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**Datasheet for the decision  
of 7 June 2016**

**Case Number:** T 1325/15 - 3.5.07

**Application Number:** 07864887.0

**Publication Number:** 2126685

**IPC:** G06F17/30

**Language of the proceedings:** EN

**Title of invention:**

Device for saving results of location based searches

**Applicant:**

QUALCOMM Incorporated

**Headword:**

Location-based searches/QUALCOMM

**Relevant legal provisions:**

EPC Art. 108, 122, 128

EPC R. 111(2)

**Keyword:**

Appealed decision - notified (yes)  
Time limit for filing notice of appeal -  
protection of legitimate expectations (no)  
Re-establishment of rights concerning time limit for filing  
notice of appeal (no)  
Admissibility of appeal - appeal deemed not to have been filed  
- reimbursement of appeal fee  
Removal of a document from the public file (no)

**Decisions cited:**

G 0005/83, G 0002/97, G 0002/12, R 0018/13, J 0002/86,  
J 0027/88, J 0013/90, J 0019/90, J 0031/90, T 0042/84,  
T 0390/86, T 0166/87, T 0428/98, T 0445/98, T 0778/00,  
T 0493/08, T 0592/11, T 2017/12, T 1553/13

**Catchword:**

See points 34 to 43 of the reasons



**Beschwerdekammern**  
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Case Number: T 1325/15 - 3.5.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.07**  
**of 7 June 2016**

**Appellant:** QUALCOMM Incorporated  
(Applicant) 5775 Morehouse Drive  
San Diego, CA 92121-1714 (US)

**Representative:** Potter, Julian Mark  
WP Thompson  
55 Drury Lane  
London WC2B 5SQ (GB)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted on 9 February 2015  
refusing European patent application No.  
07864887.0 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman** R. Moufang  
**Members:** R. de Man  
M. Rognoni

## **Summary of Facts and Submissions**

- I. The applicant (appellant) filed a notice of appeal against the decision of the Examining Division refusing European patent application No. 07864887.0.
  
- II. The decision was taken in oral proceedings held on 21 October 2014 and issued in writing on 9 February 2015. An acknowledgement of receipt was faxed to the EPO on 19 March 2015, confirming receipt on 13 February 2015 of both the decision (on EPO Form 2007) and the reasons for the decision (on EPO Form 2916).
  
- III. The notice of appeal was received on 19 June 2015 together with the statement of grounds of appeal and a letter labelled "Letter 1" comprising a main request and an auxiliary request, both requests dealing with the apparent late filing of the appeal.

With its main request, the appellant requested that the Examining Division reissue the decision. With its auxiliary request, it requested re-establishment of rights pursuant to Article 122 EPC in respect of the time limit for filing the notice of appeal.

In case its auxiliary request was allowed, the appellant requested re-establishment of rights in respect of the time limit for paying the eighth-year renewal fee and the corresponding additional fee. The eighth-year renewal fee had been paid on 7 November 2014 but had been refunded by the EPO on 3 June 2015.

The appeal fee, the two fees for re-establishment of rights and the eighth-year renewal fee as well as the corresponding additional fee were paid on the same day.

- IV. In a communication accompanying a summons to oral proceedings, the Board expressed the preliminary view that the Examining Division would not have been competent to (re)issue the decision in accordance with the appellant's main request and that the notice of appeal had been received only after the expiry of the relevant time limit. It further expressed doubts whether the auxiliary request for re-establishment of rights could be allowed. In addition, the Board noted that the eighth-year renewal fee, if due, appeared to have been paid in time.
- V. With a letter dated 18 December 2015, the appellant *inter alia* filed statutory declarations by the professional representative and by Ms Modlock, the office manager of the representative's firm, a copy of an email by the representative reporting the Examining Division's decision to the appellant and a copy of a letter dated 6 April 2015 containing the appellant's instructions to file an appeal. It requested that EPO Form 2019 dated 9 February 2015 be removed from the public file.
- VI. With a letter dated 14 January 2016, the appellant filed further statutory declarations by the professional representative and by Ms Modlock.
- VII. In the course of oral proceedings held on 20 January 2016, the appellant replaced its requests with a main request, first and second auxiliary requests and a separate procedural request. At the end of the oral proceedings, the chairman declared the debate closed and announced that the decision would be given in writing.

VIII. With a letter dated 1 February 2016, the appellant filed further observations.

IX. The appellant's final requests read as follows:

"MAIN REQUEST

The Board decides that the omission of the attachment of the 'text of articles 106 to 108' from the Decision of the Examination Division of 9 February 2015 means that the appeal was filed in due time because the time period for appeal had not yet expired.

1<sup>st</sup> AUXILIARY REQUEST

The Board finds that the omission of the attachment of the 'text of articles 106 to 108' was contrary to the principle of legitimate expectation and hence the appeal is to be treated as having been filed in due time.

2<sup>nd</sup> AUXILIARY REQUEST

That the applicant's request for restitution under article 122 be allowed.

SEPARATE PROCEDURAL REQUEST

That the document bearing the text of articles 106 to 108 be removed from the public file."

X. The content of Ms Modlock's statutory declarations may be summarised as follows.

She was employed as the office manager at the representative's firm. One of her responsibilities was to manage the firm's docketing procedure.

