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D E C I S I O N
of 10 June 1996

Case Number: J 0016/94 - 3.1.1

Application Number: 93203101.6

Publication Number: -

IPC: A61K 38/25

Language of the proceedings: EN

Title of invention:
Method of enhancing mental function

Applicant:
APPLIED RESEARCH SYSTEMS ARS HOLDING N.V.

Opponent:
-

Headword:
Notice of appeal/APPLIED RESEARCH SYSTEM

Relevant legal provisions:
EPC Art. 106(1), 108, 109
EPC R. 64(b), 65

Keyword:
"Form of appeal - admissible (no)"

Decisions cited:
J 0019/90; J 0011/94; J 0027/94; T 0032/81; T 0007/81;
T 0085/88; T 0371/92

Headnote:
For a notice of appeal to comply with Article 108, first sentence, and Rule 64(b) EPC, it must express the definite intention to contest an appealable decision. An appeal filed as a subsidiary request, i.e. subject to the condition that the main request be allowed by the first instance, is therefore inadmissible.



Case Number: J 0016/94 - 3.1.1

DECISION
of the Legal Board of Appeal 3.1.1
of 10 June 1996

Applicant: APPLIED RESEARCH SYSTEMS ARS HOLDING N.V.
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Decision under appeal: Decision of the Receiving Section of the European
Patent Office dated 24 May 1994 according to
which the European application No. 93 203 101.6
shall not be treated as a divisional application.

Composition of the Board:

Chairman: J. Saisset
Members: B. J. Schachenmann
G. Davies

Summary of Facts and Submissions

I. European patent application No. 93 203 101.6, which according to the appellants' request for grant was to be treated as a divisional application based on European patent application No. 89 300 751.8 (parent application), was filed at the British Patent Office on 29 October 1993.

On the same day the appellants dispatched a letter to the European Patent Office approving, in accordance with Rule 51(4) EPC, the text of the parent application.

II. While the approval reached the European Patent Office on 2 November 1993, the appellants were informed by the British Patent Office on 3 November 1993, that their divisional application had been forwarded to the EPO since, pursuant to Article 76(1) EPC, it could only be filed directly with the EPO. The application was received at EPO on 5 November 1993.

III. On 12 January 1994 the Receiving Section of the EPO informed the appellants of the fact that the point of law concerning the time up to which a divisional application could be filed had been referred to the Enlarged Board of Appeal. In order not to prejudice this decision the current official practice would be maintained. Thus, if the appellants requested a decision, it would be decided that the application could not be filed as a divisional application.

IV. By letter of 27 January 1994 the appellants applied for a decision on the matter by the EPO which, on 24 May 1994, decided that application No. 93 203 101.6 could not be treated as divisional application.

V. On 7 July 1994 the appellants filed a letter which contained a plurality of requests and started with the following statement:

"This communication constitutes an application for restoration under the provisions of Article 122 EPC."

The main request put forward in the letter was an application for re-establishment of rights with respect to the "time limit" under Rule 25(1) EPC for filing a divisional application.

As a **first subsidiary request** the letter contained a request for re-establishment of rights by treating the application as having been filed on the date it reached the British Patent Office.

As a **second subsidiary request** the letter contained a notice of appeal against the decision dated 24 May 1994 as well as the statement of grounds of appeal pursuant to Article 108 EPC. More precisely, it was stated in this context:

"In the event the application for restoration is not allowed, I hereby notify the EPO that the applicant (...) appeals against the decision of 24 May 1994 to the extent that the EPO refuses to treat the application as a divisional application (...)", and:

"In the event the application for restoration is allowed I request refund of the appeal fee (...)."

An appeal fee and a fee for re-establishment of rights were paid on 8 July 1994.

VI. In support of these requests the appellants submitted that due to an excusable error on the part of the records manager the divisional application was sent to the British Patent Office. If it had directly been filed at the EPO, it would have reached the office on the same date as the approval of the text of the parent application pursuant to Rule 51(4) EPC.

Moreover, it was argued that the approval had clearly been conditional upon a divisional application having been properly filed. Thus, in fact no valid approval of the text had been given. Reimbursement of the appeal fee was requested on the basis that there had been substantial procedural violations on the part of the EPO in that the appellants' approval of the text should not have been deemed final until at least the date the EPO received the divisional application.

VII. In a letter filed on 6 July 1995 the appellants confirmed these requests and additionally requested that, in the event the Legal Board of Appeal decided to set aside the decision under appeal, the fee for re-establishment of rights be refunded.

