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**Datasheet for the decision
of 28 September 2010**

Case Number: T 1926/09 - 3.3.05

Application Number: 06010838.8

Publication Number: 1688177

IPC: B01F 7/16

Language of the proceedings: EN

Title of invention:

Container for transporting and storing field controllable fluid

Applicant:

LORD CORPORATION

Headword:

Magnetorheological device/LORD CORP

Relevant legal provisions:

EPC Art. 108, 106(1)
EPC R. 101(1), 103(1)

Keyword:

"Appeal (inadmissible) - Notice of appeal (missing) - Appeal fee (paid): not sufficient for valid filing of the appeal"
"Reimbursement of the appeal fee: no"

Decisions cited:

J 0019/90, J 0016/94, T 0371/92, T 0778/00, T 0445/98

Catchword:

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Case Number: T 1926/09 - 3.3.05

D E C I S I O N
of the Technical Board of Appeal 3.3.05
of 28 September 2010

Appellant: LORD CORPORATION
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Cary, NC 27512-8012 (US)

Representative: Dunlop, Brian Kenneth Charles
Wynne-Jones, Lainé & James LLP
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 23 April 2009
refusing European patent application
No. 06010838.8 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: G. Rath
Members: H. Engl
S. Hoffmann

Summary of Facts and Submissions

I. European patent application No. 06 010 838.8 was refused by decision of the examining division posted on 23 April 2009.

II. Under cover of a letter dated 24 August 2009 the applicant filed a statement of grounds for appeal and amended sets of claims as a main request and auxiliary requests A and B.

The appeal fee was paid on 16 June 2009, within the time limit prescribed by Article 108 EPC. However, no notice of appeal was received in due time, i.e. within two months of notification of the contested decision (Article 108 EPC).

III. According to the file, the applicant was informed on 26 August 2008 of the missing notice of appeal, in a telephone conversation with the formalities officer acting on behalf of the examining division. The representative was asked to look into the matter and to inform the EPO accordingly. A copy of the result of this consultation was sent to the applicant on 4 September 2009 by fax and again by confirmation letter on 9 September 2009.

IV. Under cover of a letter dated 21 September 2009, the applicant informed the EPO that it was unable, despite extensive searches, to find the part of the file covering the filing of the notice of appeal.

V. An official communication of the board was issued on 20 January 2010 informing the applicant that no notice

of appeal had been received and that the appeal would in all likelihood be rejected as inadmissible pursuant to Article 108 in conjunction with Rule 101(1) EPC. Further observations, if any, were invited within a time limit of two months.

A further communication of the board was issued on 5 February 2010, drawing attention to decision J 19/90.

- VI. The applicant filed further observations in a letter dated 5 March 2010.
- VII. A summons to oral proceedings was sent on 23 March 2010, to be held on 19 October 2010, to discuss the question of admissibility of the appeal.
- VIII. In a letter dated 19 August 2010, the applicant informed the board of its intention not to attend the oral proceedings. No further arguments were put forward. Accordingly, the summons for oral proceedings was cancelled.
- IX. The appellant's arguments, insofar as they are relevant for the present decision, may be summarised as follows:

Apparently, the part of the file covering the filing of the notice of appeal was missing from the representative's file and the documents concerned could not be found, despite extensive efforts to locate them.

However, a *de facto* notice of appeal existed in that the appeal fee had been paid in time, thus clearly indicating that an appeal was being made which could only have been directed against the decision of

23 April 2009. The fee sheet relating to said payment was in writing and identified both the appellant and its representative.

The final requirement in J 19/90 that there had to be an explicit declaration of the wish to contest a particular decision had only been inferred by the deciding board from a combination of Articles 106(1), 108 and Rule 64 EPC (1973). According to the representative, the board in J 19/90 could not justify the distinction it had made between a letter requesting an appeal and an instruction to pay the fee.

Moreover, decisions J 19/90 and T 445/98 invoked by the present board had both been taken in opposition cases rather than *ex partes* proceedings, where different considerations in the exercise of any discretion should apply.

