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Bezeichnung der Erfindung: Tennis racquet

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : A63B 49/00

## ENTSCHEIDUNG / DECISION

vom / of / du 30 April 1990

Anmelder / Applicant / Demandeur : Hugo Marrello

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Postal strike/MARRELLO

EPÜ / EPC / CBE Article 113(1), Rule 85(2)

Schlagwort / Keyword / Mot clé : "General interruption in delivery of mail" -  
"Basis of decision"

### Leitsatz / Headnote / Sommaire

I. Article 113(1) EPC requires decisions by the EPO to be based only on grounds or evidence on which the parties concerned have had an opportunity to present their comments.

This fundamental principle is not observed in a case in which the Office has made an examination of the facts of its own motion (Article 114(1) EPC) unless the parties concerned have been fully informed about the enquiries made and the results thereof and then given sufficient opportunity to present their comments before any decision is issued.

II. When the Office investigates facts of its motion pursuant to Article 114(1) EPC, it must do so in a wholly objective manner.



Case Number : J 4/90

D E C I S I O N  
of the Legal Board of Appeal  
of 30 April 1990

Appellant : Hugo Marrello  
119 Elgin Street  
Thornhill, Ontario L3T 1W7  
Canada

Representative : Gordon MacGregor  
Eric Potter & Clarkson  
14 Oxford Street  
Nottingham NG1 5BP  
UK

Decision under appeal : Decision of the Receiving Section  
of the European Patent Office  
i.a. refusing a claimed priority.

Composition of the Board :

Chairman : P. Ford  
Members : C. Holtz  
J-C. Saisset

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J 4/90

## Summary of Facts and Submissions

- I. European patent application No. 88 311 544.6 was submitted by the Appellant's English representative, having his place of business in Nottingham, UK, through the United Kingdom Patent Office, which afforded it the filing date of 6 December 1988. The application claimed priorities from three United States applications, No. 128 381, 236 832 and 249 337, filed on 3 December 1987, 26 August and 26 September 1988, respectively. 3 December 1988 fell on a Saturday, extending the priority year to include Monday 5 December 1988 (Rule 85(1) EPC).
  
- II. In a letter dated 20 December 1988, the representative pointed out that, although the filing date was one day over the convention period for priority, he still believed that the application was entitled to claim priority under Article 87(1) EPC. In support of this he referred to a disruption of mail in the United Kingdom to which in his opinion Rule 85(2) applied. He further drew attention to the fact that he had dispatched the application by a private courier service, on the afternoon of the 2 December 1988. Due to an error, the application was only delivered on Tuesday 6 December 1988.

In a second letter dated the same day, the representative asked for a statement by the President of the European Patent Office under Rule 85(2) EPC, extending the time limit for parties who resided in, or who had appointed representatives with their place of business in, the United Kingdom to at least 6 December 1988.

- III. The European Patent Office undertook an investigation into the matter. A letter dated 12 January 1989 was sent to the

United Kingdom Patent Office with a request for information on the alleged postal strike in the area of Nottingham, referring to a recent telephone conversation.

In this letter, from the Legal Division, reference was made to evidence which seemed to indicate that the strike had only a local character. The source and content of this evidence is not mentioned. The United Kingdom Patent Office was asked to send confirmation that it could not issue an official notice that the strike qualified as a "general interruption". If, on the other hand, it should turn out that the strike did fulfil the conditions for an extension of time limits, it was pointed out that the Legal Division would need to know its exact duration and in particular whether the period of 18 November - 1 December referred to by the United Kingdom Patent Office also included the subsequent dislocation in the delivery of mail.

- IV. In a letter dated 17 February 1989, the United Kingdom Patent Office stated through its Assistant Comptroller that it would have issued a certificate for the period of 18 November - 6 December 1988 under Rule 111(1) of the Patents Act of 1977, had any national application been involved.
- V. Further, in letters dated 26 April 1989 and 4 July 1989, the Royal Mail Letters of the United Kingdom supplied the European Patent Office with the information that there had been a local unofficial industrial action by postal staff at Nottingham Letters District Office between 16.00 hrs on 16 November 1988 and 22.00 hrs on 24 November 1988 without prior warning. The postal authorities confirmed that mail boxes in the centre of Nottingham had been closed, that posting boxes and smaller sorting offices were operating approximately six miles outside the city centre, that

certain districts outside Nottingham usually send their mail through Nottingham, but that during the strike they had forwarded all mail themselves. Finally, the Royal Mail Letters pointed out that they could only offer a very much reduced service, e.g. four or five days for first class mail to reach its destination. There is no indication in these answers from the Royal Mail Letters as to the duration of the subsequent dislocation of mail.

