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D E C I S I O N
of 15 October 1998

Case Number: J 0037/97 - 3.1.1

Application Number: 92913812.1

Publication Number: 588944

IPC: G01S 13/80

Language of the proceedings: EN

Title of invention:

"An improved miniature transponder device"

Applicant:

Algernon Promotions, Inc.

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 106, 108

EPC R. 67

Keyword:

"Decision subject to appeal - no"

"Reimbursement of the appeal fee - no"

Decisions cited:

G 0008/91, J 0021/80, J 0013/83, J 0012/86, J 0029/92,

J 0002/93, J 0024/94, T 0041/82, T 0323/87, T 0324/90,

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: J 0037/97

D E C I S I O N
of the Technical Board of Appeal 3.1.1
of 15 October 1998

Appellant: Algernon Promotions, Inc.
Apartadeo 4725
Panama 5 (PA)

Representative: Witte, Alexander, Dr.-Ing., et al.
Witte, Weller, Gahlert, Otten & Steil
Patentanwälte
Rotebühlstrasse 121
70178 Stuttgart (DE)

Art under appeal: Communication of the Examining Division of the
European Patent Office posted 4 November 1997
informing the applicants of the cancellation of
the intended publication of the mention of grant
of European patent application No. 92 913 812.1.

Composition of the Board:

Chairman: J.-C. Saisset
Members: B. Schachenmann
A. Lindqvist

Summary of Facts and Submissions

- I. Algernon Promotions Inc. are the applicants of European patent application No. 92 913 812.1. On 7 November 1997 the applicants filed an appeal against a communication of the Examining Division dated 4 November 1997. The appeal fee was paid at the same time. The communication informed the applicants of the cancellation of the intended publication of the mention of the grant. The cancellation of the publication was a consequence of the suspensive effect of a previous appeal by a third party against a decision of the Legal Division rejecting a request for suspension of proceedings for grant under Rule 13 EPC.

- II. In a communication dated 5 December 1997 the Legal Board of Appeal informed the applicants (appellants) that their appeal of 7 November 1997 appeared to be inadmissible since it did not lie from an appealable decision.

- III. In response the appellants withdrew their appeal by letter of 18 December 1997. At the same time they requested reimbursement of the appeal fee "under Rule 67 EPC". According to their submission reimbursement was justified by the fact that they had not received from the EPO "the basis" for the cancellation of the announced publication of the mention of the grant. In their view, this amounted to a procedural violation.

- IV. On 16 January 1998 the Board informed the appellants that the appeal fee could not be refunded and pointed to decision T 41/82 setting out the situations in which reimbursement of the fee was (or was not) possible. In particular, if an appeal was withdrawn the appeal fee could not be reimbursed on the basis of Rule 67 EPC.

- V. By letter dated 2 March 1998 the appellants maintained their request for reimbursement of the appeal fee submitting that, since the appealed communication of 4 November 1997 did not constitute a decision, their letter dated 7 November 1997 could not have been an appeal. Thus, no appeal had come into existence and the fee was paid without reason.

Reasons for the Decision

1. From the facts set out above, it follows that the appellants no longer base their request for reimbursement of the appeal fee on Rule 67 EPC. Indeed, reimbursement of the appeal fee according to that provision could only be ordered if the appeal was deemed to be allowable. However, since the appellants withdrew their appeal, the proceedings have been terminated without decision. Nonetheless, the appellants are of the opinion that the appeal fee should be reimbursed on the ground that their appeal never came into existence since it was filed against a communication which clearly did not constitute an appealable decision.
2. Before considering this issue, it has to be examined whether, after withdrawal of the appeal, the Board still has the power to decide on a request for reimbursement of the appeal fee.

According to the jurisprudence of the Boards, appeal procedures are terminated, as far as the substantive issues are concerned, when the sole appellant withdraws the appeal (G 8/91, OJ EPO 1993, 346). However, the

Boards, in the exercise of their inherent original jurisdiction, still have to decide on requests concerning procedural questions arising from the former proceedings (see e.g. T 41/82, OJ EPO 1982, 256).

