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**Datasheet for the interlocutory decision
of 22 October 2019**

Case Number: T 0317/19 - 3.5.04

Application Number: 11760353.0

Publication Number: 2550799

IPC: H04N5/228, H04N7/18, G06F19/00

Language of the proceedings: EN

Title of invention:

SYSTEM AND METHOD FOR PROVIDING A SINGLE USE IMAGING DEVICE
FOR MEDICAL APPLICATIONS

Applicant:

Depuy Synthes Products, Inc.

Headword:

Relevant legal provisions:

EPC R. 139 sentence 1
EPC Art. 108 sentence 1, 108 sentence 2
RFees Art. 5(2), 7(2)
Arrangements for deposit accounts 5.1.3, 5.4.1

Keyword:

Correction of error - form for payment of appeal fee (yes)

Decisions cited:

G 0001/12, G 0001/18, J 0027/96, J 0003/01, J 0025/01,
J 0006/02, J 0020/12, J 0009/14, T 0445/08

Catchword:

An error in a duly filed form for paying the appeal fee may be corrected under Rule 139, first sentence, EPC (Reasons, points 2.3 to 2.5).



Beschwerdekammern

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Case Number: T 0317/19 - 3.5.04

I N T E R L O C U T O R Y D E C I S I O N
of Technical Board of Appeal 3.5.04
of 22 October 2019

Appellant: Depuy Synthes Products, Inc.
(Applicant) 325 Paramount Drive
Raynham, MA 02767 (US)

Representative: Walker, Ross Thomson
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 21 September
2018 refusing European patent application
No. 11760353.0 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman C. Kunzelmann
Members: G. Decker
B. Willems

Summary of Facts and Submissions

- I. The appeal lies against the decision of the examining division posted on 21 September 2018 refusing European patent application No. 11 760 353.0.
- II. On 21 November 2018, the appellant filed a notice of appeal which contained the following sentence: *"We are paying the appeal fee from our deposit account no. 28050721 by way of the attached fee sheet"*. It was accompanied by a filled out Form 1038E (titled "Letter accompanying subsequently filed items"). This form indicated in the "Fees" box the appeal fee (*"011 Appeal fee for an appeal filed by an entity other than those referred to in Rule 6(4) and (5) EPC"*) and in the box for "Amount to be paid" the amount of EUR 2 255. However, the box for "Method of payment" did not indicate a method but stated *"Not specified"*. Consequently, the debit order was not carried out. The balance of the deposit account at this date was well above the amount of the appeal fee.
- III. In a communication dated 21 January 2019, the examining division informed the appellant that, pursuant to point 5.1.3 of the "Arrangements for deposit accounts" (ADA), the EPO was only accepting debit orders submitted in electronically processable XML format and that debit orders submitted in any other way were considered invalid and therefore not to be carried out.
- IV. With a letter dated 30 January 2019, the appellant submitted that it was paying the appeal fee again from its professional representative's deposit account by way of an attached fee sheet. Form 1038E electronically

filed on 30 January 2019 together with the above letter contained correctly filled out boxes for the "Amount to be paid" and for the "Method of payment" indicating "*Debit from deposit account*" as well as the deposit account number and the account holder. As a consequence, the amount of EUR 2 255 was debited from the above account on the same day.

- V. In that same letter, the appellant requested a correction under Rule 139 EPC of Form 1038E filed on 21 November 2018 to specify the representative's EPO deposit account in the method of payment box. As an auxiliary measure, the appellant requested re-establishment of rights under Article 122 EPC and paid the corresponding fee.
- VI. Oral proceedings were held before the board on 22 October 2019. The appellant's final requests were that the request for correction under Rule 139 EPC be allowed and that the appeal be deemed to have been filed.
- VII. The appellant's arguments where relevant to the present decision may be summarised as follows:

The request under Rule 139 EPC fell squarely within the principles established in G 1/12, Reasons 37. The appellant originally intended to refer to "*Debit from deposit account*" in the box for "Method of payment" on Form 1038E. This was immediately apparent from the notice of appeal containing a corresponding sentence (see point II above). The error to be remedied was the incorrect statement "*Not specified*". The appellant filed its correction request as soon as it became apparent that a mistake had been made. Following G 1/12, Reasons 37, an allowable correction has

retrospective effect. The appellant was not requesting re-establishment into a defined procedural phase as a whole, as understood in the context of J 27/96.

