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**DECISION**  
**of 20 August 2004**

**Case Number:** J 0014/03 - 3.1.1

**Application Number:** 00127117.0

**Publication Number:** 1234657

**IPC:** B30B 15/14

**Language of the proceedings:** EN

**Title of invention:**  
Screw press

**Applicant:**  
Aida Engineering Co., Ltd.

**Opponent:**  
-

**Headword:**  
Admissibility/AIDA

**Relevant legal provisions:**  
EPC R. 85(2), 84a(1)

**Keyword:**  
"Admissibility of appeal - no request, evidence or argument by appellant in first instance proceedings - whether party adversely affected by inevitable decision resulting from its own actions (no)"  
"Admissibility of evidence available or obtainable prior to first instance decision but only filed on appeal (no)"

**Decisions cited:**  
J 0011/88

**Catchword:**  
-



Case Number: J 0014/03 - 3.1.1

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.1  
of 20 August 2004

**Appellant:** Aida Engineering Co., Ltd.  
2-10, Ohyama-cho  
Sagamihara-shi  
Kanagawa 229-1181 (JP)

**Representative:** Shelley , Mark Raymond  
K. R. Bryer & Co.  
7 Gay Street  
Bath BA1 2PH (GB)

**Decision under appeal:** Decision of the Receiving Section of the  
European Patent Office dated 12 August 2002  
deciding the right to priority claimed in  
European patent application No. 001271170 was  
not validly claimed.

**Composition of the Board:**

**Chairman:** J.-C. Saisset  
**Members:** C. Rennie-Smith  
M. J. Vogel

## Summary of Facts and Submissions

- I. This appeal is against the decision of the Receiving Section of 12 August 2002 requested by the appellant (the applicant for European patent application No. 001 271 17.0 - "the application") and declaring that the right to priority of Japanese patent application No. 11-350900 of 10 December 1999 had not been validly claimed. To obtain the benefit of the claimed priority, the application had to be filed by 11 December 2000 (10 December 2000 being a Sunday i.e. a day on which EPO filing offices were closed - see Rule 85(1) EPC). The application papers were in fact received at the EPO in Munich on 12 December 2000.
- II. The appellant was informed by a communication sent on 7 February 2001 that the date of the claimed priority fell more than one year before the filing date, that the date could be corrected within one month of notification of the communication (i.e. by 17 March 2001) and that, if the deficiency was not remedied in due time, there would be no priority as claimed. The appellant replied by a letter of 14 February 2001, noting that the application papers were received on 12 December 2000, saying the papers had been dispatched on 8 December 2000 by its representative in the United Kingdom and that inquiries were being made as to whether there were grounds for an extension of the time limit under Rule 85(2) EPC due to a general interruption in the delivery of mail. Copies of documents (1) and (2) (see paragraph VII below) were sent with this fax. The appellant took no steps to remedy the deficiency by the time limit of 17 March 2001.

- III. Since the appellant had not remedied the deficiency within that time limit, a "Noting of loss of rights" communication dated 27 April 2001 was sent. The appellant then filed a fax request of 6 July 2001 for a decision - the letter simply referred to the ~~A~~Noting of loss of rights@ letter and said ~~A~~We hereby request a decision on this matter under Rule 69(2)@. In a letter of 5 December 2001 (replying to a fax from the EPO unrelated to the present issue), the appellant again said investigations were being made as to whether there were grounds for an extension of the time limit under Rule 85(2) EPC.
- IV. In its communication of 22 March 2002, the Receiving Section observed that no Statement of the President of the EPO pursuant to Rule 85(2) had been made, that the priority claim had not been filed within the priority year and invited the appellant to file comments it might consider relevant within two months (i.e. by 1 June 2002). The appellant did not reply to this communication but, in a letter of 4 June 2002, requested a two month extension of time in which to do so. This extension was refused, in a letter from the EPO of 17 June 2002, as being made after the time limit previously set had expired.
- V. In the reasons for its decision of 12 August 2002, the Receiving Section simply observed that the priority of 10 December 1999 had to be claimed within one year; that the filing date of the application was 12 December 2000; that there were no grounds for changing the filing date, there being no information as to a general interruption in the delivery of mail in the United

Kingdom and no statement to that effect having been issued by the EPO President; that Rule 84a EPC did not apply since the application papers were not dispatched more than five days before the deadline; and that therefore the request in the applicant's letter of 6 July 2001 was rejected.

