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D E C I S I O N
of 26 October 1998

Case Number: J 0027/97 - 3.1.1
Application Number: 95906779.4
Publication Number: WO 95/19316
IPC: B66D 1/10
Language of the proceedings: EN

Title of invention:
Balancing hoist and material handling system

Applicant:
D. W. Zimmerman Manufacturing, Inc. et al

Opponent:
-

Headword:
Notification/D. W. ZIMMERMAN

Relevant legal provisions:
EPC Art. 119, 133(2)
EPC R. 65, 69, 77(1), 78(2), 82, 85a(1), 85b, 104b

Keyword:
"Notification by ordinary letter"
"Notification deemed to have been made when despatch has taken place"
"No regular notification by facsimile transmission"

Decisions cited:
J 0009/96, J 0030/96, J 0032/97

Headnote:
Facsimile transmission does not comply with the form notification has to take under Rule 77(1) EPC. The irregularity of such transmission is not cured by the fact that the facsimile of a document has reached the addressee (Rule 82 EPC).



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Boards of Appeal

Chambres de recours

Case Number: J 0027/97 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 26 October 1998

Appellants:

D. W. Zimmerman Manufacturing, Inc.
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**Common
representative:**

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Decision under appeal:

Decision of the Receiving Section of the European
Patent Office posted on 13 January 1997 according
to which the European patent application
No. 95 906 779.4 was deemed to be withdrawn.

Composition of the Board:

Chairman: J.-C. Saisset
Members: B. Schachenmann
S. Perryman

Summary of Facts and Submissions

I. The appellants, a company and its president both having their place of business and residence respectively in the USA, are applicants of Euro-PCT application No. 95 906 779.4 (Int. publication No. WO 95/19316). On 13 October 1995, the due date for performing the acts for entering the regional phase before the EPO, the appellants had still not appointed a European professional representative.

II. The EPO file contained copies of communications under Rule 85a(1) and 85b EPC date stamped 17 April 1996 and addressed to the applicant first named in the application. Other than the file copies themselves there was no record in the EPO file that the originals had been despatched as ordinary letters under Rule 78(2) EPC.

By communication pursuant to Rule 69 EPC of 25 June 1996 the EPO notified the appellants that their application was deemed to be withdrawn because the national basic fee, the search fee and the designation fees were not paid within the time limits specified in Rules 104b(1) and 85a EPC.

III. On 4 July 1996 a first European professional representative wrote to the EPO on behalf of the appellants asking for copies of any communications it had issued setting a date on which the fees referred to above may be paid late with surcharge. By facsimile transmission of the same date the EPO provided the representative with copies of the file copies of the communications under Rule 85a(1) and 85b EPC.

- IV. On 16 August 1996 the appellants' present professional representative submitted that the finding of the EPO was inaccurate and applied, as main request, for a decision on the matter under Rule 69(2) EPC. As auxiliary request an application for restitutio in integrum was filed with respect to the time limits for performing the acts for entering the regional phase before the EPO. On 19 August 1996 all the necessary fees including the surcharges were paid.
- V. In support of the main request sworn declarations of the second applicant (in his capacity as president of the first applicant) and his secretary were filed attesting that the communications concerning the periods of grace under Rules 85a(1) and 85b EPC were never received. Only upon reading the Rule 69(1) EPC communication did the applicants learn that such communications were issued. However, there was no record in the EPO file of when or by whom the posting of these communications was performed. As the postal service between Germany and the United States was reliable, it had to be assumed therefore that the EPO had failed to despatch them as required by Rule 78(2) EPC so that the grace periods under Rules 85a(1) and 85b EPC had not yet started.
- VI. In its decision dated 13 January 1997 the Receiving Section of the EPO upheld its communication pursuant to Rule 69 EPC and rejected the application for restitutio as inadmissible. Consequently, it came to the conclusion that the application was deemed to be withdrawn.

With respect to the main request the Receiving Section found that the EPO merely had to ascertain whether there were any irregularities apparent from the file as concerns the despatch of the communications under

Rule 85a(1) and 85b EPC. From the fact that no such irregularities could be seen, it was concluded that there was no reason to assume that these communications were not despatched.

The application for restitutio was rejected as inadmissible on the grounds that pursuant to Article 122(5) EPC and the jurisprudence of the Enlarged Board of Appeal the periods of grace under Rule 85a(1) and 85b EPC and the corresponding basic time limits were excluded from re-establishment of rights.

VII. The appellants lodged an appeal against the decision referred to above. They requested that

1. the decision under appeal and the communication pursuant to Rule 69(1) EPC be set aside,
2. it be decided that the application was not deemed withdrawn, or
3. as auxiliary request, it be decided that the applicants had their rights re-established.

