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**Datasheet for the decision
of 14 December 2011**

Case Number: T 0377/11 - 3.3.10
Application Number: 02028664.7
Publication Number: 1304366
IPC: C09K 3/18, C03C 17/25,
C03C 17/34
Language of the proceedings: EN

Title of invention:

Use of a photocatalytically rendered superhydrophilic surface
with antifogging properties

Patentee:

Toto Ltd.

Opponent:

AGC Glass Europe

Headword:

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Relevant legal provisions:

EPC Art. 108

EPC R. 99(1)(b)(c)

Decision of the President of the EPO dated 26 February 2009

Keyword:

"Debit order for the appeal fee no valid means of filing the
appeal"

"Requirements for filing of appeal in electronic form the same
as in paper form"

"No obligation on the Board to notify the Appellant that the
notice of appeal is missing when an appeal fee has been paid"

Decisions cited:

G 0002/97, J 0019/90, J 0025/92, J 0016/94, T 0371/92,
T 0932/93, T 0460/95, T 0696/95, T 0778/00, T 0358/08

Catchword:

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Case Number: T 0377/11 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 14 December 2011

Appellant:
(Opponent)

AGC Glass Europe
Chaussée de La Hulpe, 166
B-1170 Bruxelles (BE)

Representative:

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MPV Patent SPRL
9, Rue Sainte Gertrude
B-1490 Court-Saint-Etienne (BE)

Respondent:
(Patent Proprietor)

Toto Ltd.
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Kokurakita-ku
Kitakyushu-shi
Fukuoka 802 (JP)

Representative:

Grünecker, Kinkeldey,
Stockmair & Schwanhäusser
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Decision under appeal:

Interlocutory decision of the Opposition
Division of the European Patent Office posted
29 October 2010 concerning maintenance of
European patent No. 1304366 in amended form.

Composition of the Board:

Chairman: P. Gryczka
Members: J. Mercey
F. Blumer

Summary of Facts and Submissions

- I. In the interlocutory decision posted on 29 October 2010, the Opposition Division found that European patent No. 1 304 366 (application No. 02 028 664.7) in amended form met the requirements of the EPC.
- II. On 13 December 2010, a sum of 1180 Euro was credited to an EPO bank account by virtue of an electronically filed debit form. Said form referred to this payment as an appeal fee, cited the above application number, and contained the name and address of the representative of the Opponent, hereafter designated the "Appellant".
- III. In a communication dated 1 March 2011, the Board indicated that it was of the preliminary opinion that the appeal had not been validly filed, since the mere payment of an appeal fee did not constitute a valid means of filing, citing decision T 778/00 (OJ EPO 2001, 554) in this respect.
- IV. On 3 March 2011, the Appellant filed the statement of grounds of appeal.
- V. In response to the communication of the Board, the Appellant argued that an appeal had been validly filed as the document filed on 13 December 2010 via *epoline* "was not merely a form for the payment of fees and costs, as was the case in decision T 778/00 (*loc. cit.*), but rather "une lettre d'accompagnement relative à des pièces produites ultérieurement" which contained a request, namely that an appeal fee be debited. From the application number, the decision being contested could implicitly be deduced, such that there was no doubt

about the sender's intention of filing an appeal against this decision. T 778/00 was additionally not relevant to the present case, because it was rendered before the entry into force of EPC 2000 and was based on the fact that the appeal was not filed **in writing**, this no longer being a requirement in EPC 2000, and electronic filing now being possible. The Appellant also cited *inter alia* decisions T 932/93 and T 358/08 (not published in OJ EPO), which confirmed that a request according to Rule 99(1)(c) EPC could be implicit, the extent of the appeal being a matter for the grounds of appeal. It further cited J 25/92 (not published in OJ EPO), wherein it was considered that if a request was uncertain, the EPO should clarify the situation by asking the requester. It further argued that its right to be heard had been violated during the first instance opposition proceedings, as highly relevant documents had not been taken into account.

- VI. The Respondent (Patent proprietor) argued that the "lettre d'accompagnement" filed on 13 December 2010 neither indicated the decision under appeal nor the subject of the appeal and thus did not fulfil the requirements of Rule 99(1)(b) or (c) EPC. Decisions T 932/93 and T 358/08 (neither published in OJ EPO) cited by the Appellant were not applicable in the present case, because in both cases underlying said decisions, the decision impugned was clearly identified in the Notice of Appeal, and there was a request that said decision be set aside.
- VII. The Appellant requested that the appeal shall be deemed to have been filed and that the appeal be declared admissible.

The Respondent requested that the appeal shall be deemed not to have been filed, or subsidiarily, that the appeal be dismissed as inadmissible.

VIII. At the end of the oral proceedings, held on 14 December 2011, the decision of the Board was announced.

Reasons for the Decision

1. Article 108 EPC, first and second sentences, provides that notice of appeal must be filed, in accordance with the Implementing Regulations, within two months of the date of notification of the decision appealed from. Notice of appeal is not deemed to have been filed until the fee for appeal has been paid.
2. In the present case, the decision posted on 29 October 2010 is deemed to have been delivered on 8 November 2010 (Rule 126(2) EPC); accordingly, the time limit under Article 108 EPC, first and second sentences, for filing the notice of appeal and paying the appeal fee expired on 10 January 2011 (Rules 131(4) and 134(1) EPC).
3. It is not disputed that the appeal fee was paid in due time, a debit order recording payment of an appeal fee, and including the application number and the name and address of the representative of the Appellant having been filed on 13 December 2010.
4. However, no notice of appeal was received within the time limit designated by Article 108 EPC. The Board

thus holds that no appeal has been filed within the time limit for appeal.