Per day the firm received 10 to 15 pieces of EPO post and handled around 200 pieces of correspondence. Of those, at least half required either date entry or checking of existing deadlines.

Each morning a records clerk reviewed each communication received, identifying any deadlines or due dates by which a certain action needed to be completed and creating corresponding entries in the *Inprotech* docketing system software. For communications which required client instructions, *Inprotech* automatically generated a due date for reporting the communication to the client. This acted as a reminder for the responsible representative and was set at one month from the date of posting the communication. If a due date was entered into *Inprotech*, the first page of the communication was stamped with a "records department stamp". This stamp was marked with the initials of the records clerk and with any due dates relating to the communication.

Once the records clerk had reviewed and processed the incoming mail, it was normally passed to her for a second check. Upon completing the check, she added her initials to the records department stamp. The mail was then delivered to the representative responsible for the case, who carried out a third check when reporting the communication to the client. If she was due to be absent, she notified the relevant representatives that they had to carry out the second check of their post themselves or make appropriate arrangements.

*Inprotech* generated weekly prompt lists for all attorneys, showing the due dates for the cases that they were responsible for.

In the present case, the written decision had been received on Friday, 13 February 2015. When the records clerk had processed it on Monday, 16 February 2015, no due date had been identified due to the absence of EPO Form 2019. Consequently, no entry had been made in *Inprotech*, and the document had not been stamped with a records department stamp.

She had been out of the office from 16 February 2015 until 23 February 2015. She had notified the relevant representatives of her absence and had confirmed that they had to check their own post or make appropriate arrangements.

As no entry had been made in *Inprotech*, the generated prompt lists had not included the due dates relevant to the present case.

To her knowledge, this was the first time in over 15 years that a mistake had made it through the checks.

XI. The content of the representative's statutory declarations may be summarised as follows.

The firm's docketing procedure was as described in Ms Modlock's statutory declarations.

Once the records department had finished processing the mail, he went through his mail identifying correspondence which required further action. For EPO communications, he checked the records department stamp and verified that the date entered with the stamp corresponded to the deadline set out in the communication and had been entered in *Inprotech*. This was the "third check" referred to in Ms Modlock's statutory declarations.



*Inprotech* generated weekly prompt lists for all attorneys, showing the due dates for the cases they were responsible for. Upon receipt of his prompt list, he reviewed the upcoming due dates to check that the necessary action had been taken or was in progress, and that the due date had been or would be met, as appropriate.

When reporting a communication to the client, he generally checked *Inprotech* to ensure that the correct due date had been entered. When he received client instructions, he checked his prompt list to see whether a response was due to be filed imminently.

As set out in Ms Modlock's statutory declarations, in the present case no due date associated with the Examining Division's decision had been entered in *Inprotech*, and the document had not been stamped with a records department stamp.

He did not recall whether he had remembered that the office manager had been out of the office. Uncharacteristically, he had not noticed that the decision had not been marked with the records department stamp. However, he had identified the document as one requiring further action because the decision had been reported to the client.

He had reviewed the decision on 19 March 2015 and had dictated a reporting email to the client. This email correctly reported the due dates for filing a notice of appeal and a statement of grounds of appeal. He had not noticed the absence of the records department stamp or that these dates had not been entered in *Inprotech*. It

appeared that he had not checked *Inprotech*, which was uncharacteristic behaviour for him.

He had returned the acknowledgement of receipt on 19 March 2015. It was his practice to return acknowledgements of receipt at the time he reported a communication to the client because that was generally the first time he had had an opportunity to review and check the various components of the document.

The client's instructions to file an appeal had been received on 7 April 2015. The representative's prompt list for that week had not contained a deadline for filing a notice of appeal. He had therefore not treated the instructions as urgent. Consequently, the deadline for filing a notice of appeal had been missed.

He had become aware that the notice of appeal had not been filed on 16 June 2015, when he had received an email from the client requesting an update on the status of the appeal.

This was the first time that such an error had occurred in his 7 years of practice at the firm and in his 20 years of practice overall.

XII. With respect to the main request, the appellant essentially argued as follows.

The Examining Division's decision had not been accompanied by the text of Articles 106 to 108 EPC. This was contrary to Rule 111(2) EPC, which required that decisions be accompanied "by a communication pointing out the possibility of appeal and drawing the attention of the parties to Articles 106 to 108, the text of which shall be attached". The acknowledgement of receipt which

had accompanied the decision and the office manager's statutory declarations served as evidence of the omission.

According to a main line of reasoning, the omission of the text of Articles 106 to 108 EPC meant that the decision had not been properly notified to the appellant. This followed from Article 119 EPC, which stated that decisions are to be notified by the EPO "in accordance with the Implementing Regulations" and hence referred not only to Rules 125 to 130 EPC but also to Rule 111 EPC.

Although Rule 111(2), second sentence, EPC stated that the parties may not invoke the omission of "the communication", this did not mean that the omission of the text of Articles 106 to 108 EPC could not be invoked. This was so in view of the importance of attaching that text and was confirmed by the travaux préparatoires to the EPC 1973. In addition, decision J 13/90 (OJ EPO 1994, 456) stated that the EPO could not omit any acts which a party to proceedings could legitimately have expected and which might well have helped avoid a loss of rights.

