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**Datasheet for the interlocutory decision
of 24 February 2014**

Case Number: T 2017/12 - 3.5.06

Application Number: 01989207.4

Publication Number: 1337931

IPC: G06F 15/173

Language of the proceedings: EN

Title of invention:

Domain name acquisition and management system and method

Applicant:

Snapnames.com, Inc.

Relevant legal provisions:

Vienna Convention on the Law of Treaties

Art. 31, 32

EPC (1973)

Art. 112(1)

EPC (2000)

Art. 94(2), 106(1), 108, 122

R. 126(2), 131(1)(2)(4), 134(1), 136

Keyword:

"Late filing of notice of appeal and grounds of appeal"

"Late payment of appeal fee"

"Two fees for re-establishment due for two missed time limits"

"Re-establishment of rights - no"

"Referral of question to the Enlarged Board"

Decisions cited:

G 0005/83, G 0002/08, J 0002/78, J 0005/80, J 0021/80,
J 0016/82, J 0024/87, J 0026/95, T 0489/93, T 0079/01,
T 1026/06, T 0046/07, T 1289/10, T 1535/10, T 2210/10,
T 1486/11

Catchword:

The following question is referred to the Enlarged Board of Appeal: Where a notice of appeal is filed but the appeal fee is paid after expiry of the time limit of Article 108 EPC, first sentence, is this appeal inadmissible or deemed not to have been filed?



Case Number: T 2017/12 - 3.5.06

INTERLOCUTORY DECISION
of the Technical Board of Appeal 3.5.06
of 24 February 2014

Appellant:
(Applicant)

Snapnames.com, Inc.
115 NW First Avenue
Suite 300
Portland, OR 97209 (US)

Representative:

Ström & Gulliksson AB
P.O. Box 4188
SE-203 13 Malmö (SE)

Decision under appeal:

**Decision of the Examining Division of the
European Patent Office posted 15 November 2011
refusing European patent application
No. 01989207.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: D. H. Rees
Members: M. Müller
W. Sekretaruk

Summary of Facts and Submissions

- I. With its decision announced in the oral proceedings of 5 October 2011, which was subsequently given in writing and posted on 15 November 2011, the Examining Division refused European patent application 01 989 207.4.
- II. On 31 May 2012 the applicant filed an appeal against this decision, paid the appeal fee and filed grounds of appeal. Additionally it requested that the appellant's rights in the filing of an appeal and in the filing of the statement of grounds of appeal within the time limits prescribed by Article 108 EPC be re-established according to Article 122 EPC. Simultaneously it paid the fee for re-establishment of rights twice, once for each missed time limit. At the same time the refund of one of the fees was requested due to the interrelation between the two time limits and since they both related to one and the same loss of right.
- III. According to the appellant, the removal of the cause of non-compliance with the time limit occurred on 18 May 2012 when it received a letter indicating that renewal fees could no longer be paid because the application was no longer pending.
- IV. In its grounds for re-establishment of rights, the applicant claims that it was unable to observe the time limit despite all due care required by the circumstances. When the application was refused the applicant company was owned by Overseenet, Inc. ("Overseenet"). At that time, Overseenet was working to finalize the sale of the applicant company to NameDrive US, LLC ("NameDrive"). After complicated negotiations

that had taken longer than expected the deal was closed on 31 January 2012, i.e. only a few days after the due date for filing an appeal on 25 January 2012. In the turbulent period with extraordinary activities leading up to the closing the applicant or its owner who controlled its activities apparently forgot to instruct the applicant's representative to proceed with an appeal. It was well established case law that for cases where the cause of non-compliance with a time limit involved some error in carrying out the party's intention to comply with the time limit, the all-due-care criterion was considered to be satisfied if non-compliance resulted either from exceptional circumstances or from an isolated mistake in a normally satisfactory case handling environment. One of the typical examples falling into the first group was organizational upheaval. That could be derived from cases T 469/93, T 1136/04 and T 14/89.

- V. In its annex to the summons to oral proceedings the board expressed its preliminary view that the request for re-establishment appeared to be admissible but not allowable.
- VI. In reply, the appellant filed an affidavit signed by Mr Snyder, who has had a central position during the business transaction on both the seller and the buyer sides, as proof for the circumstances set out in its grounds for re-establishment. The application was refused during negotiations which, according to the initial plans, had been expected to be closed before the end of the appeal period. By then, the responsibility for appeal would no longer have rested on the seller side had the deal been completed in time.