VI. The appellant filed a Notice of Appeal by fax of 22 October 2002, paid the appeal fee on the same date and filed a Statement of Grounds of Appeal by fax on 23 December 2002. The appellant's arguments, as set out in the Grounds of Appeal, are summarised in paragraph VII below. The items of documentary evidence supplied by the appellant, and referred to by it as "References", are referred to below by the more conventional term "Document" but using the same numbering as in the Grounds of Appeal.

VII. The appellant's arguments as set out in the Grounds of Appeal can be summarised as follows.

(i) The application papers were collected from the representative's office in Bath at 17.00 on 8 December 2000 by Royal Mail Swiftair Express Delivery Service which, the appellant says, usually provides next day delivery to the EPO in Munich and other German destinations. However, due to unofficial strikes and adverse weather conditions in the locality of the representative's office, delays were encountered resulting in delivery at the EPO only on 12 December 2000. In support of the above, the appellant has filed the following documents:

- (1) A copy of a page from a Royal Mail logbook apparently retained by the representative which shows a Swiftair reference number, the address "EPO D-80298 Munich", the date 8 December 2000 and, in a box headed "Number of items", the entry "One" (presumably a package containing the application papers in question).
- (2) A copy of the Swiftair label attached to the package which shows the same address but with the addition of the word "Germany" and the same reference number. The label as produced carries a number of statements including "Your item is tracked until it leaves the UK. We can't guarantee delivery time in other countries."
- (3) A copy of a letter of 22 August 2001 from a Royal Mail employee to the appellant's representative, replying to a letter from him of 13 June 2001. Referring to the same reference number, this letter records the following "tracking information" namely, that the package was collected from an "unknown firm" at 20.07 on 8 December 2000, was received at Swiftair's Outward Office of Exchange in Reading at 22.18 on 9 December 2000, was despatched to Frankfurt on the afternoon of 10 December 2000 and was received in Frankfurt at 18.44 on the same date. The Royal Mail employee then offers the opinion that "if a similar item had been received in the United Kingdom it would then be treated as a First Class and would have the expectation of being delivered the following day".

(ii) The appellant then argues that in at least the ten days preceding 11 December 2000, the mail service in the representative's locality was interrupted and/or subsequently dislocated on account of strikes, adverse weather conditions and disruption to railways and other transport due to the weather. Documents (4) to (9) are newspaper articles of various dates between 7 and 19 December 2000 describing such weather conditions, strikes and transport disruption.

(iii) The appellant submits that these circumstances in combination led to delay in the transport of the papers between Bath and Frankfurt and that this may have caused further delay between Frankfurt and the EPO in Munich. As regards that last submission - as to delay between Frankfurt and Munich - the appellant says its representative has made extensive inquiries of Deutsche Post to ascertain the exact date and time of delivery but has been unable to obtain this information which it asks the EPO to provide. The Grounds of Appeal conclude by saying the appellant "understands Deutsche Post delivers 95% of all mail the following day and therefore further delay appears to have occurred between Frankfurt and the EPO since the Swiftair item was received in Frankfurt at 18.44 local time on 10 December 2000 [and] should therefore under normal circumstances [have] arrived at the EPO on 11 December 2000".

VIII. On 25 March 2004 the Board sent to the appellant a communication containing a provisional opinion in substantially the same terms as the Reasons below and

directing the appellant to file any comments thereon or any further requests by way of written submissions within two months of the deemed date of receipt of the communication (i.e. by 6 June 2004). The communication concluded by stating that, subject to any such submissions, a decision might be issued after that date.

- IX. In reply to that communication the appellant made no submissions but, in a letter sent by fax on 4 June 2004, asked for an initial extension of time of two months for replying in order to allow further time to continue with enquiries at the UK Patent Office concerning whether the conditions of Rule 85(2) EPC apply. The Board decided not to allow that request (see paragraph 13 below).
- X. The appellant requests (by implication) that the decision under appeal be set aside and (in terms) that the time limit under Article 87(1) EPC be extended to the date of actual receipt of the application documents at the EPO pursuant to Rule 85 EPC. There is no request for oral proceedings.

