

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

**Datasheet for the decision
of 14 September 2007**

Case Number: T 0971/05 - 3.3.03

Application Number: 97307441.2

Publication Number: 0832936

IPC: C08L 83/07

Language of the proceedings: EN

Title of invention:

Photo-curable liquid silicone rubber compositions for templating mother molds

Patentee:

Shin-Etsu Chemical Co., Ltd.

Opponent:

GE Bayer Silicones GmbH & Co. KG

Headword:

-

Relevant legal provisions:

EPC Art. 108, 112, 122

EPC R. 69(1), 84a

RRF Art. 8(3)

Keyword:

"Incorrect debit order (yes)"

"Restitutio in integrum (no)"

"Referral of a question to the Enlarged Board of Appeal (no)"

Decisions cited:

G 0001/86, T 0152/82, T 0017/83, T 0170/83

Catchword:

-



Case Number: T 0971/05 - 3.3.03

DECISION
of the Technical Board of Appeal 3.3.03
of 14 September 2007

Appellant:
(Opponent)

GE Bayer Silicones GmbH & Co. KG
Legal Department, Building V7
D-51368 Leverkusen (DE)

Representative:

Gille Hrabal Struck Neidlein Prop Roos
Patentanwälte
Brucknerstrasse 20
D-40593 Düsseldorf (DE)

Respondent:
(Patent Proprietor)

Shin-Etsu Chemical Co., Ltd.
6-1, Otemachi 2-chome
Chiyoda-ku
Tokyo (JP)

Representative:

Stoner, Gerard Patrick
Mewburn Ellis LLP
York House
23 Kingsway
London WC2B 6HP (GB)

Decision under appeal:

**Interlocutory decision of the Opposition
Division of the European Patent Office dated 2
May 2005 and posted 25 May 2005 concerning
maintenance of the European Patent No. 0832936
in amended form.**

Composition of the Board:

Chairman: R. Young
Members: M. C. Gordon
H. Preglau

Summary of Facts and Submissions

- I. On 1 August 2005 the appellant (opponent) lodged an appeal against the interlocutory decision of the Opposition Division, posted 25 May 2005. In this decision the Opposition Division had found that the patent in amended form met the requirements of the EPC.

Concerning the payment of the appeal fee the notice of appeal reads as follows:

"Die Beschwerdegebühr gemäß Art.108 in Höhe von Euro 1020,00 wird von unserem laufenden Konto 2800 1054 online überwiesen." (in English: "The appeal fee pursuant to Art.108 amounting to 1020.00€ will be transferred electronically from our deposit account 2800 1054."). No payment was, however, received. The statement setting out the grounds of appeal was filed by the appellant on 30 September 2005.

- II. On 27 October 2005 a communication of loss of rights pursuant to Rule 69(1) EPC was sent to the appellant, stating that the appeal fee had not been paid and that accordingly the appeal was deemed not to have been filed (Article 108, second sentence EPC).

Attention was also drawn to Article 8(3) RRF (establishment of transfer of a payment in due time), Rule 84a EPC (late receipt of documents) and Article 122 EPC (re-establishment of rights). Concerning the possibility of a request according to Article 122 EPC it was mentioned that this applied only to an applicant or a proprietor.

III. The appellant responded with letter dated 7 December 2005, requesting a decision according to Rule 69(2) EPC.

In relation to this request, reference was made to Article 125 EPC according to which the European Patent Office takes into account principles of procedural law generally recognised in the Contracting States. According to German law (§ 140 BGB) the conversion of a non-valid procedural action into a valid one would be possible. In the present case, the appellant had mentioned in his notice of appeal that the fee would be "online überwiesen" ("transferred electronically") from deposit account No 2800 1054. A detailed statement of grounds of appeal had also been submitted to which furthermore comparative examples had been annexed. This showed without any doubt that the appellant had the clear will to file an appeal. Under these circumstances it would have been possible for the EPO, after establishing that the appeal fee had not been actively transferred, to reinterpret the statement in the letter of 1 August 2005 as a debit authorisation. In this connection all the necessary details had been made available, in particular the file number, the procedural step to be taken, the amount of the appeal fee and the number of the deposit account.