Instead, it was requesting correction of an isolated procedural measure that had been taken during the appeal proceedings, i.e. the incorrect filling out of Form 1038E. Moreover, the case law which assumed an impermissible circumvention of the specific requirements of re-establishment of rights under Article 122 EPC 1973 if a correction under Rule 88 EPC 1973 were to be applied related to different circumstances, namely, the correction of the designation of states. However, the exclusion under Article 122(5) EPC 1973 of re-establishment of rights in relation to the non-observance of time limits under Article 79(2) EPC 1973 for the payment of designation fees had been removed in the provisions of the revised EPC applicable in the present case.

Reasons for the Decision

1. The appellant filed notice of appeal on 21 November 2018 and therefore within the two-month time limit prescribed in Article 108, first sentence, EPC which ended on 3 December 2018 (Rules 126(2), 131(2) and (4), 134(1), first sentence, EPC). However, due to the initial error in the "Method of payment" box on Form 1038E, the debit order for the payment of the appeal fee was not carried out before expiry of that time limit. Following the Opinion G 1/18 of the Enlarged Board of Appeal (EBA), Conclusion 1 a) (not yet published in the OJ EPO), this results in the appeal deemed not to have been filed.

2. *Request for correction, Rule 139 EPC*

2.1 To change the above result, the appellant filed a request for correction under Rule 139, first sentence, EPC and claimed that the retroactive effect of an allowable correction led to the appeal being deemed to have been filed.

2.2 Under Rule 139, first sentence, EPC linguistic errors, errors of transcription and mistakes in any document filed with the EPO may be corrected on request.

2.3 General applicability of Rule 139, first sentence, EPC

2.3.1 In the context of requests for correction of the designation of states, the boards of appeal denied the applicability of Rule 139 EPC (Rule 88 EPC 1973) in several decisions invoking otherwise a circumvention of re-establishment of rights under Article 122 EPC 1973. It was stated that correction of a mistake was an isolated procedural measure and not a case of re-establishment into a defined procedural phase as a whole (see J 27/96, Reasons 3.2). A procedural loss of rights only indirectly caused by the incorrect document would not be remedied by a later correction of the document pursuant to Rule 139, first sentence, EPC. This principle also characterised the functional and essential difference between a correction under Rule 88, first sentence, EPC 1973 on the one hand and *restitutio in integrum* pursuant to Article 122 EPC 1973 on the other hand (see J 3/01, Reasons 10; J 25/01, Reasons 4). To cancel procedural effects after failure to meet a time limit would be to apply Rule 88, first sentence, EPC 1973 beyond its clear and unambiguous wording and would violate the scope of application of Article 122 EPC 1973 which stipulated specific

requirements for grant of re-establishment of rights (see J 6/02, Reasons 15).

2.3.2 It is true that the above decisions related only to correcting of the designation of states and that the relevant provisions for re-establishment of rights have been changed in the meantime, as claimed by the appellant. However, it can be left open whether these circumstances are already sufficient to disregard the above case law for the following reason.

2.3.3 In its decision G 1/12 (OJ EPO 2014, A114), the EBA has already affirmed that a correction of errors under Rule 139, first sentence, EPC in documents filed with the EPO generally applies.

(a) According to the EBA, this followed clearly from the EPC structure as intended by the legislator, Rule 139 EPC having been left in the part relating to "Common provisions", where it had already been in the EPC 1973. Since it applied to any document filed with the EPO, the EBA saw no reason why it should not also apply to appeals (see G 1/12, Reasons 33 to 36).