In a supplementary line of reasoning, the appellant argued that the omission of the text of Articles 106 to 108 EPC resulted in the written decision not being a "decision". This followed from decision T 390/86 (OJ EPO 1989, 30), which stated that a decision given orally had to be formally completed by giving reasons for the decision in writing in accordance with (then) Rule 68(2) EPC 1973 before the two-month period for filing the notice of appeal started to run.

Following either line of reasoning, the written decision had not yet been notified and the time limit for filing the notice of appeal had therefore not yet expired.

XIII. With respect to the first auxiliary request, the appellant essentially argued as follows.

In view of Rule 111(2) EPC, the appellant could have legitimately expected the EPO to attach to the decision the text of Articles 106 to 108 EPC. The very unusual omission of this text was causally linked to the non-observance of the time limit for filing the notice of appeal, because the records clerk had been trained to look for deadlines, and anything that was not in the expected form ran the risk of not being recognised. The notice of appeal should therefore be deemed to have been filed in time.

XIV. In support of its request for re-establishment of rights, presented as the second auxiliary request, the appellant essentially argued as follows.

As evidenced by the statutory declarations, the representative's firm had in place a normally satisfactory system for monitoring time limits. The firm's docketing procedure generally included three checks, and still two checks on days when the office manager was absent. It had always worked and was the sort of system that was required by the case law of the boards of appeal. The mistakes that had been made were isolated mistakes. It followed from the case law, in particular decisions J 2/86 (OJ EPO 1987, 362), J 27/88 of 5 July 1989, J 31/90 of 10 July 1992 and T 166/87 of 16 May 1988, that such isolated mistakes did not mean that all due care required by the circumstances had not been taken.

## **Reasons for the Decision**

1. The appellant's letter dated 1 February 2016, filed after the closure of the debate, is disregarded because the Board sees no reason to reopen the debate (Article 15(5) RPBA).
2. Pursuant to Article 110 EPC, it is first to be examined whether an admissible appeal was validly filed.
3. The decision to refuse the application was given in oral proceedings held on 21 October 2014. According to Rule 111(1) EPC, a decision given orally is subsequently to be put in writing and notified to the parties. The notification is what triggers the two-month time period for filing the notice of appeal (Article 108, first sentence, EPC).
4. The Examining Division issued its written decision on 9 February 2015. An acknowledgement of receipt (EPO Form 2936) signed by the appellant's representative and returned to the EPO by fax on 19 March 2015 confirms that the appellant received the decision on EPO Form 2007 accompanied by the reasons for the decision on EPO Form 2916 on 13 February 2015.
5. According to Rule 111(2), first sentence, EPC, decisions of the EPO which are open to appeal "shall be accompanied by a communication [German: 'Hinweis', French: 'avertissement'] pointing out the possibility of appeal and drawing the attention of the parties to Articles 106 to 108 EPC, the text of which shall be attached".

The communication is included on EPO Form 2007 and was hence received by the appellant. The text of Articles 106 to 108 EPC is normally sent as a separate sheet on EPO Form 2019.

6. The appellant submitted that, although online file inspection indicated that EPO Form 2019 had been sent on 9 February 2015, this form had not been among the documents it had received. The appellant had checked its paper file and had no record of having received the form. In addition, the acknowledgement of receipt (as prepared by the EPO) only mentioned that EPO Forms "2007+2916" had been included in the communication. The appellant referred to another case in which the acknowledgement of receipt mentioned EPO Forms "2007/2916/2019 + annexes".
7. Since the appellant plausibly denied having received EPO Form 2019 and no evidence is available to the Board that suggests otherwise, the Board accepts that the appellant did not receive the text of Articles 106 to 108 EPC.

*Main request*

8. With its main request, the appellant requested the Board to confirm that the decision had not been validly notified to it and that, therefore, the period for filing the notice of appeal had not yet expired when the appeal was filed. The appellant gave two lines of argument in support of this request. First, the omission of EPO Form 2019 with the text of Articles 106 to 108 EPC meant that there had been no "notification" of the decision. Second, in so far as anything had been notified to the appellant, in view of the omission it had not been a "decision".

Both lines of argument attempt to attach a legal consequence to the omission of the text of Articles 106 to 108 EPC. However, Rule 111(2), second sentence, EPC reads "The parties may not invoke the omission of the communication".

9. The appellant argued that the impossibility of invoking the omission of the communication did not mean that the omission of the text of Articles 106 to 108 EPC could not be invoked. Rule 111(2), second sentence, EPC referred to the omission of the communication "pointing out the possibility of appeal and drawing the attention of the parties to Articles 106 to 108", not to the omission of the text of those articles. That made sense, because the communication only gave the information that an appeal was possible. It did not inform the party of the existence and duration of the time limit for filing the notice of appeal, of the existence and duration of a time limit for filing the statement of grounds of appeal, or of the requirement to pay an appeal fee. All that information was included in the text of Articles 106 to 108 EPC, which hence was of considerably more importance than the content of the communication.