The appellant also cited decisions T 17/83 (OJ EPO 1984, 307) and T 170/83 (OJ EPO 1984, 605) where Boards had decided in favour of the appellant by interpreting an unclear debit order.

IV. On the same day (7 December 2005) the appellant also filed a request for restitutio in integrum and paid the appeal fee and the fee for the request for restitutio

in integrum. In support of the request for restitutio in integrum the appellant argued that the appeal fee had not been paid because of an isolated error of a qualified assistant in a well-functioning organisation where an error of such kind had never previously occurred. The request was accompanied by a declaration of said assistant. The appellant was aware that restitutio in integrum is only allowed with respect to the time limit for filing the statement of grounds of appeal but due to the communication of the EPO concerning the assignment of the case to Board 3.3.03 and the mentioning of the case number there was no reason for the proprietor not to believe that the appeal had been correctly filed.

Also the patent proprietor had received the statement of grounds of appeal with the invitation to comment. The information that possibly the appeal might be deemed not to have been filed came much later. It would also be in the interests of the patent proprietor to allow the restitutio in integrum and so to avoid the costs for nullity actions at national courts.

V. Auxiliarily it was requested to refer to the Enlarged Board of Appeal the question of allowability of restitutio in integrum, with respect to the time limit for paying the appeal fee in the case that an appeal pursuant to Article 108(1) EPC was filed, the statement of grounds was filed in due time, the appeal fee however was not paid during the time limit for filing the appeal.

VI. Also auxiliarily oral proceedings were requested.

VII. The respondent commented in a letter sent by facsimile on 12 January 2006, that the previous opponent had expressed an intention to pay the appeal fee by means of the deposit account. This expressed intention was not sufficient authority for the EPO to debit the fee. The Office could not debit a deposit account merely because other actions taken by a party were consistent with filing an appeal. The circumstances in the decisions cited by the opponent were different from those in the case under consideration.

Concerning the request for restitutio in integrum the respondent referred to G 1/86 (OJ EPO 1987, 447).

VIII. In a communication dated 13 April 2006 the Board issued a preliminary opinion, explaining the difference between the case under consideration and the cases, dealt with in the decisions cited by the appellant.

Concerning the request for restitutio in integrum the Board referred to point 6 and the last paragraph of the order of G 1/86 which made clear that Article 122 EPC was not applicable to the present case.

IX. The appellant, in a response dated 13 June 2006 argued again with reference to decisions T 17/83 (erroneously referred to as T 12/83) and T 170/83, that the considerations in these decisions, when applied to the present case could only lead to a decision in favour of the appellant. A decision in favour of the appellant would not conflict with any legitimate interests of the patent proprietor, since the patent could in any case be revoked according to Article 138 EPC.

Concerning the request for restitutio in integrum it was argued that the Enlarged Board in G 1/86 had not decided on a case of a request for restitutio in integrum with respect to payment of the appeal fee.

- X. A summons to attend oral proceedings was issued on 17 July 2006.
- XI. With letter dated 4 October 2006 the appellant withdrew its request for oral proceedings and stated that it would not attend the scheduled oral proceedings.
- XII. With a communication issued on 10 October 2006 the Board informed the parties that the scheduled oral proceedings were cancelled.

Reasons for the Decision

A. Missing Appeal Fee

- 1. According to Article 108 EPC a notice of appeal shall not be deemed to have been filed until after the fee for appeal has been paid.

