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**Datasheet for the decision
of 17 May 2022**

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Title of invention:
PIPE SCREW JOINT

Applicant:
Nippon Steel & Sumitomo Metal Corporation
VALLOUREC OIL AND GAS FRANCE

Opponent:
Tenaris Connections BV

Headword:

Relevant legal provisions:

EPC Art. 99(1), 111(1)

EPC R. 139 sentence 1

RFees Art. 5(2), 7(2)

Arrangement for deposit accounts 5.1.2, 5.1.3, 5.4.1, 5.4.2

RPBA 2020 Art. 11

Keyword:

Correction of error - form for payment of opposition fee

Remittal to the department of first instance

Decisions cited:

G 0001/12, G 0001/18, J 0010/87, J 0004/03, J 0005/19,

J 0008/19, T 0152/82, T 0017/83, T 0170/83, T 0445/08,

T 0579/16, T 2620/18, T 0317/19, T 1000/19, T 0444/20

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1146/20 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 17 May 2022

Respondents:

(Patent Proprietors)

Nippon Steel & Sumitomo Metal Corporation
6-1, Marunouchi 2-chome
Chiyoda-ku
Tokyo 100-8071 (JP)

VALLOUREC OIL AND GAS FRANCE
54 rue Anatole France
59620 Aulnoye-Aymeries (FR)

Representative:

J A Kemp LLP
80 Turnmill Street
London EC1M 5QU (GB)

Appellant:

(Opponent)

Tenaris Connections BV
Piet Heinkade 55
1019 GM Amsterdam (NL)

Representative:

August Debouzy
7, rue de Téhéran
75008 Paris (FR)

Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on
20 February 2020.**

Composition of the Board:

Chairman M. O. Müller
Members: A. Lenzen
M. Blasi
S. Bertrand
R. Romandini

Summary of Facts and Submissions

- I. This decision concerns the appeal filed by the opponent (appellant) against the decision of the opposition division (decision under appeal) according to which the opposition against European patent No. 2 216 576 (patent in suit) is deemed not to have been filed (point II.2 of the Reasons and the order in EPO Form 2309.2) or is rejected as inadmissible (order in EPO Forms 2307 and 2339 (Sheet 1)). The basis for the decision was the opposition division's finding that the opposition fee had not been paid within the time limit set out in Article 99(1) EPC.
- II. The appellant had filed a notice of opposition on the last day of the opposition period (i.e. 20 June 2018) via EPO Online Filing, together with EPO Form 1038E (form 1038E) and supporting documents. The notice of opposition contained facts and arguments in support of the merits of the opposition. Form 1038E did not contain any payment information such as a debit order. As regards the payment of the opposition fee, the following was stated in the notice of opposition (page 4, paragraph 1): "*Any fee is to be charged against account [no.]*".
- III. On 12 July 2018, the EPO issued a communication pursuant to Rule 112(1) EPC, informing the appellant that the notice of opposition was deemed not to have been filed because the opposition fee had not been paid in due time. With this communication, a time limit of two months was set for the appellant to apply for a decision pursuant to Rule 112(2) EPC on the matter if it considered that finding inaccurate. On the same date, the EPO also sent information to the appellant

about the new filing and format requirements in force for debit orders since 1 December 2017.

IV. By letter dated 20 September 2018, received on 21 September 2018, the appellant requested withdrawal of the communication pursuant to Rule 112(1) EPC or, alternatively, oral proceedings and issuance of a decision in accordance with Rule 112(2) EPC. The appellant requested, *inter alia*, "a correction of errors under Rule 139 EPC for a mistake in the Form used for the filing of the notice of opposition" (page 4, first paragraph under point 3). The appellant argued that documents had been mistakenly filed which did not contain a debit order in the electronically processable XML format and stated that when the notice of opposition had been filed, the debit account contained sufficient funds. With its letter, the appellant also filed a corrected version of form 1038E. The corrected form 1038E contained, in electronically processable XML format, the authorisation for the EPO to debit the opposition fee in the amount of EUR 785 from the professional representative's deposit account, as reflected by the headings "Fees" and "Payment" as well as entries relating to the debit order. The opposition fee was then debited from the deposit account.

