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**Datasheet for the interlocutory decision
of 14 February 2023**

Case Number: T 1678/21 - 3.5.04

Application Number: 18704816.0

Publication Number: 3593534

IPC: H04N21/236, H04N5/222,
H04N21/434

Language of the proceedings: EN

Title of invention:

TRANSPORTING ULTRA-HIGH DEFINITION VIDEO FROM MULTIPLE SOURCES

Applicant:

Raytheon Company

Headword:

Relevant legal provisions:

EPC Art. 108, 122(1)

EPC R. 139 sentence 1, 6(4), 6(5)

Keyword:

Correction under Rule 139 EPC available for mistakes in EPO Form 1038 (1038E) incorrectly authorising debitting of the reduced appeal fee (yes)

Criteria for assessing a request for correction under Rule 139, first sentence, EPC

Correction allowed (yes)

Entitlement of a company to the reduced appeal fee detectable from the file at the end of the appeal period (according to experience, without evidence, generally no)

Decisions cited:

G 0001/12, G 0001/18, J 0008/80, J 0006/02, J 0019/03,
J 0001/20, J 0005/19, J 0003/01, T 0152/82, T 0317/19,
T 1474/19, T 0333/20, T 1146/20, T 3098/19

Catchword:

1. From the company name of an appellant alone it can generally not be derived that the appellant does not meet the conditions of Rule 6(4,5) EPC in conjunction with European Commission Recommendation 2003/361/EC of 6 May 2003 for payment of the reduced appeal fee. This applies even where a company name is well-known.

2. Where it is not clear from the file at the end of the appeal period whether or not an appellant at the point in time of payment of the reduced fee meets the conditions of Rule 6(4,5) EPC, no clear intention to pay the regular appeal fee can be detected that under the principles of T 152/82 would entitle the EPO to ex officio debit the amount of the regular fee.

3. An appellant who gives a debit order for payment of the reduced appeal fee even though it clearly does not meet the conditions of Rule 6(4,5) EPC commits an obvious mistake in the meaning of J 8/80 and G 1/12. Such an appellant is imputed to have had the clear intention to pay the regular fee, reason why no evidence to prove this intention is required.

4. The exhaustive criteria to assess Rule 139 EPC are "principles" (a) to (c) of G 1/12, i.e. essentially those of J 8/80, points 4 and 6:

(a) The correction must introduce what was originally intended.

(b) Where the original intention is not immediately apparent, the requester bears the burden of proof, which must be a heavy one. The same applies, pursuant to J 8/80, point 6, where the making of the mistake is not self-evident.

(c) The error to be remedied may be an incorrect statement or an omission.

complemented by criterion

(d) balancing of the public interest in legal certainty with the interest of the party requesting correction, with the factors (i.e. sub-criteria of this criterion) relevant to the specific case.

As a rule, criteria (a) to (d) are to be assessed in the order (c), (a), if applicable, together with (b), and (d).



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Case Number: T 1678/21 - 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 14 February 2023

Appellant: Raytheon Company
(Applicant) 870 Winter Street
Waltham, MA 02451-1449 (US)

Representative: Dentons UK and Middle East LLP
One Fleet Place
London EC4M 7WS (GB)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 6 July 2021
refusing European patent application
No. 18704816.0 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair B. Willems
Members: B. Müller
B. Le Guen

Summary of Facts and Submissions

- I. The appeal is against the decision dated 6 July 2021 refusing European patent application No. 18 704 816.0.
- II. On 6 September 2021, the professional representative of the registered applicant Raytheon Company (hereinafter also referred to as the "applicant/appellant") electronically filed a "Letter accompanying subsequently filed items", EPO Form 1038 (also referred to as EPO Form 1038E), which comprises three boxes.

The first box identifies the sole "subsequently filed" document (a document filed subsequent to the filing of the European patent application; see Rule 50 EPC), i.e. the "Notice of appeal", the second box is entitled "Fees", and the third box is split into the two sub-boxes "Method of payment" and "Refund/Reimbursement".

In the second box, the following is stated under the heading "Fees": "11e Appeal fee for an appeal filed by a natural person or an entity referred to in Rule 6(4) and (5) EPC". The amount of EUR 1 955 (hereinafter: "reduced appeal fee") is indicated under the heading "Amount to be paid".

In the third box, the following statement is made under the heading "Method of payment": "The European Patent Office is hereby authorised, [sic] to debit from the deposit account with the EPO any fees and costs indicated on the fees page."

III. The final sentence of the notice of appeal reads as follows: "Any additional fees that may be required can be debited from our deposit account [xxx]".

On 6 September 2021, there were sufficient funds in the deposit account not merely for debiting the reduced but the regular appeal fee, i.e EUR 2 705 pursuant to Article 2(1), item 11, of the Rules relating to Fees as in force from 1 April 2020 (OJ EPO 2020, A3; hereinafter also referred to as "RFees").

IV. On Friday, 24 September 2021, the examining division remitted the appeal to the Boards of Appeal.

V. On the same day, the examining division also issued a communication entitled "Debiting of fees" (EPO Form 2935) stating that the amount of EUR 1 955 had been debited but the amount of EUR 2 705 was the correct amount of the appeal fee. The examining division added that it had instructed Directorate Treasury and Accounting to debit the outstanding amount of EUR 750 from the deposit account, leaving the payment date unchanged. The deposit account holder was given two months to file reasoned objections.

On Monday, 27 September 2021, the examining division issued a "brief communication" comprising only the following sentence: "Please be informed that our communication of 24.09.2021 (form 2935) was sent in error and is cancelled."

On 27 September 2021, the outstanding amount had not been debited and was not, according to the records of the Directorate Treasury and Accounting, debited thereafter, in accordance with the communication dated 27 September 2021.

- VI. A statement of grounds of appeal was filed on 15 November 2021.
- VII. On 23 November 2021, the board issued a communication pursuant to Rule 100(2) EPC inviting the applicant/appellant to file observations on the following issues within a period of two months.
- (a) The board had doubts whether the registered applicant/appellant Raytheon Company was "a natural person or an entity referred to in Rule 6(4) and (5) EPC", i.e. a small or medium-sized enterprise, a non-profit organisation, a university or a public research organisation and, thus, whether it was entitled to the reduced appeal fee.
- (b) According to Internet resources (i.e. the entry under https://en.wikipedia.org/wiki/Raytheon_Company, accessed on 11 November 2021), Raytheon Company was a defunct company prior to its merger with United Technologies. The post-merger company was Raytheon Technologies. In view of this, the representative was asked to clarify the status of the applicant/appellant Raytheon Company at the filing date of the appeal and ever since. (*Note: On 6 February 2023, the following was still said underneath the title of this entry: "This article is about the defunct company prior to its merger with United Technologies. For the post-merger company, see Raytheon Technologies."*)
- (c) If the status of the applicant/appellant was clarified, the question whether the correct appeal fee had been paid within the time limit of two months of notification of the decision ("appeal period"), which expired on 16 September 2021, would

have to be addressed. The crucial point was whether the representative could show that the applicant/appellant, at the point in time when the appeal was filed, existed and was an entity referred to in Rule 6(4) and (5) EPC. If the representative could not make such a showing, then the appeal would likely be deemed not to have been filed for lack of payment of the regular appeal fee.

VIII. In a letter of 24 November 2021, the professional representative who had filed the appeal (hereinafter: "the professional representative") requested that EPO Form 1038, filed on 6 September 2021, be corrected under Rule 139 EPC to indicate that the regular appeal fee for an appeal filed by an entity other than those referred to in Rule 6(4) and (5) EPC (EUR 2 705) should be debited. He also requested that the regular appeal fee be taken from his law firm's deposit account and retroactively deemed to have been paid on 6 September 2021. Attached to the letter was a copy of an exchange of emails between the professional representative and the U.S. instructing attorney (referred to as "Annex-A"). In support of his request, the professional representative made the following submissions.

It had been decided in Board of Appeal decisions T 444/20 and previously T 317/19 that Rule 139 EPC, first sentence, could be used to correct an error in a duly filed form for paying the appeal fee.

The appellant's intention to file an appeal and pay the appeal fee was shown by the emails attached as Annex-A. Annex-A included an email from the professional representative to the U.S. instructing attorney dated 25 August 2021 advising regarding the prospects of an

appeal, and a subsequent email from the U.S. instructing attorney to the professional representative dated 3 September 2021 instructing the professional representative to proceed.

The appellant's intention to file an appeal and pay the appeal fee was also shown by the filing of the notice of appeal and payment of the appeal fee on 6 September 2021, and by the inclusion of the statement "Any additional fees that may be required can be debited from our deposit account ..." in the notice of appeal filed on 6 September 2021.

The appellant's intention to file an appeal and pay the appeal fee was further shown by the filing of the grounds of appeal on 15 November 2021.

The appellant's intention to pay the regular appeal fee could also be inferred from the fact that

- no declaration of entitlement to the reduced appeal fee had been submitted and that
- the applicant was a well-known large entity.

The error in EPO Form 1038 had been brought to the professional representative's attention by the board's communication dated 23 November 2021. Accordingly, the request for correction had been filed without delay.

Oral proceedings were requested should the board be minded to refuse the request for correction.

IX. In communications of 17 December 2021 and 7 January 2022, the board drew the professional representative's attention to the fact that his

submissions dated 24 November 2021 did not clarify the status of the applicant/appellant Raytheon Company at the filing date of the appeal (6 September 2021) and ever since.

- X. In a letter of reply of 10 January 2022, the professional representative submitted that Raytheon Company was a wholly-owned subsidiary of Raytheon Technologies Corporation on 6 September 2021 and had been ever since. Raytheon Company had merged with United Technologies on 3 April 2020 and, as a result of the merger, Raytheon Company had become a wholly-owned subsidiary of the merged parent company, which parent company was then renamed as Raytheon Technologies Corporation.

A copy of a Certificate of Merger issued by the Secretary of State of the state of Delaware, USA, regarding the merger of 3 April 2020 (referred to as "Annex-B") and a copy of a report dated 3 April 2020 filed with the United States Securities and Exchange Commission by Raytheon Technologies Corporation (referred to as as "Annex-C") were provided as supporting evidence.

The applicant/appellant further submitted that Raytheon Technologies Corporation was a very large company comprising the combined assets of the historic United Technologies Corporation and Raytheon Company. Accordingly, as a wholly-owned subsidiary of Raytheon Technologies Corporation, the applicant/appellant Raytheon Company clearly was not an entity referred to in Rule 6(4) and (5) EPC.

In addition to the other reasons set out in the request for correction of an error, it was the applicant's/

appellant's intention to pay the full appeal fee and on filing the notice of appeal, it was never intended to rely on the provisions of Rule 6(4) and (5) EPC. A procedural mistake was made in the EPO Form 1038 filed on 6 September 2021.

The conditional request for oral proceedings was maintained.