(b) The EBA also rejected the argument that, applying the general principle of *lex specialis derogat legi generali*, Rule 139 EPC was to be considered "*lex generalis*", which was excluded by specific provisions (such as Rule 101 EPC in the case there). The EBA could not find in the wording of Rule 139 EPC any indication that this generally applicable provision referred to exceptional provisions. The EPC drafters did not in the wording of Rule 139 EPC make use of any introductory or final formula which, by definition, would have

referred to a specific provision excluding the general provision, as was the case in several other EPC provisions (see G 1/12, Reasons 39).

- (c) The present board is aware that the EBA made the above findings only in the context of the correction of an error in the appellant's name and of Rule 101 EPC as a possible *lex specialis*. However, the board fails to see why the lines of argument set out above should not equally apply to a correction of an erroneously filled payment form and to the relation between Rule 139 EPC on the one hand and the provisions concerning the re-establishment of rights on the other hand. The board also notes that the EBA in G 1/12 was apparently aware of the case law cited in point 2.3.1 above, as can be seen from the reference made to decisions J 27/96 and J 6/02 in point 37 of the Reasons.

2.4 Requirements for a correction under Rule 139, first sentence, EPC

2.4.1 In G 1/12, Reasons 37, the EBA summarised the following principles which the boards of appeal have developed as regards corrections under Rule 88, first sentence, EPC 1973 (Rule 139, first sentence, EPC).

- (a) The correction must introduce what was originally intended. The possibility of correction cannot be used to enable a person to give effect to a change of mind or development of plans. It is the party's actual rather than ostensible intention which must be considered.

- (b) Where the original intention is not immediately apparent, the requester bears the burden of proof, which must be a heavy one.
- (c) The error to be remedied may be an incorrect statement or an omission.
- (d) The request for correction must be filed without delay.

2.4.2 In the present case, the appellant has met these requirements.

- (a) The appellant originally intended to pay the appeal fee via Form 1038E on 21 November 2018. This would have been achieved if the "Method of payment" box had correctly indicated the entry "*Debit from deposit account*" instead of "*Not specified*". Accordingly, the appellant requested a corresponding correction.
- (b) The original intention to pay the appeal fee via Form 1038E was also immediately apparent, as can be seen from the document to be corrected itself. In Form 1038E, the appellant selected the (only optional) "Fees" box and indicated the relevant appeal fee ("*011 Appeal fee for an appeal filed by an entity other than those referred to in Rule 6(4) and (5) EPC*"). Any remaining doubts are dispelled by the appellant's indication in the notice of appeal letter which accompanied Form 1038E and expressed the unambiguous intention to pay the appeal fee ("*We are paying the appeal fee from our deposit account no. 28050721 by way of the attached fee sheet*"). In the absence of any contrary requirement in Rule 139 EPC, the board is also not

prevented from using indications of the appellant's original intention outside the document to be corrected (see also G 1/12, Reasons 28: in the event of a deficiency as to the appellant's identity which is to be corrected under Rule 101(2) EPC, the board must establish the true intention of the appellant on the basis of the information in the appeal *or otherwise on file*).

Consequently, the strict requirements as to the appellant's burden of proof do not apply here.

- (c) Furthermore, the error to be remedied in the present case is an incorrect statement in a document filed with the EPO, namely, the wrong indication in the "Method of payment" box on Form 1038E.
- (d) Finally, the appellant filed its request under Rule 139 EPC only 9 days after the examining division's communication dated 21 January 2019 (see point III above) which hinted at the fact that the payment of the appeal fee had not been carried out. The board is, therefore, satisfied that the appellant filed its request for correction without delay.

2.4.3 Apart from the requirements set out in G 1/12, Reasons 37, the EBA neither listed any further requirements for an allowable correction under Rule 139, first sentence, EPC, nor explicitly stated that that list was to be regarded as exhaustive and that no further requirements should be considered. Consequently, there is case law which considered further requirements to safeguard legal certainty and the interests of third parties and the public.

- (a) Subsequent to the EBA's decision in G 1/12, the referring board in that case additionally took into account the necessity for procedural legal certainty and the respondent's interests when deciding on the appellant's request for correction (see T 445/08, interlocutory decision of 26 March 2015, Reasons 10, 11 and 13.6).