V. The opposition division, after holding oral proceedings, issued the decision under appeal. For its finding that the opposition fee was not paid within the time limit under Article 99(1) EPC, the opposition division's reasoning, relevant for the case at hand, is essentially as follows:

- The "Arrangements for deposit accounts" (ADA) that entered into force on 1 December 2017 (ADA 2017) were applicable. The debit order was not filed in

an electronically processable format (XML) as required by point 5.1.2 ADA 2017. The appellant's debit order was invalid (point 5.1.3 ADA 2017), and the date of receipt could not be regarded as the payment date (point 5.4.2 ADA 2017).

- A correction under Rule 139 EPC was not allowable. Rule 139 EPC was not a general provision, and errors could only be corrected in accordance with the legal framework in place. In accordance with T 170/83, a payment or a debit order was a matter of fact where a certain amount was transferred to and put at the disposal of the EPO. It was, therefore, not regarded as a procedural declaration which could be corrected pursuant to Rule 139 EPC. This was also reflected in point A-X, 7.1.1 of the Guidelines for Examination in the European Patent Office issued in November 2017 (GL 2017).

In contrast to the minutes (point 2.4 and the order in EPO Form 2309.2) and the Reasons for the decision under appeal (see point II.2) according to which the opposition division decided that the opposition was deemed not filed, EPO Forms 2307 and 2339 (Sheet 1) stated the order according to which the opposition division rejected the opposition as inadmissible pursuant to Rule 77 EPC.

In the decision under appeal (point I.1.5: "*notice of opposition having corrected payment*"), the opposition division acknowledged the payment of the opposition fee. The decision does not contain any statement relating to the further fate of this fee, nor was the fee refunded at a later stage.

- VI. On appeal, the appellant requested that the opposition be deemed to have been filed. The appellant argued,

inter alia, that the opposition division should have allowed its request for correction of form 1038E because the requirements set out in decision G 1/12 of the Enlarged Board of Appeal had been met.

- VII. In preparation for the oral proceedings, scheduled at the appellant's request, the board issued a communication pursuant to Article 15(1) RPBA 2020. In it, the board explained why it considered Rule 139 EPC to be applicable to the case at hand and that it intended to hear the parties at the oral proceedings on the allowability of such a correction. It also noted that while the appellant had stated in the request for correction that the deposit account had contained sufficient funds on the date when notice of opposition had been filed, no supporting documents had been submitted. The board also set a time limit of two month from notification of the communication for the parties to file observations on the applicability of Rule 139 EPC and the allowability of the correction.
- VIII. By letter dated 15 September 2021, the appellant filed a statement of the deposit account showing the balance at the beginning and the end of the day on which the notice of opposition had been filed as well as the account postings on that day.
- IX. By letter dated 21 September 2021, the patent proprietors (respondents) announced that they would not attend the oral proceedings. They also filed procedural requests (see point XI below) but did not comment on the merits of the current appeal.
- X. The board cancelled the oral proceedings.

XI. The parties' requests relevant for this decision are as follows.

The appellant requests that:

- the decision under appeal be set aside and that the opposition be deemed to have been filed based on a correction under Rule 139 EPC as the main request
- the case be remitted to the opposition division for further prosecution

The respondents request that the case be remitted to the opposition division for further prosecution if the board concludes that the opposition is deemed to have been filed.

Reasons for the Decision

Fundamental deficiency relating to the decision under appeal

1. In accordance with the decision under appeal, the appellant's debit order filed on the last day of the opposition period was not valid and could not be corrected pursuant to Rule 139 EPC with the consequence that the opposition was deemed not to have been filed. However, contrary to opinion G 1/18, which was known at the date of the oral proceedings before the opposition division, the opposition fee was not refunded, nor was a refund announced.
2. The decision under appeal has to be set aside alone for the reason that it cannot be clearly established what the opposition division's decision was for the terminating of the opposition proceedings.