In this context, the appellant submitted that it was apparent from the travaux préparatoires to the EPC 1973 that the legislator had intended to provide a party with at least one clear indication of the time limit for filing a notice of appeal. Whereas earlier proposals for Rule 68(2) EPC 1973 (corresponding to Rule 111(2) EPC) provided that the communication which accompanied a decision was to inform the parties of the period within which an appeal could be filed and added that parties could invoke neither the omission of the communication nor any errors contained therein, these proposals had been abandoned in favour of the current text. The reason

for this change was explained in the following passage from the Minutes of the Munich Diplomatic Conference of 1973 (Rule 69 and Articles 105-107 were later renumbered as Rule 68 and Articles 106-108):

"With reference to the communication of the possibility of appeal in accordance with Rule 69, paragraph 2, the principle that parties may [sic] invoke errors in the communication was abandoned; errors are however almost entirely excluded because reference must always be made in the communication to the relevant provisions of Article 105-107, the text of which must be attached." (M/PR/G, Annex I, Report on the results of Main Committee I's proceedings, section C.II.10)

Removing the requirement to specify the period in the communication excluded the risk of the EPO making errors in determining the period. But to realise the intention of the legislator, it was mandatory for the text of Articles 106 to 108 EPC to be attached.

10. Contrary to the appellant's position, the Board considers that Rule 111(2), second sentence, EPC also applies to the omission of the text of Articles 106 to 108 EPC (as was held before with respect to Rule 68(2) EPC 1973 in decisions T 42/84, OJ EPO 1988, 251, reasons 13, and T 493/08 of 29 September 2009, reasons 6.2.6 under (c)). The argument that the attachment of the text of Articles 106 to 108 EPC is "more important" than the communication itself is not persuasive, since the communication explicitly draws attention to Articles 106 to 108 EPC and the text of the EPC is available to anyone.

As to the travaux préparatoires to the EPC 1973, the proposed version of (then) Rule 69(2) of the Draft



Implementing Regulations (see document M/2) stipulated that decisions be accompanied by a communication specifying *inter alia* the period for filing an appeal and that parties could invoke neither the omission of, nor any errors contained in, the communication. This led to various comments about whether it was fair to prevent a party from invoking an error made by the EPO that might have misled it into an irrecoverable position (see documents M/20, paragraph 22; M/21, paragraph 35; M/32, paragraph 37; M/41, paragraph 14; M/52/I/II/III, paragraph 25; M/54/I/II/III, page 26). At the Munich Diplomatic Conference, during the discussions of Main Committee I, the Swiss delegation expressed the view that a party should not be able to invoke the omission of the communication but should also suffer no detriment resulting from an incorrect communication. This led the Committee to adopt a proposal by the Netherlands delegation not to specify calculated time limits but to draw the parties' attention to the relevant provisions of the EPC and quote their text, which in practical terms excluded incorrect indications (Minutes of Main Committee I, paragraphs 2319 to 2334). The subsequently redrafted version of Rule 69(2), substantially corresponding to Rule 111(2) EPC, was silent on errors in the communication but still stated that its omission could not be invoked (see document M/142/I/R 13). It is therefore evident that the passage from the Minutes of the Munich Diplomatic Conference quoted by the appellant, which is part of the report on the results of Main Committee I's proceedings, should have read "the principle that parties may not invoke errors in the communication was abandoned"; the German and French texts are in fact accurate on this point ("wurde der Grundsatz, daß Beteiligte aus fehlerhafter Belehrung keine Ansprüche herleiten können, fallen gelassen" and "le Comité a renoncé au principe selon lequel les

parties ne peuvent se prévaloir d'un avertissement entaché d'erreurs"). In any event, the legislator did not intend to abandon the principle that the omission of the communication, including information on the time period for filing an appeal, could not be invoked. In the Board's view, the travaux préparatoires confirm its interpretation of Rule 111(2) EPC.

11. As the omission of the text of Articles 106 to 108 EPC may not be invoked, it affects neither the validity of the decision nor that of its notification. The appellant having received EPO Form 2007 on 13 February 2015, i.e. within ten days following its posting on 9 February 2015, pursuant to Rule 126(2) EPC the decision is deemed to have been notified on 19 February 2015. That is therefore the date from which the two-month period for filing the notice of appeal is to be calculated. Consequently, the period for filing the notice of appeal expired on Monday 20 April 2015. Since the notice of appeal was received and the appeal fee paid only on 19 June 2015, the appeal was not filed in due time. The Board therefore cannot allow the main request.

*First auxiliary request*

12. With its first auxiliary request, the appellant requested the Board to confirm, in application of the principle of the protection of legitimate expectations, that the notice of appeal, although filed after expiry of the relevant period, is deemed to have been filed in time. Referring to decision J 13/90, OJ EPO 1994, 456, reasons 5, the appellant argued that the EPO may not omit any acts which a party could have legitimately expected and which might well have helped avoid a loss of rights.

In essence, the appellant's argument is that it could have legitimately expected the EPO to attach the text of Articles 106 to 108 EPC to all decisions and that the omission of the text in the present case, i.e. the EPO's violation of its legitimate expectations, had caused it not to recognise the received communication as a decision.

