly notified under old Rule 126(1), first sentence, EPC and Rule 126(2) EPC. In other words, it assumed that the despatch and acceptance of decisions using the UPS courier service fulfil the notification requirements of Rule 126(1) EPC and thus trigger the period for appeal in the same way as notification by post.

6. Under old Rule 126(1) EPC, the version applicable here, *"Decisions incurring a period for appeal or a petition for review ... shall be notified by registered letter with advice of delivery."*

7. The board did not explain its application of old Rule 126(1) EPC and Rule 126(2) EPC.

8. The Enlarged Board takes the view that the conditions set out in those provisions are not however fulfilled in the present case. Old Rule 126(1) EPC – at least as clearly worded until the new version entered into force on 1 April 2015 – relates solely to notification by post using a "registered letter with advice of delivery" and not to any other kind (by UPS in this case).

9. Under these circumstances the board's reasons for regarding the appeal as late-filed do not withstand summary review.

While it is not for the Enlarged Board to decide whether the appeal actually was filed in time (the crucial issue for the point of law referred), the board's incorrect assumption about the rules applicable is directly relevant to the question whether a referral is needed. As a consequence of that assumption, its finding that the appeal was late-filed is not based on reasoning sufficient to establish such a need under Article 112(1)(a) EPC. Without that (incorrect) reasoning the board could not have reached the conclusion, on which the present referral depends, that the appeal had been filed after the period specified in Article 108, first sentence, EPC.

This case therefore does not fulfil the criterion under Article 112(1)(a) EPC that a decision on the referral be required.

10. The present referral to the Enlarged Board is thus inadmissible under Article 112(1)(a) EPC.

Order

For these reasons it is decided that:

The referral is inadmissible.