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**Datasheet for the decision
of 20 September 2019**

Case Number: T 0128/18 - 3.2.03

Application Number: 02782021.6

Publication Number: 1461509

IPC: E21B19/10

Language of the proceedings: EN

Title of invention:

A METHOD AND A DEVICE FOR PREVENTING PIPESKIDDING

Patent Proprietor:

Malm Orstad AS
Odfjell Well Services AS

Opponents:

HD Oil Technology Holding AS
Shell Internationale Research Maatschappij B.V.

Headword:

Relevant legal provisions:

EPC R. 82(2), 82(3), 130(2), 136
EPC Art. 108, 133

Keyword:

Decisions cited:

T 1281/01

Catchword:



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Case Number: T 0128/18 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 20 September 2019

Appellant: Malm Orstad AS
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Appellant: Odfjell Well Services AS
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Respondent: HD Oil Technology Holding AS
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 6 February 2017**

revoking European patent No. 1461509 pursuant to
Article 101(3) (b) EPC.

Composition of the Board:

Chairman	G. Ashley
Members:	E. Kossonakou
	V. Bouyssy

Summary of Facts and Submissions

- I. The present appeal was filed by the patent proprietors (appellants) against the revocation decision pursuant to Rule 82(3) EPC dated 6 February 2017 and concerning the European patent N° 1 461 509.
- II. The notice of appeal, containing also a statement of grounds, was filed on 20 December 2017. The appeal fee was paid on the same date.
- III. The appeal is based on the ground that, in the proceedings following a first appeal (T 2368/10), the EPO had been notifying all procedure-relevant documents to the wrong representative.
- IV. In opposition proceedings, the patent proprietors' registered representative (in the following "the original representative") authorised a further representative (in the following "the further representative") to take part in the oral proceedings which took place before the opposition division on 8 October 2010. The opposition division then decided that the patent could be maintained in amended form (interlocutory decision dated 9 November 2010).
- V. This decision was appealed by all parties (opponents 1 and 2 and the patent proprietors). The patent proprietors' original representative authorised the further representative to file the appeal and to conduct the appeal proceedings.
- VI. That first appeal procedure was closed without decision (26 September 2013, EPO Form 3324, closure of the

appeal proceedings), when all appealing parties withdrew their respective appeals.

VII. The patent was thus to be maintained in the version proposed by the opposition division, and consequently the EPO issued the communication pursuant to Rule 82(2) EPC to the further representative on 22 November 2013.

VIII. The required translations were not filed, either within the basic time limit, or in reaction to the communication pursuant to Rule 82(3) EPC dated 8 April 2014 concerning the failure to observe the time limit.

Only the printing fee was paid within the time limit set, not however by the patentees but by opponent 1.

Accordingly the patent was revoked with decision pursuant to Rule 82(2) and (3) EPC (Form 2333, dispatched by registered letter with advice of delivery) dated 6 February 2017.

IX. The appellants submitted that their original representative became aware of the revocation when trying to pay national renewal fees on 30 October 2017. They reacted by filing on 20 December 2017 the present appeal and, in parallel with an essentially identical submission, the missing translations of the claims. The printing fee was paid again by the appellants on that same date.

X. The appellants argued essentially that the revocation decision was null and void due to the fact that all procedurally relevant documents following the closure of the first appeal procedure were notified to the further representative, who however had only been

authorised to act in the first appeal proceedings. The authorisation had thus automatically ended with the termination of those proceedings, so that all notifications to the further representative could not have had any legal effect. The present appeal sought to have this fact formally acknowledged, with the conclusion that the claim translations were filed in good time and the printing fee was timely paid.

- XI. Oral proceedings before the Board were summoned for 20 September 2019. At the same time (11 March 2019) the Board issued a communication pursuant to Article 15(1) RPBA setting out its preliminary evaluation of the case, indicating that the sole topic of discussion at the oral proceedings would be the appeal's admissibility.
- XII. With letter dated 29 May 2019 the appellants submitted further arguments and referred to decision T 1281/01 as concerning a similar case and thus possibly setting a precedent. Cancellation of the oral proceedings was requested.
- XIII. In a further communication dated 21 June 2019 the Board took position anew and announced the maintenance of the oral proceedings.
- XIV. With letter dated 9 August 2019 the appellants requested the referral of the following questions to the Enlarged Board of Appeal:

"1. Does the serving of a Decision constitute a "notification" triggering the time limit for filing an Appeal within the terms of Art. 108 if the Decision was served to a person who, at the time of the decision, was (still) indicated as

Representative in the Patent Register although, according to the files of the case, that person was not authorized anymore in the procedure terminated by the Decision?