Therefore the present application had disappeared from the radar of the IP organisation on the seller side. Conversely, the buyer's responsibility only started when the transaction was actually completed, i.e. after the expiry of the time limit for filing an appeal, and it had no right to interfere with the prosecution of the present application before that.

The appellant also argued that the aforementioned criteria, "exceptional circumstances" and "isolated mistakes", for accepting that all due care had been taken even though a time limit was not complied with were alternatives and should be assessed separately. Exceptional circumstances having been demonstrated it was not necessary to also identify an isolated mistake.

VII. Oral proceedings, at which the appellant was not represented, took place on 7 June 2013. At the end of the proceedings, the board rejected the appellant's requests for re-establishment of rights and for refund of one of the fees for re-establishment. Furthermore the board decided to continue the proceedings in writing to consider whether the appeal should be deemed not to have been filed or found to be inadmissible.

VIII. In a subsequent communication the board indicated its preliminary opinion that the wording of Article 108 EPC, second sentence, would lead to a dismissal of the appeal as inadmissible. However, in view of the fact that a number of Board of Appeal decisions had come to a different conclusion and due to possible consequences for other provisions of the EPC a referral of questions to the Enlarged Board of Appeal might be necessary.

IX. In its letter of 23 September 2013 the appellant, despite having been informed via both the minutes and the subsequent communication that the board had decided this point, further argued that the fees for the omissions of filing the appeal and the grounds were in fact only one issue, as they were closely interlinked. Following the principle of good faith only one fee should be paid, because deciding on the present two issues did not cause more workload for the EPO. As to the question of inadmissibility the appellant noted that, despite the fact that the EPC did not explicitly define the effects of a rejection of a request for re-establishment, it seemed quite logical that the effect of a rejected such request was null and void and the case would stand as it would have, had the request for re-establishment not been filed in the first place. Consequently, given that the notice of appeal was filed and the appeal fee was paid after the prescribed time limits, the appeal had to be considered as not filed pursuant to Article 108 EPC. Applying the findings of J 2/78, J 21/80 and J 24/87 the appeal fee should be refunded as lacking a legal basis. The same reasoning applied for the 11th and 12th renewal fees because the application was no longer pending when the respective payments were made.

Reasons for the Decision

1. The request for re-establishment of rights in the right to file an appeal and to file grounds of appeal

1.1 Applicable version of the EPC

Article 122 EPC, together with Rule 136 EPC, are applicable in this case (see Articles 1 and 5 of the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000).

1.2 Admissibility of the request for re-establishment of rights

1.2.1 Loss of a means of redress

Under Article 108 EPC, a notice of appeal shall be filed within two months of notification of the decision. It shall not be deemed to have been filed until the fee for appeal has been paid. Within four months of notification of the decision, a statement setting out the grounds of appeal shall be filed. The appeal was filed and the appeal fee was paid on 31 May 2012, i.e. after the corresponding time limit had expired on 25 January 2012. The grounds of appeal were submitted on 31 May 2012, i.e. also after the relevant time limit had expired on 26 March 2012. (For the calculation of the time limits see Rule 126(2), Rule 131(1), (2) and (4) and Rule 134(1) EPC.)

1.2.2 Inability to observe the time limit

The filing of the appeal depended on a pertinent instruction by the applicant or the owner of the applicant, Overseas. As this instruction was forgotten, the European representative was unable to file the

notice and the grounds of appeal and to pay the appeal fee in time.

1.2.3 Admissibility of the request

Under Rule 136(1) EPC any request for re-establishment of rights shall be filed in writing within two months of the removal of the cause of non-compliance with the period. The appellant's representative has put forward that he had knowledge of the missed time limit since 18 May 2012, which date the board accepts, for the purposes of this decision, as the date of the removal of the cause of non-compliance. The request for re-establishment was filed on 31 May 2012 along with a statement of the grounds on which it was based and the facts on which it relied. On the same day, the omitted acts were completed by the filing of a notice of appeal, a statement of grounds of appeal, and the payment of the appeal fee together with two fees for the request for re-establishment as required by Rule 136(2) EPC. Consequently, the request for re-establishment is admissible.

