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I n t e r l o c u t o r y D E C I S I O N
of 22 November 2005

Case Number: T 0991/04 - 3.3.05

Application Number: 01000356.4

Publication Number: 1221338

IPC: B01D 53/94

Language of the proceedings: EN

Title of invention:
Modified platinum NO_x trap

Applicant:
Ford Global Technologies, Inc.

Opponent:
-

Headword:
Admissibility of appeal/FORD GLOBAL

Relevant legal provisions:
EPC Art. 23(3), 91(1)(b)(3), 108, 110(1), 164(2)
EPC R. 36(1)-(5), 41, 65(1)(2), 66(1)

Keyword:
"Deficient form of the notice of appeal filed by the
epoline[®]-system"
"Admissibility of the appeal according to the principle of the
protection of legitimate expectations"

Decisions cited:
G 0005/88, G 0002/97, G 0008/91, G 0003/99, J 0018/88,
J 0003/05, T 0014/89, T 0210/89, T 0571/91, T 0570/02,
T 0935/00

Catchword:-



Case Number: T 0991/04 - 3.3.05

I n t e r l o c u t o r y D E C I S I O N
of the Technical Board of Appeal 3.3.05
of 22 November 2005

Appellant: Ford Global Technologies, Inc.
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Representative: Messulam, Alex Moses
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 18 May 2004
refusing European application No. 01000356.4
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: M. Eberhard
Members: E. Wäckerlin
S. Hoffmann

Summary of Facts and Submissions

I. The appeal lies from the decision of the Examining Division posted on 18 May 2004 refusing European patent application no. 01 000 356.4.

II. The appellant filed the notice of appeal together with the grounds of appeal on 13 July 2004 not by regular mail or faxed letter but by using the technical means of the so-called *epoline*[®]-system provided for by the European Patent Office for filing documents relating to a European patent application.

The notice of appeal was drafted as an electronic Microsoft Word document which bore at the end of the text a facsimile signature of the appellant's registered European patent attorney. The electronic transmission of this notice of appeal was transmitted to the European Patent Office using the representative's smart card certificated by the European Patent Office on 13 July 2004. The electronically filed appeal was opened by the formalities officer responsible for the application on the same date.

III. With letter dated 7 February 2005 sent by normal post the appellant filed *inter alia* a hard copy of the appeal dated 13 July 2004 which was signed by the appellant's representative and requested that the notice of appeal be regarded as admissible.

IV. The appellant argued that he learned from a correspondence in the proceedings of another European patent application that the online filing procedure

could not be used in appeal proceedings. He applied for *restitutio in integrum* of the present application on the same grounds as he had given in the other European patent application. In connection with the latter the appellant argued that he was frankly surprised that the filing of an appeal via *epoline*[®]-system was not permissible all the more so as he had received from the European Patent Office a communication (form 3322) suggesting that the appeal had been accepted and referred to a Technical Board of Appeal. The appellant admitted that he was not aware of the Notice of the European Patent Office dated 3 December 2003 concerning the electronic filing of documents within the meaning of Rule 36 EPC (OJ EPO 2003, 609) which expressly rules out electronic filing in opposition and appeal proceedings. Furthermore, he argued that in the present day a permanent record can be created by electronic means and is "for all intents and purposes the same as a piece of paper carrying a signature" and, additionally, is more reliable than a faxed letter. He took the view that his notice of appeal transmitted electronically fully complied with the requirement "filed in writing" under Article 108 EPC. As a precautionary measure, he asked that the current signed copy of his appeal be accepted as a late confirmation of the electronically filed notice of appeal.

- V. At the same time, the appellant requested *restitutio in integrum* for the aforementioned reasons and authorized the European Patent Office to deduct the respective fee for re-establishment from his deposit account.

Reasons for the Decision

1. The present interlocutory decision only concerns the admissibility of the appeal.

In the case under consideration the question arises whether the appeal is admissible with respect to the fact that the (first) notice of appeal was filed on 13 July 2004 by technical means of the so-called *epoline*[®]-system provided for filing European patent applications and documents filed subsequently. In this regard the main legal issue to be considered is the legal relationship between Article 108 and Rule 36(1) to (5) EPC in conjunction with the decision of the President of the European Patent Office dated 29 October 2002 (OJ EPO 2002, 543) and the notices from the European Patent Office based on it. In other words, the question arises whether or not the notice of appeal fulfils the requirement "filed in writing" pursuant to Article 108 EPC.