2. If the answer to Question 1 is "No", can the "notification" mentioned in this Question be assumed as having been effected at the date at which the proper recipient, ie. the actually authorized person, of the Decision checked the status of the case in the Patent Register and detected the undelivered Decision?

3. If the answer to Question 2 is "No", what remedy does the EPC grant a party which was not notified of an appealable Decision, and thus rendered unable to timely file a Notice of Appeal, for the mere reason that the indication of its representation in the Patent Register was not updated by the EPO in consideration of the information concerning representation which said party had communicated to the EPO and which was available in the file of the case?"

XV. The oral proceedings took place as scheduled in the absence of the respondents pursuant to Rule 115(2) EPC and Article 15(3) RPBA. For the details of the discussion reference is made to the minutes thereof. The appellants' requests were established as follows:

- that the decision under appeal be declared null and void,
- that the case be remitted to the opposition division for re-opening the post-appeal procedure for maintenance of the patent in amended form, alternatively

- that questions be put to the Enlarged Board.

The present decision was announced at the conclusion of the oral proceedings.

Reasons for the Decision

1. Having considered the legal and factual framework of the present case, the Board found that the notice of appeal was filed after expiry of the two-month period foreseen in Article 108, first sentence EPC and also the fee for appeal was paid after expiry of the said period. The Board has therefore decided in accordance with the Opinion of the Enlarged Board of Appeal issued on 18 July 2019 in case G 1/18, point 1. b) of the Conclusion, that the appeal is deemed not to have been filed and orders the refund of the appeal fee (Opinion G 1/18, point 2 of the Conclusion).

2. The reasons for this decision are set out in the following.

As it will become apparent in light of the reasons for the decision, the answers to the questions, that the appellants had requested to be referred to the Enlarged Board of Appeal, were not necessary for the Board to be able to decide the case, since they were based on assumptions which the Board could not agree with or find correct. The questions will therefore not be further considered in this decision.

3. The revocation decision was dated 6 February 2017. Accordingly, the 2-month time limit for the filing of the notice of appeal expired (at the latest) on

18 April 2017 (16 April 2017 being Easter Sunday) and the 4-month one for the filing of the statement setting out the grounds of appeal (at the latest) on 16 June 2017.

3.1 The notice of appeal was filed and the appeal fee was paid on 20 December 2017, which is clearly later than the latest calculable expiry of the relevant periods.

3.2 As set out in the Board's communication dated 11 March 2019 the appellants could have requested re-establishment of rights in accordance with Article 122(1) and Rule 136 EPC regarding the aforementioned missed time limits for filing the notice of appeal and the statement of the grounds of appeal.

As the file contained no such request, nor had the fee for re-establishment of rights been paid, the Board nevertheless considered whether an implicit request for re-establishment was contained in the purported notice of appeal, since that letter was filed within the 2-month period from the alleged removal of the cause of non-compliance with the missed time limits for filing a notice of appeal and the related grounds and the one-year exclusive period for the filing of the request had not yet expired. In the absence of payment of the requisite fee, however, the Board had to conclude that re-establishment was not available for consideration.

3.3 These conclusions have not been contested by the appellants.

Quite to the contrary, the need for filing such a request was refuted both in writing and at the oral proceedings, the appellants' case resting essentially on the proposal that the EPO had erred in notifying all

procedurally relevant documents to the further representative (see above point X. of the facts and submissions).

The appellants considered alternatively that the revocation decision could and should be considered as having been notified on 30 October 2017 "because this was the date on which the representative of the proprietors obtained knowledge about the decision to revoke the patent: ... Therefore, the appeal, filed on 20 December 2017, was filed on time and is admissible."

- 3.4 Starting from this last point, the Board explained in its communication dated 21 June 2019 that it did not agree with this last-mentioned line of thought, since

"The date of 30 October 2017 is not a notification date, as submitted by the appellants, nor can it be understood as one. It might well have been the date when the appellants first noticed that something was amiss regarding the file at hand, but it cannot constitute the notification date of a decision, which is established following a certain procedure and presupposes actively sending the said decision to the purported recipient."