- XI. In a letter received on 21 January 2022 (dated 21 September 2021), the professional representative requested, as a precaution, re-establishment of the period to file the notice of appeal. The regular appeal fee (EUR 2 705) and the fee for re-establishment of rights (EUR 665) were paid. The professional representative provided facts, evidence and arguments in support of this request. In particular, a declaration by the docketing manager was annexed to the letter. The professional representative requested oral proceedings should the board be minded to refuse the request for correction or the application.
- XII. In a communication pursuant to Article 15(1) RPBA 2020 dated 18 February 2022, issued on the same day as a summons to oral proceedings, the board expressed its preliminary and non-binding opinion on the payment of the appeal fee.

(a) Status of Raytheon Company

In this respect the board stated that the evidence provided by the professional representative with the letter dated 10 January 2022 supported his submissions that Raytheon Company became a wholly-owned subsidiary of Raytheon Technologies Corporation as a result of its merger with United Technologies on 3 April 2020. The

board, therefore, considered that Raytheon Company existed when the appeal was filed on 6 September 2021.

(b) Missing declaration of entitlement to the reduced appeal fee

The applicant/appellant had not submitted a declaration of entitlement to the reduced appeal fee together with the notice of appeal. Nor had such a declaration been filed subsequently.

These facts in themselves did not mean that the EPO, within the time limit for filing an appeal (Article 108, first sentence, EPC), would have had to consider the applicant's/appellant's order to pay the reduced appeal fee non-operational and, together with the authorisation to debit any shortfall (see the last sentence of the notice of appeal: "Any additional fees that may be required can be debited from our deposit account"), to constitute an order to pay the regular appeal fee.

As to the reasons for this preliminary conclusion, the board referred to its communication of 23 November 2021, points 9 and 10, which were based on T 1060/19. Points 9 and 10, in pertinent part, read as follows (emphasis added):

9. ...In case T 1060/19, the appellant asserted that the EPO should have recognised the underpayment because of the missing declaration of entitlement to the reduced fee filed at the latest by the time of payment of the reduced appeal fee. The EPO would have had to debit the full fee, because it was expressly authorised to debit the appeal fee and any underpayment thereof. Points 3., 4. and 11. of the Notice from the EPO dated 18 December 2017 concerning the reduced fee for appeal for an appeal filed by a natural person or an entity referred to in Rule 6(4) EPC (OJ EPO 2018, A5) read as follows:

3. Appellants wishing to benefit from the reduced fee for appeal must expressly declare that they are a natural person or an entity covered by Rule 6(4) EPC. ...

4. [fourth sentence] ... the declaration must be filed at the latest by the time of payment of the reduced fee for appeal.

11. In case of an incorrect, false or missing declaration with payment of the reduced fee the notice of appeal may be deemed not to have been filed or the appeal may be considered inadmissible. The deficiency may not be remediable after expiry of the two-month time limit for filing the notice of appeal. Appellants claiming entitlement to the reduced fee for appeal are therefore strongly recommended to ensure that when filing the notice of appeal the eligibility criteria are fulfilled and the declaration is duly made.

The board noted that the **Council Decision CA/D 17/17 amending Article 2 and 14 RFees (OJ EPO 2018, A4) did not require such a declaration**. The board nevertheless assumed arguendo that the provisions of the Notice that were pertinent to the case in hand were binding. The board observed that Points 3 and 4 of the Notice did not merely interpret decision CA/D 17/17 of the Administrative Council, but imposed additional duties, i.e. in particular an express declaration. The board specified that from point 11 of the Notice it followed that point 4 must be read as meaning that "it is strongly recommended that" the declaration be filed together with the payment. If not, there would be a deficiency which, however, would be amenable to being remedied by supplying the declaration by the end of the two-month appeal period. The appellant could still have made the declaration after having filed the notice of appeal until expiry of the appeal period. The EPO was not in a position to elucidate whether the appellant would still do so. The EPO was consequently not in a position to establish in time that the appellant, for failure to file the declaration in question, was not entitled to the reduced fee and to debit the difference amount to the full fee. Thus, the appeal was deemed not to have been filed. In its catchword the board stated that the declaration of entitlement mentioned in the Notice from the EPO could be filed until the end of the appeal period, despite the wording of point 4, last sentence, of the Notice, which must be reconciled with the meaning of point 11 of the Notice.

10. The board shares the views expressed by the board in T 1060/19, as summarised above. It therefore deems it critical whether or not the representative can show

that the appellant, at the point in time when the appeal was filed, existed and was an entity in the meaning of Article 6(4) and (5) EPC at that point in time. The EPO cannot be expected to have made respective investigations in the course of the short 10-day period between receipt of the notice of appeal and expiry of the appeal period.

If the representative cannot make such a showing, then the facts of the present case and their legal assessment may correspond in essence to those of case T 1060/19. The appeal, as in that case, will then likely be deemed not to have been filed for lack of payment of the full appeal fee, with the shortfall of 750 EUR being substantial (Article 108 EPC, second sentence, EPC; G 1/18).

(c) Request for correction of EPO Form 1038 under Rule 139 EPC filed on 24 November 2021

The board referred to the criteria ("principles") that the Enlarged Board of Appeal (hereinafter also: "EBA") had established in G 1/12, Reasons, point 37. (*Note: In the remainder of this decision, all references to specific points of decisions of the EBA or the boards of appeal are references to the Reasons of these decisions, unless indicated otherwise.*)

Re criterion that the request for correction is to be filed "without delay"

The board considered that it was the actual knowledge of an error gathered by the responsible person that was critical in determining the starting point of the period allowed for filing a request for correction to meet the "without delay" requirement.

The responsible person, i.e. the professional representative, in his letter of 24 November 2021 requesting correction, asserted that the error in EPO

Form 1038 had been brought to his attention by the board's communication of 23 November 2021.

The board expressed doubts as to this assertion. The examining division's communications of 24 September 2021 and 27 September 2021 were clear indications that the regular appeal fee had not been paid within the appeal period. Against this backdrop, the representative was invited to explain his assertion. If he were unable to do so convincingly, then the question would arise whether filing the request on 24 November 2021, i.e. around two months after having received the two communications of the examining division, met the requirement of "without delay". The board was not convinced that it did.

Re criterion that the correction must introduce what was originally intended

The board considered that the applicant's/appellant's intent to pay the regular appeal fee was not immediately apparent from EPO Form 1038 filed on 6 September 2021. In particular, it was not apparent at first glance that the applicant/appellant was a large entity. There were indications on the Internet that the applicant/appellant Raytheon Company did not even exist.

Should the request for correction not be allowed, the regular appeal fee would be deemed not to have been paid within the appeal period. The appeal would consequently be deemed not to have been filed (Article 108, second sentence, EPC). In that case, the applicant's/appellant's request for re-establishment of rights under Article 122 EPC would become operational. The board was of the opinion that even if that request

were admissible, it would obviously not be allowable because the professional representative did not exercise the due care required by Article 122(1) EPC.

XIII. In a response received on 10 March 2022 (dated 28 February 2022) to the board's communication of 18 February 2022, another patent attorney of the professional representative's law firm made the following submissions. A declaration by the professional representative (dated 10 March 2022, hereinafter: "the representative's declaration") was attached.

Re requirement that the request for correction is to be filed "without delay"

As set out in the professional representative's declaration, he did not receive either of the examining division's communications. Therefore, he as the responsible attorney, did not become aware of the error until 23 November 2021. As such, the request for correction was filed without delay.

The representative's declaration, in pertinent part, reads as follows:

On 24 September 2021, I was not in the office. I therefore did not receive a copy of the communication dated 24 September 2021 received through [the law firm's] online EPO mailbox on that day.

I returned to the office on 27 September 2021. However, I have since learnt that a further communication was issued on that date. As this communication dated 27 September 2021 was a cancellation of the communication dated 24 September 2021, I have since learnt that neither communication was brought to my attention. Therefore, I could not have become aware of the error at this stage as I was not made aware of issuance of nor subsequent receipt of either of these communications at the time.

Therefore, it was only on receipt of the communication dated 23 November 2021 from the Boards of Appeal that I became aware of issue [sic] with the appeal fee. The next day, I immediately submitted the request for a correction along with payment of the full appeal fee.

However, **on principle**, the representatives disagreed with the suggestion that the examining division's communication dated 24 September 2021 and/or the examining division's communication dated 27 September 2021 could have and/or should have made the responsible attorney aware of the error. They had serious reasons to be concerned that a cancelled communication which was expressly stated to have been "sent in error", **on the very next working day following issue**, should be considered a "clear indication that the regular appeal fee had not been paid within the appeal period".

Instead, the first communication (dated Friday, 24 September 2021) would have alerted the professional representative that an underpayment of the appeal fee had been made, but that the underpayment was being debited leaving the payment date unchanged. The second communication (dated Monday, 27 September 2021) merely informed that the "communication of 24.09.2021 (EPO Form 2935) was sent in error and [was] cancelled". This would not have provided a clear indication of anything other than that the first communication (dated Friday, 24 September 2021) was issued in error; i.e. that there had been no underpayment of the appeal fee.

Nowhere in either communication of 24 September 2021 (Friday) or 27 September 2021 (Monday) was there any suggestion that the appeal fee had been paid for a natural person or an entity referred to in Rule 6(4) and (5) EPC as opposed to the appeal fee by any other entity. The former communication simply suggested an

underpayment in that the correct amount for the fee for appeal was EUR 2 705 but that a lesser fee of EUR 1 955 had been paid, and that a deficiency of EUR 750 would be corrected by debiting the account.

The communication dated 27 September 2021 simply stated "Please be informed that our communication of 24.09.2021 (form 2935) was sent in error and is cancelled". As such, this communication suggested that the correct appeal fee had been paid, i.e. there had been no underpayment of the appeal fee. Therefore, contrary to the suggestion in the board's preliminary opinion, this communication was not and could not have been a "clear indication that the regular appeal fee had not been paid".

As was well-established, the principle of the protection of **legitimate expectations** implied that measures taken by the EPO should not violate the reasonable expectations of parties to such proceedings. The two main principles on the protection of the legitimate expectations of users of the European patent system required firstly that the user must not suffer a disadvantage as a result of **having relied on** erroneous information or a misleading communication received from the EPO and secondly, that the EPO was to warn the applicant/appellant of any loss of right if such a warning could be expected in good faith (presupposing that the deficiency could be readily identified by the EPO).

As regards the first requirement, the applicant/appellant had suffered a disadvantage as a result of **having relied** on erroneous information or a misleading communication received from the EPO. On issuing the communication dated 24 September 2022, the EPO knew

that the applicant/appellant had made an error in paying the incorrect appeal fee and therefore the deficiency was readily identifiable to the EPO. However, instead of maintaining its good faith warning to the applicant/appellant of the error it had identified (and remedying the error as it had originally proposed on issuance of its communication dated 24 September 2021), it cancelled this communication without properly informing the applicant/appellant of its reasoning.