VI. In the Decision under appeal of 25 August 1989, the Receiving Section of the European Patent Office refers to the letter of 17 February 1989 from the United Kingdom Patent Office, as well as to the correspondence with the Royal Mail Letters, the latter being appended to the Decision.

The Receiving Section concluded from the information available that the interruption was not a general one within the meaning of Rule 85(2) EPC, referring in particular to the interruption having been limited to a relatively small geographical area, the extent having been well known to the public from the beginning of the strike, and to the fact that the interruption had begun three weeks before the critical date of 5 December 1988. In the opinion of the Receiving Section it had not been particularly difficult for the representative using reasonable diligence to circumvent the strike.

In the Decision, a request for oral proceedings was refused on the grounds that such a procedure would not have been expedient (Article 116(2) EPC).

Finally, it was pointed out in the Decision that, because of the loss of priority, the application would be published after the expiry of eighteen months calculated from 6 December 1988.

- VII. During the proceedings leading up to the Decision under appeal, the European Patent Office on 14 June 1989 had issued a communication pursuant to Rule 41(3) EPC, drawing the attention of the Appellant to the priority of 4 December 1987 falling outside the priority year. The Appellant was informed that incorrectly indicated dates could be corrected within one month of notification of the communication. Failure to remedy the indicated deficiency would lead to loss of the right of priority. To this communication (EPO Form 1051) was appended a sheet of paper containing information regarding the question of extension of time limit for claiming priority under Rule 87(1). Reference was made to the 17 February 1989 letter from the United Kingdom Patent Office (cf. para. IV above). In the opinion of the European Patent Office the interruption did not qualify as general, with the consequence that the application would only be published after expiry of eighteen months from 6 December 1988. Mention was further made of information from the Nottingham postal authorities, but its content was not revealed. The Appellant was not invited to comment on these findings of the EPO.
- VIII. The Appellant argued in a letter dated 26 June 1989, referring to the 14 June 1989 communication, that the statement of 17 February 1989 by the Assistant Comptroller did not confirm the assumption by the EPO that the interruption had not been general. The Appellant also referred to a continuing series of disputes in various regional Post Offices throughout the United Kingdom. The Appellant requested reconsideration of the matter and permission for extension of the time limit under Rule 85(2) EPC, publication after eighteen months after the claimed priority date, and finally oral proceedings before any adverse decision was issued.

- IX. In its Decision of 25 August 1989 the Receiving Section, rejecting the Appellant's requests, maintained the date of filing at 6 December 1988, denied the claimed priority and declared the postal action as not constituting a general interruption within the meaning of Rule 85(2) EPC.
- X. On 9 October 1989 the Appellant submitted a Notice of Appeal, followed on 3 January 1990 by a Statement of Grounds. The appeal fee was paid on 16 October 1989.

The Appellant requests cancellation of the Decision of 25 August 1989, restoration of the claimed priority of 3 December 1987, and reimbursement of the appeal fee.

In support of his requests, the Appellant essentially argues as follows:

The Appellant can agree with the opinion in the Decision as to the length of the interruption, from 16 November to 6 December 1988, although the effects in his view lasted until at least 7 December. The only area of difference is whether this interruption and subsequent dislocation qualifies as "general" under Rule 85(2) EPC. The statement by the Assistant Comptroller constitutes prima facie evidence of the existence of a general interruption and subsequent dislocation. It would be unsatisfactory for residents of the United Kingdom if the interpretation of Rule 85(2) by the EPO is different from that of Rule 111(1) (which is in all important respects identical to Rule 85(2) EPC) by the UK Patent Office.

Reference is further made to Decision J 11/88, where the Board of Appeal considered a statement by the Assistant Comptroller of the UK Patent Office - which was in exactly

the same terms as the statement issued in the present case - and expressed the view that it was a strong and clear official statement on the basis of which the President of the Office would not have failed to act under Rule 85(2) EPC.

The Appellant claims that the Receiving Section is wrong in applying the criterion of reasonable diligence, thereby arriving at the conclusion that the strike did not fall within the terms of Rule 85(2). The same procedure - to use another means of distribution - could have been used even if the interruption had been national.

The Omron Tateisi Decision of the UK Patents Court shows in the opinion of the Appellant that a postal dispute does not have to be a national dispute to qualify as an interruption under Rule 111(1) Patents Act 1977. In its Decision J 11/88, paragraph 7, the Board of Appeal had indicated that it had taken the Omron Tateisi decision into account when reaching its decision.

There is no action a representative in Nottingham could have taken to circumvent the effects of the interruption.

In support of these arguments, the Appellant has submitted correspondence with the Royal Mail Letters and various newspaper articles as evidence of the extent of the disruption.

As to the request for reimbursement of the appeal fee the Appellant submits that he was never provided with a copy of the letter dated 4 July 1989 from the Royal Mail Letters, on which, in his view, the Reasons for the Decision seemed to have been based almost entirely. In failing to meet the obligations imposed by Article 113(1) EPC, the Receiving Section had committed a substantial procedural violation, according to the Appellant.