It appears from the file and has not been disputed by the appellant that no appeal fee has been paid within the relevant time limit. The Board cannot concur with the argument in appellant's letter dated 7 December 2005 that the Office should have taken the wording "Die Beschwerdegebühr gemäss Art.108 in Höhe von Euro 1020,00 wird von unserem laufenden Konto 2800 1054 online überwiesen." ("The appeal fee pursuant to Art.108 amounting to 1020.00€ will be transferred

electronically from our deposit account 2800 1054") as authorising the Office to deduct the appeal fee from a deposit account.

The Board does not deny that in several decisions Boards were willing to interpret an incorrect debit order in favour of the party but it has to be underlined that in all such cases this was always done on the basis of an order to the Office.

2. Going back to one of the earliest decisions concerning incorrect debit orders T 152/82 (OJ EPO 1984, 301) it is stated as Headnote II "A debit order must be carried out notwithstanding incorrect information given in it if the intention of the person giving the order is clear." In that case the debit order read as follows: "Please debit the appeal fee (Code 11) of DM 550 to our deposit account...". At that time the appeal fee had already been increased to DM 630. Therefore the debit order was clearly addressed to the Office to deduct money from the deposit account. Only the amount mentioned was incorrect, (see Reasons, pt.7).

In T 17/83 (OJ EPO 1984, 307) the appellant filed a notice of appeal, enclosing a statement of grounds and explaining that "Instructions for payment of the appeal fee via our deposit account were sent to you on 24 November 1982." The Office could find no record of having received the debit order of 24 November 1982. The Board ruled that the statement in the notice of appeal could be considered a debit order because it contained the essential particulars. In this case an order to the Office was expressed and only the Office's records did not show it.

Whereas in the case underlying T 17/83 it reads "...instructions for payment ..via our deposit account were sent to you ..." in the present case it is stated in the notice of appeal, that the appeal fee would be "...online überwiesen..." ("...transferred electronically...") which is not an instruction directed to the Office but the announcement that the fee would be paid online. The further indication " von unserem laufenden Konto" ("...from our deposit account...") cannot be interpreted as an instruction to the Office but only as indicating the intention of the party itself to effect payment of the appeal fee by transferring the money online.

In T 170/83 (OJ EPO 1984,605) an opponent had mentioned as enclosure "debit order". In fact annexed was a debit order to the Netherlands Patent Office. The Board ruled that even under the very special circumstances (use of a national form and therefore incorrect particulars) it was possible to attribute the order to an EPO dossier and could be accepted as an order to deduct the necessary fee from a deposit account.

Again an order to an office (although the wrong office was indicated) was sent, which made clear the party's intention to have the money paid by debiting of an account established with the office and not to do it itself. This allowed the interpretation that it was meant as an order to the correct office and therefore could be carried out by the EPO.

3. These three cases mentioned above have in common that besides different incorrect details there was always

the clear order to deduct a fee from a deposit account. This is, however, absent in the present case.

4. The Office has a strong responsibility when acting on behalf of account holders. Transfer of money can only be allowed when the Office is in possession of a clear and unambiguous instruction to do so. Under other circumstances e.g. where the amount to be transferred can be interpreted or even corrected by the Office to comply with the actual fees, transfer may also be possible, particularly because very often parties do not even indicate an amount but instruct the Office only to debit the deposit account with the appropriate fee.

In the case under consideration, it will be recalled that in the notice of appeal it is stated that the appeal fee will be "online überwiesen." The word "überwiesen" cannot be interpreted as an instruction to the Office to pay the fee by debiting the deposit account but only as indicating the party's intention to transfer the appeal fee in another way.

5. That the party wanted to pay the appeal fee itself and not by instruction to the Office to do so by debiting the deposit account is further supported by the fact that the appellant filed a request for restitutio in integrum. Restitutio in integrum is by definition a means of recourse for a party which has failed to do something in a procedure before the Office. In other words, a request for restitutio in integrum is based on a mistake or omission which occurred within the responsibility of a party and not within that of the Office.

