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**DECISION**  
**of 17 September 2002**

**Case Number:** T 0846/01 - 3.5.1  
**Application Number:** 87904043.4  
**Publication Number:** 0296175  
**IPC:** H04L 27/02, H04L 5/02,  
H04L 27/28, H04B 7/005  
**Language of the proceedings:** EN

**Title of invention:**

Method and installation for digital communication,  
particularly between and toward moving vehicles

**Patentee:**

France Telecom, et al

**Opponent:**

Robert Bosch GmbH  
Interessengemeinschaft für Rundfunkschutzrechte e.V.

**Headword:**

Digital broadcast system/FRANCE TELECOM

**Relevant legal provisions:**

EPC Art. 106, 107, 108, 125  
EPC R. 64, 65(1), 67

**Keyword:**

"Admissibility of appeal (no)"  
"Reimbursement of appeal fee (no)"

**Decisions cited:**

G 0001/88, G 0005/88, G 0007/88, G 0008/88, T 0239/97,  
T 0636/97

**Catchword:**

For an appeal to be admissible, at least one of the grounds in the written statement of grounds of appeal must relate to a point which could at least arguably have been decided in the appellant's favour by the instance appealed from but which point had not been so decided, and such favourable decision on this point would have produced a different outcome.



Case Number: T 0846/01 - 3.5.1

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.1  
of 17 September 2002

**Appellants:** Interessengemeinschaft  
(Opponent 02) für Rundfunkschutzrechte e.V.  
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**Representative:** Eichstädt, Alfred, Dipl.-Ing.  
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**Respondent:** FRANCE TELECOM  
(Proprietor of the patent) 6, Place d'Alleray  
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**Representative:** Fort, Jacques  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
6 June 2001 concerning maintenance of European  
patent No. 0296175 in amended form.

**Composition of the Board:**

**Chairman:** S. V. Steinbrener  
**Members:** S. C. Perryman  
R. S. Wibergh

## **Summary of Facts and Submissions**

- I. In opposition proceedings on the patent in suit, by a decision given at oral proceedings on 5 December 1996 with written reasons posted 27 December 1996, the Opposition Division revoked the patent.
- II. The proprietors (now respondents) appealed, and at oral proceedings on 11 October 2000 in appeal proceedings T 239/97 asked that said decision be set aside and that the patent be maintained on the basis of claims 1 to 6 filed by fax dated 11 September 2000 (main request) or on the basis of claims 4 to 6 as filed by said fax (auxiliary request). At those oral proceedings, with written reasons posted 4 December 2000, this Board (in a different composition to the present) made the order that the decision under appeal was set aside, and that the case was remitted to the first instance with the order to maintain the patent in accordance with the proprietors' auxiliary request.
- III. By a communication pursuant to Rule 58(4) EPC dated 13 February 2001, the Opposition Division indicated to the parties the documents on which it intended to maintain the patent. The respondents indicated their agreement to this text by letter dated 2 March 2001. The appellants submitted no comments on the text. The only request that the appellants made after the decision of the Board of Appeal of 11 October 2000, was to receive copies of the amended pages 4 and 7 of the text referred to in the communication dated 13 February 2001 of the Opposition Division. According to the file these were sent with a communication dated 21 February 2001.

IV. By an interlocutory decision issued on 6 June 2001 the Opposition Division decided that account being taken of the amendments made by the patent proprietors during the opposition proceedings, the patent and the invention to which it related were found to meet the requirements of the convention, and indicated the currently valid documents. The reasons for the decision given were:

- "1. This decision follows an order of the Board of Appeal (Case T 0239/97). In that decision the Board agreed with the conclusion of the Opposition Division that the subject-matter of claims 5-7 as granted (ie claims 4-6 of the auxiliary request filed in the appeal procedure and now claims 1-3) meets the requirements for novelty and inventive step; the reasons had been set out in the reasoned decision of the Opposition Division dated 27.12.96, point 6.
2. Amendments carried out by the Opposition Division to renumber the claims and to adapt the description (Rule 27(1)(c) EPC) have been approved by the proprietor. The Opponent has had the opportunity to comment on these amendments.
3. It is therefore decided that the documents as amended in the opposition procedure meet the requirements of the EPC. It is therefore intended to maintain the patent in amended form (Article 102(3) EPC)."