## Reasons for the Decision

1. The appeal is admissible.

Rule 85(2).

2. In its Decision J 4/87 "Elton", OJ EPO 1988, 171, the Legal Board of Appeal found that in the event of an unforeseeable postal delay causing non-compliance with a time limit, if Rule 85(2) EPC is not applicable so as to extend the time limit, the EPO has no discretion to extend it.

The substantive issue to be decided in the present case is therefore whether the circumstances were such as to bring about an extension under Rule 85(2) EPC by operation of law.

3. As to the facts, it is agreed that there was an interruption and subsequent dislocation of mail in the Nottingham area (specific central districts of Nottingham) from 18 November to 6 December 1988 inclusive.
4. It remains to be decided whether or not this interruption was general in character. On this issue the Appellant has referred to the Decision J 11/88 "Leyland Stanford", OJ EPO 1989, 433. The Legal Board of Appeal found in that case that the character of an interruption was a question of fact which had to be decided on the basis of any credible information available. Further, the Board concluded that, if a "general interruption" occurs, any time limit which expires within the period of interruption or dislocation is extended by operation of law.

5. The facts of J 11/88 were similar to the facts of the present case insofar as there had been a strike by Post Office workers in the area where the Appellant's representative had his place of business. The question to be answered was, as in the present case, whether a strike which was not fully national could trigger the application of Rule 85(2) EPC.

Further, the evidence available to the Board consisted, as in the present case, of statements from the UK Patent Office and the UK Post Office, both of which confirmed the claims made by the Appellant as to the location and dates of the strike, the statement by the Assistant Comptroller adding that the UK Patent Office would have issued a certificate to the effect that there had been a general interruption, had any national application been involved.

6. The Board in J 11/88 first noted that the evidence from the UK Patent Office had not been available to the first instance. Then it continued: "But it is before the Board of Appeal and it clearly displaces the finding of the Formalities Section that there had been no "general interruption" in the delivery of mail within the meaning of Rule 85(2) EPC." The decision of the first instance was set aside and the Board ordered reimbursement of the surcharge paid under Rule 85(b) EPC.
7. The case now before the Legal Board of Appeal concerns an interruption of mail service in a limited area. To the background belongs the fact that there had been postal strike actions in the United Kingdom earlier in 1988 as well, causing the President of the EPO to issue a notice under Rule 85(2) EPC for the period of 31 August - 17 October 1988 (OJ EPO 1988, 466).

8. In addition to the evidence available to the first instance in the present case, the Appellant has submitted statements by the Royal Mail Letters (dated February 1989 and 6 December 1989) to the effect that there had been a backlog of mail, which was cleared for first class mail by 5 December and for second class mail by 8 December. It also provided a survey of areas where actions had taken place during November and December of that year. In all, 26 different districts are listed in the survey, actions ranging from overtime bans to strikes of one to several days, the longest period occurring in the Nottingham area where the strike lasted between 16 and 24 November, causing 5 000 "days lost" (= number of persons not working over the period).
9. Rule 85(2) EPC does not indicate what is to be understood by the term "general". However, in conformity with the finding in J 11/88, it clearly cannot have been intended to apply only to disruptions of full national extension.

The Receiving Section argues that any small disturbance of local character cannot be allowed to cause an extension of time limits, which would be likely to create intolerable situations of repeated extensions.

However, the Board of Appeal, while recognising the interest of third parties in being able to rely on time limits being honoured, finds irrelevant the fact that series of strikes could lead to repeated extensions of such limits. Each and every disruption which is general extends by operation of law the time limits in question. Nor is it merely a question of whether a disturbance was small or local geographically. What has to be decided is

whether or not the disruption of mail affected those residing in the area in such a way as to render it of general character. In that regard, a number of factors may have to be taken into account. So far as the present case is concerned, the Board first notes that the place of business of the Appellant's representative is located within postal district NG 1, i.e. in central Nottingham, which was at the heart of the affected districts.

Secondly, the Nottingham area is densely populated and commercially important.

Thirdly, the claim made by the Receiving Section that an interruption affecting the London area, especially if it is the area of delivery, would be of general character, does not necessarily mean that strikes affecting other areas as postal collection places could not be considered general, as shown by the facts just referred to.

The Receiving Section further argues that the strike could not qualify as general, because its extent was well-known to the public from the start of the strike actions. The Receiving Section refers in this context to J 11/88, claiming that the disruption there had taken the representative by surprise. It concludes that there is an obligation upon representatives to take whatever steps are necessary to overcome local difficulties.

However, the Board cannot find any reference in this decision to a surprise effect as being relevant. As a matter of fact there is in the decision no indication at all that the payment of the fee had been sent when the strike occurred.