13. Although Rule 111(2), first sentence, EPC imposes on the EPO the legal duty to attach the text of Articles 106 to 108 EPC to all decisions, it follows from Rule 111(2), second sentence, EPC and point 10 above that the appellant may not invoke the EPO's breach of that duty. For this reason the Board has doubt that the appellant in arguing the admissibility of the appeal can rely on a legitimate expectation to receive the text.
14. In any event, even if the omission violated the appellant's legitimate expectations, the principle of the protection of legitimate expectations can only be successfully invoked if the EPO's omission was the direct cause of the non-observance of the time limit for filing the notice of appeal and objectively justified the appellant's conduct (cf. decision G 2/97, OJ EPO 1999, 123, reasons 4.1).
15. In the present case, the appellant did receive EPO Form 2007, which did contain the communication referred to in Rule 111(2) EPC:

"Means of redress

This decision is open to appeal.  
Attention is drawn to the attached text of Articles 106 to 108 EPC and Rules 97 and 98 EPC."

Apart from the fact that a professionally represented appellant is expected to know the relevant time limits for filing an appeal, there is no excuse for an appellant not to look up the text of Articles 106 to 108 EPC when explicitly referred to it. In other words, if it were argued that the appellant had not had knowledge of the relevant time limits, the EPO would not be responsible.

16. Instead, the appellant submitted that the omission of the form with the text of Articles 106 to 108 EPC was the cause of, or at least a contributing factor to, the failure of a records clerk of the representative's firm to recognise the EPO's communication as an appealable decision when processing incoming mail.

It is conceivable that the records clerk's failure to recognise EPO Form 2007 as an appealable decision is, indeed, somehow linked to the absence of EPO Form 2019. Perhaps it was the clerk's practice to look primarily for the presence of EPO Form 2019 while paying less attention to the actual decision on EPO Form 2007. Or the unusual absence of the form may have contributed to an accidental oversight. But whatever the precise explanation may be, the non-recognition of EPO Form 2007 as an appealable decision cannot be seen as the objectively justified consequence of the omission of EPO Form 2019. Rather, the records clerk made a mistake falling outside the EPO's responsibility.

Moreover, the EPO cannot be held responsible on account of the omission of the form for the subsequent failure within the applicant's representative's firm of the double and/or triple checks on the received communication.

17. For these reasons the appellant cannot successfully invoke the principle of the protection of legitimate expectations in support of admissibility of the appeal. Whether the mistakes made within the representative's firm can be excused is instead a matter to be assessed within the context of the request for re-establishment of rights.

Thus the first auxiliary request cannot be allowed.

*Second auxiliary request*

18. With its second auxiliary request, the appellant requested re-establishment of rights under Article 122 EPC in respect of the time limit for filing the notice of appeal.
19. The appellant's letter to the representative dated 6 April 2015 shows that it was the appellant's intention to appeal the Examining Division's decision. The non-observance of the time limit for filing the notice of appeal was hence not the result of an intentional action, which otherwise would have ruled out re-establishment of rights. The appellant was indeed "unable" to observe the time limit, and therefore the remedy of re-establishment of rights is in principle available.
20. The Board accepts that the cause of non-compliance was removed on 16 June 2015 with the receipt by the representative of an email from the appellant requesting an update on the status of the appeal. The request for re-establishment was filed on 19 June 2015 together with payment of the corresponding fee. The request was hence filed in time (Rule 136(1) EPC).

Moreover, the request was reasoned and the omitted acts, i.e. filing of the notice of appeal and payment of the appeal fee, were completed on the same day in accordance with Rule 136(2) EPC.

The request for re-establishment is hence admissible.

21. However, a request for re-establishment of rights may be allowed only if the appellant can show that the time limit was missed in spite of all due care required by the circumstances having been taken (Article 122(1) EPC). It is established case law that the same requirement of all due care applies to the appellant's professional representative.
22. In the present case, the first error in dealing with the EPO's communication of 9 February 2015 was made by a records clerk working in the representative's firm, i.e. by an assistant.

According to the case law of the boards of appeal, where an assistant has been entrusted with carrying out routine tasks, the same strict standard of care is not expected as is demanded of the representative himself. A culpable error on the part of the assistant may be excused provided that the representative can show that he has chosen for the work a suitable person, properly instructed in the tasks to be performed, and that he has exercised reasonable supervision over the work.

23. The error made by the records clerk consisted in not identifying a due date relating to the EPO's communication and consequently not making an entry in the firm's *Inprotech* docketing system software.

According to the office manager's statutory declaration, "no due date associated with the Decision was identified due to the absence of EPO Form 2019".

Since the office manager did not make the error herself and in fact was out of the office on that day, she cannot have observed personally that the absence of EPO Form 2019 was the reason why the records clerk failed to identify the EPO's communication as a decision triggering time limits for appeal. Her statement hence appears to suggest that the records clerk could not have identified a due date, because due to his training or known work habits he relied on the presence of EPO Form 2019 for proper processing of appealable decisions.

24. In the letter of 18 December 2015, the representative argued that "the absence of this form was a key reason that our Records Department did not input the due dates for filing a notice of appeal and statement of grounds of appeal into *Inprotech*. Although our Records Clerks receive training to identify documents such as Decisions, they are clearly not as qualified and do not have as much knowledge as a Professional Representative. Given the number of documents they have to process on a daily basis, when they review a document, they are instructed and proceed to look for a time limit. This is of course particularly important with reporting letters from overseas attorneys where relevant deadlines may be in different places in a letter".