2. Article 110(1) EPC prescribes that the Board of Appeal shall decide on the allowability of an appeal (only) if it is admissible. Although Articles 106 to 108 EPC stipulate some specific formal requirements to be observed by the appellant when filing an appeal, the EPC does not expressly lay down when an appeal is considered to be admissible or inadmissible.

3. This question is answered by Rule 65(1) and (2) EPC.

It must be noted already now that neither paragraph (1) nor (2) of Rule 65 EPC refers to Rule 36 EPC (cf. T 953/00, point 1 of the reasons) because Rule 36 EPC

concerns generally the filing of documents and not the admissibility of a procedural act as such, which leads to some legal ambiguity.

4. There is no doubt that the notice of appeal filed on 13 July 2004 complies with the requirements pursuant to Rule 65(2) EPC.

As a preliminary consideration, it should be pointed out that according to Rule 65(2) EPC, second sentence, the notice of appeal shall be rejected as inadmissible if deficiencies according to Rule 65(2) EPC, first sentence, are not corrected in good time i.e. they are not corrected within a time limit set by the European Patent Office. Contrary to Rule 65(1) EPC and its reference to Article 108 EPC, the time limit set out in Rule 65(2) EPC can expire after the end of the two-month time limit for filing a notice of appeal set out in Article 108 EPC and must be seen as an exception to the rule that all requirements as regards admissibility must be fulfilled at the end of the time limit set out in Article 108 EPC. The reason behind this Rule may be seen in the minor impact of these requirements referred to in Rule 65(2) EPC on procedural certainty.

As Rule 65 EPC in its present wording was also part of the very first version of the European Patent Convention, the validity of Rule 65(2) EPC, second sentence, cannot be seriously questioned by a reference to the principle laid down in Article 164(2) EPC that in the case of conflict between the provisions of this Convention and those of the Implementing Regulations, the provisions of this Convention shall prevail. The fact that requirements stipulated by an Article of the

EPC need to be specified by the Implementing Regulations does not create a case of conflict. As the Convention itself does not define the requirements establishing the admissibility of an appeal, Rule 65 EPC specifies these requirements in an authentic way. The Diplomatic Conference as the legislator of the European patent system drafted the first versions of the EPC and the Implementing Rules as a legal unity which should be read in a consistent way. In this regard the Implementing Regulations have the function of an authentic interpretation of the Convention.

The Board holds that this principle of authentic interpretation also applies to the requirement "filed in writing" pursuant to Article 108 EPC, first sentence, which is discussed in detail below.

5. Rule 65(1) EPC stipulates that if the appeal does not comply *inter alia* with Article 108 EPC, the Board shall reject it as inadmissible. In the present case the question arises whether or not the notice of appeal filed by means of the *epoline*[®]-system fulfils the requirement "filed in writing" pursuant to Article 108 EPC.

The case law has not yet expressly decided on the meaning of the requirement "filed in writing" although the question whether a notice of appeal fulfils the formalities under Article 108 EPC has already been answered in the affirmative as regards the filing of letters filed by facsimile.

It is clear that any interpretation of the requirement "filed in writing" pursuant to Article 108 EPC is only

allowed if this notion itself is imprecise or ambiguous (*in claris non fit interpretatio*).

In common speech the expression "filed in writing" seems to be unambiguous but a closer examination of the term reveals several possible meanings which have to be specified for legal use. Does "filed in writing" mean that the text is handwritten, typewritten or printed, is the (handwritten) signature an essential part of this form and does "filed in writing" refer only to paper documents or also to electronic forms of documents? Thus in the Board's view, the requirement "filed in writing" pursuant to Article 108 EPC needs further specification in order to provide a clear procedural position.