- 3.5 Regarding the appellants' main argument as to who was the correct addressee of notifications after the conclusion of the first appeal proceedings, the sequence of events, and in particular the content of the various submissions relating to representation in the opposition and the first appeal procedure, was discussed in detail. More specifically, it was discussed whether it could be derived from the letters of the original representative dated 8 September 2010, 30 September 2010 and 18 January 2011 that the further

representative was merely sub-authorised to act before the EPO only at the oral proceedings of 8 October 2010 in opposition and then again at the subsequent appeal proceedings, but not in the post-appeal opposition proceedings.

3.5.1 Although the Board would not doubt the appellants' good faith when declaring that this was their intention, the Board was nevertheless unable to find literal and/or unequivocal support for that understanding in any of the documents on file. The general language of the letter of 8 September 2010 ("... we appoint ... as further representatives. It is announced that they will attend to the oral proceedings") does not lend itself to the understanding of a sub-authorisation to a specific, limited end being granted, nor does the fact that a normal authorisation form F1003 was filed with the letter of 30 September 2010 help support this argument. The letter of 18 January 2011 contains the notice of appeal and refers to an enclosure containing the original representative's instructions to "act on our behalf in the appeal proceedings". In the light of today's knowledge one could perhaps understand this sentence as limiting the power to act to only the appeal proceedings. At the time however, and in light of the previous instructions in opposition, the understanding that it was simply a renewal of instructions in an ongoing cooperation between the original and further representatives would have been a more obvious conclusion drawn by the reader, particularly when considering that the very first letter (of 8 September 2010) clearly indicated the appointment of a *further* representative.

3.5.2 The communication pursuant to Rule 82(3) EPC drawing attention to the missing translations of the claims and

setting an extra time limit of two months for compliance was issued on 8 April 2014. Receipt was acknowledged by the further representative without any indication that something was amiss regarding the authority of the addressee to receive notifications.

The decision revoking the patent was issued on 6 February 2017, notified accordingly to the further representative and its receipt acknowledged the next day, again without any indication that something was amiss regarding the authority of the addressee to receive notifications.

The procedure underlying the present case was thus definitively closed and notice of termination of the opposition proceedings was notified to the parties' representatives with a communication dated 19 May 2017; in the case of the patent proprietors, it was dispatched to the further representative, as had previously been done.

- 3.5.3 In such circumstances, in light of both the documents on file and the relevant actions/omissions, no error can be found in the EPO's action to notify all relevant procedural documents to the further representative, including notifications after the closure of the first appeal procedure. In fact, since two representatives had been appointed, notification to the further representative was sufficient (Rule 130(2) EPC). If any doubt could have persisted as to the identity of the appellants' representative, and thus of the correct recipient of notifications at that stage, the appropriate course of action would have been for either the original or the further representative to have clarified the matter with the EPO. In the absence of any action or indication to this effect, the Board can

only conclude that notifications were continued to be correctly addressed to the further representative.

- 3.5.4 The appellants' argument drawn from the Board's use of the term "purported recipient" (communication dated 21 June 2019) in order to support the applicability of decision T 1281/01 to the present case, and also the request for the referral of questions to the Enlarged Board of Appeal, relies on an incorrect understanding of a statement that merely set out in general terms how the notification date is established.

Moreover, the facts underlying decision T 1281/01 are different to those of the present case. In that case there had been a formal change of representative duly and clearly communicated to the EPO, and the last appointed representative had pursued actively the prosecution of the case, so that he was able to react immediately and notify the EPO of the error. In the present case, in the course of almost 4 years there was no action or any indication that something might be amiss. All notifications from the EPO were received and duly acknowledged.

4. The appellants also referred to decisions T 703/92 and T 382/03 /93 in support of their submissions that all relevant procedural documents had not been effectively notified to the appointed representative (Rule 130(1) EPC). However, the circumstances of these cases are not comparable with those of the present case. In T 703/92 the written decision and minutes of the oral proceedings were not sent to the authorised representative of the opponents, but directly to the opponents. In T 382/03 there was an issue with a new representative who had to prove that he was authorised to act on behalf of a party.

5. From the above reasoning, it follows that the present appeal was filed and the relevant fee was paid after expiry of the period foreseen in Article 108, first sentence EPC. Therefore the appeal is deemed not to have been filed and the appeal fee has to be reimbursed.

Order

For these reasons it is decided that:

1. The appeal is deemed not to have been filed.
2. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:



C. Spira

G. Ashley

Decision electronically authenticated