### **Reasons for the Decision**

1. In its grounds of appeal the appellant has asked the EPO to provide the exact date and time of receipt at the EPO of the application documents (see paragraph VII(iii) above). The appellant clearly has the EPO filing receipt (see Grounds of Appeal, paragraph 6) showing 12 December 2000 as the date of receipt. None of the copies of the relevant papers available to the Board, in the form of either paper or electronic files,



give any indication of the actual time of delivery. However, it is not in dispute, and it appears from the file never to have been disputed, either that the application papers were only received at the EPO on 12 December 2000 or that the final date for receipt in order validly to claim the priority sought was 11 December 2000. Indeed, all the appellant's arguments on appeal are directed to establishing that there should be an acceptable reason for the delay of one day. Accordingly, the Board cannot see how it would assist either the appellant or the Board to know the exact time of receipt.

2. While the requirements of the EPC as to filing times and payment of appeal fee have been met, the Board has very considerable doubt whether the further requirement that the appellant has been adversely affected is satisfied.
  
3. The only step taken by the appellant in reply to the several communications from the Receiving Section regarding the priority claim in question was to file, in response to the first such communication of 7 February 2001, copies of documents (1) and (2) in support of the statement that the application papers were dispatched on 8 December 2000. That fact in itself could have no impact on the question since it was the date of receipt which was critical and (as mentioned in 1 above) it has never been in dispute that the application papers were received at the EPO on 12 December 2000.

4. The only other step taken by the appellant in the first instance proceedings was to ask, in its fax of 6 July 2001, for a decision. However, despite asking for a decision, the appellant produced no arguments or evidence at all in relation to the substance of the matter at issue, namely the late receipt of the application documents and the resulting loss of the claimed priority, nor did it at any time make any request that the finding of the Receiving Section be set aside and/or that the time limit under Article 87(1) EPC be extended to the date of actual receipt of the application documents at the EPO pursuant to Rule 85 EPC. Such a request was only made for the first time in the statement of grounds of appeal. The decision under appeal refers (see paragraph V above) to a request in the appellant's letter of 6 July 2001 to set aside the ~~AN~~oting of loss of rights~~@~~ of 27 April 2001 but the Board notes, having examined the letter of 6 July 2001, that in fact it contained no such request.

5. The communication of 22 March 2002 sent in reply to the appellant's request for a decision was not a decision as such but a reasoned statement containing the Receiving Section's analysis of the facts, its opinion that the priority claim could only be saved if Rule 85 EPC could be invoked to extend the time limit, and its reasons for not being able to invoke that Rule on the information available. The communication of 22 March 2002 ended with an invitation to the appellant in the following terms:

"Pursuant to Article 113 EPC, the applicant is hereby offered the possibility to present further comments he may consider relevant within a period of TWO MONTHS

- from notification of the present communication, following which an appealable decision will be issued (Article 106(3) EPC). Should you consider to withdraw that request for a decision in view of the above, you are invited to do so within the same period."
6. The appellant did not reply to that communication, either within the two months or at all (although it did, after expiry of the two months, ask for more time to reply). The decision which subsequently issued was, as could only be expected, in substantially identical terms to the reasoned statement in the previous communication - the only difference being that the "Summary of Facts and Submissions" included reference to that communication and subsequent correspondence.
  7. That during the first instance proceedings the appellant took none of the steps one would normally expect to have been taken is underlined by the fact that, in the appeal proceedings, evidence and arguments as to the substance of the case have been provided. Despite having been alerted in the Board's communication of 25 March 2004 to the possibility of a finding of inadmissibility and to the fact that all the relevant evidence filed on appeal is late-filed evidence, the appellant has neither made a request for the late-filed evidence to be admitted, either to avoid a finding of inadmissibility or for any other reason, nor made a request for remittal to the first instance in view of the late-filed evidence, nor offered any explanation for the late filing of evidence. None the less, in order to see whether the late-filed evidence could assist the appellant, the Board has proceeded to

- consider both the admissibility and the effect of the evidence now provided.
8. The Board must, in assessing whether the evidence now filed on appeal is admissible, consider whether such evidence could have been filed sooner. With one exception (see paragraph 9 below), all the additional evidence filed with the Grounds of Appeal - that is, the newspaper articles forming documents (4) to (9) - was publicly available from the date of publication of each such article, that is in the period 7 to 19 December 2000. The Board notes that in fact the appellant obtained documents (4) to (9) by download from newspaper archive websites on one of two dates, namely 27 May 2002 (shortly before the expiry of the two months the appellant was given to comment on the communication of 22 March 2002) and 23 December 2002 (the date on which the grounds of appeal were filed by fax).
  