6. In general, the interpretation of legal terms lies within the competence of the Boards of Appeal because of their judicial function unless the Implementing Regulations to the Convention stipulate an authentic interpretation within the framework set by the Convention because the Boards of Appeal are not only bound by the European Patent Convention but also by the Implementing Regulations as part of the Convention according to Article 23(3) EPC. The framework set by the Convention means that, if any provision of the Implementing Regulations violates a procedural principle laid down in the Convention itself, such a provision has to be disregarded by the Board of Appeal according to Article 164(2) EPC but otherwise the Board of Appeal has to apply all provisions of the Implementing Rules.

7. Rule 36 EPC concerns specific forms of documents filed subsequently to the patent application and may be considered to constitute an authentic interpretation as mentioned above of the term "filed in writing" referred to in Article 108 EPC.

8. Before applying Rule 36 EPC it has to be decided whether or not Rule 36 EPC can be directly applied to appeal proceedings, i.e. not in conjunction with Rule 66(1) EPC.

Rule 36 is headed "documents filed subsequently" (French version: "documents produits ultérieurement"). Only the German version "Unterlagen nach Einreichung der europäischen Patentanmeldung" and the wording in paragraph 5 of this rule clarifies that this rule concerns documents filed subsequently to the patent application, but it remains open whether Rule 36 is only to be applied to documents filed before the Examining Division or whether it may also be applied in opposition and in appeal proceedings.

9. There are at least three objections to a direct application of Rule 36 EPC in appeal proceedings.

Firstly, it was already in dispute whether the provisions of Part III, Chapter II of the Implementing Regulations and in particular Rule 36 EPC, were applicable in opposition proceedings and, as a result of this discussion, Rule 61a EPC was inserted by the Decision of the Administrative Council of 20 October 1977 (cf. in detail T 570/02; point 2 of the reasons with reference to the preparatory documents concerning the insertion of Rule 61a EPC stating that the

insertion would not change the previous legal situation but was only for clarification).

Secondly, the systematic position of Rule 36 EPC in the context of the EPC could be an argument against a direct application of that rule in appeal proceedings. Rule 36 EPC is the last rule of Chapter II of Part III of the Implementing Regulations which is headed "Provisions governing the application" whereas provisions concerning "Appeal Procedures" and "Common provisions governing procedure" are to be found in Part VI and Part VII of the Implementing Regulations, respectively. This could be an indication that Rule 36 EPC as such only concerns the procedure before the Examining Division and not the procedural stages of opposition and appeal proceedings.

Thirdly, Rule 36(2) EPC stipulates that "all documents other than those referred to in the first sentence of paragraph 1 shall normally be typewritten or printed". The use of the word "normally" (in the German version: "sollen", in the French version: "en principe") indicates a discretion for the European Patent Office. Such a discretion seems inappropriate with regard to the procedural requirement "filed in writing" stipulated by Article 108 EPC.

10. Having in mind these objections to a direct application of Rule 36 EPC in appeal proceedings, the question arises whether it would be appropriate to apply Rule 36 EPC according to Rule 66(1) EPC *mutatis mutandis* to a notice of appeal.

11. The application of Rule 36 EPC in appeal proceedings pursuant to Rule 66(1) EPC is, however, also open to legal objection.

Firstly, with regard to the wording "unless otherwise provided" in Rule 66(1) EPC, it seems that Article 108 EPC could constitute such a proviso. The requirement "filed in writing" stipulated in Article 108 EPC could exclude the filing of a notice of appeal "by other means of communication" provided for by Rule 36(5) EPC because the latter concerns the filing of documents in general without reference to their content, while Article 108 EPC could concern the specific form for filing a notice of appeal as *lex specialis*.