- V. In the present appeal the appellants filed a notice of appeal on 13 July 2001, asking that the interlocutory decision of the Opposition Division of 6 June 2001 be set aside, the granted patent be revoked completely, and as an auxiliary request that oral proceedings be appointed. In the grounds of appeal filed on 10 October 2001, the appellants indicated *inter alia* that the auxiliary request for maintaining the patent allowed by the Board of Appeal at the oral proceedings on 11 October 2000 was first put forward at those oral proceedings, and discussed why the prior art was considered to justify revocation of the patent.
- VI. In a communication dated 4 January 2002, the Board of Appeal indicated its provisional opinion that the appeal was inadmissible, because no complaint was made about the adaptation of the description or the renumbering of the claims, the only issues left to the Opposition Division to decide by the earlier decision of the Board of Appeal.
- VII. In a letter received 13 February 2002, the respondents requested that the appeal be rejected as inadmissible, also on the grounds that the issues raised in the grounds of appeal had already been discussed before the Opposition Division and at the oral proceedings before the Board of Appeal on 11 October 2000 and the then auxiliary request could not have taken the appellants by surprise. If the proceedings should be continued, the respondents requested an apportionment of costs under Article 104 EPC by reason of the appellant's failure to submit documents or discuss issues at the appropriate stage earlier in the proceedings.

VIII. By a letter received 14 May 2002, the appellants further referred to the forms accompanying the decision under appeal, and the principle of fulfilment of reasonable expectations (Vertrauensschutz) as justifying their appeal, and asked for repayment of the appeal fee if the appeal was found inadmissible.

IX. In a further communication dated 27 May 2002, the Board indicated that its provisional view that the appeal was inadmissible remained unchanged. The sheets attached to the opposition division's decision could not give rise to a reasonable expectation that an issue already finally decided on appeal could be re-opened. Oral proceedings, at which the sole issue to be discussed was that of the admissibility of the appeal, would be appointed. As admissibility of the appeal was a completely new issue, on which any party was entitled to be heard at oral proceedings it was thus likely that pursuant to Article 104 EPC the ordinary rule as to costs, namely that each party should meet its own costs for attending those oral proceedings would be considered appropriate. Oral proceedings took place on 17 September 2002.

X. The arguments submitted by the appellants can be summarized as follows.

- The cover sheet of the decision under appeal stated:

"The Opposition Division has decided:  
Account being taken of the amendments made by the patent proprietor during the opposition proceedings, the patent and the invention to which

it relates are found to meet the requirements of the Convention."

The second sheet of the decision under appeal stated:

"Possibility of appeal

This decision is open to appeal. Attention is drawn to the attached text of Articles 106 to 108 EPC."

In view of these statements, every client would have believed that the question of whether the invention met the requirements of the Convention was still open to appeal. Whereas the representative as an attorney knew of the principle that no appeal was possible against something finally decided, he was surprised to receive an interlocutory decision in which the Opposition Division was expressly allowing an appeal. Trusting in this statement an appeal was accordingly filed.

- The principles of good faith and the protection of legitimate expectations (Vertrauensschutz) had been accepted as generally recognized among the Contracting States, and as part of the law to be applied by the EPO (G 5/88, G 7/88 and G 8/88 (OJ EPO 1991, 137)), and governed relations between the EPO and its users. It would be a breach of these principles if the present appeal, filed in reliance on the statements appearing in the decision under appeal that an appeal was possible, were to be found inadmissible. The principles already required that an applicant who responded



to an ambiguous communication from the EPO could not be penalized if he was misled into taking the wrong action. The communication here was not ambiguous: it stated explicitly that an appeal was possible.

- All the formal requirements were met. The decision of 6 June 2001 was a decision of an Opposition Division, and an appeal against this was admissible under Article 106(1) EPC. The appellants were adversely affected, as their request for complete revocation had not been met. The notice of appeal had been filed within the 2 month time limit of Article 108 EPC, the fee had been paid within this time limit, and written grounds of appeal had been filed within the 4 month time limit set by Article 108 EPC. Thus all the requirements of Articles 106-108 EPC for an appeal to be admissible had been fulfilled.
- Both fulfilment of all the formal requirements, and the principle of the protection of reasonable expectations required that the appeal be found admissible.