VIII. On 11 September 1995, the Legal Board of Appeal issued a communication indicating that according to the appellants' letter of 7 July 1994 the appeal appeared to have been filed conditionally, subject to the rejection of the application for re-establishment for which another department of the EPO was competent. However, an appeal could not be filed subsidiarily depending on the future outcome of other proceedings before the EPO. But even if the appeal were considered to have come into existence and to be admissible, it appeared that it would not have any prospect of success in view of the case law of the Legal Board of Appeal with regard to the filing of divisional applications.

- IX. In their reply of 25 October 1995, the appellants submitted that the letter of 7 July 1994 should be considered both as an independent application for re-establishment of rights under Article 122 EPC (to the Receiving Section) and as an appeal (to the Legal Board of Appeal) against the previous decision of the Receiving Section.
- X. In a second communication annexed to the summons to oral proceedings issued on 18 March 1996, the Legal Board pointed to several passages in the letter of 7 July 1994 indicating that the appeal was made conditional upon the outcome of the pending proceedings before the Receiving Section. The appellants were informed that therefore the first issue to be dealt with at the oral proceedings would be the admissibility of the appeal.
- XI. In a further letter dated 8 May 1996 and at the oral proceedings of 10 June 1996, the appellants made the following requests:
- that the admissibility of the appeal be upheld and the substantive appeal be stayed pending resolution of the application to the Receiving Section for re-establishment of rights;
 - that the application for re-establishment of rights be considered immediately by the Receiving Section.

As to the substance of the appeal, it was requested:

- that the contested decision be set aside and the European patent application No. 93 203 101.6 be treated as a divisional application;
- that the appeal fee be reimbursed pursuant to Rule 67 EPC.

XIII. In support of the admissibility of the appeal the appellants presented substantially the following arguments:

- (i) In decision J 11/94 it was found that for reasons of legal certainty any declaration regarding procedure must be unambiguous which - according to the decision J 27/94 - implies that such declaration must not be subject to any condition leaving it unclear whether or not the EPO could proceed further on the basis thereof. Thus, the test for whether a procedural declaration is or is not unambiguous is whether the declaration was clear enough for the EPO to proceed on the basis thereof. In the circumstances of the present case, the appellants' procedural declarations were perfectly clear enabling the EPO to proceed further on the basis thereof.
- (ii) The test referred to above is to be distinguished from any consideration in a procedural declaration which relates to the order in which several requests should be considered by the EPO. This distinction is illustrated by the practice of the EPO in relation to the consideration of main and subsidiary requests. In the present circumstances it was therefore clear that the

appellants intended the expression "subsidiary request" to relate to the order in which the requests should be considered. By the use of this expression the appellants used the terminology accepted in that context.

- (iii) The receipt of a notification pursuant to Rule 69(1) EPC may make it necessary for the applicant to file several parallel requests concerning different departments of the EPO. However, there is no provision in the Convention requiring that those requests be filed separately.

- (iv) The Convention sets out the minimum requirements for filing an admissible appeal. All these requirements had been met in the present case. It would be against the principle of good faith to impose additional requirements which are not foreseen in the Convention.

Reasons for the decision

1. The appellants maintain that, in spite of their having filed the appeal in the form of a subsidiary request, all the requirements foreseen by the Convention for filing an admissible appeal have been met.

2. According to Rule 65 EPC, an appeal is to be rejected as inadmissible if it does not comply with Articles 106 to 108 EPC and with Rule 1(1) and 64(b) EPC unless each deficiency has been remedied before the relevant time limit laid down in Article 108 EPC has expired.

3. Rule 64(b) EPC, in particular, sets out the minimum content required in a notice of appeal before the expiry of the 2-month time limit of Article 108 EPC. It is not necessary, under this Rule, that the scope of the appeal be expressly stated in the notice of appeal (see eg. decisions T 32/81, OJ EPO 1982, 225; T 7/81, OJ 1983, 98; T 85/88). However, the payment of an appeal fee does not in itself constitute the valid filing of an appeal unless accompanied by a notice of appeal containing an explicit declaration of the intention to file an appeal (see decisions J 19/90, points 2.1 ff of the reasons, not published in the OJ EPO; T 371/92, point 3.5 of the reasons, OJ 1995, 324).

4. One of the main objects of the provisions of Article 108, first sentence, and Rule 64(b) EPC is to provide legal certainty as to whether or not a decision of the EPO is contested. A notice of appeal must not therefore raise or leave doubts whether a party indeed wished to contest a decision by means of an appeal. This is not only important in view of the time limit under Article 108 EPC, first sentence, and the further steps to be taken by the first instance under Article 109 EPC but, in particular, in view of the suspensive effect of pending appeals according to Article 106(1) EPC, last sentence, which may affect the rights of third parties.

