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**Datasheet for the decision
of 30 March 2009**

Case Number: T 1090/08 - 3.3.08

Application Number: 00989693.7

Publication Number: 1224287

IPC: C12N 15/12

Language of the proceedings: EN

Title of invention:

Pectinophora gossypiella (pink bollworm) bacillus
thuringiensis toxin receptor BT-R2

Applicant:

THE UNIVERSITY OF TEXAS SYSTEM

Headword:

Admissibility/TEXAS

Relevant legal provisions:

EPC Art. 108

EPC R. 2(1), 103(1)(b), 126(2), 136(1)(2)

Decision of the President of the European Patent Office dated
29 October 2002 on the electronic filing of patent
applications and other documents

Notice dated 29 October 2002 concerning the electronic filing
of patent applications and other documents

Notice from the European Patent Office dated 3 December 2003
concerning the electronic filing of documents within the
meaning of Rule 36 EPC

Decision of the President of the European Patent Office dated
12 July 2007 concerning the electronic filing of patent
applications and other documents

Decision of the President of the European Patent Office dated
26 February 2009 concerning the electronic filing of documents

Keyword:

"Admissibility of appeal - grounds of appeal filed online
(no)"

"Re-establishment of rights (yes)"

Decisions cited:

T 0781/04, T 0991/04, T 0514/05, T 0395/07, T 0765/08

Catchword:

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Case Number: T 1090/08 - 3.3.08

D E C I S I O N
of the Technical Board of Appeal 3.3.08
of 30 March 2009

Appellant: THE UNIVERSITY OF TEXAS SYSTEM
201 West 7th Street
Austin, Texas 78701 (US)

Representative: W.P. Thompson & Co.
Coopers Building
Church Street
Liverpool L1 3AB (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 17 January 2008
refusing European application No. 00989693.7
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: L. Galligani
Members: T. J. H. Mennessier
C. Rennie-Smith

Summary of Facts and Submissions

I. The present appeal lies from the decision of the Examining Division of 17 January 2008 to refuse European patent application No. 00989693.7 (which is based on the International Application PCT/US00/41521) for lack of inventive step (Article 56 EPC).

II. In this decision, the abbreviations below will be used in to indicate the corresponding official pronouncements:

"the 2009 Decision" - Decision of the President of the European Patent Office dated 26 February 2009 concerning the electronic filing of documents (OJ EPO 2009, 182).

"the 2007 Decision" - Decision of the President of the European Patent Office dated 12 July 2007 concerning the electronic filing of patent applications and other documents (OJ EPO 2007, Special Edition No. 3, page 12).

"the 2002 Decision" - Decision of the President of the European Patent Office dated 29 October 2002 on the electronic filing of patent applications and other documents (OJ EPO 2002, 543).

"the 2002 Notice" - Notice dated 29 October 2002 concerning the electronic filing of patent applications and other documents (OJ EPO 2002, 545).

"the 2003 Notice" - Notice from 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).

Further, the term *epoline* is used in this decision to mean the online facility of that name offered to its users by the EPO and for which the relevant software is supplied by the EPO free of charge. It is understood that the word *epoline* is registered as a trade mark in a number of European countries.

III. The notice of appeal was filed by faxed letter on 25 March 2008 and the appeal fee was paid on the same date. The statement of grounds of appeal was filed on 27 May 2008 by online electronic means using the *epoline* facility. Both the cover sheet completed by the appellant's representative and the acknowledgment of receipt issued by the EPO as part of the online filing procedure state the date of transmission and receipt respectively to be 27 May 2008, which was the last possible day for filing the grounds of appeal pursuant to Article 108 EPC and Rule 126(2) EPC. The cover sheet also contained, immediately above the signature section, the following:

Statement

The undersigned hereby declares that the subsequently filed items do NOT contain or are NOT intended to contain any communication relating either an appeal, an opposition, a limitation, a revocation proceeding or any proceedings for review (Special edition No. 3 OJ EPO 2007, A.4. Article 2(3) "Paragraph 1 shall not apply to documents in opposition proceedings, in European patent limitation or revocation proceedings, in appeal proceedings, or in proceedings for review by

the Enlarged Board of Appeal of decisions of the boards of appeal.")