XI. The arguments submitted by the respondents can be summarized as follows.

- The printed annexed sheet to the decision of 6 June 2001 indicated that an appeal was allowable. This did not however mean that anything could be the subject of this appeal, rather one had to look at what had been decided by this decision, and

this was only the renumbering of the claims and the adaption of the description.

- An appeal which did not relate at all to what had been decided by the decision of 6 June 2001, but only to what the Board of Appeal had decided earlier was clearly inadmissible.
- It would be to open Pandora's Box to allow appeals against a Board of Appeal decision.
- The principle of the protection of legitimate expectations could not be relied on to create a right the opponent never had. In decision T 239/97 of 11 October 2000 the Board of Appeal had decided the issue of the validity of the subject matter of the claims and this decision had become legally binding as of that date. This issue was not open to reconsideration by the Opposition Division, and no statement made by them could re-open the question.
- Merely looking at the cover sheets with their standard wording in isolation was inappropriate. If the whole text of the decision was looked at it was clear that in their decision of 6 June 2001, the only matters then newly decided on by the Opposition Division were the renumbering of the claims and the adaption of the description, and only this could have been appealed.
- The claims as maintained by the Appeal Board Decision of 11 October 2000, were included in the granted claims, and the appellants had the

opportunity to state all their objections to them already in the original opposition proceedings and the first appeal proceedings. They could not have been taken by surprise by these claims, and there was no reason to afford them any further opportunity to dispute their validity.

XII. The appellants requested that the appeal be declared admissible, or else that the appeal fee be reimbursed.

The respondents requested that the appeal be rejected as inadmissible.

XIII. At the end of the oral proceedings the decision of the Board was announced.

## **Reasons for the Decision**

### Admissibility of appeal

1. As laid down in Rule 65(1) EPC, an appeal shall be rejected as inadmissible unless it complies with the requirements of Articles 106 to 108 and with Rule 1, paragraph 1, and Rule 64, subparagraph (b) EPC before the relevant time limit laid down in Article 108 EPC has expired. In defining the persons entitled to appeal, Article 107 EPC states that any party **adversely affected by a decision** may appeal. The underlined words mean that the appellant must be adversely affected because some point which could have been decided in his favour by the instance appealed from had not been so decided, and such favourable decision on this point would have produced a different outcome. In this

- context, it has to be noted that the "fact that an opponent has failed within the time allowed, to make any observations on the text in which it is intended to maintain the European patent after being invited to do so under Rule 58(4) EPC does not render his appeal inadmissible" (see G 1/88; OJ EPO 1989, 189).
2. Article 108 EPC third sentence requires that within four months after the date of notification of the decision, a written statement setting out the grounds of appeal must be filed. For grounds in a written statement to fulfil this requirement of being grounds of appeal, at least one of the grounds must at least arguably relate to some point by which the appellant was adversely affected by the decision under appeal, that is relate to a point material to the outcome which could at least arguably have been decided in the appellant's favour by the instance appealed from but which point had not been so decided. An appeal cannot be an excuse for requesting consideration of points which the instance appealed from was not entitled to consider. If the written grounds filed relate only to such points the requirement of Article 108 EPC for written grounds of appeal is not fulfilled and the appeal must be rejected as inadmissible.
  3. The decision under appeal here makes clear (see point III above) that the Opposition Division has merely decided on the numbering of the claims, and the adaption of the description, but that the decision that the subject matter of the claims complies with the requirements of novelty and inventive step is that of the earlier Appeal Board decision T 239/97 of 11 October 2000. The grounds of appeal make equally

clear that the appellants have no complaint about the renumbering of the claims or the adaptation of the description as done by the Opposition Division, but are only seeking to re-open the issue of validity of the claims which has already been decided in the earlier Appeal Board decision T 239/97 of 11 October 2000. This decision took full legal effect already on 11 October 2000. Both on the ground that Article 106 EPC makes no provisions for appealing from a decision of a Board of Appeal, and by reference to the principle of *res judicata*, a principle generally recognized in the Contracting States, and thus to be taken into account under Article 125 EPC, this decision T 239/97 was not open to challenge in the subsequent continuation of proceedings before the Opposition Division and cannot be open to challenge in the present proceedings.