These statements again appear to suggest that the records clerk had not been trained to recognise EPO Form 2007, which does not itself mention a time limit but only refers to Articles 106 to 108 EPC, as an appealable decision triggering important time limits.

25. At the oral proceedings before the Board, although initially appearing to confirm the above impression, the representative eventually stated that he assumed that the records clerk had been trained to recognise EPO Form 2007. But he could give no further information on the instructions given to the records clerk, as he had not been responsible for the clerk's training.
26. The Board considers that an assistant should receive instructions enabling him to recognise a communication from the EPO as a decision triggering time limits for filing an appeal even in the absence of EPO Form 2019. Indeed, it follows from Rule 111(2), second sentence, EPC that the presence of that form cannot be relied upon. Furthermore, an assistant should be instructed to consult his supervisor if any doubt arises about the meaning of a particular communication.

The appellant's explanations and the statutory declarations therefore do not convince the Board that the records clerk's mistake may be excused as an isolated error made by a suitable, properly instructed and supervised person; they rather point in the opposite direction. Nevertheless, the appellant may have overstated the relevance of EPO Form 2019 to the representative's firm's docketing procedure when making its case for the main request and the first auxiliary request. At this stage, the Board prefers not to examine this point further, including whether to allow the appellant to amend its position and to provide evidence of the records clerk's training, but will first consider the second error that was made, which is the failure of the cross-check on the records clerk's work.

27. According to the case law of the boards of appeal, the requirement of all due care normally requires a firm to



have at least one independent cross-check built into its system for monitoring time limits. The appellant argued that this applied only to large firms and that its representative's firm, whose London Office had only ten qualified representatives, was not "large" in that sense.

However, as explained in decision T 428/98, OJ EPO 2001, 494, reasons 3.5, only in exceptional cases have the boards of appeal accepted that an independent cross-check could be dispensed with. Those were cases where the representative's firm was a small unit in which he essentially bore sole responsibility for substantive processing of the files and the demand for time-limit monitoring was accordingly limited, and where time-limit monitoring also involved intensive personal co-operation between the representative and his assistant. In the case underlying decision T 428/98, the representative's firm was staffed by six people dealing in their main professional capacity with cases commonly subject to time limits, and the deciding board accordingly did not condone the lack of an independent cross-check.

In the present case, the London Office of the representative's firm is staffed with ten people dealing with cases subject to time limits, and there is no "intensive personal co-operation" between the representative and the records clerk. The office manager's statutory declarations confirm that a large number of deadlines are processed on a daily basis. An independent cross-check is therefore required and a failure of the cross-check, if not excusable, may lead to the conclusion that all due care was not taken. In other words, an independent cross-check in the present case is not merely an optional safety measure on top of what all due care requires.

28. As evidenced by the office manager's statutory declarations, in the representative's firm an independent cross-check is in fact part of its docketing procedure. This "second check" is normally performed by the office manager herself. On days when she is absent, the attorneys have to perform the second check on incoming mail themselves or otherwise ensure that it is carried out.

The office manager further mentioned a "third check" as part of the firm's procedure, to be carried out by the representative when reporting the communication to the client.

In his statutory declarations, the representative explained that it was his habit to make that "third check" when he went through his mail after the records department had processed it. At the time of reporting a communication to the client, he only "generally" checked *Inprotech*.

The representative's own routine hence deviates from the firm's normal procedure as described by the office manager, which requires the "third check" to be made when the communication is reported to the client. The "third check" as performed by the representative is in fact the "second check" - and the only independent cross-check - on days when the office manager is absent.

On the day the Examining Division's decision was processed, the office manager was absent and had notified the firm's attorneys accordingly. The representative was thus to carry out the cross-check himself and is hence responsible for its failure.

29. The appellant argued that it was established case law that the requirement of all due care was fulfilled if non-compliance with a time limit was the result of an isolated mistake within a normally satisfactory system for monitoring time limits. The representative's firm's docketing procedure constituted such a normally satisfactory system, as it had worked in the past and it complied with the requirements set out in the case law of the boards of appeal. Moreover, since a system with a cross-check would identify any single mistake, the term "an isolated mistake" had to be understood as encompassing more than one mistake. In the present case, the failure to file the notice of appeal in time had been caused by a combination of isolated mistakes and the requirement of all due care was therefore complied with.
30. All due care requires an appellant or its representative to have in place a normally satisfactory system for monitoring time limits: if a mistake that in itself might be excusable is not corrected because of deficiencies in the system, then all due care has not been taken. But having a satisfactory system in place does not relieve a representative of his duty to take all due care required by the circumstances when performing procedural steps forming part of that system. Just as a representative bears responsibility for the actions of his assistants (in the form of his duties to select, instruct and supervise), so too is he responsible for his own actions. The appellant's proposition has therefore to be rejected (see also decisions T 592/11 of 25 October 2012, reasons 5.2.2, and R 18/13 of 17 March 2014, reasons 19 to 21).
31. The circumstances of the present case required the representative to perform the cross-check, and hence to

perform it with all due care. Although the appellant submitted that the failure of the cross-check was the result of an "unusual situation", no specific circumstances were brought forward to explain how the error could occur. Either the representative never carried out the cross-check, or he did carry it out but failed to notice that the decision had not been marked with the records department stamp. In the absence of any special circumstances, neither possibility can be reconciled with the requirement of all due care. Thus the second auxiliary request, i.e. the request for re-establishment of rights, cannot be allowed.