1.3 Allowability of the request for re-establishment of rights

The request is not allowable because it has not been established to the board's satisfaction that the applicant has exercised all due care in handling the case.

1.3.1 All due care - general remarks

Both the applicant and its representative have to take all due care required by the circumstances (see Article 122(1) EPC and J 5/80, headnote I). All due care required by the circumstances means that the appellant and its representative must take the appropriate steps to meet the time limit in question. In this respect, an assessment has to be made as to which steps in particular a party acting reasonably can be assumed to have taken. As a general rule, a party acting reasonably would at least take precautions against expectable problems in common situations.

1.3.2 Due care in take-over periods

As a starting point the board accepts that in the course of complicated transfers of ownership of a company isolated mistakes cannot be entirely avoided despite all due care. But this does not mean that transfer negotiations alone are an acceptable excuse for failing to observe time limits. Consequently, the board cannot accept the appellant's argument that company transfer negotiations per se constitute exceptional circumstances which would establish that all due care had been taken although a time limit was missed. The board considers that the take-over of a company is a normal economic activity which does not necessarily affect everyday business. The board concludes that it was up to the appellant to provide details as to why the present take-over negotiations may have affected the patent administration in an exceptional manner.

1.3.3 The facts of the case at hand

The appellant has put forward that, at the time the application was refused, it was owned by Oversee. The sale to NameDrive was closed on 31 January 2012, this date being very shortly after the due date for filing the appeal on 25 January 2012. The negotiations regarding the purchase were conducted in a turbulent atmosphere; they were complicated and took longer than expected. The board considers that it is not exceptional for transfer negotiations to take longer than expected for unforeseen reasons and that, therefore, due care requires that suitable precautions be taken for this case. The appellant did not provide any detail regarding the patent handling procedures employed by the applicant or the new owner and how they might have been affected by the "turbulent" takeover negotiations; reference is only made to "a long history of patent development" and "a hitherto flawless record". Also no concrete details were given of the nature of the error and how it occurred; all that is said is that "SnapNames or Oversee ... apparently forgot to instruct the professional representative".

2. Refund of one fee for re-establishment of rights

The relevant part of Article 122 (1) EPC provides: "An applicant ..., who was unable to observe a time limit ..., shall have its rights re-established ...". Rule 136(1) EPC, second sentence, states: "The request for re-establishment of rights shall not be deemed to have been filed until the prescribed fee has been paid." The Schedule of Fees and Expenses of the EPO refers, under item 13, to "Fee for re-establishment,

... ". There are no explicit provisions in the EPC dealing with the case in which several time limits have been missed. The board takes this as an indication that each time limit has to be considered separately and concludes that, in the absence of any hint to the contrary, for the number of fees to be paid the number of missed time limits is decisive.

This is in line with the decision J 26/95 (OJ EPO 1999, 668, headnote 3) of the Legal Board of Appeal which, concerning the fees for missed time limits for a reply to the examining division's communication and the payment for the 6th renewal fee, held:

"Where time limits expiring independently of one another have been missed by the applicant, each resulting in the application being deemed withdrawn, a request for re-establishment has to be filed in respect of each unobserved time limit. In accordance with Article 122(3), second sentence, EPC [1973], a fee for re-establishment has to be paid in respect of each request. It is irrelevant whether the requests for re-establishment are filed in the same letter or in different letters and whether they are based on the same or different grounds (point 5.2)."

The same reasoning applies to the requests for re-establishment of rights in relation to the filing of a notice of appeal and of the grounds of appeal, firstly because the corresponding time limits expire independently of one another, notwithstanding the fact that they are triggered by the same event, namely the dispatch of the written reasons for a decision. The board notes that for example if the time limit for

filing an appeal were extended from a weekend to a Monday by virtue of Rule 134(1) EPC, this would have no effect on the expiry of the time limit for filing the grounds of appeal. Secondly, failure to meet either of these time limits individually results in a loss of the right to appeal. Article 108 EPC, first sentence, states that the appeal shall be filed within two months of the notification of the decision and Article 108 EPC, third sentence, provides that a statement setting out the grounds of appeal shall be filed within four months of notification. Failure to comply with either one of the two time limits would cause the appeal to be rejected as inadmissible, provided that the appeal fee was paid. Consequently, two fees for re-establishment were indeed due and hence a refund of one of those fees is not possible.