VIII. In their statement of grounds the appellants primarily criticized the finding of the Receiving Section that since no irregularities could be seen from the file "there was no reason to assume that the corresponding communications to the applicant were not despatched". The Receiving Section had thereby disregarded the undisputed evidence of the appellants that the communications were not received and had offered no evidence that the communications were in fact despatched. According to Rule 78(2) EPC notification was deemed to have been made when despatch has taken place, i.e. once a letter was handed over to the postal service. However, at the time a communication and the

copy thereof were date stamped despatch had not yet taken place because the communication was still in the hands of a member of the EPO. Thus, it could not be excluded with the required degree of certainty that the communications had been lost within the EPO before they were despatched.

Further arguments concerned re-establishment of rights and alleged violation of certain provisions of the PCT.

Reasons for the Decision

1. The appeal complies with the requirements under Rule 65(1) EPC and is therefore admissible.

2. According to Article 119 and Rule 78(2) EPC notifications in respect of addressees not having either a residence or their principal places of business within the territory of one of the Contracting States and who have not appointed a representative in accordance with Article 133(2) EPC shall be effected by ~~posting the document to be notified as ordinary letter.~~
In such cases, notification will be deemed to have been made when despatch has taken place, even if the letter is returned to the sender owing to the impossibility of delivering it to the addressee.

The appellants, both having their place of business or residence in the US, had not yet appointed a European professional representative when the EPO had to issue the communications under Rule 85a(1) and 85b EPC. Thus the EPO was correct in following the procedure of Rule 78(2) EPC for notification of these communications.

3. However, the appellants make the point that in the circumstances of the present case there was no proof of the despatch of the communications in question by the EPO, which was a precondition for applying the legal fiction of deemed notification under Rule 78(2) EPC.

The appellants asserted already in the proceedings before the department of first instance that they never received the communications under Rule 85a(1) and 85b EPC at their registered address in the USA. This was confirmed by two sworn declarations. The Board has no reason to question these assertions and declarations, all the more so, as the first instance did not contest them, either. It cannot be excluded therefore that the communications were lost at some stage within the EPO before they were despatched to the post-office. The fact that date-stamped copies of the communications are present on the file, cannot of itself be treated as proof that the originals thereof, after having been generated in the Receiving Section, were indeed handed to the internal postal service, or that the internal postal service duly despatched them to the post-office (see point 7 of the decision J 9/96 of 27 November 1997).

4. Thus, according to the constant jurisprudence of the Legal Board (J 9/96, J 30/96, J 32/97), it cannot be assumed in such circumstances that despatch of the original communications under Rule 85a and 85b EPC indeed has taken place. As a consequence notification cannot be deemed to have been made under Rule 78(2) EPC.

5. However, as follows from the file, the EPO had transmitted copies of these communications by facsimile to the appellants' first representative on 4 July 1996 (see point III, supra). If such transmission were a valid notification, the periods of grace pursuant to

Rules 85(1)a and 85b EPC might arguably have been considered as expiring already on Monday, 5 August 1996, i.e. before the acts under Rule 104b EPC were completed on 19 August 1996.

Article 119 EPC provides that the EPO shall, as a matter of course, notify those concerned of any communication from which a time limit is reckoned. According to Rule 77(1) EPC any such notification shall take the form either of the original document, a copy thereof certified by, or bearing the seal of, the EPO or a computer print-out bearing such seal. In the circumstances of the present case, the facsimile transmission of 4 July 1996 obviously was neither the original document nor a copy certified by the EPO or bearing its seal. Moreover, facsimile transmission is not mentioned in Rule 77(2) EPC as a way in which notification shall be made. As concerns in particular Rule 77(2)(d), the President of the EPO did not yet make use of the authorization to determine technical means of communication to effect notification. Thus, the facsimile transmission in question cannot be considered as regular notification within the meaning of Article 119 and Rule 77 EPC.

In this context the further question arises whether the mentioned irregularities in the notification could be regarded as cured under Rule 82 EPC. According to this provision, notification shall be deemed to have been made if the document to be notified, i.e. the original document or a copy certified by the EPO or a copy bearing its seal (Rule 77(1) EPC), has reached the addressee. Since, as set out above, this was not the case here, the irregularities of notification were not cured in accordance with Rule 82 EPC with the effect that the facsimile transmission of 4 July 1996 was no valid notification of the communications under Rule 85a(1) and 85b EPC.

6. As a summary of the above, the Board comes to the conclusion that notification of the communications in question cannot be deemed to have taken place. Since, in the meantime, the appellants paid the fees due to Rule 104b EPC together with the surcharges provided for in Rules 85a(1) and 85b EPC, it is not necessary for the EPO to issue new communications pursuant to these Rules.

The appellants' main request being allowable, their auxiliary request needs no further consideration.

Order

For these reasons it is decided that:

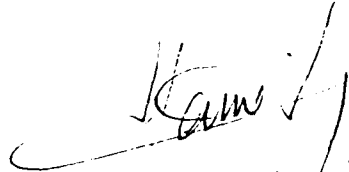
1. The decision under appeal is set aside.
2. The case is remitted to the Receiving Section for further prosecution.

The Registrar:



M. Beer

The Chairman:



J.-C. Saisset

Z. Sch.