B. Request for restitutio in integrum

6. Concerning the request for restitutio in integrum reference is made to G 1/86 and especially to point 6 of the reasons and the last paragraph of the order which make clear that an opponent is only entitled to re-establishment of rights if he has failed to observe the time limit for filing the statement of grounds of appeal but not if he has failed to file a notice of appeal.

7. The Enlarged Board of appeal in the cited decision G 1/86 defined when and to what extent an opponent might benefit from Article 122 EPC, although the wording of this Article is restricted to an applicant or proprietor of the patent. That means that the conditions given in this decision have to be respected and there is no basis to broaden what has been stated by the Enlarged Board. Only if the opponent had filed a valid notice of appeal (in due time and with correct payment of the appeal fee) and therefore had acquired the status of appellant in an appeal proceedings, but had failed to file the statement of grounds of appeal, might he be allowed restitutio in integrum. The crucial point is, whether the opponent had already acquired the status of appellant in an appeal procedure. If not, Article 122 EPC cannot be invoked.

8. In the present case an appeal procedure did not start because of the non-payment of the prescribed appeal fee. The mere letter containing the notice of appeal is not itself sufficient to start the appeal procedure. To come into existence an appeal needs the notice of

appeal of a party **and** the payment of the appeal fee (Article 108 EPC). As this did not happen in the present case, the putative appellant never became a party to an appeal procedure and therefore cannot benefit from Article 122 EPC as such.

Consequently there was no need to consider the circumstances which led to the non-payment of the appeal fee.

C. Referral to the Enlarged Board of appeal

9. According to Article 112 EPC the Boards may refer questions to the Enlarged Board of Appeal in order to ensure uniform application of the law or if an important point of law arises. Concerning the allowability of a request for restitutio in integrum filed by an opponent with respect to appeal procedures the jurisprudence of the EPO is homogeneous and consistently based upon decision G 1/86. Consequently there is no need to refer a question to the Enlarged Board of Appeal to ensure uniform application of the law. As to the question of whether an important point of law arises, the allegedly extenuating circumstances referred to by the appellant (Section IV, third paragraph, above) cannot lead to a different conclusion because these concern the facts of the particular case and not, therefore, an important point of law.

9.1 Nor does the Board see any reason to deviate from the jurisprudence in the argument of the appellant that the Enlarged Board of Appeal had not explicitly dealt with the question of restitutio in integrum in case of non-payment of an appeal fee by an opponent.

- 9.2 Contrary to the opinion of the appellant the Enlarged Board of Appeal decided the question of allowability of restitutio in integrum filed by an opponent in a comprehensive manner. In coming to its conclusion, the Enlarged Board of Appeal had already considered that opponents may not have their rights re-established in respect of time limits for appeals, and this on the basis of the wording of Article 122(1) EPC, the historical documentation relating to the EPC and the national laws of the Member States (Reasons, pt 6).
- 9.3 Since the appellant in the present case did not fulfil the necessary formalities according to Article 108 EPC, first and second sentence an appeal procedure was not even initiated and therefore the second part of the formalities, filing the statement of grounds of appeal (Article 108 EPC, third sentence), as had been done by the appellant in the present case, cannot alter the situation that no appeal was in existence. Hence the appellant in the present case falls into the category already dealt with by the Enlarged Board of Appeal in its decision G 1/86 (Reasons pt 6).
- 9.4 Therefore the request for referring the question of allowability of restitutio in integrum in relation to the payment of an appeal fee has to be rejected.
10. As there is no appeal in existence, the appeal fee paid late (Section IV, first paragraph, above) must be reimbursed. As the Board has dealt with the admissibility of the request for restitutio in integrum in substance, coming to the conclusion that this

request must fail, a reimbursement of the respective fee cannot be ordered.

Order

For these reasons it is decided that:

1. The appeal is deemed not to have been filed.
2. The request for restitutio in integrum is rejected.
3. The request for referral of a question of law to the Enlarged Board of Appeal is rejected.
4. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

E. Goergmaier

R. Young