- (b) Furthermore, the boards of appeal additionally considered the public's legitimate interest in relying on the information published by the EPO (see J 9/14, Reasons 3 and 4, regarding a request for correction under Rule 139 EPC of the withdrawal of the designation of a contracting state).

- (c) Finally, in J 20/12 the board dealt with the question of whether an application was still pending after its (erroneous) withdrawal under Article 67(4) EPC. It touched upon the problem that an application would potentially remain pending *ad infinitum* after it was withdrawn if a correction request under Rule 139 EPC led to such pendency because there was no time limit placed on the right to make this request (see J 20/12, Reasons 5.2 and 5.3). From this it could be inferred that a correction under Rule 139 EPC should no longer be available as a legal remedy if a statutory time limit has expired or a statutory event has occurred.

2.4.4 In the present case, there is no need to decide whether the EBA's list of requirements for a request under Rule 139, first sentence, EPC is exhaustive. The potential further requirements set out above are met anyway.

- (a) The necessity of legal certainty, according to which parties are, as a rule, bound by their procedural acts (see T 445/08, interlocutory decision of 26 March 2015, Reasons 10 and 13.6), does not play a role in the present *ex parte* case since there is no respondent who may have relied on the appellant's original (non-)payment of the appeal fee and whose interests could potentially be sacrificed if correction were to be allowed.

- (b) Moreover, in this case there is no legitimate interest of the public in relying on the information published by the EPO, i.e. that upon inspection of the European Patent Register it was apparent that the appellant originally used the incorrectly filled form for paying the appeal fee. In this context, it must be considered that the appellant subsequently filed certain procedural requests to eliminate the legal consequences of its mistake. However, until the board has decided on the appeal, third parties cannot legitimately trust that it would dismiss those requests such that the mistake leads to the appeal being deemed not to have been filed.

- (c) In the present case, the board also does not see the danger of an indefinitely long, unclear legal status of the application in suit because of the correction request under Rule 139 EPC not being subject to a statutory time limit. Since the appellant had filed notice of appeal and had actually intended to pay the appeal fee within the two-month time limit under Article 108, first sentence, EPC, the appeal proceedings were initiated within the prescribed time frame. The correction request relates to a mistake committed

within that time frame. As a consequence, it need not be decided whether the requirements listed by the EBA in G 1/12 are sufficient *per se* to prevent the above danger.

- 2.5 Retroactive effect of a correction under Rule 139, first sentence, EPC
- 2.5.1 The EBA further stated in G 1/12, Reasons 37, that an allowable correction under Rule 139 EPC has "retrospective effect". This effect results in the correct indication of the payment method "*Debit from deposit account*" in the respective box on Form 1038E *ab initio*.
- 2.5.2 However, it could be argued that the correct indication of the method of payment would only be an intermediate step before the appeal fee could be debited, while the time limit for payment had already expired.
- 2.5.3 In this context, Articles 5(2), 7(2) RFees in conjunction with point 5.4.1 of the current ADA must be considered. The latter provision states the following: "*Provided there are sufficient funds in the deposit account on the date the EPO receives the debit order, that date will be considered as the date on which the payment is made.*" Accordingly, as the EPO received the (retroactively corrected) debit order on 21 November 2018 and as the balance of the professional representative's deposit account was sufficient on that date, the above date - which was before the expiry of the time limit under Article 108, first sentence, EPC - is to be considered as the payment date.

3. The board concludes that the requirements for the correction requested are met, and thus that the correction is to be allowed. As a consequence, the appeal is retroactively deemed to have been filed, the correction under Rule 139 EPC having effect *ex tunc*.
4. Since the board comes to a positive conclusion under Rule 139 EPC, there is no need to decide on the request for re-establishment of rights under Article 122 EPC. Therefore, the respective fee is to be reimbursed.

Order

For these reasons it is decided that:

1. The request for correction under Rule 139 EPC is allowed.
2. The appeal is deemed to have been filed.
3. The reimbursement of the fee for requesting re-establishment of rights is ordered.

The Registrar:

The Chairman:



K. Boelicke

C. Kunzelmann

Decision electronically authenticated