Secondly, legal certainty forbids the application of Rule 36 EPC in conjunction with Rule 66(1) EPC to a notice of appeal. The formal requirement "filed in writing" according to Article 108 EPC must have a clear, predictable meaning for the appellant and must not depend on whether or not the Boards of Appeal decide that Rule 36 EPC is applicable *mutatis mutandis*. As it can be inferred from point 7 of the decision G 8/91 of the Enlarged Board of Appeal (OJ EPO 1993, 346), it must be decided in each single case whether a principle established for the departments of first instance can be applied to the appeal procedure *mutatis mutandis* by Rule 66 EPC. This view is supported by the fact that a notice of appeal is a document without any direct equivalent document in examining proceedings and an application of Rule 36 EPC to a notice of appeal would in any case require a discretionary decision of the Boards of Appeal stating that a notice of appeal is comparable with other documents to be filed during the

examination proceedings. Consequently, any amendment to Rule 36 EPC would bring with it an uncertain period during which the jurisprudence would need to apply the amended provision to appeal proceedings. In case of doubt, procedural certainty could only be regained by a decision of the Enlarged Board of Appeal. These considerations might be the reason why the established jurisprudence predominantly applied Rule 36(3) and (5) EPC directly in appeal proceedings (G 3/99, OJ EPO 2002, 347, point 20 of the reasons; T 571/95, point 1 of the reasons; J 18/88, point 2 of the reasons; T 210/89, points 1 and 10 of the reasons). This legal view is shared by legal literature (Günzel, Benkrad *Europäisches Patentübereinkommen*, Munich 2002, Article 108 no. 4; Joos, Singer/Stauder, *Europäisches Patentübereinkommen*, Munich 2000, 2. edition, Article 108 no. 15).

12. Before evaluating the above listed arguments (points 9 - 11), it seems to be necessary to scrutinize more precisely the legal relationship between Article 108 and Rule 36 EPC and in particular its paragraph 5 with regard to the required form of a notice of appeal because these considerations could exclude both the direct application of Rule 36 EPC to a notice of appeal and an application *mutatis mutandis* pursuant to Rule 66 EPC.

13. Rule 36(5) EPC reads *inter alia* as follows:

"Notwithstanding paragraphs 2 to 4 the President of the European Patent Office may permit documents filed after filing of the European patent application to be transmitted to the European Patent Office by other

means of communication and lay down conditions governing their use. He may, in particular, require that within a period laid down by him written confirmation be supplied reproducing the contents of documents so filed and complying with the requirements of these Implementing Regulations...".

14. Rule 36(5) EPC acknowledges two different qualities of forms for filing documents with the European Patent Office. The term "written confirmation" is seen as different from the form required by transmission by "other means of communication" essentially concerning electronic means of communication.

It is not immediately obvious that Rule 36(5) concerns the form of a procedural act, for example the notice of appeal in the present case, because the notion "other means of communication" first of all concerns the way in which documents can be filed independently of the required form for its content. However, the admittance of a certain method of transmission entails the acknowledgment of the form required by the technical means of this transmission and therefore it is justified to consider Rule 36(5) EPC also as a provision concerning the form of a specific procedural act such as the notice of appeal.

Rule 36(5) EPC does not define the term "written confirmation" but within the context of the whole rule it obviously refers to a text written on paper which differs from the non-paper form concerning "other means of communication" and which is to be determined by a decision of the President of the European Patent Office.

15. The foregoing considerations lead to the question whether or not the term "filed in writing" in Article 108 EPC is to be interpreted in the same way as the term "written confirmation" in Rule 36(5) EPC namely exclusively as a statement on paper. If this were to be the case, then the term "filed in writing" in Article 108 EPC would require in each case the filing of a notice of appeal on paper and the possibility to use "other means of communication" pursuant to Rule 36(5) EPC would be excluded by Article 164(2) EPC. Thus, a non-paper form would conflict with the requirement of filing a notice of appeal on paper according to such a narrow interpretation of the term "filed in writing" and Article 108 EPC would prevail over Rule 36(5) EPC.

16. When interpreting the term "filed in writing" referred to in Article 108 EPC it should be noted that this term was already used in the very first version of the European Patent Convention and that Rule 36(5) of the very first version of the Implementing Regulations already read as follows:

"Documents filed after filing of the European patent application may, by way of exception to the provisions of paragraphs 2 to 4, be sent to the European Patent Office by telegram or telex. However, a document reproducing the content of such telegram or telex and complying with the requirements of these Implementing Regulations must be filed within two weeks as from the receipt of such telegram or telex. If this document is not filed in due time, the telegram or telex shall be deemed not to have been received".