The applicant's counter-arguments were not convincing. It depended on the principle of good faith combined with the fact that it put no additional workload on the EPO to decide on these two omitted acts rather than only one to justify its opinion that only one fee was payable. In this respect the board notes that the fee structure of the EPC does not necessarily reflect the actual workload imposed on the EPO in any individual case. Rather, legislators have chosen lump sums as fees that are for example independent of the number of auxiliary requests to be decided or the days allowed for conducting oral proceedings.

In G 2/08 (OJ 2010, 456) the Enlarged Board stated that from Articles 31 and 32 of the Vienna Convention, according to which the EPC had to be interpreted (see also G 5/83, OJ EPO 1985, 60), it followed that the

provisions of a treaty had, as a matter of good faith, to be construed primarily according to the ordinary meaning of the terms in their context and in the light of its object and purpose. This means that the judge is not entitled to depart from clear provisions of law.

3. Questions to the Enlarged Board of Appeal

Under Article 112(1) EPC 1973 the Board of Appeal, in order to ensure uniform application of the law or if a point of law of fundamental importance arises, and possibly of its own motion, shall refer any question to the Enlarged Board of Appeal if it considers that a decision is required for the above purposes.

3.1 Uniform application of the law

According to Article 108 EPC, second sentence, "Notice of appeal shall not be deemed to have been filed until the fee for appeal has been filed."

3.1.1 The majority interpretation in Board of Appeal decisions

Article 108 EPC, second sentence, has been interpreted in numerous decisions of the Boards of Appeal to mean that an appeal does not come into existence if the appeal fee is not paid within the two-month time limit so that a late filed appeal fee has to be reimbursed. Many of these decisions relate to a request for re-establishment after a late payment of the appeal fee.

Where re-establishment was refused, the board generally dealt with the appeal itself and its non-existence in only a few sentences.

The leading decision is J 21/80. In this case the appeal fee had been paid late. The board held that, "En raison de l'inexistence d'un recours valable, le montant de la taxe de recours payée tardivement doit être restitué." There is no further reasoning. The order, originally in French, contains the following statement: 'Le recours contre la décision de la Section de dépôt du 12 mai 1980 est considéré comme non formé.' The English translation of this, "The appeal against the Decision ... is inadmissible", is incorrect, whereas the German translation is accurate: "Die Beschwerde ... gilt als nicht eingelegt."

The decision J 24/87 as cited by the appellant comes to the same conclusion but also without any reasoning.

The decision J 2/78 as also cited by the appellant is not pertinent for the issue in question because in that case no appeal fee had been paid at all.

J 16/82 followed J 21/80, stating (reasons 2, 9 and 10):

"2. Zu den Voraussetzungen einer rechtswirksamen Beschwerde gehört, daß die Beschwerdegebühr innerhalb der nach Artikel 108 EPÜ vorgeschriebenen 2-Monatsfrist entrichtet wurde. Andernfalls gilt die Beschwerde nach Artikel 108 Satz 2 EPÜ nicht als eingelegt (siehe Entscheidung der JurBK J 21/80 vom 26. Februar 1981, AB1. EPA 1981, 101). ...

9. Da eine Wiedereinsetzung somit nicht stattfinden kann, gilt die Beschwerde gem. Artikel 108 Satz 2 EPÜ als nicht eingelegt. Artikel 108 Satz 2 EPÜ ist entsprechend seiner Entstehungsgeschichte in Zusammenhang mit Satz 1 in dem Sinne zu verstehen, dass die Beschwerde nicht als eingelegt gilt, wenn die Beschwerdegebühr nicht innerhalb der in Satz 1 genannten Beschwerdefrist entrichtet worden ist (siehe auch die bereits unter Nr. 2 erwähnte J 21/80 vom 26. Februar 1981, ABl. EPA 1981, 101).

10. Gilt eine Beschwerde gem. Artikel 108 Satz 2 EPÜ deswegen als nicht eingelegt, weil die Beschwerdegebühr erst nach Ablauf der Beschwerdefrist gezahlt wurde, so kann der mit der Zahlung der Gebühr verfolgte Zweck nicht mehr erreicht werden. Die Beschwerdegebühr ist daher zurückzuzahlen, ohne daß es einer besonderen Anordnung der Beschwerdekammer bedarf."