The communication of 27 September 2021 provided no reasoning as to why the earlier communication had been issued in error, but instead misled the applicant/appellant to believe that there had **been no underpayment and that the correct appeal fee must have originally been paid.**

Indeed, there was nothing in either communication detailing that the appeal fee had been paid for a natural person or an entity referred to in Rule 6(4) and (5) EPC. The communication dated 24 September 2021 simply indicated that there had been an underpayment. Therefore, when the communication of 27 September 2021 was received with no detail as to why the communication dated 24 September 2021 was "sent in error and [was] cancelled", it was and continued to be legitimate to expect that the communication dated 24 September 2021 had been issued erroneously and therefore there had been no deficiency, **i.e. underpayment of the appeal fee.**

Therefore, on issuing the communication of 27 September 2021, the appellant was misled into **believing that the correct appeal fee had been paid.**

It followed that there was no delay in filing the request for correction.

Re requirement that the correction must introduce what was originally intended

The applicant/appellant disputed that a "wholly-owned subsidiary of a large company" could be an entity referred to in Rule 6(4) and (5) EPC. Under paragraph 4(a), the reduction referred to in paragraph 3 should be available to small and medium-sized enterprises. Pursuant to paragraph 5, for the purposes of paragraph 4(a), Commission recommendation 2003/361/EC of 6 May 2003 concerning the definition of micro, small and medium-sized enterprises (OJ EU L 124, p. 36 of 20 May 2003) should apply.

According to the applicant/appellant, the Guidelines for Examination, A-X, 9.2.1 recited (in part):

The category of micro, small and medium-sized enterprises is made up of enterprises which employ fewer than 250 persons, which have an annual turnover not exceeding EUR 50 million and/or an annual balance sheet total not exceeding EUR 43 million and for which **no more than 25% of the capital is held directly or indirectly by another company that is not an SME.** (emphasis added)

Following the all-stock merger of equals transaction between Raytheon Company and United Technologies Corporation on 3 April 2020, the merged company changed its name to Raytheon Technologies Corporation. Per Annex C which was filed on 10 January 2022, "Raytheon Technologies was one of the largest aerospace and defense companies in the world with approximately \$74 billion in pro forma 2019 net sales and a global team of 195,000 employees, including 60,000 engineers and scientists". As Raytheon Company was a **wholly**-owned

subsidiary of Raytheon Technologies Corporation, which was not an SME as per the definition above, Raytheon Company was also not "an entity referred to in Rule [6](4) and (5) EPC".

Therefore, it had been the actual intention of the applicant/appellant and that of the professional representative to pay the regular appeal fee, not the reduced appeal fee for entities referred to in Rule 6(4) and (5) EPC.

As regards whether or not this mistake was immediately obvious, it was submitted that as the EPO issued the communication dated 24 September 2022, it was clear to the examining division that an obvious and/or immediate error had been made; namely that the incorrect appeal fee had been paid. Indeed, issuance of this communication was clear evidence that a mistake had occurred and had been clearly identified by the EPO.

Nevertheless, even if the original intention had not been immediately apparent based on the information available to the EPO, it was immediately apparent from the information known to the applicant/appellant and its professional representative, as set out in his declaration.

The applicant/appellant also noted that since the merger, over 125 European regional phase entries and/or divisional applications had been filed on behalf of Raytheon Company by the representatives' law firm; evidence was attached. In all of these filings, no declaration had ever been submitted that Raytheon Company was a natural person or an entity referred to in Rule 6(4) and (5) EPC nor had any request for reduced filing or examination fees ever been made.

Furthermore, both appeals which had been filed in addition to the present appeal by that law firm for Raytheon Company since the merger correctly identified the applicant/appellant as a large entity, i.e., the appeals were filed paying the regular appeal fee for both EP 18704817.8 and EP 17777699.4.

Therefore, it was submitted that it had been the applicant's/appellant's **original intention** to pay the **regular appeal fee**.

For completeness, it was not disputed that the fact that T 444/20 related to "a well-known large entity which is not entitled to the reduced appeal fee" (per point 2.4.2(bii) of the decision) was only a "further fact" which corroborated the assumption that the appellant originally intended to pay the regular appeal fee. However, as with T 444/20, point 2.4.2(bi), the professional representative in the case in hand did not file an **explicit declaration** pursuant to the Notice that the applicant/appellant had wished to make use of the reduced appeal fee. In addition, it was evident to the professional representative that the applicant/appellant, Raytheon Company, was not an entity referred to in Rule 6(4) and (5) EPC and therefore was not entitled to a reduced appeal fee.

As such, the **request for correction** should be accepted.

The request for oral proceedings was maintained.

XIV. In its further reply of 4 April 2022, the applicant/appellant made the following submissions.

The debiting of fees communication dated 24 September 2021 would only have been issued by the EPO upon the identification of an error in the fee for appeal paid on 6 September 2021. That communication also made the necessary correction to resolve that error, by specifically confirming that the Directorate Treasury and Accounting department had been instructed to debit the representative's deposit account with the remainder of the appeal fee due. That finding and the action taken by the EPO corrected the error, leaving the payment date unaffected, in other words the appeal fee would have been fully paid and deemed to have been paid in time. There could be no question that at that time the examining division had come to the conclusion that the applicant/appellant had made an error in paying the reduced appeal fee and that the EPO had taken upon itself the task of correcting that error.

The actions of the EPO at that stage were fully consistent with accepted procedure. The EPO was authorised to debit the full amount of the fee from the representative's deposit account in the event of an underpayment, especially when this was explicitly authorised by the professional representative as was the case in this appeal. This procedure was well established and was followed by the examining division on issuance of the communication of 24 September 2021.

The debiting of fees communication dated 24 September 2021 set, at paragraph IV, a two-month deadline by which the deposit account holder could file reasoned objections to the assessment of facts, failing which, its agreement to the correction would be assumed. Such deadline, therefore, afforded the applicant/appellant the opportunity to present its reasoning in the event it believed the error identified

by the EPO to be incorrect and/or the proposed correction to be incorrect. The applicant/appellant had at no stage filed reasoned objections in response to the 24 September 2021 communication.

Whether or not there might be case law that discussed whether the EPO should **investigate** whether the correct appeal fee was paid and/or whether the amount lacking should be deemed sufficiently small as to be deductible from a representative's deposit account by the EPO of its own volition was immaterial in the case in hand for the reasons that on or before 24 September 2021 the EPO had concluded that an error had been made and had instigated the necessary correction. This was entirely consistent with the finding of the EBA in G 1/18, especially given that the applicant's/appellant's representatives had explicitly instructed the EPO to deduct any fee due from their deposit account and the EPO had done so (the 24 September 2021 communication confirmed this).

The applicant/appellant remained in the dark as to what caused the EPO to issue its subsequent communication of 27 September 2021. Additionally, that communication was confusing at the time.

First, the communication of 24 September 2021 was explicitly an *ex post facto* communication. The Directorate Treasury and Accounting department had been instructed to debit the remainder of the fee due. That is, **the instruction had already been given**. The further action required by the communication of 24 September 2021, if any was desired, was stipulated in section IV. The communication of 27 September 2021 merely stated that the communication of 24 September 2021 was sent in error and that the

"communication" was cancelled. The communication of 27 September 2021 did **not** inform the representative that the earlier instruction to the Directorate Treasury and Accounting department had been rescinded. At face value, there was nothing in the EPO's communication of 27 September 2021 that could have alarmed the applicant/appellant that something was awry with the appeal. Had there been a problem, the 24 September 2021 communication stated that action had already been taken by the EPO. The 27 September 2021 communication gave no indication that the correction had been annulled and that there would then be a problem with the appeal. It was entirely reasonable, as indeed occurred, to understand the communication of 27 September 2021 that all was in order with the appeal. This also explained why the professional representative had not been alerted as to a possible error made by the professional representative's in-house paralegals when filling out EPO Form 1038.

It appeared that a decision to rescind the action advised in the communication of 24 September 2021 was taken on the basis of an unspecified internal, "speculative investigation", which had been conducted without consulting the applicant/appellant and seemingly "without any clear application of specified rules of procedure prescribed by the Convention".

The EPO, specifically the examining division, had reviewed the notice of appeal and noted that the incorrect appeal fee had been paid, either as they were well aware that Raytheon Technologies Corporation was a large entity or in view of the lack of an accompanying declaration. Therefore, the debiting of fees communication of 24 September 2021 was not issued in error. Instead, the communication dated

27 September 2021, cancelling this debiting of fees communication, when the EPO had already identified an error and given instructions to correct it, appeared itself to have been erroneously issued stemming from some unspecified, procedurally irregular internal investigation by the examining division.

The applicant/appellant **requested** that the board **reinstate the instruction** to the Directorate Treasury and Accounting department, on the basis that this was the correct action taken by the EPO in the circumstances and deem the fee paid in time. As auxiliary measure, it was submitted that the request for **re-establishment** be deemed to have been filed in time given the procedural issues of this case, for the reasons set out in the applicant's/appellant's reply of 4 April 2022.

The request for oral proceedings was maintained in the event the board was minded not to reinstate the instruction.

XV. **The requests**

Initially, with its letter of 24 November 2021, the applicant/appellant requested that EPO Form 1038, filed on 6 September 2021, be corrected under Rule 139 EPC to indicate that the regular appeal fee for an appeal filed by an entity other than those referred to in Rule 6(4) and (5) EPC (EUR 2 705) should be debited (see point VIII. above). The applicant/appellant also requested that the regular appeal fee should be taken from its law firm's deposit account and retroactively deemed to have been paid on 6 September 2021 (*ibid.*).

With a letter received on 21 January 2022, re-establishment of the period to file the notice of appeal was requested as a precaution (see point XI. above).

In its latest submission of 4 April 2022, the applicant/appellant requested reinstatement of the examining division's instruction to the Directorate Treasury and Accounting of 24 September 2021 (see previous point XIV.).

Reasons for the Decision

A. Background

1. The applicant's/appellant's notice of appeal against the decision of the examining division of 6 July 2021 was received on 6 September 2021. This was within the two-month appeal period set out in Article 108, first sentence, EPC, which expired on 16 September 2021 (see Rules 126(2) and 134(1) EPC). Together with the notice of appeal, instructions were given on EPO Form 1038 to debit the reduced appeal fee.

Further to the board's communication of 23 November 2021, the applicant/appellant identified that these instructions were erroneous as the regular appeal fee should have been paid. The applicant/appellant filed the requests to undo the consequences of this error, as set out above, in point XV.