The Board notes that telegram and telex did not concern documents which were based on a copied original sheet of paper and both were at least partly transmitted by electronic means. In the legal system of the EPC, telegram and telex complied with the requirement "filed in writing" stipulated in Article 108 EPC, because the failure to file a confirmation letter did not lead to the inadmissibility of the procedural act expressed in this document but to the legal fiction pursuant to the then valid Rule 36(5) EPC, second sentence, that the document shall be deemed not to have been received.

In this regard the Board points out that, on the basis of the present valid Rule 36(5) EPC, the Notice from the European Patent Office dated 6 December 2004 (OJ EPO 2005, 44 point 4.1) stipulates that, as a rule, it is no longer necessary to file a written confirmation of documents filed by facsimile, which means that the faxed letter is already considered to comply with the formal requirement of "filed in writing".

17. When considering the "Travaux Préparatoires" it is obvious that Rule 36(5) EPC of the very first version of the EPC also included documents filed during the appeal proceedings and had to be understood as an authentic interpretation and implementation of the requirement "filed in writing" in Article 108 EPC.

This very first version of Rule 36(5) EPC was derived from Article 68 No. 8, first paragraph of the so-called Haertel-Draft of 8 March 1963 stating that "Anmeldungen, Anträge, Beschwerden und sonstige

Eingaben in einem Verfahren vor dem Europäischen Patentamt können abweichend von den Vorschriften des Artikels ... beim Europäischen Patentamt auch telegraphisch oder fernschriftlich eingereicht werden". This draft had been amended by the working group "Patents" (Ref. 4419/IV/63-D) as follows: "Die Schriftstücke in einem Verfahren vor dem Europäischen Patentamt können abweichend von den Vorschriften der Artikel ... beim Europäischen Patentamt auch telegraphisch oder fernschriftlich eingereicht werden" (emphasis added by the Board).

On the other hand, the draft versions of the corresponding provisions of the EPC on the form of the notice of appeal already required that the notice of appeal be "filed in writing" which obviously included by means of telegram or telex.

The first preliminary draft of the Implementing Regulations to the Convention establishing a European System for the Grant of Patents (Inter-governmental conference for the setting up of a European System for the Grant of Patents, BR/51/70) still contained in number 11 to Article 66 of the draft of the Convention the reference to "proceedings before the European Patent Office", therefore including appeal proceedings, although Article 66 of the draft was already placed in the chapter concerning examination proceedings. The Board did not find any comment in the "Travaux Préparatoires" as to why the final version of Rule 36(5) EPC actually implemented by the Munich Diplomatic Conference (1973) did not contain the reference to "proceedings before the European Patent Office" but merely referred to subsequently filed

documents. The lack of such a comment seems to indicate that the amendment was not a result of a modified legal view on the relationship between Rule 36(5) EPC and Article 108 EPC.

18. The Board is aware of the fact that a purely historical view is not justified according to the established legal principles of interpretation. However, as the wording "documents filed subsequently" in Rule 36 EPC also applies directly to documents filed in appeal proceedings (as a subsequent procedural step to the filing of a European patent application), the Board sees no convincing reasons to deviate from the established jurisprudence that Rule 36 and in particular Rule 36(5) EPC in its first and later versions was directly applicable in appeal proceedings.

Therefore, the Board concludes that the requirement "filed in writing" in Article 108 EPC did not establish a predetermined and unalterable definition so that a notice of appeal had exclusively to be filed on paper but also included forms implemented by the very first version of Rule 36(5) EPC.

19. Since this very first version of Rule 36(5) EPC has to be considered an authentic interpretation and implementation of the term "filed in writing" in Article 108 EPC, the Administrative Council was competent to amend this implementation according to Article 33(1)(b) EPC as long as this amendment was still covered by the general meaning of the term "filed in writing" in Article 108 EPC.

It is to be noted that Article 108 EPC in the version of the Revised European Patent Convention (EPC 2000, special edition No. 1 of the OJ EPO 2003, not yet in force) no longer stipulates the requirement "filed in writing" in Article 108 EPC but refers to the Implementing Regulations with regard to the form of a notice of appeal. This amendment supports the Board's view that the Contracting States did not consider the requirement "filed in writing" in the present version of Article 108 EPC as an essential, predetermined element of the Convention which could be at odds with Rule 36(5) EPC.