- IV. The Board's registrar sent a letter dated 5 August 2008 to the appellant observing that the grounds of appeal had been filed electronically contrary to "the 2007 Decision" and that it could therefore be expected that the appeal would be rejected as inadmissible and inviting the appellant's comments within two months. In reply, the appellant filed by fax on 7 October 2008 a letter dated 6 October 2008 from its representative containing a request for re-establishment of rights, a written statement of the representative in support of that request, and a further copy of the statement of grounds of appeal in order, as the representative explained, to complete the omitted act.
- V. The facts and arguments in support of the request for re-establishment of rights can be summarised as follows. The representative acknowledges the grounds of appeal were filed electronically. He says the error was not detected until receipt of the registrar's letter of 5 August 2008, and thus the cause for non-compliance with the time limit for filing the grounds of appeal was removed on the date of receipt, namely 11 August 2008 (a date-stamped copy of the letter being produced to prove that was the date of receipt). He describes the system his firm maintains, including four checks by different persons at different stages, to avoid incorrect filing of documents at the EPO and says the firm has standing instructions not to file electronically documents excluded from such filing by "the 2007 Decision".

In the present case, despite numerous reminders to the appellant's US attorneys in California, the representative (whose firm is in England) only received instructions from them to file the grounds of appeal by telephone on the final day for filing, 27 May 2008. Since California time is eight hours behind United Kingdom time, the instructions came too late to follow the usual procedure. Other staff having left the office, the representative prepared the grounds of appeal himself without any assistance and, in haste to meet the deadline and thus overlooking the significance of doing so, sent the document electronically. He concludes by submitting that this was an isolated error in an otherwise reliable system and that the appellant should not be prejudiced by such an error which is not of its own making.

- VI. By "the 2009 Decision", which entered into force on 5 March 2009, "the 2007 Decision" ceased to have effect and it then became permissible to file *inter alia* statements of grounds of appeal online or on admissible electronic data carriers (see respectively Articles 14, 13 and 5(1) of "the 2009 Decision"). The only provision relating specifically to documents filed in appeal proceedings is the requirement that their authenticity is "confirmed by means of an enhanced electronic signature" (see Article 8(2) of "the 2009 Decision").
- VII. The appellant requests re-establishment of its rights to the effect that its statement of grounds of appeal filed on 7 October 2008 be treated as properly filed.

Reasons for the Decision

1. This interlocutory decision concerns only the issues of the admissibility of the appeal and the appellant's request for re-establishment of rights.

2. It appears that all the requirements for formal admissibility of the appeal have been met with one exception - the statement of grounds of appeal was filed by *epoline*. This did not affect the date of filing - both the cover sheet completed by the appellant's representative and the acknowledgment of receipt issued by the EPO as part of the online filing procedure clearly state the date of transmission and receipt respectively to be 27 May 2008 (which was in fact the last possible day for filing the grounds of appeal pursuant to Article 108 EPC and Rule 126(2) EPC). Therefore, the sole issue affecting the admissibility of the appeal is the fact that the statement of grounds of appeal was filed by *epoline*.

Provisions regarding use of epoline

3. "The 2007 Decision" was the provision in force at the relevant time in the present case, namely 27 May 2008 when the statement of grounds of appeal was filed. Article 1 of "the 2007 Decision" stated that European and international (PCT) patent applications might be filed in electronic form. Article 2(1) permitted certain other documents (those within the meaning of Rule 50 EPC and Rule 89 bis.1 and 2 PCT) to be filed in electronic form and Article 2(2) said that should not apply to priority documents (with the exception of those digitally signed by the issuing authority and

accepted by the EPO). Article 2(3) provided that Article 2(1) did not apply to documents in opposition proceedings, in European patent limitation or revocation proceedings, in appeal proceedings, or in proceedings for review by the Enlarged Board of Appeal of decisions of the boards of appeal. Thus Articles 1 and 2 of "the 2007 Decision" established what might and might not be filed electronically and it appears clear that all documents in appeal proceedings were excluded. The categories of documents excluded from electronic filing at that time were the subject of the statement (see section III above) appearing above the signature of the appellant's representative. That statement was apparently part of the standard form cover sheet prepared by the EPO for use with *epoline* transmissions. (It appears that in the statement the word "to" was unintentionally omitted after the word "relating".)