All three requests, including the request for correction under Rule 139 EPC, continue to be pending, even though the applicant/appellant did not repeat the request for correction in its latest submission of

4 April 2022. This is because it has not formally dropped that request (cf. R 5/19, point 3.6). The board further considers the order of the requests to be as follows:

The primary request is the request for reinstatement because the underlying assertions are that it was the EPO and not the applicant's professional representative that had committed a mistake. The first alternative request is the request for correction of an error by the professional representative under Rule 139 EPC, because the language of that provision, different from Article 122(1) EPC governing requests for re-establishment of rights, does not require that the error that had occurred caused a time limit to be missed despite all due care having been exercised. The remaining request for re-establishment is, therefore, the second alternative request.

2. Under the second sentence of Article 108 EPC, "Notice of appeal shall not be deemed to have been filed until the fee for appeal has been paid". Where notice of appeal is filed within the time limit but the appeal fee is paid after expiry of that time limit, an appeal is deemed not to have been filed (G 1/18, OJ EPO 2020, A26, final section C, point 1(a)).
3. In the case in hand, the question is whether the requirements of Article 108, second sentence, EPC are met despite payment of the reduced appeal fee either because
 - the examining division's instruction to the Directorate Treasury and Accounting in its communication of 24 September 2021 must be reinstated (primary request; see section B. below),

- the applicant's/appellant's statements made with a view to paying the appeal fee, both in the notice of appeal and EPO Form 1038 (see above, points II. and III.), must be assessed as instructions to pay the regular appeal fee thus obviating the applicant's/appellant's request for correction under Rule 139 EPC (see section C. below),

or because

- the request for correction under Rule 139 EPC (first alternative request; see section D. below) or
- the request for re-establishment of rights under Article 122(1) EPC (second alternative request)

must be granted.

As a preliminary matter, the law governing the payment of the appeal fee, insofar as pertinent to the case in hand, will be laid out in greater detail in the following point A.4.

4. *Provisions relating to the payment of the appeal fee*

- 4.1 Up until 1 April 2018, there was a single amount of the appeal fee, which, after the latest increase, stood at EUR 1 880.

For appeals filed after that date, legislation has provided for a regular and a reduced amount of the appeal fee, i.e. a staggered appeal fee: pursuant to Article 1(4) of the Decision of the Administrative Council of 13 December 2017, CA/D 17/17 (OJ EPO 2018, A4), Article 2(1), item 11 RFees was amended to set the appeal fee at EUR 1 880 for an appeal filed by a natural person or an entity referred to in Rule 6(4) and (5) EPC and at EUR 2 255 for an appeal filed by any other entity. Article 3(4) of Decision CA/D 17/17

provides that this applies to appeals filed on or after 1 April 2018.

Paragraphs 4 and 5 of Rule 6 EPC read as follows:

(4) The reduction referred to in paragraph 3 shall be available for:

- (a) small and medium-sized enterprises;
- (b) natural persons; or
- (c) non-profit organisations, universities or public research organisations.

(5) For the purposes of paragraph 4(a), Commission recommendation 2003/361/EC of 6 May 2003 concerning the definition of micro, small and medium-sized enterprises as published in the Official Journal of the European Union L 124, p. 36 of 20 May 2003 shall apply.

The definition referred to in Rule 6(5) EPC, in pertinent part, is as follows:

Article 2

Staff headcount and financial ceilings determining enterprise categories

1. The category of micro, small and medium-sized enterprises (SMEs) is made up of enterprises which employ fewer than 250 persons and which have an annual turnover not exceeding EUR 50 million, and/or an annual balance sheet total not exceeding EUR 43 million.

Article 3

Types of enterprise taken into consideration in calculating staff numbers and financial amounts

1. An "autonomous enterprise" is any enterprise which is not classified as a partner enterprise within the meaning of paragraph 2 or as a linked enterprise within the meaning of paragraph 3.

2. "Partner enterprises" are enterprises which are not classified as linked enterprises within the meaning of paragraph 3 and between which there is the following relationship: an enterprise (upstream enterprise) holds, either solely or jointly with one or more linked enterprises within the meaning of paragraph 3, 25 % or more of the capital or voting rights of another enterprise (downstream enterprise).

However, an enterprise may be ranked as autonomous, and thus as not having any partner enterprises, even if this 25 % threshold is reached or exceeded by the following investors [under certain conditions]:

- (a) ["business angels", under further conditions];
- (b) universities or non-profit research centres;
- (c) institutional investors, including regional development funds;
- (d) autonomous local authorities [under further conditions].

3. "Linked enterprises" are enterprises which have any of [various] relationships with each other ...

Part A, Chapter X, 9.2.1 of the Guidelines for Examination in the EPO (version of March 2021, hereinafter: "the Guidelines") recite in respect of the definition referred to in Rule 6(5) EPC (emphasis added):

The definition of SMEs is that contained in European Commission Recommendation 2003/361/EC of 6 May 2003 as published in the Official Journal of the European Union. Under the recommendation, an enterprise is considered to be any entity engaged in an economic activity, irrespective of its legal form. The category of micro, small and medium-sized enterprises is made up of enterprises which employ fewer than 250 persons, which have an annual turnover not exceeding EUR 50 million and/or an annual balance sheet total not exceeding EUR 43 million and **for which no more than 25% of the capital is held directly or indirectly by another company that is not an SME.**

The eligibility of the further entities listed in Rule 6(4) EPC is subject to the following definitions:

(i) "Non-profit organisations" are organisations not allowed by their legal form or statutes, under the relevant law, to be a source of income, profit or other financial gain to their owners, or - if allowed to make a profit - there is a legal or statutory obligation to reinvest the profits made in the interest of the organisation.

...

[end of quotation]

The board notes that there are exceptions to the 25% criterion set out in the extract of the Guidelines reproduced above: under Article 3, point 2 of the definition of micro, small and medium-sized enterprises adopted in the above mentioned Commission recommendation, a fully held small entity may also qualify as a micro, small or medium-sized enterprise under Rule 6(4-5) EPC if it is held by a certain other entity, for example an institutional investor (see sub-point (c)).

Article 2(1) RFees was amended by Article 1 of the Decision of the Administrative Council CA/D 12/19 of 12 December 2019 (OJ EPO 2020, A3), which, pursuant to its Article 4, entered into force on 1 April 2020. Article 1 of the decision increased the amounts of the appeal fee to EUR 1 955 and EUR 2 705 in item 11 of Article 2(1) RFees, respectively. The new amounts of the fees specified in Article 1 of the decision, according to its Article 5(1), as a rule, apply to payments made on or after 1 April 2020. (*Note: For payments made on or after 1 April 2022 the appeal fee has again increased (Decision of the Administrative Council CA/D 13/21 of 15 December 2021, OJ EPO 2022, A2)*).

Pursuant to Article 8 RFees, "[a] time limit for payment shall in principle be deemed to have been observed **only if the full amount** of the fee has been paid in due time. ... [The EPO may,] where this is considered justified, overlook any **small amounts** lacking without prejudice to the rights of the person making the payment." (Emphasis added.)

4.2 Under Article 5(1) and (2) and 7(2) RFees, the fees due to the EPO must be paid by payment or transfer to a

bank account held by the EPO, or by other methods of paying fees allowed by the President of the EPO, who must in this case also lay down the date on which such payments are to be considered to have been made.

The "Arrangements for deposit accounts" as revised by the Decision of the President of the EPO of 20 August 2019 (Supplementary publication 4 to OJ EPO 2019), hereinafter referred to as "ADA 2019", valid from 1 October 2019, make available deposit accounts for paying fees to the EPO (point 1 ADA 2019).

Subject to point 9 ADA 2019, deposit accounts may be debited only in respect of fees payable to the EPO in connection with European and PCT proceedings (point 5 ADA 2019). Debiting occurs on the basis of an electronic debit order signed by the account holder or the authorised representative (point 5.1.1 ADA 2019), for example, using EPO Form 1038E (point 5.1.2 ADA 2019).

Provided there are sufficient funds in the deposit account on the date the EPO receives the debit order, that date will be considered the date on which the payment is made (point 5.4.1 ADA 2019).

The board notes that neither point 5.1.1 nor point 5.4.1 nor any other provision of the ADA 2019 requires that a fee amount be specified in the debit order.

B. Primary request: reinstate communication by the examining division

1. The applicant/appellant requests that the examining division's instruction to Directorate Treasury and

Accounting to debit the deposit account with the difference between the regular appeal fee and the reduced appeal fee, originally given in the examining division's communication dated 24 September 2021, be reinstated.

2. The communication, in point I, sets out the amount debited of EUR 1 955. This amount corresponded to the amount expressly authorised in EPO Form 1038 of 6 September 2021.

The subsequent point II reads:

Applying the principles laid down in Board of Appeal Decision T 152/82 (OJ EPO 1984, 301), the substance of the debit order, taking into consideration the stage reached in the proceedings and the content of the file, is found to be as follows ...

The correct amount of the appeal fee was found to be EUR 2 705.

In point III, as a result of this finding, it is said that Directorate Treasury and Accounting had been instructed to correct the debit, leaving the payment date unchanged, by debiting the account with the lacking amount, being the difference of EUR 750 between the initial debit and the correct amount.

Final point IV reads:

Within two months of notification of this communication the deposit account holder may file reasoned objections to this assessment of the facts, failing which his agreement to the correction will be assumed.

3. With its communication the examining division obviously followed the provisions in Part A, Chapter X, 4.2.3 of the Guidelines, which read as follows:

A debit order must be carried out notwithstanding incorrect information given in it, if the intention of the person giving the order is clear (see T 152/82). The EPO corrects a debit order of its own motion, for example, if there is a discrepancy between the type of fee intended to be paid and the corresponding amount due on the date of receipt of the debit order (see also A-X, 7.1.2). The party is informed of any such correction by means of a communication from the EPO providing a two-month period for objecting to it in the event of disagreement by the party. In that case, the fee will be debited as indicated in the (erroneous) debit order or, if applicable, any corrective booking carried out will be reverted. The principles outlined above, however, do not allow the correction of a debit order by adding any fee that is not indicated in it, even if, according to the status of proceedings, that fee is due on the date of receipt of the debit order.

4. The applicant/appellant asserted that the examining division was correct in issuing the communication of 24 September 2021. It had recognised that payment of the reduced appeal fee was incorrect, either because it knew that the applicant/appellant was a large company or because the declaration of entitlement to the reduced appeal fee was missing. The applicant/appellant also pointed out that it had never objected to the debiting of the lacking amount during the period specified in point IV of the communication.

5. The board holds that the request to reinstate the examining division's communication of 24 September 2021 cannot be granted.

As mentioned under point A.2. above, under Article 108, second sentence, EPC, "Notice of appeal shall not be deemed to have been filed until the fee for appeal has been paid." An appeal will be deemed not filed if the notice has been received in time, but the fee paid after expiry of the appeal period (G 1/18, conclusion 1(a)).

According to Article 109(1), first sentence, EPC, "If the department whose decision is contested considers the appeal to be admissible and well founded, it shall rectify its decision."