20. The Board has no doubt that the present valid version of Rule 36(5) EPC confers the competence to permit the form of documents required by the admission of "other means of communication" to the President of the European Patent Office because the delegation given is sufficiently precise and is within the competence of the Administrative Council pursuant to Article 33(1) b) EPC. Therefore, the President's decisions based on Rule 36(5) EPC implement the requirement "filed in writing" in Article 108 EPC in the same way as if it were directly implemented by Rule 36(5) EPC.

21. As a result of the foregoing legal considerations the Board finds that the question of whether or not the notice of appeal under consideration fulfils the requirement "filed in writing" in Article 108 EPC is answered by Rule 36(5) EPC and Article 2 of the Decision of the President of the European Patent Office dated 29 October 2002 (OJ EPO 11/2002, 543; in the following "the President's Decision") in conjunction with point 1 of the Notice from the European Patent

Office dated 3 December 2003 (OJ EPO 12/2003, 609; in the following "the EPO-Notice").

In other words, the notice of appeal under consideration must formally comply with the EPO-Notice in conjunction with the President's Decision in order to fulfil the requirement "filed in writing" pursuant to Article 108 EPC, otherwise the appeal is inadmissible according to Rule 65(1) EPC.

22. The Board assumes in favour of the appellant that the EPO-Notice is validly implemented with respect to the admittance of the electronic form of the documents cited therein.

As already stated under point 14 second paragraph above, Rule 36(5) EPC not only concerns simple administrative measures such as the admittance of the use of an electronic device of the European Patent Office but additionally the legislative act to implement a specific form for a procedural act.

In favour of the appellant, the Board leaves it open as to whether or not the President's Decision delegates the legislative power to the European Patent Office in a sufficiently precise manner under Article 10(2)a) EPC.

23. Point 1 of the EPO-Notice reads as follows:

"The European Patent Office has extended the functionality of its *epoline*[®] Online Filing software. As from 3 December 2003, documents other than priority documents may be filed electronically in grant

proceedings. This possibility is not yet available in opposition and appeal proceedings; in such proceedings, therefore, the electronic filing of documents is not admissible (French version: "pas permis")."

In the terms of Rule 36(5) EPC the non-admittance of the *epoline*[®]-system in opposition and appeal proceedings by the EPO-Notice necessarily means that the notice of appeal is not in the form required by Article 108 EPC when filed by way of *epoline*[®]-system.

24. When applying the aforesaid legal view to the notice of appeal under consideration, the Board states that the appeal is not admissible according to Rule 65(1) EPC, because the notice of appeal as a document in appeal proceedings is expressly excluded from the *epoline*[®]-system by the EPO-Notice and also not admitted under any other provision based on Rule 36(5) EPC. Thus the notice of appeal does not comply with the formal requirement "filed in writing" in Article 108 EPC.
25. For the sake of clarity and completeness, the Board emphasises that the wording of the last part of the third sentence of point 1 of the EPO-Notice "the electronic filing of documents is not admissible (French version: pas permis)" is only a legal conclusion drawn by the European Patent Office from the legal fact that the filing of documents via the *epoline*[®]-system was not admitted during opposition and appeal proceedings.

Such a conclusion is not binding on the Boards of Appeal and, moreover, it does not constitute a legal

basis for deciding that the appeal under consideration is inadmissible.

If the Board holds the French version "pas permis" as determining, then the wording would only indicate that the use of a technical device provided for the use of the public by the European Patent Office is restricted. In this case, if an appellant does not follow the rules (of the house), a continuous misuse could only be prevented by administrative measures such as the cancellation of the right to use the smart-card for the *epoline*[®]-system. Considering the Board's legal view concerning the incorrect form of the notice of appeal, these questions are not decisive for the present case and, therefore, any further discussion is unnecessary.

26. The Board's statement in point 24 above that the appeal under consideration is not formally admissible because of the incorrect form of the notice of appeal filed via the *epoline*[®]-system does not however conclude the matter for the present Board.