- 2.1 As set out above in sections I and V, the opposition division, while having found that the opposition was deemed not to have been filed and while this finding was announced as an order at the end of the oral proceedings (see minutes, point 2.4 and the order in EPO Form 2309.2), the opposition division rejected the opposition as inadmissible pursuant to Rule 77 EPC in the decision under appeal (see EPO Forms 2307 and 2339 (Sheet 1)). The final outcome of the opposition division's decision - opposition not deemed filed or rejected as inadmissible - is thus ambiguous. Certainty on the outcome is necessary for the final allocation of the opposition fee. In the first alternative, the opposition fee would be refunded in the absence of a legal basis for keeping the paid amount; in the second alternative, the fee would be kept.
- 2.2 In its opinion G 1/18 (OJ EPO 2020, A26), the Enlarged Board of Appeal dealt with the issue of whether, in a situation where a notice of appeal had been filed in due time but the appeal fee had been paid late, the appeal was to be held as inadmissible or deemed not to have been filed. The Enlarged Board of Appeal held that, in such a situation, the appeal is deemed not to have been filed and, furthermore, that the appeal fee is to be reimbursed *ex officio* (G 1/18, Conclusions, point 1(a) and point 2). The "minority view" in the boards' case law, which had considered the issue of whether the notice of appeal was deemed filed as an additional and implicit condition for an appeal to be admissible (G 1/18, point II.3 of the Reasons), was no longer to be applied (G 1/18, Conclusions, first sentence). Instead, the "majority view" was confirmed to be applicable, according to which the assessment of whether an appeal is deemed to have been filed is a first and separate step to establish the existence of

an appeal before assessing, in a second step, the admissibility of the appeal (G 1/18, point VII. of the Reasons).

- 2.3 In this case, the situation differs from the one described in the previous point only in that it concerns the filing of an opposition and not an appeal: the opposition division found that the notice of opposition was filed in due time, but the opposition fee was paid late.

In its opinion, the Enlarged Board of Appeal also stated that, in view of the similarity of the wording of the provisions governing the filing of an appeal and an opposition, *"it goes without saying that the answer given to the referred question, including the part on reimbursement of the fee paid, will have direct implications for the other legal situations"*, by which the Enlarged Board of Appeal referred, *inter alia*, to oppositions (G 1/18, points I.2.(1)(a) and XI of the Reasons). Thus, if a notice of opposition has been filed in due time but the opposition fee is not paid in due time, the opposition is deemed not to have been filed, and the opposition fee must be reimbursed.

- 2.4 However, as set out above, the opposition division's decision is contradictory, and there are at least two alternative explanations for this:

- As the decision announced at the oral proceedings and the statement in the Reasons for the decision under appeal might suggest, the opposition division intended to follow opinion G 1/18, which was known at the time considering that it had been issued in July 2019 and the oral proceedings took place in December 2019. The opposition division, however,

erroneously used an incorrect order in EPO Forms 2307 and 2339 (Sheet 1) and omitted to deal with the issue of reimbursement of the opposition fee paid on 21 September 2018.

- As EPO Forms 2307 and 2339 (Sheet 1) and the absence of any dealing with the issue of reimbursement of the opposition fee might suggest, the opposition division followed the "minority view", either being unaware of opinion G 1/18 or by not applying it. The opposition being deemed not to have been filed - a necessary prerequisite for rejecting the opposition as inadmissible under Rule 77(1) EPC - was announced at the oral proceedings as an interlocutory decision, and the announcement of the rejection of the opposition as inadmissible as the final decision was erroneously omitted. While this alternative might appear less likely, it cannot be excluded at the outset.

Hence, as the outcome of the opposition proceedings cannot be clearly established, the decision suffers from a fundamental deficiency.