32. As to decisions J 2/86, J 27/88, J 31/90 and T 166/87 relied on by the appellant, the following is noted.

In decisions J 2/86 and J 31/90, the mistake was not made by a professional representative and the boards did not determine that in the circumstances of those cases the professional representative was required to perform a cross-check.

In decision J 27/88, the mistake was made by an assistant working under the responsibility of a US attorney. Although the US attorney performed a cross-check which failed, the board did not determine that all due care in the circumstances of that case required the US attorney to carry out that cross-check.

In decision T 166/87, the deciding board excused a mistake made by a professional representative as an isolated mistake within a normally satisfactory system, even though no mitigating circumstances are mentioned. This decision supports the appellant's position, but the present Board considers that, on this point, it is not in line with the decisions mentioned in point 30 above

and is difficult to reconcile with the requirement of all due care.

33. In view of the above, the Board need not revisit the question of the records clerk's training or examine whether the representative took all due care required by the circumstances when he prepared a reporting email to the appellant on 19 March 2015 without noticing the missing records department stamp and when he did not ensure that the relevant time limits had been entered in *Inprotech* upon receiving, on 7 April 2015, the appellant's instructions to file an appeal. Nor is it necessary to examine whether the fact that the representative prepared the reporting email for the appellant and returned the acknowledgement of receipt to the EPO not without delay but as late as 19 March 2015 should have signalled to him that something might have been amiss.

*Consequence of filing an appeal out of time*

34. In decisions T 2017/12 (OJ EPO 2014, A76) and T 1553/13 (OJ EPO 2014, A84), the deciding boards referred to the Enlarged Board of Appeal the question whether an appeal is to be found inadmissible **or** deemed not to have been filed if the notice of appeal is filed and the appeal fee paid only after expiry of the time limit for filing the notice of appeal. The procedural situation in the present case is the same.

For various reasons, neither referral has resulted in an answer to this question.

35. Both referral decisions concentrated on the meaning of Article 108 EPC, second sentence, EPC, which reads "Notice of appeal shall not be deemed to have been filed

until the fee for appeal has been paid". In numerous decisions the boards of appeal had interpreted this provision as meaning that an appeal did not come into existence, i.e. the notice of appeal was deemed not to have been filed, if the appeal fee was not paid within the two-month time limit of Article 108, first sentence, EPC. In a smaller number of deviating decisions, the boards of appeal dismissed the appeal as inadmissible where the notice of appeal was filed and the appeal fee paid after expiry of the time limit.

36. Referring to Articles 31 and 32 of the Vienna Convention on the Law of Treaties and decision G 5/83 (OJ EPO 1985, 64), both referring boards noted that the EPC was to be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the EPC in their context and in the light of the EPC's object and purpose. They then observed that the ordinary meaning of Article 108, second sentence, EPC appeared to be that before the appeal fee had been paid the appeal was deemed not to have been filed, and that once the fee had been paid the aforementioned provision no longer applied, with the consequence that the appeal was filed. No relationship between the payment of the appeal fee and the time limit for filing the appeal could be derived from the literal wording of Article 108 EPC. The boards saw no reason why Article 108, second sentence, EPC was to be read as "Notice of appeal shall not be deemed to have been filed until the fee for appeal has been paid in time".
37. Although there is no doctrine of binding precedent under the EPC, the principles of legal certainty and uniform application of the law require a board of appeal having to decide on a particular legal question to take into account how the question was decided in earlier

decisions. A board is hence not bound by an earlier decision in an unrelated case, but it must give appropriate weight not only to the reasons given for resolving a particular question in a particular way, but also to the extent to which the solution adopted has found acceptance in later decisions. Thus, where in the jurisprudence of the boards of appeal a particular interpretation of a provision has been adopted which over many years has proved to be a satisfactory and predictable solution, a compelling reason should exist to justify giving preference to a different interpretation.

The Board sees no compelling reason to deviate from the established approach of regarding an appeal filed out of time as deemed not to have been filed. Furthermore, as explained below, it considers this approach also to be in line with an interpretation of the EPC in accordance with the customary principles of treaty interpretation as codified in the Vienna Convention on the Law of Treaties.

38. According to those principles, the starting point for the interpretation of a provision is its wording. As the Enlarged Board of Appeal has explained in decision G 2/12 (OJ EPO 2016, A27), however, it may well be that the wording only superficially has a clear meaning. The result of a literal interpretation must, therefore, be confirmed *inter alia* by a systematic interpretation of the provision taking into account its function and position within the EPC as a whole (see reasons V, under (3) and (4), VII.1, under (1), and VII.2, under (1)).
39. The interpretation of Article 108, second sentence, EPC as meaning that filing of the notice of appeal and payment of the appeal fee after the expiry of the time

limit of Article 108, first sentence, EPC results in the appeal having been filed (but out of time) presupposes that the late filing of the notice of appeal is, at least to an extent, legally effective and not to be treated as if no notice of appeal has been filed at all. This assumption deserves closer examination.