The examining division initially, in issuing its communication entitled "Debiting of fees" on Friday, 24 September 2021, as explained above, found that the appeal fee was not paid in full and therefore instructed Department Treasury and Accounting to debit the shortfall. But on 27 September 2021, i.e. the following working day, it declared that this communication was cancelled. On 27 September 2021, it transmitted the appeal to the Boards of Appeal.

This transmission was in line with the principle underlying Article 109(1), first sentence, EPC: if the department of first instance considers that there is a deficiency regarding the appeal fee raising doubts about the existence of an appeal, then it cannot logically examine whether the appeal is admissible and well-founded (and, if so, grant interlocutory revision), but must transmit the appeal to the Boards of Appeal.

Pursuant to Rule 101(1) EPC, it was then for the board to which the case was assigned to examine the existence and admissibility of an appeal.

Given that the examining division had no jurisdiction to issue the communication, the board is not empowered to reinstate it.

That the examining division has no jurisdiction on this type of matter is presupposed in numerous board decisions; for payment of the appeal fee in general,

see G 1/18, section B II; for payment of the reduced appeal fee by debit order see T 1474/19, point 21.

It is therefore immaterial why the examining division issued the communication of 24 September 2021, i.e. whether it considered the applicant/appellant to be a large company or because the declaration under the Notice was missing.

In the light of the foregoing, the applicant's/ appellant's criticism in its letter of 4 April 2022 that the examining division had conducted a "speculative investigation ... without any clear application of specified rules of procedure prescribed by the Convention" is in essence plainly beside the point. It was the board which conducted the investigation after the case had been referred to it. Apart from that, it would have been most unusual if the examining division had been in a position to carry out this investigation, with the original communication having been issued on a Friday and its cancellation, allegedly after such investigation, on the following Monday.

Whether or not the substance of the examining division's communication, i.e. the instruction to debit the shortfall relying on T 152/82, would have been in compliance with the law will be addressed in the following section C.

C. Is the authorisation to debit the reduced fee on EPO Form 1038, properly assessed, an authorisation to debit the regular fee obviating the request for correction?

The first alternative request for correction would be moot if a proper assessment of the authorisation to

debit on EPO Form 1038 revealed the applicant's/ appellant's clear intention to give the instruction to debit the regular fee. Such was the conclusion in recent case T 1474/19 (see below, point C.1.). The board in that case (in point 25, first paragraph) considered that the most persuasive approach to this issue was based on the principles set out, *inter alia*, in T 152/82, which therefore will be discussed in point C.2. below. In point C.3., this board will then analyse under which conditions the approach of T 152/82 applies to the staggered appeal fee.

1. *Case T 1474/19*

In case T 1474/19, the reduced appeal fee was paid for an appellant being a multinational company. The facts are similar to those of this case; see, in particular, point I of the decision:

On 11 April 2019, the appellant filed a notice of appeal through their professional representatives ... via EPO Online Filing. This notice stated, *inter alia*, that "Instructions to debit the Appeal Fee on our Deposit Account are enclosed". The notice of appeal was accompanied by a completed EPO Form 1038E "Letter accompanying subsequently filed items", indicating "11e Appeal fee for an appeal filed by a natural person or an entity referred to in Rule 6(4) and (5) EPC" in the "Fees" box 15-1 and "EUR 1 880.00" as the "Amount to be paid". The box "Method of payment" box [sic] indicated that "The European Patent Office is hereby authorised, [sic] to debit from the deposit account with the EPO any fees and costs indicated on the fees page".

After a thorough analysis of the case law on debit orders pursuant to the Arrangements for Deposit Accounts in the respective applicable version, the board accepted that payment was made in the appropriate amount.

In point 28, the board noted that "In accordance with Article 108 EPC, there was a single appeal fee, with Article 2(1), item 11 RFees only making the applicable amount of the fee dependent on the appellant's legal status". In point 29, the board pointed out that, while the ADA 2017 required the indication of one or more fees, it did not require specifying the amount of the fee to be paid. Pursuant to point 5.4.1 ADA 2017, provided there were sufficient funds in the deposit account on the date the debit order was received by the EPO, that date was considered the payment date. Referring to T 152/82, the board held that, since no amount needed to be specified, the EPO had to execute a debit order for a particular fee for which the purpose of the payment was clear, in accordance with its substance, even if no or an incorrect amount was given. **The EPO had to establish from the debit order, the other documents on file and the circumstances of the case,** which fee the appellant intended to pay and the applicable fee amount for the payment to be valid.

Applying these principles, the board concluded (emphasis added):

32. In the current case, the debit order on EPO Form 1038E was filed together with the notice of appeal, which in turn explicitly states that the "instructions to debit the Appeal Fee on our Deposit Account are enclosed". **It specifies the appeal fee and authorises the EPO to debit the fee from the deposit account in the applicable amount.** As it is undisputed that the appellant is not entitled to the appeal fee reduction, and the declaration referred to in Rule 6(6) EPC was indeed not filed, the applicable amount of the fee is EUR 2 255.

Thus, the **appellant's clear intention was to pay the appeal fee to file a valid appeal,** the applicable amount being EUR 2 255.

33. The debit order was received by the EPO on 11 April 2019, together with the notice of appeal. As

there were sufficient funds in the deposit account on 11 April 2019, this is to be considered the (full) payment date (see again T 152/82: "As the original debit order was clear despite the incorrect fee amount indicated in it, the only possible conclusion is that the appellant's payment is to be regarded as made on time.").

Comments

This board notes that, according to point I of the Summary of Facts and Submissions of decision T 1474/19, the debit order on EPO Form 1038E specified the "Appeal fee for an appeal filed by a natural person or an entity referred to in Rule 6(4) and (5) EPC" and authorised the EPO to debit from the deposit account the "fees ... indicated on the fees page" being part of EPO Form 1038E, **not** the fee from the deposit account "**in the applicable amount**", as stated in point 32. This means that the debit order specifying the **reduced** fee authorised the EPO to debit just that fee.

This board further notes that the board in T 1474/19 obviously determined the circumstances pertinent to the payment **after** expiry of the appeal period (a communication going in a different direction having been sent after its expiry), similar to T 152/82 where proceeding this way was approved (in points 8 and 9 reproduced in point C.2. below). But the board did not identify the circumstances from which it concluded that the appellant was a multinational company (in point IX of the Summary of Facts and Submissions and point 25, first paragraph *in fine*) and why it was undisputed that it did not meet the criteria of Rule 6(4,5) EPC (point 32). Importantly, the board did not say that this fact (multinational company) and conclusion (criteria of Rule 6(4,5) EPC not met) could be detected

from the file as it stood **at the end of the appeal period.**

Finally, the "declaration referred to in Rule 6(6) EPC" relates to the fee reduction specified in Rule 6(3) EPC for "a person referred to in Article 14, paragraph 4, [who] files a European patent application or a request for examination in a language admitted in that provision", not to the reduced appeal fee specified in Article 2(1) item 11 RFees. A declaration in relation to that latter fee is mentioned in the Notice only and has no legal basis in the pertinent Council Decision CA/D 17/17; see T 1060/19, point 11 (as excerpted in point XII.(b) above).

2. *Case T 152/82*

To determine whether T 1474/19 could be followed, the board will first reproduce the core of the decision in case T 152/82 on which the decision in T 1474/19 is based. In T 152/82 the board, in effect, considered that when the assessment of a statement revealed a clear intention to pay a specific fee indicated in the incorrect amount a correction of the statement was superfluous.

2.1 *Relevant excerpt*

In case **T 152/82 of 5 September 1983** (OJ EPO 1984, 301, "Debit order I/BASF") (official English translation of German original) an incorrect amount of the appeal fee was paid by debit order. The board held *inter alia* (emphasis added):

4. One way of remedying the present deficiency quite simply is to assess the substance of the debit order, i.e. the **intention expressed** therein. This **intention**

can only be taken to mean that the appellant wishes the **valid amount** of the appeal fee **to be debited**. The debit order can therefore be carried out in the clearly intended manner by the EPO itself without any further enquiry being necessary, provided that the said "Arrangements for deposit accounts" do not preclude such a step.

...

6. Although the current version of the "Arrangements for deposit accounts" requires that the debit order be in respect of one or more specific fees (6.1 of the said Arrangements) and contain "the particulars necessary to identify the purpose of the payment" (6.3 thereof), it does not stipulate that the amount - or indeed the correct amount - has to be given at all. ...

7. Since the "Arrangements for deposit accounts" contain no obligation to specify the amount, the EPO must execute a debit order in accordance with what is plainly the substance of that order, even though the amount specified therein is incorrect. As the intention is clear, it is not even necessary to consult the account holder. The **application of Rule 88 EPC**, which is possible per se but requires a certain procedure (drawing attention to the error, request for correction and decision), **is superfluous** in such a case because, unlike cases covered by Article 7(2) of the Rules relating to Fees, the purpose of the payment is immediately evident here and hence the correct amount of the fee can be established. The EPO is therefore authorised to execute a debit order from which the purpose of the payment is clear even when the amount of the fee in question is not indicated or is incorrectly indicated.

On the point in time when the fulfilment of the conditions is to be assessed point 8 says the following:

8. Establishing that a statement is clear, while not an interpretation of intention (otherwise the statement would not be clear), is nonetheless an interpretative process. Under certain circumstances the stage reached in the proceedings and the content of the file need to be taken into consideration. It is possible that the clarity of intention is not evident from the debit order alone but only with the aid of the file. It may well be that only when the stage reached in the proceedings is taken into consideration will it become

absolutely clear that what is intended beyond any doubt is not, say, the opposition fee but the fee for appeal, not the third renewal fee but the fourth. It will not therefore always be possible for the Cash Office to establish what is indubitably intended. This may become apparent only when a department familiar with the stage reached in the proceedings comes, say, to examine for admissibility or to carry out a check where a legal consequence ensues. Such a department, realising what was clearly intended, would also be authorised, without further reference to the account holder, to have the debit order carried out, or the outstanding amount debited, in accordance with what was clearly intended. Since what is at issue here is establishing something clear and not a decision (i.e. choice of possible alternatives), it is sufficient for the department concerned to have authority to examine.

Point 9 further reads as follows (emphasis added):

9. As a result of a deficiency in a debit order it may therefore be that the correct debit (or debit of any shortfall as the case may be) will be delayed and this gives rise to the question of when, in view of the delayed or additional debit, full payment is deemed to be made. Subject to the following conditions, the **ruling date of payment** would be the **date of receipt of the debit order** which, although deficient, was deemed to be **clear from the instructions given**. The question of whether there is a sufficient amount in the account to cover the debit is not to be determined by reference to the date of receipt (cf. 6.4 of the Arrangements for deposit accounts). Between receiving the deficient debit order and establishing what is clearly intended **a lengthy period of time may elapse**, during which other debits are made. From the legal point of view the case should be treated in the same way as the perfectly plausible case where a debit order, correct in every way, is not carried out for some time through an oversight on the part of the Office or where, for the same debit order, an insufficient amount is charged to the account through an error on the part of the Cash Office (e.g. transposition of digits).