VIII The appellant requested that the decision under appeal be set aside and a patent granted on the basis of the claims in accordance with the main request or auxiliary requests A or B, submitted with the statement of grounds of appeal.

The appellant also requested reimbursement of the appeal fee.

Reasons for the Decision

1. According to Article 108 EPC, notice of appeal must be filed within two months of notification of the decision. The applicant does not dispute that no notice of appeal was filed in due time.
2. The applicant however contends that a *de facto* notice of appeal existed in that the appeal fee was paid in time, thus clearly indicating that an appeal was being made which could only have been directed against the decision of 23 April 2009.
3. The board cannot accept this argument. It was already decided in J 19/90 (of 30 April 1992, not published in the OJ EPO, Reasons points 2.1.2 to 2.1.4) that merely paying the fee for appeal does not constitute a valid lodging of an appeal. According to said decision, this applies even if the object of the payment was indicated as being a "fee for appeal" relating to an identified patent application and the form for payment of fees and costs was used.

This decision was confirmed in subsequent decisions of the boards of appeal, for example T 445/98 (of 10 July 2000, Reasons point 3) and T 371/92 (OJ EPO 1995, 324, Reasons points 3.2, 3.4 and 3.5).

Furthermore, the board draws attention to decision T 778/00 (of 6 July 2001, not published in the OJ EPO), in particular its Reasons points 2.1, 2.2 and 2.4. This decision again confirms that the mere appeal-fee payment is no substitute for the procedural act of filing the appeal as prescribed in Article 108, first sentence,

EPC in conjunction with Rule 99(1)(b) and (c) EPC (Rule 64(a) and (b) EPC 1973), because the appeal fee could have been paid by the representative before the party concerned has decided whether or not an appeal should be filed.

4. The applicant argues that decisions J 19/90 and T 445/98 were both taken in opposition cases rather than *ex parte* proceedings, where different considerations in the exercise of any discretion should apply. However, the present board is of the opinion that it is in the public interest in both *ex parte* and *inter partes* proceedings to be informed with certainty about the applicant's intention of challenging a first-instance decision. Consequently, there can be no discretion regarding the procedural acts prescribed in Articles 106 to 108 EPC in conjunction with Rule 99 EPC for the filing of an appeal.

Therefore, the present board does not see any valid ground to depart from the case law cited.

5. The applicant also raised the issue of "natural justice" (letter of 5 March 2010, page 3). It was argued that if a patent application was refused without appeal, the applicant was being unjustifiably "punished" for a perceived "offence". The applicant was thus forced to seek protection by filing a divisional application of the parent application of the current case which was still pending. It was the applicant's understanding that filing such divisional applications was not considered by the EPO to be in the public interest and might even constitute an abuse. Therefore, it was unacceptable and improper for the EPO to infer

an understanding of the EPC which promoted such a course of action.

The present board wishes to observe the following. The board is far from "punishing" anybody for "offences" perceived or real, but is bound to administer the law as laid down in the Convention. Considerations relating to the filing of a divisional application are not relevant for the present case and cannot, therefore, be taken into account by the board.

6. For these reasons, the appeal must be rejected as inadmissible (Rule 101(1) EPC).
7. Refund of the appeal fee

Since the appeal must be rejected as inadmissible, it cannot be considered as to the substance. For the same reason there is no legal basis for ordering the reimbursement of the appeal fee (see J 16/94 of 10 June 1994, Reasons point 8).

Rule 103(1) EPC governs the reimbursement of the appeal fee (a) in the case of interlocutory revision or if the board of appeal deems an appeal to be allowable, or (b) if the appeal is withdrawn before the filing of the statement of grounds of appeal and before the period for filing that statement has expired. Neither provision is applicable in the present case.

Therefore, the appeal fee cannot be reimbursed.

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 rejected.

The Registrar

The Chairman

C. Vodz

G. Raths