While the decision under appeal has to be set aside for this reason alone, the board, as announced in its communication dated 22 July 2021, decided not to remit the case under Article 11 RPBA 2020 at this stage but to review the opposition division's finding that the opposition fee had not been paid in due time.

Opposition deemed to have been filed

3. By letter dated 20 September 2018, filed within two months from notification of a communication pursuant to Rule 112(1) EPC containing the information that the notice of opposition was not deemed filed due to non-

payment of the opposition fee, the appellant requested a correction of errors in form 1038E which had been submitted via EPO Online Filing together with its notice of opposition. With the same letter, the appellant filed a corrected form 1038E, now including, in electronically processable XML format, the authorisation for the EPO to debit the opposition fee in the amount of EUR 785 from the professional representative's debit account. The opposition division did not allow the request for correction. *Inter alia*, for this reason, the opposition division found the opposition inadmissible or not to have been filed.

4. Pursuant to Rule 139, first sentence, EPC, linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request.
5. The board considers the appellant's request for correction under Rule 139 EPC to be allowable and thus overturns the opposition division's finding in this respect. Not only is Rule 139, first sentence, EPC applicable in this case, but the requested correction can also be allowed.
6. Applicability of Rule 139 EPC
 - 6.1 The opposition division took the view that Rule 139 EPC was not applicable. It held that Rule 139 EPC was not a general provision and that errors could only be corrected in accordance with the legal framework in place. In accordance with T 170/83, a payment or a debit order was a matter of fact where a certain amount was transferred to and put at the disposal of the EPO. It was therefore not regarded as a procedural declaration which could be corrected pursuant to

Rule 139 EPC. This was also reflected in A-X, 7.1.1 GL 2017.

6.2 The board, however, considers the general procedure for correcting errors under Rule 139, first sentence, EPC to be available in the case at hand in which the error concerns the ADA debit order to pay the opposition fee using form 1038E.

6.2.1 As pointed out in decision G 1/12 by the Enlarged Board of Appeal, Rule 139, first sentence, EPC is among the provisions implementing Part VII of the EPC headed "Common provisions" (G 1/12, OJ EPO 2014, A114, point 33 of the Reasons). This provision thus generally applies to any document filed in relation to proceedings governed by the EPC, such as examination, opposition and appeal proceedings.

The Enlarged Board of Appeal, in G 1/12, point 39 of the Reasons, also rejected the argument according to which Rule 139 EPC, being a general provision (*lex generalis*), was to be excluded by a specific provision (*lex specialis*), for instance by Rule 101 EPC in appeal proceedings. Thus, Rule 139 EPC is applicable irrespective of the existence or applicability of any specific provision such as, in relation to opposition proceedings, Rule 77 EPC.

While decision G 1/12 was concerned with errors relating to the appellant's name, the current board sees no reason why Rule 139, first sentence, EPC should not also apply to an order to debit the opposition fee from the EPO deposit account using form 1038E, the deposit account having been made available by the EPO pursuant to Articles 5(2) and 7(2) RFees and the corresponding decision of the President of the EPO

relating to the arrangements for deposit accounts. The fee is one prescribed under the EPC, and the debit order is addressed to the EPO, intended to be comprised in a document filed with the EPO to initiate opposition proceedings.

The board, therefore, concurs with the appellant that Rule 139, first sentence, EPC is applicable in the circumstances of this case.

The board notes that this approach is also in line with more recent case law, such as decisions T 317/19 of 22 October 2019 (point 2.3.3(c) of the Reasons), J 8/19 of 29 November 2019 (points 1 to 3 of the Reasons), T 1000/19 of 20 March 2020 (points 4.1 and 4.2 of the Reasons), T 2620/18 of 19 September 2020 (point 5.1 of the Reasons) and T 444/20 of 22 January 2021 (point 2.3 of the Reasons), in all of which Rule 139, first sentence, EPC was considered to be applicable in relation to an ADA debit order in a document filed with the EPO to pay either an opposition or appeal fee.