4. The Board agrees with the appellants that the principles of good faith and the protection of legitimate expectations (*Vertrauensschutz*) are generally recognized among the Contracting States, and are part of the law to be applied by the EPO (cf Enlarged Board of Appeal Decisions G 5/88, G 7/88 and G 8/88 (OJ EPO 1991, 137)), and govern relations between the EPO and its users. However the principle is that the EPO must not mislead the user to act to his detriment. In the situation considered in the above Enlarged Board Decisions, there was an established and published practice of the EPO that documents, including oppositions, intended for the EPO but filed at the German Patent Office in Berlin would be treated as filed as of that date at the EPO. This practice was found to have no legal basis, but yet the principles of good faith and the protection of legitimate

expectations required the EPO to treat a user who had relied on the published practice as if he had filed the documents at the EPO itself at that date. The established and published practice of the EPO itself caused the user take the wrong procedural steps instead of the right ones, at a time when taking the correct steps would still have been open to the user. The EPO could not then refuse to recognize as valid the procedural steps the EPO's own published practice had caused the user to adopt, even though the published practice had no legal basis. The legitimate expectation is that the EPO will not mislead users to their detriment. There can be no legitimate expectation that a statement by the EPO can be relied on as overriding existing law so as to alter an already existing legal situation in one's favour and to the disadvantage of another party.

5. In the present case, by way of contrast, after the decision of the Board of Appeal of 11 October 2000 was announced, there was no procedure by which the appellants could have appealed this decision. Not even the appellants have alleged that there was any established or published practice that Board of Appeal decisions could be appealed. Even if a subsequent communication from the EPO was truly such as reasonably to make the applicants believe that they could appeal, and they did so appeal the only identifiable detriment to them would be the time they wasted on filing such an appeal and the payment of the appeal fee. The principle of the protection of legitimate expectations can at best be used to compensate for a detriment suffered by a user. A misstatement by the EPO cannot retrospectively confer a right the user had not till

then had: this is a quite different situation to that of a misstatement causing a user to take the wrong action and thereby lose a right he was in possession of at the time of the misstatement. In the present case the only possible relevance of the principle of the protection of legitimate expectations is to the question of reimbursement of the appeal fee, and this is dealt with in the section below on reimbursement.

6. Given that the written grounds of appeal thus only relate to points which the Opposition Division was not entitled to consider, the appeal must be rejected as inadmissible.

*Reimbursement of the appeal fee*

7. The reasons in the decision under appeal state that the Opposition Division was concerned only with renumbering the claims and adapting the description, but that novelty and inventive step of the subject matter of the claims had already been decided by the earlier decision of the Board of Appeal agreeing with the reasoning of an earlier decision of the Opposition Division. The Board can see nothing here which could have given rise to any expectation that the notification concerning the possibility of appeal related to anything beyond the decision of the Opposition Division as to renumbering the claims and adapting the description, and certainly nothing suggesting that issues dealt with in these earlier decisions could be re-opened in any appeal. Admissible appeals concerning a decision of an opposition division relating solely to adaption of the description are occasionally filed (see eg T 636/97 of 26 March 1998, not published in OJ EPO), so that the

standard reference to the possibility of an appeal is necessary.

8. The Board cannot see that the communication of the Opposition Division decision of 6 June 2001 affords any reasonable basis for an expectation that an appeal re-opening the questions already decided in the earlier Board of Appeal decision is possible. Any detriment to the appellants caused by filing an inadmissible appeal results from their own mistaken interpretation, and not from anything written by the EPO. Thus there is here no case for reimbursement of the appeal fee outside the provisions of Rule 67 EPC based on some application of the principle of the protection of legitimate expectations.
9. Nor does the Board see here any procedural violation such as might have made equitable reimbursement of the appeal fee under Rule 67 EPC if the appeal had been allowed, which it has not been.
10. The respondents have not pursued their request for an apportionment of costs. The issue of admissibility of the appeal was a completely new issue, on which any party should be entitled to defend its own position at oral proceedings if it so chose, and the Board sees no reasons of equity pursuant to Article 104 EPC to depart from the ordinary rule as to costs, namely that each party shall meet its own costs.



**Order**

**For these reasons, it is decided that:**

1. The appeal is rejected as inadmissible.
2. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

M. Kiehl

S. Steinbrener