This interpretation is in line with the preparatory documents of the EPC concerning the adoption of the 2-month period under Article 108 EPC, first sentence, for filing the notice of appeal. It was argued in this context that "any other party to the case, as well as the general public, have a natural interest in knowing as soon as possible whether the decision of the EPO is contested or not" (see Comments on the preparatory documents: M/15, No. 49, and M/21, No. 9).

Thus, for a notice of appeal to comply with Article 108, first sentence, and Rule 64(b) EPC, it must express the **definite** intention to contest an appealable decision.

5. In the circumstances of the present case, the appellants' letter dated 7 July 1994 (see point V, above) constituted first and foremost an application for re-establishment of rights under the provisions of Article 122 EPC, whereas the appeal was filed as a "second subsidiary request".

In the practice before the EPO, a subsidiary (or auxiliary) request is generally considered as a request which is contingent upon the main request (and possible preceding subsidiary requests) being held to be unallowable (see eg. decision T 153/85, point 2.1.b of the reasons, OJ EPO 1988, 1).

Indeed, the appellants' own statement that they appealed against the decision dated 24 May 1994 of the Receiving Section "in the event the application for restoration is not allowed", is in agreement with the accepted terminology and practice in connection with subsidiary requests.

6. Against this background the legal issue arises whether or not the appellants' declarations in the letter dated 7 July 1994 constituted a notice of appeal complying with the requirements pursuant to Article 108 and Rule 64(b) EPC as set out in point 4, above.

- 6.1 In the Board's view the appellants' letter cannot be understood otherwise than that they wished to have their appeal considered only if the application for re-establishment of rights according to the main and first subsidiary requests was not successful.

6.2 The Board does not share the appellants' view that main and subsidiary requests merely relate to the "order" in which the requests are to be proceeded with by the EPO. According to the practice of the EPO referred to above, a subsidiary request cannot, normally, be considered if the main request or a higher ranking subsidiary request is allowed. A party to the proceedings (as well as third parties) can never be sure whether a subsidiary request will become relevant, at all. Thus, an appeal filed as subsidiary request, i.e. on the condition that a main request is not allowed by the first instance, does not express the definite (but only a conditional) intention of a party to appeal.

6.3 This is confirmed by the appellants' further request that the appeal fee be refunded if the application for re-establishment were to be allowed by the first instance which clearly implies that, in that case, the appeal should not be deemed to have been filed.

6.4 Contrary to the appellants' submissions, their procedural declaration did not enable the EPO to proceed further on the basis thereof. In particular, it remains unclear whether the first instance should have proceeded under Article 109 EPC (interlocutory revision) without previously considering the appellants' main request or should have dealt with the appellants' main request without considering the time limits prescribed for interlocutory revision.

6.5 Thus, the appellants' letter referred to above does not comply with the requirements provided by Article 108 and Rule 64(b) EPC for a notice of appeal. Consequently, the appeal has to be rejected as inadmissible under Rule 65 EPC.

7. None of the other arguments put forward by the appellants have convinced the Board either.

- 7.1 The test proposed by the appellants for whether a procedural declaration is or is not ambiguous does not take into account that a notice of appeal must not only allow the EPO to proceed on its basis but, in particular, be clear and unambiguous to the public which may be affected by the suspensive effect of the appeal. However, as set out above, the procedural declarations in question did not comply with any of these requirements.
- 7.2 The Board accepts that there may be situations in which "parallel" requests concerning different departments of the EPO can be filed in one and the same letter. However, the issue is not relevant here. As set out above, the application for re-establishment and the appeal were not, in the present case, filed as "parallel" requests but clearly as main and subsidiary requests.
8. Since the appeal must be rejected as inadmissible, it cannot be considered as to the substance.
- For the same reason there is no legal basis for ordering reimbursement of the appeal fee.
9. In order to avoid any misunderstanding, it is pointed out that the present decision only refers to the appellants' appeal filed as "second subsidiary request" in the letter of 7 July 1994. The main request and the first subsidiary request contained in that letter constituting an application for re-establishment under Article 122 EPC are still pending and will have to be dealt with by the competent department of the EPO.

Order

For these reasons it is decided that:

The appeal is rejected as inadmissible.

The Registrar:



M. Beer

The Chairman:



J.-C. Saisset