6.2.2 The opposition division argued that *"[a]ccording to T 170/83 a payment or a debit order is a matter of fact whereby a certain amount is transferred to and put at the disposal of the EPO"*.

The current board notes that the relevant passage in decision T 170/83 (point 8 of the Reasons) reads:

"To make a payment is to perform an act, namely to make a given amount available to the EPO at a particular time (Article 9(1), 1st sentence, Rules relating to Fees). This applies also to payments via deposit accounts."

The current board agrees in that making a payment, in the form of a money transfer, is indeed the performance of an act. What triggers the money transfer, however, is to be considered separately. Pursuant to point 5.1.2 ADA 2017, an ADA debit order to pay a procedural fee from the EPO deposit account must be filed with the EPO in an electronically processable format (XML), and it can be filed, for instance, by using documents such as form 1038E.

While in T 170/83, point 8 of the Reasons, it is also stated that "*...because the running of deposit accounts falls outside the grant or opposition procedures, it is not governed by Rule 88, 1st sentence, EPC [1973]*", this, in the board's view, represents an *obiter dictum* since the competent board in fact had considered the document filed with the EPO to comply with the requirements for a debit order under the ADA (see point 7 of the Reasons) such that the question of the applicability of Rule 88 EPC 1973 (corresponding to Rule 139 EPC) had not become relevant in that case.

Finally, further decisions from around the same time as decision T 170/83 allowed a correction pursuant to Rule 88 EPC 1973 (corresponding to Rule 139 EPC) of a debit order relating to a deposit account made available by the EPO which was acknowledged or at least not ruled out (see e.g. T 152/82, OJ EPO 1984, 301, point 7 of the Reasons and T 17/83, OJ EPO 1984, 306, point 6 of the Reasons).

In any event, however, in so far as decision T 170/83 is understood to exclude the applicability of Rule 139, first sentence, EPC in relation to ADA debit orders in general, this approach has been superseded by the more

recent case law issued in the aftermath of decision G 1/12 for the reasons set out above.

7. Allowability of the request for correction under Rule 139 EPC

7.1 In decision G 1/12 (point 37 of the Reasons), the Enlarged Board of Appeal summarised the following principles which the boards have developed for corrections under Rule 88, first sentence, EPC 1973, predecessor of Rule 139, first sentence, EPC.

- (a) The correction must introduce what was originally intended. The possibility for correction cannot be used to enable a person to give effect to a change of mind or development of plans.
- (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.

The board is of the view that, when applying these principles, the requested correction can be allowed.

The appellant's original intention to pay the opposition fee was immediately apparent from the circumstances that a notice of opposition comprising facts and arguments together with supporting documents was filed and that it had been stated in it that "*Any fee is to be charged against account [no].*" (see II. above). Taking this information into account is in line with G 1/12, point 28 of the Reasons, which reads "*the board must establish the true intention of the*

appellant on the basis of the information in the appeal or otherwise on file" (emphasis added). The principle set out in point (a) of G 1/12 is thus complied with.

As the original intention is immediately apparent, the principle set out in (b) does not apply here.

The error to be remedied in the case at issue is an omission, namely the omission of the ADA debit order in electronically processable XML format in form 1038E as filed on 20 June 2018. The principle set out in point (c) of G 1/12 is thus complied with as well.

Lastly, the appellant filed its request for correction under Rule 139 EPC within the two-month time limit set by the opposition division with its communication pursuant to Rule 112(1) EPC. The board takes the view that whether a request for correction under Rule 139 EPC can be considered as having been filed without delay (see the principle set out in (d)) depends on the circumstances of the case. The board also concurs with the considerations set out in T 579/16 (point 24 of the Reasons), according to which, in assessing whether the request was filed without delay, the interests concerned have to be weighed up against each other, namely, on the one hand, the interest of the party requesting the correction of a genuine mistake and, on the other hand, the interest of the other parties that rely on published information, including the interest in legal certainty (see also T 445/08, interlocutory decision of 26 March 2015, points 10 and 13.6 of the Reasons). In the current case, the respondents must have been aware of an imminent opposition because a notice of opposition comprising facts and arguments together with supporting documents was filed within the time limit prescribed in