4. Before considering the relevant case-law, the Board observes that, by virtue of Article 13, "the 2007 Decision" entered into force at the same time as the revised text of the EPC i.e. on 13 December 2007 (the effective date pursuant to Article 8(1) of the Act Revising the Convention on the Grant of European Patents of 29 November 2000). Prior to 13 December 2007, the relevant provisions corresponding to those in "the 2007 Decision" were contained in three separate texts, all of which were superseded by "the 2007 Decision" (see Article 12 thereof). It was, however, those texts which were in force when all but one of the previous decisions of the boards of appeal discussed below were taken. It also appears that differences in the wording of "the 2007 Decision" and the previous measures may

reflect differences in the capacity or possible uses of the *epoline* service.

5. "The 2002 Decision" provided that European and PCT applications could be filed electronically and that other documents within the meaning of Rule 36 EPC 1973 or Rule 89bis.1 and 2 PCT might be so filed in accordance with "the 2002 Notice". Section 2.1 of "the 2002 Notice" specified the designation of the inventor, the authorisation and the form for entry into the European phase. Thus neither "the 2002 Decision" nor "the 2002 Notice" mentioned documents in appeal proceedings which were thus at that time (October 2002) excluded from electronic filing only by not being included.

6. However, the later "2003 Notice" stated:

*"1. The European Patent Office (EPO) 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."*

A footnote at the end of the first sentence referred the reader to the earlier "2002 Decision" and "2002 Notice", thus confirming that by December 2003 *epoline* could accommodate more than in October 2002.

7. What is to be noted is that electronic filing of documents in appeal proceedings was described in "the

2003 Notice" as a "possibility" which was "not yet available" and "therefore,...not admissible". That provision is to be compared with that in the subsequent "2007 Decision" which simply stated electronic filing "shall not apply" to *inter alia* appeals without any comment on admissibility or otherwise. As the present case demonstrates, electronic filing of appeal documents was indeed during the currency of "the 2007 Decision" a "possibility" and therefore "available", in as much as documents filed electronically did in fact reach the intended recipients (namely, the first instance department of the EPO whose decision was under appeal, to which appeals are sent initially as Article 109 EPC requires). Indeed, it appears from the case-law referred to below that this was also the position in late 2005 when most of those cases were decided, so the different wording in "the 2007 Decision" seems to have reflected a further change in "possibility" which took place after 2003.

Case-law on epoline filing

8. The Board is aware of five earlier decisions about electronic filing in appeal proceedings. In the earliest of these cases, T 514/05 (OJ EPO 2006, 526), a notice of appeal was filed electronically ten days before the time limit expired and no further steps were taken before such expiry. Two months later the Examining Division's formalities officer sent a communication informing the appellant that online filing was not permitted and advising it to file an appeal "in normal way before expiry of deadline" but this produced no reply. Board 3403 held that the "purported notice of appeal did not fulfill the formal

conditions for the filing of a notice of appeal". It considered "the 2002 Decision" and "the 2003 Notice" and, while not concluding that these *per se* excluded online filing of notices of appeal, found that there was **no** legal provision actually permitting such online filing. The Board then turned to consider the legal effect of the notice of appeal and concluded it had no effect and had to be deemed not to have been filed.

9. In both the cases T 991/04 of 22 November 2005 and T 781/04 of 30 November 2005, the same appellant filed notices of appeal together with statements of grounds of appeal by *epoline*, in both cases before the time for filing a notice of appeal had expired. In both cases also the appellant, while arguing its appeals should be held admissible, filed requests for re-establishment of rights. Two different boards of appeal each found that filing appeals electronically was inadmissible but differed as to the consequences for the appellant.
10. In T 991/04 (*supra*), Board 3305 considered that, in application of the principle of legitimate expectations, the appellant could have expected to receive, in the interval between the deficient online filing and the expiry of the time for filing a notice of appeal, a warning in sufficient time to allow it to file a notice of appeal in a permitted manner and, for that reason, the appeal was admissible. The re-establishment request was therefore considered not to be relevant. The Board held *inter alia* that, even though the manner of filing was not permitted, the notice of appeal was in fact received and that fact could not be disregarded: admissibility might remain an issue but it would be unconvincing to conclude that no appeal was pending.