Thus, beyond a not further explained reference to the Article's "Entstehungsgeschichte", none of these decisions gave any reasoning for this interpretation of Article 108, second sentence. Later decisions generally add nothing to the minimal reasoning of these leading decisions.

In T 489/93, the board, when rejecting the appeal as "unzulässig" or inadmissible, for late payment of the appeal fee, stated, "Die Beschwerde war daher als unzulässig zu verwerfen, Regel 65(1) EPÜ [1973]. Der Wortlaut in Regel 65(1) EPÜ als 'unzulässig' ist in einem weiten Sinn verwendet, d. h. umfasst sowohl den Fall der existenten (aber 'unzulässigen') wie den der

nicht existenten Beschwerde." Considering the case to fall in the latter category, and citing J 21/80, it ordered the repayment of the appeal fee.

3.1.2 Dissenting decisions

In decisions T 1289/10, T 1535/10 and T 2210/10 the appeal was dismissed as inadmissible without refund of the appeal fee where the notice of appeal was filed and the appeal fee was paid after expiry of the time limit for filing an appeal, but the reasons for the decision do not specifically address this point.

In decision T 79/01 the appeal was found inadmissible after an incomplete payment of the appeal fee and the incomplete fee was not reimbursed. The board argued (reasons 9 and 10) that this led to a consistent interpretation of Rule 65(1) EPC 1973 and that,

"There is no reason to provide the appellant with a more favourable treatment in case of late (or insufficient, as in the present case) payment of the appeal fee (ie the appeal is deemed not been filed and the appeal fee is reimbursed) as in case of, for example, late filed statement of grounds (inadmissibility of the appeal). Moreover the 'travaux préparatoires' seem to support this interpretation. In the 'Materialien zum EPÜ' (IV/6514/61-D) is provided for, with reference to the "Entscheidungsmöglichkeiten der Beschwerdekammer' that 'Die Kammer kann feststellen, dass die Beschwerde wegen Nichtentrichtung der Gebühr unzulässig ist'."

3.2 Point of law of fundamental importance

The same wording as in Article 108 EPC can be found in Article 94 EPC (request for examination), Article 99 EPC (opposition) and Article 105a EPC (limitation), Article 112a (petition for review), and in Rule 22 EPC (registration of transfers), Rule 89 EPC (intervention), Rule 123 EPC (conservation of evidence), and Rule 136 EPC (re-establishment). Consequently, the interpretation of Article 108 EPC, second sentence, could have implications that go beyond the current case to be decided.

3.3 A dissent between decisions on a related issue

For illustration of such possible implications, the board notes that the decisions T 1026/06, T 46/07 and T 1486/11 differ on the question as to whether a request for re-establishment is deemed not to have been filed when the fee for re-establishment was paid after the two-months time limit according to Rule 136(2) EPC, in view of Rule 136(1) EPC, last sentence, which provides that "[t]he request for re-establishment of rights shall not be deemed to have been filed until the prescribed fee has been paid" (which corresponds to the formulation of Article 108 EPC in question).

In these decisions the boards had to deal with three cases in which the appellants requested re-establishment after late filing of the notice of appeal and late payment of the appeal fee but in which also the fee for re-establishment was filed late.

In all three cases, the request for re-establishment was not granted, the appeal was deemed not to have been filed and the refund of the appeal fee was ordered.

In T 46/07 and T 1486/11, the boards concluded in view of Article 122(2) and (3) EPC 1973 and Rule 136(1) EPC, last sentence, respectively, that the request for re-establishment of rights was deemed not to have been filed and that, therefore, the fee for re-establishment had to be reimbursed (see T 46/07, headnote, and T 1486/11, reasons 1.8 and 3). In T 1026/06, however, the board did not refer to Article 122(3) EPC 1973, second sentence, but rejected the request for reimbursement of the fee for re-establishment because that fee was necessary to make the request for re-establishment effective and was therefore paid with a legal basis (see reasons 7).

3.4 Why a decision of the Enlarged Board of Appeal is required

In the case at hand it depends on the interpretation of Article 108 EPC, second sentence, whether the appeal fee has to be refunded (if the appeal is deemed not to have been filed) or not (if the appeal came into existence but is inadmissible). The board tends to consider that the appeal is inadmissible.