In such cases, **what matters is that on the day on which the delayed or additional debit is first attempted, there is a sufficient amount in the account to cover the debit.**

In point 14 of T 1474/19, the board derived from T 152/82 and subsequent case law (discussed in

point 13) endorsing it, but not relating to the staggered appeal fee, the following summary of the case law concerning the validity of a debit order submitted under the ADA:

Notwithstanding formal deficiencies, a debit order in line with the prescribed (from 1 December 2017 only: electronic) filing requirements has to be assessed on its substance, in view of the party's clear intention objectively expressed in the order, to pay a particular fee (e.g. appeal fee) from an identifiable account. No fee amount needs to be specified. On this basis, the EPO is authorised to and must debit the intended fee in the applicable, i.e. correct, amount.

2.2 *Analysis of T 152/82*

This board understands T 152/82 as holding that, as far as payment of EPO fees is concerned, obvious errors in the amount of EPO fees in debit orders under the ADA need not be corrected if the intention to pay the correct amount is clear. In the case of the appeal fee, a finding that this intention is clear can be made **after** expiry of the appeal period "as long as the payment order is clear from the instructions given". In this board's view, even though not expressly mentioned, it is obvious that the intention must be clear **before** expiry of the appeal period.

Pursuant to T 152/82 a correction under Rule 88, first sentence, EPC 1973 (now Rule 139, first sentence, EPC) would equally be possible, but "require [] a certain procedure" (point 7).

One could thus equal the view expressed in T 152/82 with considering an incorrect amount indicated in a debit order to be tantamount to an obvious error in writing, which is amenable to correction, but, being obvious, not necessary to be corrected. The difference

between the incorrect amount and the error in writing being "merely" that obviousness of the incorrect amount needs to be determined after a careful analysis of the file, at an appropriate point in time, in many cases, after expiry of the pertinent period, such as the appeal period.

Interpreted this way, T 152/82 can be followed.

3. *Under which conditions does T 152/82 apply to the staggered appeal fee?*

The board in T 1474/19, in points 16 and 17, summarised case law of the boards "pursuing a 'more literal' approach", all of the respective cases relating to the appeal fee, and most of them (those in point 17) relating in addition to the payment of the reduced appeal fee to which the appellant was not entitled. For various reasons, none of those decisions had applied the approach of T 152/82.

3.1 *Absence of declaration under the Notice*

For this board, as a preliminary matter, it must be excluded that the **absence of a declaration under the Notice** alone can be considered as an expression that the appellant did not consider itself to be an entity referred to in Rule 6(4,5) EPC (from which it might be inferred that it had the clear intention to pay the regular appeal fee; see at the end of this point). The same conclusion was drawn in point 6.2 of T 2620/18. The reason being that there is **no legal basis** for requiring a declaration for benefiting from a reduction of the appeal fee, as held for example in T 225/19 (point 2.4) and suggested in T 1060/19 (points 1.3.2 and 1.3.3). As stated in point C.1. above (see

"Comments"), the declaration in Rule 6(6) EPC relates to the reduction of the filing and examination fees for persons referred to in Article 14(4) EPC mentioned in Rule 6(3) EPC only. Users of the European patent system have therefore been alerted to this view and might have opted to refrain from filing the declaration in respect of the appeal fee if they so wished.

This board is aware that there are other boards that do invite parties to file such a declaration; see, e.g., T 3023/18, point 6 and point IV of the Facts and Submissions, and T 637/21, point III of the Facts and Submissions, in which the board had invited the appellant to file such a declaration. In the case in hand, for the reasons given in the previous paragraph, the board did not consider this to be expedient.

An SME, e.g., may still opt to file a declaration of its own volition specifying that it meets the requirements of Rule 6(4,5) EPC; such a declaration may mention turnover, staff numbers and the fact that the appellant is not held by a large company at more than 25%.

Apart from that, the non-filing of the declaration may simply have been a mistake (see T 3023/18, as summarised in T 1474/19, point 17).

3.2 *The conditions*

This board considers that both T 152/82 and the summary of the subsequent case law endorsing it given in T 1474/19 (in point 14 reproduced in point C.2.1 above *in fine*) can be followed, but **only under the condition that it is known to a board from the file as it stands at the end of the appeal period that the appellant, at**

the point in time of authorising the debit of the reduced appeal fee, was not entitled to the reduction of the appeal fee under Rule 6(4,5) EPC.

This proviso is in line with T 333/20 and T 3023/18, both cited in T 1474/19 in point 17 where the board said as to the former decision:

T 333/20 ... came to the conclusion that the debit order in question was only for the reduced fee, and the appeal was ... not deemed to have been filed as **the board had not been able to determine** if the appellant was a privileged entity, and they could therefore not take advantage of the reduced fee.

Conversely, if it can be determined from the file by the end of the appeal period that, at the point in time of payment, the appellant was not a privileged entity, the appellant may be considered to have had the clear intention to pay the regular fee. The reason is simply that otherwise the condition of Article 108, second sentence, EPC would not be met and the appeal, under G 1/18, conclusion 1(a), be deemed not filed. An applicant, a patent proprietor, or an opponent, however, must be considered clearly intending to file a valid appeal. T 1474/19 obviously starts from this premise. See also below, point D.4.3.

4. *Can the rationale of T 152/82 be applied to determine whether an appellant is a privileged entity?*

In T 152/82 (point 8) examples are given of the kind of doubts as to fee payment that may not be detected by the "Cash Office" but at a later stage of the proceedings (emphasis added):

It may well be that only when the stage reached in the proceedings is taken into consideration will it become absolutely clear that **what is intended beyond any doubt**

is **not**, say, the **opposition fee but the fee for appeal**, not the **third renewal fee but the fourth**.

This board believes that a formalities officer, or a registrar of the boards, at the EPO will generally be well-equipped to answer these questions without doubt as they all have two prongs: the **first** prong is the identification of the **type** of fee that should clearly follow from the file, e.g. whether the proceedings are at the opposition or appeal stage. The **second** prong is the **amount** of the fee depending **only** on the point in time that can also easily be determined from the publication of the fees in the EPO's official journal, which is regularly updated (*inter alia*, because the fees have so far been increased in regular time intervals). The **knowledge required** is basic knowledge relating to the patent fee structure (initiation of proceedings or other fee-generating events, such as renewal, and where to find information about the amount due at a specific point in time). This knowledge can be imputed on formalities officers and registrars.

As stated above (in point A.4.1), the regular and reduced appeal fee may be considered as two amounts of the same, staggered, fee (as in T 1474/19, point 28: "single appeal fee").

There may be exceptions, such as those of a natural person, clearly identifiable as such, or an entity clearly identifiable as a university, where it will be obvious that they qualify for the reduced appeal fee.

However, when it comes to recognising whether an organisation is a non-profit entity and when it comes to determining the correct amount of the appeal fee for a for-profit company and more precisely whether the company is an SME, what matters is not basic knowledge

pertaining to the patent fee structure, as in the cases dealt with in T 152/82. In the case of a for-profit company, the knowledge required rather relates to the size of business players across the world, more specifically to their turnover and number of employees (and whether more than 25% of their equity is owned by a large enterprise).

This board is of the firm conviction that this knowledge cannot but for exceptional cases (e.g. an EPO employee knowing the company from parallel files) be imputed on those who need to determine whether the regular or reduced fee is due, i.e. in appeal cases at a first stage the formalities officer and registrar, and, at a second stage, the board members. Clear indications to this effect are usually absent from the file. A large company may be based outside of Europe and not well-known to those EPO employees.

Even if the company name is well-known to such EPO employees, corporate restructuring may have an influence. It may lead to the creation of new companies or new designations of existing companies. The true nature of the new entities may not be apparent from the EPO file without the EPO having requested additional information.

- This case is one example: professional observers published incorrect reports on the Internet that, prior to a merger, Raytheon Company, the applicant/appellant in this case, was defunct. If those observers are not knowledgeable, how can EPO staff not involved in monitoring corporate business dealings be?
- Furthermore, large corporations may form non-profit entities. In the U.S., where the current applicant/

appellant is based, for-profit corporations may operate their own non-profit entity as a corporation. Such a "501(c)(3) organization" is a corporation, trust, unincorporated association, or other type of organization exempt from federal income tax under section 501(c)(3) of Title 26 of the United States Code (see [https://en.wikipedia.org/wiki/501\(c\)\(3\)_organization](https://en.wikipedia.org/wiki/501(c)(3)_organization)). Tax exempt organisations can be found on the website of the Internal Revenue Service (IRS), the revenue service for the United States federal government, at <https://www.irs.gov/charities-non-profits/search-for-tax-exempt-organizations>. A substantial number of the organisations listed there are corporations. Some of them have company names that include the term "foundation" or a similar term suggesting a charitable purpose, others have not.

The fact that non-profit corporations may be created by for-profit entities casts sufficient doubt on the assumption that the EPO may generally be in a position to "divine" from the company name alone that the company is not a non-profit entity.

- Another example supporting that conclusion is that of an SME bearing, by coincidence, the name of a well-known large company. The EPO may not be able to identify that the respective company is an SME not held by the well-known company at more than 25%.

In the cases of both non-profit corporations and such SMEs, it would obviously be unjustified for the EPO

- to debit the regular appeal fee on the basis of instructions to debit the reduced fee assuming

those instructions to have clearly been given in error, because the appellant was not entitled to the fee reduction and thus expressed the clear intention to pay the regular fee and

- to require the payer to request reimbursement of the difference collected without legal basis.

The absence of a declaration under the Notice can play no role given that there is no legal basis for it so that the requirement in the Notice may be ignored (see point C.3.1).

5. *Conclusion*

It must be noted that T 1474/19 sheds no light on how, in that particular case, the board could determine the size of the appealing company on the basis of the file as it stood at the end of the appeal period alone. As indicated in the comment under point C.1. above, the board did not identify the circumstances from which it concluded that the appellant was a multinational company and that "it [was] undisputed that the appellant [was] not entitled to the appeal fee reduction" (point 32).

It should be added in this respect that T 152/82 was concerned with the - as shown above, rather trivial - issue of the right amount of a clearly determinable fee. According to T 152/82, identifying the correct type of fee expressly or by implication should suffice, the incorrect indication of the amount of the fee should not be detrimental. This board can subscribe to that view but is unable to see the parallel to the issue of determining whether a business entity is deemed "big or small" (pursuant to the pertinent Commission recommendation; see point A.4.1 above), a

non-profit entity or a natural person, which would enable determining eligibility for the reduced appeal fee. Different from T 152/82, when it comes to the appeal fee,

- the clarity of intention to pay the regular appeal fee is not evident from the debit order alone and,
- as a rule, it will not be possible to establish such an intention with the aid of the file alone at whatever later stage of the proceedings by determining whether the appellant is entitled to a fee reduction under Rule 6(4,5) EPC or not (different from the situation described in point 8 of T 152/82).