The Board is of the opinion that, on the basis of the facts of this specific case, the principle of good faith has to be applied.

27. In the present case, the time limit for filing a notice of appeal according to Article 108, sentence 1 EPC expired on 28 July 2004. The European Patent Office received the notice of appeal via the *epoline*[®]-system on 13 July 2004. Since the appellant observed all technical conditions required by the *epoline*[®]-system, the notice of appeal was automatically filed by the system in the so-called Phoenix-file. The formalities

officer responsible for the case opened and read the electronic mail on 13 July 2004.

It is obvious that the European Patent Office could have warned the appellant about the formal deficiency in his notice of appeal before the time limit for filing the notice of appeal through a proper channel had expired.

28. The European Patent Office is in principle not obliged to advise appellants whether or not an appeal filed is admissible, because this legal question has to be decided in a decision of the competent Board of Appeal and not in a communication from the formalities officer dealing with the application.

Furthermore, appellants cannot shift their own responsibility for complying with the provisions of the European Patent Convention to the European Patent Office.

29. However, in the present case the appellant could have reasonably expected to receive a warning from the European Patent Office about the non-admittance of filing of documents during opposition and appeal procedures because the non-admittance of these documents not only concerned the legal question on the required form for a notice of appeal but also the administrative question on the proper use of a technical device provided for by the European Patent Office. In the latter case, the appellant could have had the legitimate expectation that the European Patent Office informed the appellant as soon as possible about the restricted possibility of using the *epoline*[®]-system.

A similar procedural situation is given in case an appellant files a European patent application at the sub-office in Vienna contrary to Article 75(1)(a) EPC. In such a case, instead of sending a warning to the applicant, the application is immediately sent by the sub-office Vienna to the European Patent Office in Munich in order to guarantee the earliest possible filing date in favour of the applicant.

30. It is obvious that a legally effective filing date for any document can only be obtained by using the proper channels for filing a document with the European Patent Office. As far as the European Patent Convention does not stipulate a specific way for filing, these channels are determined by the European Patent Office by administrative measures such as by providing specific letter boxes, a postal service for reception of documents or specific electronic means of communication. Therefore, even if a document is physically filed in a building of the European Patent Office, it does not obtain a filing date when the stipulated channels are not used.
31. Applicants can expect that they be informed by the European Patent Office about the use of the correct administrative channels for filing documents with the European Patent Office and, if they made a readily identifiable mistake, to be warned accordingly. This principle applies in particular with regard to the newly introduced *epoline*[®]-system because it is well-known that mistakes are more likely under a new system. In this context it should be noted that the European Patent Office improved the technical configuration of

the *epoline*[®]-system after the date when the present notice of appeal was filed by introducing a new "window" in the software titled as "important reminder" which expressly warns the applicant about the restricted use. This fact indicates that the prior system could be misleading.

32. Thus the Board holds that, in the present ex-parte case, the European Patent Office was obliged to inform the appellant as soon as possible about the deficiency of his notice of appeal.

As in the present case the deficiency of the notice of appeal under consideration was readily identifiable for the European Patent Office on 13 July 2004, 15 days still remained for the appellant to file a notice of appeal through the proper channels and enough time remained for the European Patent Office to warn the appellant before the two-month time limit pursuant to Article 108 EPC expired. Thus, the Board is convinced that the appellant, if he had been informed by the European Patent Office as soon as possible, would have filed a new notice of appeal in due time through the appropriate channels. Factually, the appellant filed a copy of the notice of appeal dated 13 July 2004 by adding a new signature after having been informed about his failure.

33. Therefore, in applying the established jurisprudence on the principle of the protection of legitimate expectations (G 5/88, reasons point 3.2, OJ EPO 1991, 137; G 2/97, reasons point 4.1; OJ EPO 1999, 123; J 3/05, reasons point 4; T 14/89, reasons point 5, OJ EPO 1990, 432) the Board holds that the notice of

appeal dated 13 July 2004 is deemed to have fulfilled the requirement "filed in writing" in Article 108 EPC.