3.4.1 Rules of interpretation

In case G 5/83 (OJ EPO 1985, 60; see "Preliminary Observations") the Enlarged Board of Appeal stated that the European Patent Convention has to be interpreted according to Articles 31 and 32 of the Vienna

Convention on the Law of Treaties. These Articles read in full:

"Article 31: General rule of interpretation

1. A treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose.

2. The context for the purpose of the interpretation of a treaty shall comprise, in addition to the text, including its preamble and annexes:

(a) any agreement relating to the treaty which was made between all the parties in connection with the conclusion of the treaty;

(b) any instrument which was made by one or more parties in connection with the conclusion of the treaty and accepted by the other parties as an instrument related to the treaty.

3. There shall be taken into account, together with the context:

(a) any subsequent agreement between the parties regarding the interpretation of the treaty or the application of its provisions;

(b) any subsequent practice in the application of the treaty which establishes the agreement of the parties regarding its interpretation;

(c) any relevant rules of international law applicable in the relations between the parties.

4. A special meaning shall be given to a term if it is established that the parties so intended.

Article 32: Supplementary means of interpretation

Recourse may be had to supplementary means of interpretation, including the preparatory work of the treaty and the circumstances of its conclusion, in order to confirm the meaning resulting from the application of Article 31, or to determine the meaning when the interpretation according to Article 31:

- (a) leaves the meaning ambiguous or obscure; or
- (b) leads to a result which is manifestly absurd or unreasonable."

3.4.2 Applying the general rule of interpretation

It follows from Article 31 (1) of the Vienna Convention and G 5/83 that the EPC should be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of the treaty's object and purpose. Article 31 (2) and (3) define which documents constitute this context and which additional sources shall be taken into account for the purpose of interpretation. Article 31 (4) adds that a special meaning can only be given to a term if it is established that the parties to an international treaty so intended. The ordinary meaning of Article 108 EPC, second sentence, "Notice of appeal shall not be deemed to have been filed until the fee for appeal has been filed," appears to be that before the appeal fee has been paid the appeal is deemed not to have been filed, and once the fee has been paid the aforementioned provision no longer applies, with the consequence that the appeal is filed. No relationship between the payment of the appeal fee and the time limit for filing

the appeal can be derived from the literal wording of Article 108 EPC. Furthermore, the board is not able to establish, based on the text of the EPC or its preamble, that the parties to the EPC wanted Article 108 EPC, second sentence to be read "Notice of appeal shall not be deemed to have been filed until the appeal fee has been paid [in time]", nor is the board aware of any other source of interpretation as mentioned in Article 31 (2) and (3) of the Vienna Convention that would establish this.

The board is not convinced by the appellant's argument that the appeal fee has to be refunded because it was paid without a legal basis. The Board accepts that fees paid without a legal basis are to be refunded. However, in cases like the present one there is a legal basis for payment of the appeal fee since the board has to decide on the appeal. The Rules relating to Fees do not distinguish between decisions on admissibility and decisions on substantive matters.

3.4.3 Applying supplementary means of interpretation

Article 32 of the Vienna Law of Treaties justifies the use of supplementary means of interpretation in order to confirm the meaning resulting from the application of Article 31 or if the interpretation under Article 31 leaves the meaning ambiguous or obscure or leads to a manifestly absurd or unreasonable result. The board considers that the latter is not the case. Thus supplementary means of interpretation can only be used to confirm the meaning resulting from the application of Article 31.

In this regard, the board notes that there is nothing in the travaux préparatoires directly concerning the interpretation of present Article 108 EPC, second sentence. But it may appear that document IV/6.514/61-D indirectly confirms the board's interpretation.