- This differs starkly from the conclusion in T 514/05 (*supra*) that the appeal was deemed not to have been filed but it appears that the earlier decision T 514/05 (decided on 8 September 2005) was not considered.
11. In T 781/04 (*supra*) Board 3503 also found the appeal formally inadmissible. Both T 514/05 and T 991/04 were considered and distinguished as to the legal consequence of *epoline* filing. In T 514/05 the factual situation was different - in that case the appellant's attention was drawn to the deficient form of filing after the time for filing a notice of appeal had expired, whereas in T 781/04 there remained time to inform the appellant who could then have filed a notice of appeal correctly. However, Board 3503 came to a different conclusion as to the consequences of electronic filing from Board 3305 in decision T 991/04 despite the similar facts, including the possibility of warning the appellant before the time limit expired. Board 3503 preferred not to link the finding of inadmissibility to the omission of a warning and observed that it was rather the appellant's own mistake which led to the finding of inadmissibility. Nevertheless, the omission had deprived the appellant of an opportunity to correct the deficiency and for that reason the Board held that the appropriate remedy was to allow the request for re-establishment of rights.
12. The fourth decision is T 395/07 of 21 June 2007 in which a notice of appeal was filed by *epoline* twelve days before the time limit expired. The decision under appeal was reversed by the first instance by interlocutory revision, so the only issue for the Board of Appeal was whether the appeal fee should be

reimbursed. The decision referred to T 991/04, considered the notice deemed filed in time on the principle of the protection of legitimate expectations, and concluded that the appeal fee should not be reimbursed. Neither T 514/05 nor T 781/04 (*supra*) was apparently considered. Accordingly, T 395/07 does not add anything significant to the relevant jurisprudence.

13. The fifth and last decision is the most recent, namely T 765/08 of 4 February 2009 in which Board 3403 (in a different composition) followed its own previous decision in T 514/05 (see point 8 above). This case is the only decision of which the present Board is aware which was decided under "the 2007 Decision". In this case the notice of appeal (though not so called) was filed by *epoline* on 21 January 2008 and further documents (apparently the statement of grounds of appeal and claim requests, though again not so called) were filed by *epoline* on 3 April 2008. The Board referred to both decisions T 991/04 and T 781/04 (*supra*) as having found that such appeals must be rejected as inadmissible. (It did not mention that, in both those cases, the boards proceeded to avert the consequence that the appeals were rejected, but of course it did not have to mention that.) It also referred to its own decision T 514/05 (*supra*) that an appeal filed online must be deemed not to have been received, absent the explicit permission of the President of the EPO to use this way of filing documents for appeal proceedings.

14. Then, in a passage which is significant for the present decision, the Board observed that Rule 2(1) EPC specifies a possible legal effect foreseen for the irregular use of unapproved technical means, namely

that such a document shall be deemed not to have been received. The Board then observed that "the 2007 Decision" made it clear that parties were not permitted to use the *epoline* system for the filing of documents for opposition or appeal proceedings, even if the system is capable of handling them - for such documents the *epoline* system had to be considered as non-existent. The Board therefore held that the notice and grounds of appeal had to be deemed not to have been received as they had been filed by non-approved technical means. Three points stated as being in favour of this solution were that it reflected the legislative intent, avoided the legal problems that might arise from manifestly inadmissible appeals, and forestalled parties being able to impose on the EPO the use of technical means for purposes not intended.

15. Although very recent, T 765/08 (*supra*) has now been overtaken by the even more recent "2009 Decision" which allows documents in appeals to be filed by *epoline*. Accordingly, the *epoline* system now has to be considered as existent for such documents and the points which T 765/08 saw as favouring its conclusion have been rendered moot - the legislative intent has changed, appeals filed online are admissible, and the electronic means are approved and thus cannot be imposed on the EPO. It is beyond doubt that, if filed by *epoline* now, the appellant's statement of grounds of appeal would be admissible. The questions which the Board must answer are first, what was the consequence of using such a method of filing on 27 May 2008 and, second, if that consequence was adverse to the appellant, can it be avoided by its request for re-establishment of rights?

Admissibility of the appeal

16. In two of the decisions reviewed above (T 514/05 and T 765/08), the appeals were deemed not to have been filed and in the other three (T 991/04, T 781/04 and T 395/07) the appeals were held to be inadmissible but then saved either because (in T 991/04 and T 395/07) there was time available in which the appellants could have expected a warning which would have allowed them to re-file by an acceptable means or because (in T 781/04), a request for re-establishment of the appellant's rights was allowed. The material differences between "inadmissible" and "deemed not filed" are that, in the former case, an appeal exists and can be "saved" by for example re-establishment of rights but, in the latter case, no further proceedings are possible and the appeal fee is refunded (as was ordered in both T 514/05 and T 765/08). However, that brings into focus the essential difference between this case and all the previous cases known from the jurisprudence.

