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Boards of Appeal

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Chambres de recours



Case Number : J 2/87

D E C I S I O N of 25 September 1987
correcting errors in the decision of
the Legal Board of Appeal
of 20 July 1987

Appellant : MOTOROLA, INC.
1303 East Algonquin Road
Schaumburg, Illinois 60196
USA

Representative : Hudson, Peter David
Motorola Ltd.
Patent and Licensing Operations Europe
Jays Close
Viables Industrial Estate
Basingstoke Hampshire RG22 4PD
Great Britain

Composition of the Board :

Chairman : P. Ford
Members : C. Payraudeau
R. Schulte

In application of Rule 89 EPC the Decision given on 20 July 1987
is hereby corrected as follows:

replace "5 November 1984" by "27 December 1984"
on page 1, line 5
on page 6, line 17
on page 7, line 3
and on page 8, line 6.

The Registrar:

J. R. G.

The Chairman:

Reinhold

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

Aktenzeichen / Case Number / N° du recours : J 2/87

Anmeldenummer / Filing No / N° de la demande : 82 901 198.0

Veröffentlichungs-Nr. / Publication No / N° de la publication : WO82/03304

Bezeichnung der Erfindung: Pilot tone detector utilising phase deviation
Title of invention: signals
Titre de l'invention :

Klassifikation / Classification / Classement : H 04 H 5/00

ENTSCHEIDUNG / DECISION

vom / of / du 20 July 1987

Anmelder / Applicant / Demandeur : MOTOROLA, INC.

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : MOTOROLA

EPO / EPC / CBE Arts. 97(1), (2), 108, 109(2), 113(2), 122

Kennwort / Keyword / Mot clé : "Admissibility of appeal" - "Invalid Communication" - "Time limit for restitutio" - "Principle of good faith".

Leitsatz / Headnote / Sommaire

- I. The minimal requirements of Art. 108 EPC are satisfied when the notice of appeal can be interpreted as containing a request for rectification of the decision concerned on the grounds that due to the fact that the conditions set forth in a former Communication of the EPO were now fulfilled, the decision was no longer justified.
- II. Principles of good faith govern the relations between the EPO and applicants for European Patents and a Communication from the EPO containing erroneous information which has misled the Appellant into an action causing the refusal of his patent application is void and of no effect in its entirety.

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Decision under appeal : Decision of the Head of the Formalities Section
of European Patent Office dated 28 May 1985
refusing European Patent Application
No. 82 901 198.0 pursuant to Article 97(1) EPC.

Composition of the Board :

Chairman : P. Ford
Member : C. Payraudeau
Member : R. Schulte

Summary of Facts and Submissions

I. Euro PCT application PCT/US 82/00254 was given the European patent application number 82 901 198.0. After examination, a Formalities Officer of the Examining Division sent a "communication pursuant to Rule 51(4) and (5) EPC" to the Appellant (Form 2005) on 5 November 1984. This standard printed form stated that if he approved the patent being granted on the basis of the annexed text, the Appellant must pay the fees for grant and printing and file a translation of the claims in the two official languages of the EPC other than the language of the proceedings within three months from the Communication.

The Form 2005 also stated that "if these acts are not carried out in due time, the examination will be resumed"; the application might be refused on the basis of Article 97(1) in conjunction with Article 97(2) and Article 113(2) EPC.

II. The Formalities Section of Directorate General 2 of the EPO, having received no answer from the Appellant within the time limit set, gave a decision refusing European patent application in pursuance of Article 97(1) EPC on 28 May 1985.

III. On 25 July 1985 the Appellant sent a telex to the EPO, confirmed by letter received at the EPO on 26 July 1985, stating that the Appellant hereby approved the proposed text and was paying an appeal fee and the fees for grant and printing. It was also stated that translations of the claims into French and German would be filed in due course.

The Appellant requested that Form 2005 be re-issued in order to allow further time for filing a translation in Italy. The fee for appeal was paid on 25 July 1985.

On 13 August 1985 the Appellant was requested by a brief Communication to file a formal notice of appeal in accordance with Article 108 and Rule 64 EPC which he filed on 19 October 1985.

The Appellant filed the above-mentioned translations at the EPO on 13 December 1985 but did not file any other statement within the four months period provided by Article 108 EPC.

IV. The file was remitted to the Legal Board of Appeal on 10 January 1987. In answer to a Communication of the Registrar of the Board of Appeal dated 20 January 1987 informing the Appellant of the reference allocated to his appeal and expressing doubt as regards the admissibility of the appeal in view of its formal deficiencies and of the absence of a statement of grounds, the Appellant submitted in a telex dated 1 June 1987 confirmed by a letter received at the EPO on 15 June 1987:

- (i) that the telex of 25 July 1985 together with its confirmatory letter of the same date should be regarded as a valid notice of appeal, the formal deficiencies of which had been remedied by the letter of 19 October 1985,
- (ii) that no further statement of grounds needed to be filed;
- (iii) that similar circumstances obtained following the Rule 54(1) Communication in two other European patent applications: in these applications following failure

to pay the requisite fees and subsequent refusal, appeal was filed in exactly the same manner as in the present application. These two earlier applications have since been granted.

Reasons for the Decision

Admissibility of the appeal

1. The first question to be decided is whether the appeal is admissible having regard to the requirements of Article 106-108, and Rule 64 EPC.

According to these Articles and Rule, a notice of appeal must be filed in writing within two months of the decision which is impugned identifying the decision and the extent to which amendment or cancellation of the decision is requested.

A statement setting out the grounds of appeal must be filed within four months after the date of notification of the decision.