40. Numerous provisions of the EPC specify that a certain document is to be filed within a particular time period or "in due time". In the latter case, the Implementing Regulations either specify the corresponding time limit or leave that to the EPO ("within a period to be specified"). In almost all cases, the EPC also specifies the legal consequence of not filing the document "in due time" without, however, distinguishing between late filing and non-filing. In a few cases the timely filing of the document is a condition for a certain provision to be triggered and the consequence of both late filing and non-filing is simply that the provision is not triggered. For example, if an applicant does not file the supporting certificate of Article 55(2) EPC within four months of filing the application (Rule 25 EPC), it cannot benefit from Article 55(1) EPC. Another instance is the filing of a request for a decision on a loss of rights under Rule 112(2) EPC. Thus, the general rule is in fact that the late filing of a document is treated in the same way as its non-filing (a possible exception being the special case of the priority period of Article 87(1) EPC).

41. Article 108, first sentence, EPC requires that notice of appeal be filed within two months of notification of the decision. If no notice of appeal is filed, then no appeal comes into existence. Although the position that Rule 101(1) EPC means that a late-filed notice of appeal brings into existence an inadmissible appeal may be not



unreasonable, in view of the general rule that no distinction is to be made between the late filing and the non-filing of a document, the Board considers that no appeal exists where a notice of appeal was not (deemed to be) filed in due time.

42. The Board notes that its approach, although it has not always consistently been applied in the jurisprudence of the boards of appeal, is also in line with the reasoning in earlier decisions which have argued that an appeal is deemed not to have been filed where the appeal fee was paid in time but the notice of appeal was filed only after expiry of the two-month period of Article 108(1) EPC (see in particular decisions J 19/90 of 30 April 1992, reasons 1.2.2 and 4; T 445/98 of 10 July 2000, reasons 1.2, 5, 6 and 7; and T 778/00, OJ EPO 2001, 554, section V of the facts and submissions and point 6 of the reasons).
43. It follows that in the present case the appeal is deemed not to have been filed and that, consequently, the appeal fee is to be reimbursed.

*Separate procedural request*

44. The appellant requested that EPO Form 2019, which appears in online file inspection under the title "Means of redress" and is dated 9 February 2015, be removed from the public file. The appellant submitted that its presence in the public file did not accurately reflect the facts relating to the documents that its representative received.
45. According to Article 128(4) EPC, the file relating to a published application may be inspected on request, subject to the restrictions laid down in the

Implementing Regulations. Which parts of the file are excluded from public inspection is exhaustively regulated by Rule 144 EPC. Since the document whose removal is requested does not fall under any of the four categories of documents listed in this rule, it must be open to public file inspection, unless it is not part of the "file relating to" the application in the first place.

46. The files relating to European patent applications are created, maintained and processed using the EPO's electronic file system (Rule 147(2) EPC and Article 1 of the Decision of the President of the EPO dated 12 July 2007, OJ EPO, Special edition No. 3, 2007, 121). In the present case EPO Form 2019 was created within the application's electronic file. It also clearly "relates" to the application; it does not, for example, relate to a different application. The form is therefore part of the file relating to the application.
  
47. That in the present case EPO Form 2019 was not received by (and most likely not sent to) the appellant's representative hence does not mean that it is not part of the file. The file relating to an application within the meaning of Article 128 EPC may include documents produced by the EPO and not communicated to the applicant. This is confirmed by Rule 144(b) EPC, which excludes from public file inspection those documents of the file which are used for the preparation of decisions and notices and which are not themselves communicated to the parties. An example of a document produced by the EPO which is not communicated to the applicant but is still open to public file inspection is a document containing the search starting date or the examination starting date (see Notice from the EPO dated 29 January 2013, OJ EPO 2013, 153).

48. In summary, EPO Form 2019 is part of the file and may be inspected on request pursuant to Article 128(4) EPC. Consequently, the request for removal of the document from the public file is to be refused.
49. The refusal of this request cannot be interpreted as meaning that the appellant did receive EPO Form 2019. The Board in fact accepts that the appellant did not (see point 7 above), and its registrar has annotated the document accordingly.

*Second fee for re-establishment and renewal fees*

50. In its "Letter 1", the appellant made a conditional request for re-establishment of rights in respect of the period for paying the eighth-year renewal fee with additional fee (see section III above). The eighth-year renewal fee would have fallen due on 30 November 2014 and was in fact paid on 7 November 2014; the time limit of Rule 51(1) and (2) EPC was thus met. It follows that the request for re-establishment was made without cause and that the corresponding fee will have to be refunded by the EPO. The same applies to any renewal fee which had not yet fallen due on the date on which the Examining Division's decision became effective.

## Order

### For these reasons it is decided that:

1. The request for re-establishment of rights in respect of the time limit for filing the notice of appeal is refused.
2. The appeal is deemed not to have been filed.
3. The appeal fee is to be reimbursed.
4. The request for removal of a document from the public file is refused.

The Registrar:

The Chairman:



I. Aperribay

R. Moufang

Decision electronically authenticated