17. Whereas in all five earlier cases the notice of appeal was filed by *epoline*, in this case the notice of appeal was filed by an unarguably acceptable means, namely fax. Thus as of the date of that fax, 25 March 2008, on which the appeal fee was also paid, there was an appeal in existence which could only lead to reimbursement of the appeal fee if subsequently withdrawn before the time for filing the grounds of appeal expired (see Rule 103(1)(b) EPC). Since manifestly no withdrawal occurred, indeed a statement of grounds of appeal was filed in time (only just in time - after 6pm Central

European Time on the last day, 27 May 2008 - but none the less in time), no question of the appeal being deemed not filed arises in this case. The only possible consequence for the appellant of the filing of the statement of grounds of appeal by *epoline* is that, if the statement is treated as not filed, the appeal would become inadmissible. To that extent, and that limited extent only, this case is marginally more similar to T 991/04 and T 781/04 than to the other cases discussed above. (In those two cases, the notices and grounds of appeal were **both** filed by *epoline* - in fact filed together - and of course, as already mentioned, the filing of the notice of appeal by unapproved means endangered the very existence of the appeal not just the admissibility of the grounds of appeal.)

18. While the facts of this case are some considerable distance from those of any of the earlier cases, the Board is unable to ignore the fact that the statement of grounds of appeal was filed by a means not permitted at the time of filing, a fact acknowledged in his statement by the appellant's representative who actually made the *epoline* filing. The Board therefore has no alternative but to conclude that the statement of grounds of appeal was not filed in time with the consequence that, unless the appellant's request for re-establishment of rights is allowed, the appeal must be rejected as inadmissible.

Re-establishment request

19. As regards admissibility of the re-establishment request, the only question is the date of removal of the cause of non-compliance. The appellant's

representative argues this should be date of receipt (11 August 2008) of the letter of 5 August 2008 from the Board's registrar. His statement in support of the re-establishment request states both that the danger of using an incorrect means of filing was recognised in his firm and that he despatched the grounds of appeal by *epoline* on 27 May 2008 - those facts would suggest he knew, or should have known, that he was using an incorrect means of filing. Against that he also says expressly that when he made that *epoline* filing he did so under pressure and failed to recall the significance of using that means.

20. Since the Board finds the balance of his statement perfectly plausible, it also accepts his evidence in this respect. The main point against the representative is the statement above his signature (see section III above) but, if he failed under pressure to recall that *epoline* was not allowed for appeal documents, then it is credible that under pressure he did not re-read a statement on a standard form document he erroneously considered acceptable. The Board accepts that on this particular occasion the representative overlooked in its entirety the significance of using *epoline* and only realised his mistake when he received the registrar's letter. Accordingly, 11 August 2008 can be seen as the date of removal of the cause of non-compliance. The re-establishment request was filed, the appropriate fee paid and the omitted act completed within two months of that date. The request also states the grounds and facts relied on. Accordingly the request is admissible (see Rule 136(1) and (2) EPC).

21. The Board considers that the request is also allowable. On the representative's evidence, his firm has a standing system of checks to ensure that mistakes such as happened in this case are avoided. The mistake only happened when that system could not be used, namely when an overseas client in a different time zone gave very late instructions which required the representative to file the grounds of appeal "against the clock". It is easily understandable that, when matters are left to the last minute, mistakes may happen.
22. The representative submitted that this was an isolated error in an otherwise reliable system and that the appellant should not be prejudiced by such an error which is not of its own making. The Board agrees that this was an example of an isolated mistake in an otherwise satisfactory system. However, the error was at least in part of the appellant's own making since it would not have arisen if it had given the representative instructions in sufficient time for him to carry them out properly. The appellant in this case was fortunate that the representative could take instructions at the last minute and implement them before the deadline expired. The representative's only error was to use *epoline* and not, for example, a fax transmission. However, as indicated above (see point 7), *epoline* was actually available and it was possible to use it for filing the grounds of appeal - the only reason not to use it for appeal documents was that the EPO had not then, as it has subsequently, officially approved its use for such documents. Now that such approval has been given, that supports the conclusion to allow the re-establishment request in a

situation which, even without such approval, would merit re-establishment. Accordingly, the request for re-establishment of rights should be allowed with the consequence that the appeal is admissible.

Order

For these reasons it is decided that:

- 1 The request for re-establishment of rights is allowed.
- 2 The appeal is admissible.

The Registrar:

The Chairman:

K. Götz

L. Galligani