The board notes that while the statement in EPO Form 2935 (see e.g. the communication of 24 September 2021 in the case in hand) that the deposit account holder may object to the debiting of a perceived shortfall within a time limit of two months may be appropriate for fees other than the appeal fee, the EPO is not entitled to debit a possible shortfall of the appeal fee on the basis of speculation and putting the burden on the payer to request a refund.

In short, this board believes that the reliance on T 152/82 in T 1474/19 is justified only in the unusual case that it can be clearly determined from the file by the end of the appeal period that the appellant on paying the reduced fee was not an entity referred to in Rule 6(4,5) EPC, in particular not an SME but a large company, and thus not a beneficiary of the provisions of Article 2, item 11, first indent, RFees, when it made the payment.

This board is not persuaded by the finding in point 32 of T 1474/19 reproduced again below:

In the current case, the debit order on EPO Form 1038E was filed together with the notice of appeal, which in turn explicitly states that the "instructions to debit the Appeal Fee on our Deposit Account are enclosed". [1] It specifies the appeal fee and authorises the EPO to debit the fee from the deposit account **in the applicable amount**. [2] As it is **undisputed** that the appellant is **not entitled** to the appeal fee reduction, [3] and the declaration referred to in **Rule 6(6) EPC** was indeed not filed, the applicable amount of the fee is EUR 2 255.

The board recalls (see points C.1. and C.3. above)

re [1]: the authorisation related to the fees indicated on the fees pages only, i.e. the reduced fee, and not the fee "in the applicable amount";

re [2]: what is critical is whether it follows from the file at the end of the appeal period that the appellant, when making the payment, was not entitled to the reduced fee and thus may clearly be imputed to have committed a mistake, i.e. its clear intention was to pay the regular fee; the board leaves the core question open how the board arrived at the conclusion that it was undisputed that the appellant was not entitled to the reduced appeal fee;

re [3]: there is no legal basis for requiring such a declaration, whose mention in Rule 6(6) EPC does not refer to the appeal fee anyway, and such declaration may be forgotten, reason why its absence cannot play a role for establishing the clear intention to pay the regular appeal fee.

6. *Application of the above principles to the case in hand*

In the case in hand there is no exception to the rule that generally the EPO cannot detect from the file alone, without any indication that the appealing company is a large company and, therefore, does not

benefit from the reduction of the appeal fee: the board could not spot the applicant's/appellant's failure to qualify as an SME from the file as it stood at the end of the appeal period. The reasons why the examining division, in its communication of 24 September 2021, came to this conclusion are immaterial as it had no jurisdiction in this respect (see point B.5. above).

At the end of the appeal period, the file, in particular the notice of appeal, mentioned Raytheon Company as the applicant. The applicant/appellant derived that Raytheon Company was not an entity under Rule 6(4,5) EPC from the fact that Raytheon Technologies Corporation was a very large company. The applicant/appellant however made this declaration only as an answer to the board's communications. The applicant/appellant had not furnished turnover or staff figures before expiry of the appeal period. It was not clear from the file either whether Raytheon Technologies Corporation held more than 25% of the capital of Raytheon Company, which could have been a criterion to identify whether Raytheon Company could benefit from the reduction of the appeal fee (see above, point A.4.1).

An Internet search had revealed that it was not even clear whether Raytheon Company existed at all on filing the appeal. It was suggested that it was defunct prior to its merger.

In the case in hand, therefore, an assessment of the file as it stood at the end of the appeal period cannot in itself reveal whether the applicant's/appellant's real nature complies with Rule 6(4,5) EPC. In case T 1474/19, the debit order was expressly given for an appeal filed by a natural person or an entity

referred to in Rule 6(4,5) EPC, i.e. for debiting the reduced appeal fee, and an authorisation was given to debit the fees mentioned on the fees page, i.e. that very page. The **amount** of the reduced fee may, in accordance with T 152/82, be disregarded, but not the failure to establish that the appellant was a natural person or **entity referred to in Rule 6(4,5) EPC** (see point C.3. above).

In the case in hand there was an additional sentence at the end of the notice of appeal authorising the debit of "[a]ny additional fees that may be required" (see point III. above), implying an authorisation to debit additional fees on top of the fees indicated on "the fees page" mentioned in the third box of the accompanying EPO Form 1038, i.e. the fees indicated in the second box of that form. But that is of no avail because the legal nature of Raytheon Company could not be determined from the file alone. In T 1474/19, assuming, as this was not mentioned in the decision, that the multinational character of the appellant did not follow from the file, there would thus have been even less reason to accept the payment, because no such sentence was mentioned in the notice of appeal or EPO Form 1038E.

7. *Overall conclusion*

As a consequence of the foregoing, in the absence of proof of the applicant's/appellant's legal nature in the file at the end of the appeal period, its statements made with a view to paying the appeal fee, both in the notice of appeal and EPO Form 1038 (see points II. and III. above), cannot be assessed as reflecting the clear intention to pay the regular appeal fee and thus, effectively, as payment of that

fee pursuant to the principles set out in T 152/82. **The applicant's/appellant's request for correction based on Rule 139 EPC is therefore applicable and will be examined in the following section D.**

8. *Final considerations*

The above conclusion is independent of the fact that this board does share the opinion expressed in T 1474/19 (in point 27) that "[t]he introduction of the fee reduction for natural persons and entities referred to in Rule 6(4) and (5) EPC clearly aimed to maintain access to justice for these persons and entities and not to introduce a new admissibility hurdle for other appellants." This board however believes that the goal of maintaining access to justice for natural persons and entities referred to in Rule 6(4) and (5) EPC cannot be attained on the basis of the approach advocated in T 1474/19 **without** introducing a new "admissibility" hurdle for other appellants for the reasons given in this section C., i.e. because the question of how the entitlement of an appellant to the reduced fee can be gleaned from the appeal file at the end of the appeal period, without requesting facts and evidence from the appellant, was not addressed. The hurdle would, incidentally, be one for establishing the existence of an appeal, not its admissibility (see above, point C.3.2 *in fine*).

Rather, what would serve the above goal while not introducing a new proof-of-existence ("admissibility") hurdle, at least not a very high one, may be, in this board's view, the adoption of a statutory provision requiring the appellant to (i) declare that it meets the requirements governing the reduction of the appeal fee, (ii) indicate which criteria, for an SME those set

out in Commission recommendation 2003/361/EC of 6 May 2003, are met, and (iii) file supporting documents. This should make the assessment of those requirements straightforward.

In the absence of such supporting documents, it is difficult to see how the EPO should, but for exceptional cases (e.g. an EPO employee knowing the company from parallel files) be in a position to determine the veracity of the indications and, as the case may be, develop doubts in that respect. Thus, it is difficult to see how the second sentence of point 10 of the Notice: "In case of doubt as to the veracity of the declaration given by an appellant, appropriate evidence may be requested." could be implemented in practice.

D. The request for correction

1. *Introduction*

Given that the assessment of EPO Form 1038, together with the final sentence of the notice of appeal, does not lead to the result that these documents contain clear instructions to debit the regular appeal fee from the applicant's/appellant's debit account, the request for correction of EPO Form 1038 becomes operational. The applicant/appellant requests that EPO Form 1038, filed on 6 September 2021, be corrected under Rule 139 EPC to indicate that the regular appeal fee for an appeal filed by an entity other than those referred to in Rule 6(4) and (5) EPC (EUR 2 705) should be paid. The applicant/appellant also requests that the regular appeal fee should be taken from its law firm's deposit account and retroactively deemed to have been paid on 6 September 2021.

According to the recent case law, correction of a payment form is generally available and has "retroactive", "retrospective" or "ex tunc" effect, with these terms obviously used interchangeably; see the cases reported in T 1474/19, point 21 et seq. (in other case law the term "ab initio" effect is used as a synonym as well; all four terms were applied as synonyms in J 8/19; see points 2.5, 2.5.1 and 3). The board in T 1474/19 however questioned the general availability of such a correction (emphasis added):

35. Thus, there is no need for the board to take a stand on the jurisprudence on correction via Rule 139 EPC, in particular whether **correction of a debit order with retroactive effect** on the date of factual payment **is an option**. Even if it were an option, **if a case does not pass the hurdle of the clear intention** to pay a fee, in accordance with the jurisprudence of T 152/82 on the basis of the debit order, **it might also not qualify for correction under Rule 139 EPC**.

It will be seen below how these doubts are to be judged.

The provisions of Rule 139, first sentence, EPC, formerly Rule 88, first sentence, EPC 1973 with identical wording, governing corrections read (references to Rule 139 EPC and Rule 88 EPC 1973 below will always be to the first sentence only):

Linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request.

As stated above (in point C.7), the applicant's/appellant's request for correction based on Rule 139 EPC is applicable, because, in the absence of proof of the applicant's/appellant's legal nature, the documents submitted upon filing the appeal cannot be assessed as

payment of the regular fee pursuant to the principles set out in T 152/82.

However, this does not mean that, in order to be able to apply those principles, it would suffice if the documents filed in the wake of the board's communications proved the applicant's/appellant's legal nature. It would not be sufficient to merely establish the presence of the missing link (not established in T 1474/19), i.e. find that the applicant/appellant, when filing the appeal, was not a privileged entity, and thus did not meet the requirement for paying the reduced fee.

There is no legal basis for proceeding this way. The finding in T 152/82 relates to an exception applying only when the EPO can detect from the file as it stood at the end of the appeal period the clear intention as to which fee the payer intended to pay. The reason is that this should be a straightforward exercise carried out in general by support staff and without the need for evidence and its analysis.

Otherwise, under Rule 139 EPC, errors may be corrected "on request". Furthermore, as T 152/82 rightly held, "The application of Rule 88 EPC [1973]... requires a certain procedure" (see above, point C.2.1). All the requirements of Rule 139 EPC must thus be examined. They will be determined below on the basis of an analysis of the case law.

Accordingly, in the next point, the board will reproduce in pertinent part, and discuss, a selection of decisions handed down since 1980 that set out general principles and specific criteria governing corrections under these provisions.

2. *The case law on correction under Rule 139, first sentence, EPC (Rule 88, first sentence, EPC 1973)*

2.1 *J 8/80 (adding the designation of one contracting state)*

In J 8/80 of 18 July 1980 (OJ EPO 1980, 293), addition of the designation of a contracting state was sought.

In point 2 of that decision, the board said:

It is the first appeal concerning Rule 88, EPC, to come before the Legal Board of Appeal and, therefore, it is desirable that the Board should explain the law and the procedure to be followed in cases of requests under Rule 88, EPC.

The criteria for correction set out in the decision are the following (emphasis added):

4. For the purposes of Rule 88, EPC, a **mistake** may be said to exist in a **document** filed with the European Patent Office if the document does not express the **true intention** of the person on whose behalf it was filed. The mistake may take the form of an **incorrect statement** or it may result from an **omission**. Correction, accordingly, can take the form of putting right an incorrect statement or adding omitted matter.