  9. The only document which was not freely available to the appellant before the end of 2000, and thus well before the first EPO communication of 7 February 2001 questioning the priority, was document (3), the letter of 22 August 2001 which supplied the "tracking information" for the package containing the application papers. The appellant could quite clearly have sought this "tracking information" at an earlier date - document (2), in the representative's possession since 8 December 2000, states "Your item is tracked until it leaves the UK". However, document (3) was, as appears on its face, only written in reply to a letter from the representative of 13 June 2001 - less than a month before the applicant asked for a decision.

10. Both the lateness of production of the new evidence, and the possibility it could have been obtained and filed during the first instance proceedings, is underlined by the several statements made by the appellant during those proceedings to the effect it was making inquiries. In its letter of 14 February 2001, it said "We are investigating whether grounds exist under Rule 85(2)...". In its letter of 5 December 2001, it said "We are currently investigating whether grounds exist under Rule 85(2)...". And in its letter of 4 June 2002, it said "We request an additional extension of 2 months for replying to the Communication to allow the applicant additional time to pursue, *inter alia*, further inquiries concerning disruption in the delivery of mail between Bath and Munich in December 2000." The only results of those inquiries which have been produced are documents which were all readily available or obtainable well before the request for a decision was made. The Board can accordingly only find that there was no reason for the late filing of this evidence.
11. Turning to consider whether the new evidence should be admitted in order to make an otherwise inadmissible appeal admissible, the Board finds it difficult to identify any factor in support of the appellant. If plausible reasons for the late-filing had been advanced, it is conceivable that the Board might have found some basis on which to exercise its discretion in favour of the appellant and thus permit its appeal to proceed to consideration of allowability. However, in the absence of any reasons at all, let alone any plausible reason, for withholding this evidence until the appeal stage,

the Board can find no reason for a more generous exercise of its discretion, namely to admit the new evidence solely in order to save the admissibility of the appeal. Moreover, as appears from paragraphs 14 to 18 below, admitting the new evidence for this reason would not lead to the appeal being allowed.

12. Had the Board been able formally to admit the newly-filed evidence into the proceedings, the question would have arisen whether or not the Board should proceed to consider the fresh case thus created (and there can be no fresher case than that created where no case previously existed) or whether it should remit the case to the Receiving Section so that it could consider the evidence it was not given in the first instance proceedings. Again, this was raised in the Board's communication of 25 March 2004 but, again, the appellant has unfortunately made no comment thereon. Although not required to decide this issue, the Board is firmly of the view that, if it had decided to admit the new evidence, it would not have remitted the case. Remittal is a matter of discretion and, if there had been a request from the appellant to remit, one factor to be taken into account, as in all discretionary decisions, would have been the behaviour of the party making the request. It follows from the reasons in the previous paragraphs that the appellant has taken no steps which could prompt the Board to exercise its discretion in the appellant's favour.
  
13. For similar reasons, the Board decided to refuse the appellant's request for additional time to reply to the communication of 25 March 2004. The reason given (continuing inquiries as to whether Rule 85(2) EPC

applies - see paragraph IX above) was very similar to the several statements about pending inquiries made by the appellant during the first instance proceedings (see paragraph 10 above). If, as appears to be the case, the appellant's hope was to obtain a letter from the United Kingdom Patent Office similar to that produced by the appellant in J 11/88 (OJ EPO 1989, 433, see paragraph 15 below), no reason was offered either why this had not been pursued before or why the two months allowed by the Board was insufficient. No evidence was supplied to the effect such inquiries had actually been made of the United Kingdom Patent Office, let alone that such inquiries were, as the letter said, continuing. Of course, the appellant's inquiries might have been unfruitful or, if not, would at best have produced yet more late-filed evidence. Further, the results of such inquiries could only relate to the question of allowability of the appeal, whereas the Board's communication also raised questions about the admissibility of the appeal, late-filed evidence and possible remittal - all matters the appellant would have to deal with before allowability of the appeal could be considered. Yet no attempt was made to comment on the Board's observations on those questions. Finally, the Board notes the request was for an **Ainitial@** extension of two months, but no reason was given why two more months might not be sufficient, nor how long might be sought in total.