The appellants' letter withdrawing the appeal contained a request for reimbursement of the appeal fee. This cannot be interpreted otherwise than as an expression of the appellants' wish to have their request for reimbursement examined irrespective of the withdrawal of the appeal. Thus, the appellants' procedural request still has to be examined by the Board.

3. In the appellants' submission, since the communication of 4 November 1997 did not constitute a decision, their letter of 7 November 1997 could not be an appeal. Thus, the appeal fee was paid without any legal reason and had to be reimbursed.

Indeed, according to the jurisprudence of the Boards of Appeal, the appeal fee would have to be reimbursed if the appeal never existed. On the other hand, it could not be refunded if the appeal was inadmissible within the meaning of Rule 65 EPC as stated by the Board in its first communication (see e.g. J 21/80, OJ EPO 1981, 101; J 12/86, OJ EPO 1988, 83; T 41/82, OJ EPO 1982, 256; T 323/87, OJ EPO 1989, 343; T 324/90, OJ EPO 1993, 33, point 9 of the reasons)

4. Thus, it is crucial to the fate of the appellants' request whether the present appeal came into existence or not. Only in the latter case the appeal fee could be reimbursed.

- 4.1 In previous decisions the Legal Board found that appeals filed against documents which were not decisions within the meaning of Article 106(1) EPC had to be rejected as inadmissible with the implication

that the appeal had come into existence (J 13/83; J 29/92; J 2/93, OJ EPO 1995, 675; J 24/94). However, these decisions did not explicitly discuss the question raised by the appellants in the present case.

4.2 The issue of inadmissibility of an appeal is governed by Rule 65 EPC according to which the Board of Appeal shall reject an appeal as inadmissible if it does not comply with Articles 106 to 108 and with Rule 1, paragraph 1, and Rule 64, sub-paragraph (b). Since Article 106(1) EPC defines the acts from which an appeal shall lie, it can be concluded from Rule 65 EPC that any appeal which, as the present one, does not comply with the provision of Article 106(1) EPC has to be rejected as inadmissible.

Obviously, the appellants do not share this view. In their submission, an appeal filed against an act of the Examining Division which was not an appealable decision under Article 106(1) EPC could, by definition, not be considered as an existing appeal. Under this assumption Rule 65 EPC, referring to existing appeals only, did not apply.

4.3 However, it appears that the appellants did not sufficiently take account of the procedural context of an appeal within the framework of the Convention.

Article 106(1) EPC refers to the decisions from which an appeal shall lie. This provision corresponds to Article 21(1) EPC defining the jurisdiction of the Boards of Appeal. Thus, the issue of whether or not a document emanating from a department of the EPO is an appealable decision rather concerns the jurisdiction of the Boards of Appeal to hear a case than the question of whether an appeal has come into existence.

Before entering into the substance of a case, it is incumbent on a Board appointed under Article 21 EPC to consider its jurisdiction to hear the case brought before it. However, the examination of the issue necessarily implies that the case is pending before that Board meaning that it is in existence in a legal sense. Thus, the examination under Article 106(1) EPC by that Board in fact presupposes an existing appeal, an issue which mainly concerns the compliance with the formal requirements under Article 108, first and second sentence, EPC.

- 4.4 Thus, from the fact that the present Board came to the opinion that the document under appeal was not an appealable decision within the meaning of Article 106(1) EPC, it cannot be concluded that the appeal was not in existence. On the contrary, such examination by the Board was only sensible for an appeal which was in existence since it indeed complied with the formal requirements pursuant to Article 108 EPC.

Consequently, according to the above considerations, the appeal fee cannot be refunded.

Order

For these reasons it is decided that:

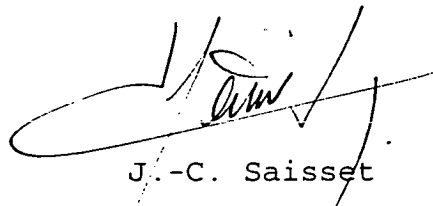
The request for reimbursement of the appeal fee is rejected.

The Registrar:



M. Beer

The Chairman:



J.-C. Saisset