Article 99(1) EPC. The issue relating to the non-payment of the opposition fee was addressed for the first time in the communication pursuant to Rule 112(1) EPC, issued by the EPO about three weeks after the notice of opposition had been received. When informed that the opposition was regarded not to have been filed due to non-payment of the opposition fee, the appellant undertook the necessary steps to prevent exactly this from happening, i.e. it filed requests for correction under Rule 139 EPC and for a decision pursuant to Rule 112(2) EPC and appealed the opposition division's decision. On the other hand, due to the issuance of the communication pursuant to Rule 112(1) EPC, the respondents must have been aware that the finding in this communication could still be reverted as long as the two-month time limit set by this communication was running and depending on the appellant's filing of a request for a decision under Rule 112(2) EPC and pending the outcome of the decision on such a request. Consequently, there was no published information in this case that could have led the respondents to rely on the opposition being deemed not to have been filed for lack of payment of the opposition fee, and legal certainty would not be negatively affected if the correction which was requested within that two-month time limit was allowed. Under the circumstances of this case, therefore, the board considers the filing of the appellant's request for correction under Rule 139 EPC to be without delay and in line with principle (d).

7.2 In G 1/12 (point 37 of the Reasons), the Enlarged Board of Appeal neither listed any further principles or 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 principles should be considered.

In its communication pursuant to Article 15(1) RPBA 2020, the board pointed to the relevance of the question of whether further criteria, beyond those formulated in G 1/12, are relevant to the correction. In reply to this communication, the respondents did not point to any additional aspects. The board is aware that according to some decisions, a mistake is eligible for a correction under Rule 139 EPC only where the mistake was also excusable (J 4/03, point 9 of the Reasons; see also J 10/87, OJ EPO 1989, 323, point 13 of the Reasons). However, for the same reasons as set out in J 5/19 (see point 2 of the Reasons), this board is of the opinion that excusability is not a requirement when applying Rule 139 EPC.

- 7.3 Thus, the requested correction of form 1038E under Rule 139 EPC is allowable.
8. Corrections allowed under Rule 139 EPC have retrospective (*ex tunc*) effect (G 1/12, point 37 of the Reasons). For this reason, form 1038E as submitted on 21 September 2018, i.e. containing the debit order in electronically processable XML format, is to be considered to have been filed on 20 June 2018, the date the notice of opposition with the form 1038E containing the error was filed. Furthermore, because the funds in the deposit account of the appellant's professional representative clearly exceeded the opposition fee on that date as shown by the corresponding statement filed with the letter dated 15 September 2021, the date of 20 June 2018 is also the date on which the payment was made in accordance with point 5.4.1 ADA 2017 and Articles 5(2) and 7(2) RFees. Consequently, in this

case, the opposition fee must be considered to have been paid in due time. The opposition must thus be deemed to have been filed. It also follows that the opposition fee is not to be refunded.

Remittal (Article 111 EPC and Article 11 RPBA 2020)

9. In view of the above considerations, the appeal is allowable, and the contested decision must be set aside. In the board's view, there are special reasons for remitting the case to the opposition division for further prosecution pursuant to Article 11 RPBA 2020.

The opposition division did not deal with the opposition as to its merits. Therefore, remittal of the case is consistent with the primary object of the appeal proceedings to review the decision under appeal in a judicial manner. Moreover, both parties requested that the case be remitted.

Need for oral proceedings

10. As is clear from the reasoning and order of this decision, each of the parties' requests (XI above) is allowable. Consequently, there was no need to hold oral proceedings, and this decision can be issued in written proceedings only.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The opposition is deemed to have been filed.
3. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



N. Maslin

M. O. Müller

Decision electronically authenticated