Further, the surprise effect seems not to be a very valid test for establishing generality. As the Appellant

has pointed out - as the decision under appeal also recognised - the fact that he tried to circumvent the strike by using a private service is irrelevant to the question of the nature and extent of the interruption. Given this, whether or not a representative could avoid the effects of the strike cannot be a test under Rule 85(2) EPC. The fact that the interruption had begun three weeks before the critical date of 5 December 1988 does not alter this conclusion. Only where it is established that the public at large was not affected could it be said that the disruption was not general.

The Receiving Section finally asserted (without evidence) that the representative decided to wait until 2 December 1988 to mail the application. The representative has pointed out that he did not wait because he chose to, but because he needed final instructions from his client, a claim which the Legal Board of Appeal has no reason to doubt.

10. From the facts noted above (paragraph 9), the Board draws the conclusion, although it is difficult to set down a general rule for delimiting the concept, that the limited geographical extent of the disruption did not disqualify the interruption as general. The statement by the Assistant Comptroller is a strong indication that it was indeed general in the sense that it was of some magnitude, affecting not only an insignificant area.

Another element to be considered is, however, whether the interruption affected the public in general. A strike which is directed only to disrupt the mail of specifically chosen addressees would not be general in character. Also from this aspect the Nottingham strike was general in nature.

The evidence from the Royal Mail indicates that the strike had far-reaching effects, in that the backlog was only cleared some two weeks after the termination of the strike, and that only a very reduced service could be offered, delivery times for first class mail being about four days.

The Board therefore concludes that there was a general interruption and subsequent dislocation of mail within the meaning of Rule 85(2) EPC. Consequently, the time limit of priority of twelve months calculated from 4 December 1987 extends by operation of law to include 6 December 1988.

#### Article 113

11. Article 113 requires decisions by the EPO to be based only on grounds or evidence on which the parties concerned have had an opportunity to present their comments.

With regard to the correspondence with the UK postal authorities, the Appellant was not given any copies. It does not satisfy Article 113 EPC to have them merely appended to the decision. In this context, it should be noted that not only information to the Office, but also written requests from the Office may be relevant to the parties and therefore should be made available to them. To this should be added that no written notation of the content of telephone conversations seems to have been made, although some reliance appears to have been placed on information obtained in such a way. It is not possible to ascertain to what degree such information finally influenced the decision. What is clear, however, is that such lack of information to the party may prevent him from understanding the context and background of written information which has been sent to him, putting him in a position in which he cannot argue his case in full.

Moreover, the Appellant was not given the opportunity to comment within two months on any of the written evidence collected by the EPO, although in the communication dated 14 June 1989 under Rule 41(3) EPC he was informed summarily of its content.

The Board further notes that the Appellant had offered to submit evidence, to which offer the Office never responded. Finally, it appears from the letter from the Assistant Comptroller that he had provided a copy thereof to the representative. There is no indication in the file that the Office did so itself.

With regard to the correspondence with the Assistant Comptroller, he was asked by the Office to confirm "that the UK Patent Office cannot issue an official notification or an unofficial one, with a content similar to the above letter of the Assistant Comptroller..." (cf. case J 11/88). The Board points out that when official investigations are made by an authority, it should make them in a wholly objective manner. Finally, in the decision under appeal, the Receiving Section does not appear to have taken into account that the Assistant Comptroller stated that investigations had been made before he had replied. He even apologised for the delay this had caused. Nevertheless, the Receiving Section does not appear to have even investigated the material used by the Assistant Comptroller before discounting the value of his statement.

12. Under Rule 84 EPC, where the Convention or the Implementing Regulations specify a period to be determined by the European Patent Office, such a period shall be not

less than two months. This applies i.a. to invitations to comment on evidence presented or on provisional opinions communicated to the parties. The attached sheet to EPO Form 1051 must be considered to be such a provisional opinion.

The fact that a party takes the opportunity to comment regardless of the lack of an invitation does not relieve the Office of its responsibilities to guarantee his right to a fair hearing and due process. The Office must ensure that the party in question has had the opportunity to consider and, if he so desires, to comment upon, all matters relevant to the decision to be given. Although in the circumstances the Appellant did comment, he was not in a position to comment on all of the material in the hands of the Office, some of which constituted important elements of the reasoning in the decision under appeal.

In summary, the Board finds that substantial procedural violations occurred during the handling of this case in the first instance. The Appellant is consequently entitled to reimbursement of the appeal fee.

Order

For these reasons, it is decided that:

1. The decision of the Receiving Section is set aside and the claimed priority of 3 December 1987 is restored.
2. The appeal fee is to be reimbursed.

The Registrar:

*J. Rbe*

The Chairman:

*Kevin Ford*

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2.5.90: *C. Hall*