14. The Board is also of the opinion that, even if the appeal were admissible and the new evidence (amounting to a fresh case) considered, the arguments and evidence of the appellant would not lead to the appeal being allowed. As the decision under appeal correctly

observed, there was no statement of the President of the EPO under Rule 85(2) EPC relating to postal disruption in the United Kingdom during the period in question. The only information as to any such possible disruption is that belatedly provided by the appellant.

15. Such information can lead to a retrospective extension of time in a particular case if, as occurred in J 11/88 (see Reasons paragraphs 5 to 7), evidence is later adduced which, had it been known at the time, would have been such as to warrant a Presidential statement. However, in that case the quality of the evidence was quite different from the present case - in particular, it included a letter from the United Kingdom Patent Office stating it was satisfied there had been a postal interruption and that, if a national application had been involved, it would have so certified. In the present case, the only evidence of interruption is that of newspaper articles which do indeed report a number of problems caused by adverse weather and unofficial strikes. However, the same articles also report measures to deal with such conditions - for example, the increased use by postal services of air transport and pleas to the public to post its Christmas mail early. Thus, even allowing for the sensationalist style and anecdotal nature of newspaper articles, this evidence is in itself inconclusive of any disruption which, had it been known to the EPO at the time, would have led to a Presidential statement.

16. The evidence as to the appellant's own package of papers is, if anything, unhelpful to the appellant. It argues that the service it used "usually provides next day delivery" in Germany but the word "usually" clearly



indicates there can be exceptions even under ordinary conditions. This is reflected in the label supplied by the service itself and completed by the appellant's representative (document (2) - see paragraph VII above) which carries the statement "We can't guarantee delivery time in other countries". In fact, the package did reach Germany on the Sunday following its despatch at a late hour (17.00 according to the Grounds of Appeal, 20.07 according to document (3)) the previous Friday evening. It was thus in its country of destination before the next working day after despatch. As for the fact it then took over a day to reach the EPO, the appellant says it understands 95% of post in Germany is delivered the following day and thus appears to accept that next day delivery, even of items within Germany, is not guaranteed.

17. The opinion of the British postal employee in document (3), that if the package had made the reverse journey "it would have the expectation of being delivered the following day", shows that, as one would expect, there is in both countries a high likelihood but no guarantee of next day delivery. It also shows that, in his opinion, mail arriving by such services will not be delivered on the day of arrival, which (although again applying to the hypothetical example of a package making the reverse journey) does not support the appellant's argument that the service it used usually provides next day delivery. It is also to be noted that this opinion was offered without reference to any postal disruption or the effects thereof, although the postal employee giving the opinion was clearly aware of the exact dates involved.

18. The appellant has not at any stage submitted any argument relating to Rule 84a(1) EPC. However, the Receiving Section, which of course had to make its decision in the complete absence of any argument or evidence from the appellant, was correct in stating in its decision that Rule 84a(1) EPC is not applicable since one of the conditions contained in the decision of the EPO President under that rule (see OJ EPO 1999, 45), namely that posting or delivery to a recognised delivery service must occur five days before the expiry of a time limit, is not satisfied in the present case. The only effect on this of the information now supplied by the appellant is that, the delivery service used by the appellant not being one referred to in the EPO President's decision, Rule 84a(1) EPC would not apply for that additional reason.
  
19. As is apparent from the above, the Board has conducted a thorough examination of the case notwithstanding the fact that the admissibility of the appeal is in doubt. This is in part because (as mentioned in paragraph 2 above) the doubt arises not in relation to non-compliance with formalities but in relation to the very nature of the appellant's contribution, or lack of contribution, to the proceedings. Having conducted that thorough examination, the Board has concluded that the decision which was issued by the Receiving Section was quite simply the inevitable consequence of the appellant's own actions and inactions, namely seeking a decision in the absence of any request while failing to make any case whatsoever, even when invited to do so. In those circumstances it is impossible to conclude that the appellant has been adversely affected.

Accordingly, the appeal is inadmissible and must for that reason be dismissed.

**Order**

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

The appeal is dismissed

The Registrar:

The Chairman:

S. Fabiani

J.-C. Saisset