5. For the following reasons, the Board is not convinced by the Appellant's submissions in support of the existence of a valid appeal.

5.1 The Appellant argued that the debit order could be regarded as a notice of appeal, as it contained all the necessary information required by Rule 99(1)(b) and (c) EPC. More particularly it contained the application number, from which the decision to be contested could implicitly be deduced, and a request, namely that an appeal fee be debited. Thus, it was clear that the sender's intention was to file an appeal against the decision of the Opposition Division concerning European patent No. 1 304 366. In this respect, the Appellant cited *inter alia* decisions T 932/93 and T 358/08, which confirmed that a request according to Rule 99(1)(c) EPC could be implicit, the extent of the appeal being a matter for the grounds of appeal.

Rule 99(1)(b) and (c) EPC specifies that the notice of appeal shall contain an indication of the decision impugned, and a request defining the subject of the appeal, respectively.

In the present case, the debit order does not explicitly refer to any decision, nor does it contain a request defining the subject of the appeal. A request that an appeal fee be debited together with an application number cannot be a substitute for an **explicit and unequivocal statement** expressing the definite intention to contest an appealable decision

(see Headnotes of T 460/95, OJ EPO 1998, 597 and J 16/94 and J 19/90, neither published in OJ EPO). Payment of the appeal fee may at the most imply that the Appellant intended to file an appeal but does not in itself constitute the notice of appeal required to institute appeal proceedings. Once an appeal fee is paid, the payer remains free to decide whether or not it wishes to lodge an appeal (see T 371/92, OJ EPO 1995, 324, points 3.5 and 3.6). If it changes its mind and drops the matter, the appeal, being non-existent, is not deemed to be withdrawn, but the fee is reimbursed because no appeal has been filed (see T 696/95, not published in OJ EPO).

Decisions T 932/93 and T 358/08 are not applicable to the present case, because in the cases underlying said decisions, the decision impugned was clearly identified in the Notice of Appeal, and there was a request that said decision be set aside (see, for example, T 358/08, Reasons for the Decision, point 5.1). In T 932/93 (see Reasons for the Decision, point 1.1), the matter of dispute was whether the **extent** to which amendment or cancellation of the decision was requested under the then applicable Rule 64(b) EPC 1973, corresponding to the **subject** of the appeal under Rule 99(1)(c) EPC 2000 in T 358/08 (see Reasons for the Decision, point 5), may be implicit, and not whether the decision impugned had been identified or a request to set said decision aside had been made.

- 5.2 The Appellant submitted that in view of the fact that with the entry into force of EPC 2000, the provision that the notice of appeal must be filed **in writing** had been deleted from Article 108 EPC, and the fact that

appeals may now be filed in electronic form, it was now obsolete to have to file an explicit statement that an appeal was being lodged.

The deletion of the words "in writing" from Article 108 EPC was indeed in view of the future use of electronic means of filing documents (see OJ EPO, Special Edition 4, 2007, Point 1 to Article 108 EPC), Rule 2(1) EPC 2000 allowing for documents in proceedings before the EPO to be filed by "technical means of communication", the admissibility of electronic means of filing being announced by the Decision of the President of the EPO dated 26 February 2009 (OJ EPO 2009, 182). However, documents filed in electronic form are subject to the same provisions governing the filing of documents on paper (see Decision of the President of the EPO dated 26 February 2009 concerning the electronic filing of documents, Article 10(5), *loc. cit.*). Hence, the fact that the debit form of 13 December 2010 was filed in electronic form, makes no difference to the requirements of Article 108 EPC, which are not met (see points 4 and 5.1 above).

- 5.3 The Appellant further argued that if the EPO considered that a request was uncertain, it should have clarified the matter by asking the requester, citing J 25/92 (not published in OJ EPO) in this respect. This was particularly pertinent in the present case, since the document accompanying the payment of the appeal fee was filed on 13 December 2010, whereas the time limit under filing the notice of appeal did not expire until 10 January 2011, which meant that the EPO had had nearly one month in which to notify the Appellant of any potential irregularity.

However, the Board holds that there was nothing unclear or ambiguous concerning the debit order filed 13 December 2010, since it represented a usual method of paying an appeal fee. Filing the notice of appeal and paying the appeal fee are treated as two separate requirements for an appeal in Article 108 EPC, first and second sentences (see point 1 above); the appeal fee can be paid together with, before or after the filing of the notice of appeal, so long as the time limit under Article 108 EPC is met. As described above (point 5.1), once an appeal fee is paid, the payer remains free to decide whether or not it wishes to lodge an appeal. There was thus no indication in said debit order from which it could have been inferred that the Appellant would inadvertently miss the time limit for filing the notice of appeal, which fell nearly a month later, such that there was no reason, let alone an obligation, for the boards of appeal of the EPO to notify the Appellant that such a notice of appeal was missing (cf. G 2/97, OJ EPO 1999, 123).

- 5.4 The Appellant also submitted that the Opposition Division had committed a substantial procedural violation by not honouring its right to be heard, as highly relevant documents had not been taken into account.

However, since in the present case there is no appeal (see point 4 above), the Board has no power to judge whether there has been a substantial procedural violation by the first instance (see T 371/92, Headnote, *loc. cit.*).

6. Since no notice of appeal has been filed, the relevant fee paid is groundless and must therefore be reimbursed.

Order

For these reasons it is decided that:

1. No appeal was filed within the time limit for appeal.
2. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:

C. Rodríguez Rodríguez

P. Gryczka