34. For the sake of completeness, the Board adds some considerations as to why it holds that it is unjustified to order that the notice of appeal dated 13 July 2004 is not pending or even, as a legal fiction, that it is deemed not to have been filed.
35. Firstly, it cannot seriously be contested that the notice of appeal reached the European Patent Office physically as an electronic message.

In the view of the Board, the receipt of this document by the European Patent Office took legal effect on 13 July 2004 because, according to Rule 95a(3) EPC, documents incorporated in an electronic file shall be considered to be originals and the competent formalities officer opened this electronic document on 13 July 2004. The Board holds that, even if a document is not filed through the proper channels, it is validly received by the European Patent Office at least at the moment when the competent formalities officer deals with this document in respect of his official field of responsibility.

In view of these legal facts, it would be hardly convincing to conclude that the notice of appeal was not pending at all. The view that the appeal is not pending would lead to the result that no appeal proceedings would be initiated and no decision would be legally required. This view might be appropriate in cases where a document is filed via "normal e-mail means". However, if a document is filed via the

epoline[®]-system with the European Patent Office, it is open, at the moment of receipt, whether its content relates to the granting proceedings or appeal proceedings or both proceedings which is also conceivable. Consequently, the question whether or not a document is validly filed cannot depend on its content.

Therefore, the Board holds that even non-permitted documents sent via the *epoline*[®]-system are validly received by the European Patent Office at the latest at the moment when the competent formalities officer takes note of the content of the electronic document. Thus, in the present case the notice of appeal dated 13 July 2004 initiated a pending appeal and the Board has to decide on its admissibility.

36. Secondly, a legal fiction that a notice of appeal is deemed not to have been filed requires as a prerequisite that appeal proceedings are pending and that a specific legal provision stipulates the fiction of the non-existence of this document. Such a legal fiction as legal consequence in case a notice of appeal is filed via the *epoline*[®]-system is neither directly stipulated by the President's Decision nor by the EPO-Notice nor by any other provision.

It might be considered appropriate to apply Article 4 of the President's Decision in an analogous way. § 1 and § 2 of this Article read as follows:

"(1) Where a filed document is illegible or incomplete, that part of it which is illegible or incomplete shall be regarded as not having been received.

(2) If a filed document is infected with a computer virus or contains other malicious software, it shall be deemed to be illegible. The Office shall not be obliged to either open it or process it."

The Board holds that the facts underlying these two paragraphs are not comparable to the non-admitted filing of a notice of appeal via the *epoline*[®]-system, because the legal fiction of "not having been received" is bound to the procedural situation where the document is either factually not legible or the opening of the electronic document cannot be reasonably expected. Moreover, particular legal difficulties would arise with respect to documents which contain submissions relating to appeal proceedings as well as to examining proceedings. This might occur in cases where an interlocutory decision of the Examining Division is appealed.

As in the view of the present Board the filing of a notice of appeal via the *epoline*[®]-system concerns the question of whether or not the notice fulfils the required form set out in Article 108 EPC, the procedural situation is so different from that dealt with in said Article 4 that an application of this specific provision *mutatis mutandis* to the appellant's disadvantage could hardly be justified.

37. Finally, the strongest argument against an application of this provision *mutatis mutandis* seems to be that there is no legal loophole which has to be filled because the legal consequence of a lack of form

pursuant to Article 108 EPC is governed by Rule 65(1) EPC.

38. The foregoing reasoning does also not permit the application of Rule 36(5), second sentence EPC, by analogy.

39. In conclusion, as regards the admissibility of the present appeal the Board reiterates its statement under point 33 that the notice of appeal under consideration is deemed to have fulfilled the requirement "filed in writing" in Article 108 EPC.

In addition, the Board holds that the notice of appeal fulfils all other requirements stipulated by Articles 106 to 108 and Rules 1(1) and 64 EPC.

Therefore, the appeal is deemed to be admissible.

40. In view of this decision, the request for *restitutio in integrum* is no longer relevant and the fee paid for re-establishment of rights is to be refunded.

Order

For these reasons it is decided that:

1. The appeal is deemed to be admissible.
2. The fee for re-establishment is refunded.

The Registrar:

The Chairman:

A. Wallrodt

M. Eberhard