IV/6.514/61-D

The travaux préparatoires in IV/6.514/61-D discuss a draft version of Article 93 which later became Article 108 EPC. In paragraph 2 of this draft Article it is explicitly stated: "Wird die Beschwerdegebühr nicht rechtzeitig entrichtet, so gilt die Beschwerde als nicht erhoben." Under "Erörterungen zu Artikel 93 des Vorentwurfs des Abkommens", on page 3, it is reported that "Herr Van Benthem stellt die Frage, ob das Abkommen ein Rechtsmittel gegen die Feststellung vorsehe, dass die Beschwerde wegen Nichtentrichtung der Gebühr als nicht eingelegt gelte. Der Präsident antwortet hierauf, in diesem Fall müsse ein Rechtsmittel vor dem europäischen Patentgericht möglich sein." On page 9 it is further explained that "Die Feststellung, dass seine eingelegte Beschwerde mangels rechtzeitiger Gebührenzahlung als nicht erhoben gilt, wird dem Beschwerdeführer in einer wiederum beschwerdefähigen Entscheidung zugestellt werden müssen. Es erscheint nicht erforderlich, diesen Grundsatz im Abkommen selbst festzulegen. Ob in der Ausführungsordnung zu diesem Abkommen eine entsprechende Bestimmung aufgenommen werden soll, wird später zu entscheiden sein."

It is thus clear that the provisions and the procedure originally envisaged were different from the ones

eventually adopted. In particular the draft article explicitly defined an appeal for which the appeal fee was not paid on time as being deemed not to be filed. This definition of what seems to be a special case does not exist in the article as it was finally adopted. There is no record of a discussion of this point with reference to the present wording. Thus it cannot be ruled out that the legislators in fact adopted the present wording because they no longer wished to make the situation of an appeal fee being paid late into such a special case.

Furthermore, it seems that the legislator in fact elsewhere used explicit wording to specify the consequences of a late-filed request. An example can be found in Article 94(2) EPC, which reads: "If no request for examination has been made in due time, the application shall be deemed to be withdrawn." Consequently, it would appear incorrect to read Article 108, second sentence, EPC in a way it is not worded.

The board notes that the decision T 79/01 referred to above cites the above document from the travaux préparatoires in support of its position not to refund the appeal fee. Indeed, in IV/6.514/61-D it is stated under "Erörterungen zu Artikel 97 des Vorentwurfs", Article 97 being a draft version of what later became Article 111 EPC, on page 6, : "Der Präsident erklärt, dass die ersten drei Absätze dieses Artikels die fünf Entscheidungsmöglichkeiten der Beschwerdekammer regeln. 1. Die Kammer kann feststellen, dass die Beschwerde wegen Nichtentrichtung der Gebühr unzulässig ist (Artikel 93 Absatz 2)." However, this referred to paragraph 1 of the proposed Article 97(1) EPC which

read: "Ist die Beschwerde nicht statthaft oder nicht in der vorgegebenen Form oder Frist eingelegt, so verwirft die Kammer sie als unzulässig." IV/6.514/61-D further explains on page 17 that "Artikel 97 des Arbeitsentwurfs führt die verschiedenen Arten von Entscheidungen auf, die die Beschwerdekammer treffen kann, und regelt Einzelheiten dieser Entscheidungen. In den Absätzen 1 und 2 wird ein terminologischer Unterschied gemacht ob einer Beschwerde wegen Fehlens bestimmter formeller Erfordernisse oder wegen Fehlens eines sachlichen Grundes versagt wird. Im ersten Fall wird die Beschwerde 'als unzulässig verworfen'. Dies geschieht, z.B., wenn die Beschwerde von jemandem erhoben worden ist, der durch die angegriffene Entscheidung nicht beschwert ist, oder wenn die Beschwerde verspätet eingelegt, die Beschwerdegebühr aber rechtzeitig entrichtet worden ist. (Ist jedoch die Beschwerdegebühr nicht oder verspätet eingegangen, so gilt gemäß Artikel 93 Abs 2 die Beschwerde 'als nicht erhoben')."

Again it is to be noted that IV/6.514/61-D relates to draft versions of Article 93 and 97 EPC which were not finally adopted in this form. This could lead to the conclusion that wording finally adopted has to be interpreted literally.

4. The request for refund of the 11th and 12th renewal fee

As the Enlarged Board's decision may have an impact on the possibility to refund the 11th and 12th renewal fees the board will deal with this request in its final decision.

Order

For these reasons it is decided that:

1. The request for re-establishment of rights is refused.
2. The request for refund of one of the fees for re-establishment is refused.
3. The following question is referred to the Enlarged Board of Appeal:

Where a notice of appeal is filed but the appeal fee is paid after expiry of the time limit of Article 108 EPC, first sentence, is this appeal inadmissible or deemed not to have been filed?

The Registrar:

The Chairman:

B. Atienza Vivancos

D. H. Rees