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D E C I S I O N
of 9 October 1995

Case Number: J 0030/94 - 3.1.1

Application Number: 81103893.4

Publication Number: 0040436

IPC: H01L 27/08

Language of the proceedings: EN

Title of invention:
Semiconductor drive

Applicant:
KABUSHIKI KAISHA TOSHIBA

Opponent:

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Headword:

-

Relevant legal provisions:
EPC Art. 21(3)(a) and (c), 109(2)
EPC R. 67

Keyword:
"Jurisdiction of the Legal Board of Appeal"
"Lost interest in the procedure pursuing"
"Request for the file to be closed"
"Reimbursement of appeal fee (yes)"
"Equity"
"Right to fair procedure".
"Legal expectation"
"Principles of good faith"

- **Decisions cited:**
J 0012/86; T 0041/82; D 0002/87; D 0002/88; G 0005/88;
G 0007/88; G 0008/88; J 0002/87; J xxxx/87; J 0010/84;
J 0003/87; J 0001/89; J 0013/90

Headnote:

1. The Legal Board is competent to decide an appeal against a decision of the Examining Division refusing a request for correction of errors in a decision to grant a European patent.
2. The statement "We have lost interest in performing an appeal procedure and request to leave closed the file" constitutes a withdrawal of the appeal.
3. After withdrawal of an appeal a reimbursement of the appeal fee can exceptionally be ordered if the appeal was not remitted to the Board of Appeal within a reasonable time after the first instance decision not to allow it.



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Boards of Appeal

Chambres de recours

Case Number: J 0030/94 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 9 October 1995

Appellant:

KABUSHIKI KAISHA TOSHIBA
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Representative:

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Decision under appeal:

Decision of the Examining Division of the European Patent Office dated 21 May 1987 refusing a request for correction of errors in the decision relating to the grant of European patent application No. 81 103 893.4 pursuant to Article 89 EPC.

Composition of the Board:

Chairman: R. L. J. Schulte
Members: J.- C. Saisset
B. J. Schachenmann

Summary of Facts and Submissions

- I. European patent application No. 81 103 893 4 was filed on 20 May 1981 claiming priority from two Japanese patent applications numbers JP 66971/80 and JP 66972/80 both of 20 May 1980.
- II. After the mention of the grant was published in the European Patent Bulletin 86/18 of 30 April 1986, the patentee filed on 12 June 1986 a request for correction of errors under Rule 89 EPC.
- III. In a decision sent to the patentee on 21 May 1987 the Examining Division refused the request.
- IV. On 22 July 1987 the patentee filed an appeal against this decision, paying the appeal fee on the same day. The statement of grounds of appeal was filed on 21 September 1987.
- V. By fax received in the EPO on 15 December 1994, the appellant sent a reminder in the form of a copy of the notice of appeal.
- VI. From an internal enquiry it appeared that, although received in time by the EPO, the notice of appeal had never been referred to the Boards of Appeal.
- VII. Informed by telephone by the Registry of the Legal Board of Appeal that work on the appeal had finally been started, the appellant replied by letter dated 2 January 1995 that following a period of more than seven years he had lost any interest in pursuing the appeal. He requested only the reimbursement of the appeal fee (DM 680) and for the file to be closed.

Reasons for the Decision

1. The appeal, which is admissible, lies from a decision of the Examining Division of the EPO dated 21 May 1987 refusing a request for correction of errors under Rule 89 EPC. As this decision neither concerns a refusal of a European application nor the grant of a European patent, the Legal Board of Appeal is responsible for examining this appeal under Article 21(3)(c) EPC. The fact that the request for correction relates to a decision to grant a European patent does not alter the competence because what is under appeal is the decision to refuse a request for correction and not the decision to grant a patent.

2. The appellant has stated that because the appeal proceedings have been outstanding for so long he has lost any interest in pursuing the appeal. As he has requested that the file should be closed, the Board concludes that the decision of the Examining Division is no longer contested and thus has become final. Consequently, the appeal has to be considered as withdrawn.

3. With regard to the request for reimbursement of the appeal fee, Rule 67 EPC states that such reimbursement shall be ordered in the event of interlocutory revision or where the Board of Appeal deems an appeal to be allowable if the reimbursement is equitable by reason of a substantial procedural violation. When appeal proceedings are terminated by the withdrawal of the appeal, Rule 67 EPC is not applicable (J 12/86, OJ 1988, 83; T 41/82, OJ 1982, 256 (point 6); D 2/87 and D 2/88, OJ 1989, 448).

- 3.1 However, in the particular circumstances of the present case, the Board is of the opinion that the question of reimbursement of the appeal fee has to be examined on the basis of equity.
- 3.2 Since, due to the withdrawal of the appeal, Rule 67 EPC is not applicable, it can be left open whether the mere fact that the appeal has not been remitted to the Board of Appeal without delay constituted a substantial procedural violation. In the present case the Board considers that the delay did not directly cause a loss of right to the patentee. Moreover, although this delay mainly resulted from an error of the EPO which did not start considering the appeal until an unreasonable period of time had elapsed, the appellant also remained passive for several years.
- 3.3 However, an appellant has a right to a fair procedure. This principle includes the obligation of the EPO to handle filed appeals with due care. Pursuant to Article 109(2) EPC, an appeal, if it is not allowed within one month after receipt of the statement of grounds, shall be remitted **without delay**. The Convention is silent about the consequences if the appeal is only remitted with a considerable delay. In the view of the Board, Article 109(2) EPC creates a legitimate expectation of the parties to the proceedings that an appeal is remitted to the Board of Appeal within a reasonable time after the first instance's decision not to allow the appeal. The EPO clearly offended against this legitimate expectation in the present case because the appeal was only referred to the Board of Appeal seven years after its filing. In conformity with the principles of good faith governing the relations between the EPO and the applicants for European patents (see Enlarged Board G 5, G 7, G 8/88, OJ

1991,137 (point 3.2 of Reasons); J 2/87, OJ 1988,330;
J xxx/87, OJ 1988,323; J 10/84, OJ 1985,71; J 3/87,
OJ 1989,3; J 1/89, OJ 1992,17; J 13/90, OJ 1994,456),
such a delay cannot be regarded as being reasonable.
Therefore the Board is of the opinion that it is
equitable under these exceptional circumstances to
order the reimbursement of the appeal fee.

Order

For these reasons it is decided that:

The reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:



M. Beer



R. Schulte