2. There is no doubt in the Board's view that the telex of 25 July 1985 constitutes a valid notice of appeal which in view of the established procedure of the EPO (see the reasons herebelow) may be considered as also containing a sufficiently clear statement of grounds to satisfy at least the minimal requirements of Article 108 EPC.

It is in fact possible to construe this telex as a request to the EPO to rectify its decision because, due to the formal approval of the text expressed in the telex, this decision was no more justified.

Consequently the appeal is admissible.

Allowability of the appeal

3. In a recent decision (J 22/86 Disapproval/ MEDICAL BIOLOGICAL dated 7 February 1987 published in European Patent Office Reports (EPOR) Volume 2, 1987, page 87, therefore issued since the decision under appeal, the Legal Board of Appeal has decided that when the Applicant does not answer the Communication under Rule 51(4) EPC within the time limit set, the patent application should be deemed to have been withdrawn.

According to the above-cited decision, the only remedy then open to the Applicant is the **restitutio in integrum** provided by Article 122 EPC if the conditions of that Article are met.

4. In the present case, since no application for **restitutio in integrum** has ever been filed and since such application is now clearly barred by the expiry of the one-year time limit of Article 122(2) (see decision J 16/86 "Patin" of 1 December 1986 - unpublished) the appeal should be rejected unless another ground for revoking the decision under appeal may be found.
5. Before the Board of Appeal, the Appellant has argued in substance that the EPO has effected an interlocutory revision in two exactly similar cases and that it should consequently have effected a similar revision in the present case.

6. The Board agrees with the Appellant that, as a principle of equity and in application of the principle "**Tu patere legem quam fecisti**", the EPO should apply the procedural provisions it has established equally to all cases even when these provisions are clearly contrary to the Convention.

7. The decision under appeal has rejected the patent application on the ground that it did not conform to the requirements of the EPC on account of the lack of approval by the Applicant of the text annexed to the Communication in accordance with Rule 51(4) EPC.

This Communication (printed form 2005) indicated (p.2):

"re 1 and 2: if these acts (payment of the fees and filing of the translations) are not carried out in due time, **the examination will be resumed**

This paragraph is in accordance with the "Guidelines for Examination in the European Patent Office at C VI.15 and with the usual practice of the EPO (which has been applied in the two other cases mentioned by the Appellant). According to this practice, in case of failure of the Applicant to conform with the conditions set forth in the Communication, the Formalities Officer of the Examining Division rejects the application in pursuance of Article 97(1) combined with Article 97(2) and Article 113(2) of the EPC and grants an interlocutory revision when the Applicant appeals from the decision of refusal (see Singer EPÜ Münchner Gemeinschaftskommentar Artikel 97 Anmerkung 16; Gall in "Echanges ASPI" No. 29 - May 1987, page 9).

8. Although the Board, following the above cited decision J 22/86 considers that the mentioned Guidelines C VI.15 and

practice are not consistent with the requirements of the Convention, these Guidelines and practice have been consistently applied and have therefore constituted the Rules of practice implemented by the EPO.

9. This Board has always held that principles of good faith govern the relations between the EPO and applicants for European patents over procedural matter laid down in the Implementing Regulations (see J 10/84 OJ EPO 1985, page 71). Another principle applied by the Board is that a Communication from the Office must be clear and unambiguous in order to produce its full effect (see J 13/84 OJ EPO 1985, page 34). The Board has also always considered that the content of a letter (or Communication) is not to be interpreted in isolation but in its context (see for example J 24/82 OJ EPO 1984, page 467).
10. In the present case, the Communication sent to the Appellant on 5 November 1984, interpreted in the light of the Guidelines and of the standard practice of the EPO has led the Appellant into believing that the legal consequences of his omission to answer the Communication would be retracted if he appealed from the decision of refusal.

It should be noted that the Appellant could not have deduced from the absence of a favourable decision within the one month time limit of Article 109(2) EPC that an interlocutory revision had been refused since the two other cases mentioned by the Appellant show that the EPO does not in fact communicate to the Appellant's decision to grant an interlocutory revision within such time limit but much later. The Appellant has in fact only been made aware that an interlocutory revision had not been granted by the letter of the Registrar of the Board of Appeal of 20 January 1987.

11. The Board considers that the Communication of the Formalities Officer of the Examining Division sent to the Appellant on 5 November 1984 was misleading in that it could be very reasonably interpreted as allowing an applicant to obtain a re-establishment of his rights, if he did abstain from answering this Communication, by simply filing a purely formal appeal.

In the present case, this misleading information had a determining effect on the decision of the Appellant not to answer the Communication in due time but to appeal later on from the subsequent decision of refusal of the patent application.

Consequently, the Communication being vitiated in one essential and determining element must be considered as void and of no effect in its entirety and a new Communication should be issued. Therefore the decision under appeal based on this Communication must be revoked.

12. It should be noted that there is no contradiction between the present decision and the above-cited decision which has not invalidated the corresponding Communication. This difference is simply due to the fact that, in the former case, the misleading information contained in the Communication had had no determining effect on the attitude of an Appellant who had filed in due time an application for *restitutio in integrum* in respect of the failure to observe the time limit for complying with the formal requirements of Rule 51(4) EPC.

The Communication could thus be in the former case considered as valid except for the incriminated part.

Order

For these reasons, it is decided that:

1. The decision of the Head of the Formalities section of Directorate General 2 dated 28 May 1985 is set aside.
2. The Communication of the Formalities Section of Directorate General 2 of the European Patent Office dated 5 November 1984 is declared to be void and of no effect.
3. The case is remitted to the first instance with the order to issue a new Communication under Rule 51(4) and (5) EPC.

The Registrar:

The Chairman:

Josef Ruckerl

Peter Ford