5. Before the Office can accede to a request for correction of a mistake, however, it must be satisfied that a mistake was made, what the mistake was and what the correction should be. This is the necessary safeguard against abuse of the provisions of Rule 88, EPC.

6. It is the responsibility of the person requesting correction to put **evidence** as to the relevant facts fully and frankly before the Office. In cases where the **making of the alleged mistake is not self-evident** and in cases where it is **not immediately evident that nothing else would have been intended** than what is offered as the correction, the **burden** of proving the facts must be a **heavy** one. ...

7. In a case such as the present one, an applicant for a European patent who wishes to add designations he **did not originally intend** to make or to replace one by another cannot be permitted to use Rule 88, EPC, to evade the requirement of Article 79, EPC, that the request for the grant of a European patent shall contain the designation of the State or States in which protection for the invention is desired.

10. It has **not** been **necessary** to consider in this appeal whether there are any inherent limitations on the right of a person to seek correction of a document under Rule 88, EPC, where there is **significant delay** in making the request for correction. In the present case, the appellant acted promptly [within less than one month, see points II and IV of the summary of facts and submissions].

Comments

Further to T 152/82 (see point C.2. above), when the intention to pay a specific fee indicated in an incorrect amount is clear, the fee may be debited in the correct amount. A correction of the indication would also be possible, but "require a certain procedure" and be "superfluous".

If there is such parallelism between assessing whether there is a clear intention to pay the valid amount and a correction of a mistake in the indication of this amount, the former merely **disclosing** the content of the assessment, then the condition of J 8/80 "**immediately evident** that nothing else would have been **intended**" (otherwise there will be a heavy burden of proof) must be interpreted the same way as the "**intention expressed clearly**" (the condition of T 152/82) that may be detected only after a possibly thorough assessment of the file taking into account all the relevant circumstances. This means that the term "immediately evident" would be tantamount to the term "expressed clearly".

In the wake of this first basic decision a substantial body of case law in relation to Rule 88 EPC 1973 and Rule 139 EPC has emerged, which adopted additional criteria for accepting corrections. In T 824/00 of 24 March 2003 (OJ EPO 2004, 5, point 7), it was expressly said that this case law dealt mostly with errors in the designation of contracting states and priority data. J 10/87 (OJ EPO 1989, 323), e.g., related to the retraction of a withdrawal of the designation of a Contracting State.

In J 6/91 (OJ EPO 1994, 349, point 2.2(3)), point 6 of J 8/80 was interpreted as meaning that

Provisions designed to facilitate correction of mistakes cannot be allowed to be used to enable a person to give effect to a change of mind or subsequent development of plans...

J 6/91 was cited in the decision of the EBA in case G 1/12 (in point 37, under "principle" (a)). Decision G 1/12 also addresses, *inter alia*, requests for correction under Rule 88 EPC 1973, now Rule 139 EPC. Three further pertinent board decisions, J 3/01, J 6/02 and J 19/03, all handed down before decision G 1/12 was adopted, are presented in points D.2.2, D.2.3 and D.2.4 below. The part of decision G 1/12 pertinent to the case in hand is set out under point D.2.5 below and analysed under point D.3.2.

2.2 **J 3/01** (*correction to indicate the designation of the United Kingdom*)

The main request in case J 3/01 was for correction under Rule 88 EPC 1973:

3. ...the appellant requested correction under Rule 88 EPC to indicate the designation of United Kingdom in box 10.1 of EPO Form 1200 filed on 5 November 1998 so

as to cancel the so-called "waiver" in section 10.2 for the designation of United Kingdom. It submitted that if this were allowed, the EPO would have to issue a communication pursuant to Rule 85a(1) EPC setting a period of grace of one month within which the appellant could still validly pay the designation fee for GB.

The question to be answered is whether a correction under Rule 88 EPC can be allowed if as consequence the EPO is obliged to issue a communication under Rule 85a(1) EPC setting or re-setting the period of grace according to this provision?

Referring (in point 7) to the established case law of the Boards of Appeal, the board held that Rule 88, first sentence, EPC 1973 did not compel the EPO to permit the correction of errors of any kind at any time. All three texts of this rule ("können" - "may" - "peuvent") gave the EPO the authority to permit certain types of correction at its discretion. The board then said (emphasis added):

10. ... the so-called **retrospective effect** of a correction under Rule 88 EPC does not cancel previous procedural events, but only causes the document corrected to be considered **from the time of correction and for the future as filed *ab initio*** in the corrected version. Correction under Rule 88 EPC does not reverse the effect of decisions already taken on the basis of the uncorrected document and does not re-open a procedural phase already terminated **or a time limit already expired**. In other words, a procedural loss of right only indirectly caused by the incorrect document will not be remedied by a later correction of the document pursuant to Rule 88 EPC. This principle also characterises the functional and essential difference between a correction under Rule 88 EPC on the one hand and *restitutio in integrum* pursuant to Article 122 EPC on the other hand.

11. ... The applicant's request for correction cannot result in an effect equivalent to that of re-establishment of the time limit pursuant to Rule 85a EPC as this would be a clear circumvention of Article 122(5) EPC ...

Comments

This decision affirms previous case law according to which the "retrospective" effect of a correction only caused the document corrected to be considered **from the time of correction and for the future as filed ab initio** in the corrected version. Correction did not re-open a time limit already expired.

Point 10 of this decision was relied on by respondent II in recent appeal case T 3098/19 equally relating to the correction of a debit order indicating payment of the reduced appeal fee. Respondent II concluded that the legal consequence of the failure to pay the correct amount of the appeal fee in time could thus not be remedied by a correction of the debit order.

The board disagreed, citing the decision of the EBA in case G 1/12. In point 38, the EBA had emphasised the "retroactive" effect of a correction under Rule 139 EPC.

For an analysis of this issue see below, point D.3.2.1.

2.3 *J 6/02 (correction of the designation of Finland to the designation of France)*

In J 6/02 of 13 May 2004 correction of the designation of Finland to the designation of France was sought. The board held (emphasis added):

2. ...Correction under Rule 88 EPC, if allowed, would have a **retroactive effect** with the consequence that the document containing the error has to be regarded as if it was filed in the corrected form.

4. Although Rule 88 EPC does **not contain any direct restriction** for its application, the EPO **case law developed functional and temporary limitations** whether

or not correction of an error was allowed either in respect of the **legal purpose** of this rule **or** in order to safeguard the **interests of the public**.

Firstly, a failure to pay designation fees cannot be corrected pursuant to the wording of Rule 88, first sentence, EPC (cf. J 21/84, EPO OJ 1986, 75; T 152/85, EPO OJ 1987, 191) which only concerns **errors in documents but not omissions of a payment of fees**. In the present case, the belated payment of designation fee and surcharge for France on 5 January 2001 cannot be corrected in that way that the payment has to be regarded as effected within the time limit under Rule 85a(2) EPC.

Secondly, correction under Rule 88 EPC does not allow to **set aside previous procedural effects**, but only causes the document corrected to be **considered from the time of correction and for future** as filed *ab initio* in the corrected version (cf. J 25/01, not published in the EPO OJ). This principle is further explained in respect of the case under consideration **in point 15 below**.

Thirdly, Rule 88 EPC does not contain an explicit reference to the **time** when and how long corrections of errors in documents could be requested. But **the wording "...may be corrected"** means clearly that there is no **obligation** of the Office to allow corrections in every case. Over the years the jurisprudence of the Boards of Appeal has established a further requirement to allow corrections of errors concerning **designation of States**, namely a **limitation of the time** during which those requests can be made (see points 2.2 and 2.3 of the reasons of decision J 16/00 not published in the OJ EPO).

5. The idea behind a **time restriction** ("Zeitgrenze") was to **safeguard the interests of the public** (see Case Law of the Boards of Appeal of the European Patent Office, 4th ed. 2001, Chapter VII.A.6, p.414). As a **balance between the interest of third parties to rely upon information given by the Office and the applicant's interest to have an error corrected**, the limitation up to a point in time sufficiently early to allow a reference at least to the requested correction of an error in the publication of an application, was found quite adequate over many years of practice. ...

...

15. ... **To cancel procedural effects after failure to meet a time limit** would be to apply Rule 88 EPC beyond

its clear and unambiguous wording (cf. J 25/01 supra) and **would violate the scope of application of Article 122 EPC** which stipulates specific requirements for grant of re-establishment of rights ...

16. ... Rule 88(1) EPC confers a **discretion** of power to the Board for allowing or not-allowing a correction of an error since it is stated in this rule that a respective error only "may be corrected".

Comments

J 6/02 lays out general principles on the application of Rule 88, first sentence, EPC 1973, in particular its relationship with Article 122(1) EPC 1973 judged in a similar fashion as in J 3/01 presented above. On this relationship see also J 19/03, point 7, criterion e., and, more generally, point 5, reproduced below. J 19/03 provides an extensive list of criteria developed by the case law for examining a request for correction.

2.4 **J 19/03** (*retraction of a notice of withdrawal of an application*)

In J 19/03 of 11 March 2005 relating to the retraction of a notice of withdrawal of an application, the board held in point 3:

... Correction under Rule 88, first sentence EPC, if allowed, has a **retroactive effect** with the consequence that the document containing the error has to be regarded as if it was filed in the corrected form (so called ab initio effect).

... Rule 88 EPC also applies to corrections of procedural acts if they are submitted by a document as i.e. a request for correction of designation of a State, of a claimed priority or as in the present case of the withdrawal of an application (cf. J 4/97, point 4 of the reasons).

Points 4 to 7 of the decision read as follows (emphasis added):

4. The Board notes that the application of Rule 88, first sentence EPC to a correction of a procedural act seems to be a more extensive interpretation than the mere wording of the first sentence of Rule 88 EPC indicates. The actual wording relates to factual errors whereas the extensive interpretation would also cover correction of subjective notions. Therefore, this extensive interpretation has to be seen in the context of the whole European Patent Convention (see below) and its statutory principles which must not be violated by a too broad or extensive interpretation of Rule 88, first sentence EPC.

5. It is further obvious that corrections of procedural acts having an *ab initio* effect have a potentially serious impact on an application, in particular if they relate to its territorial extent or to whether the application is pending at all, and raise **serious concerns as to legal certainty** not only for the applicants vis-à-vis the EPO but also for the public.

Therefore, the jurisprudence of the Boards of Appeal took as a starting point that, as a general rule, **an applicant is bound by its procedural acts** notified to the EPO provided that the procedural statement was unambiguous and unconditional (cf. J 11/87, points 3.3 and 3.6 of the reasons, OJ EPO 1988, 367; J 27/94, point 8 of the reasons, OJ EPO 1995, 831) and is **not allowed to reverse these acts so that they can be considered as never filed** (J 10/87, point 12 of the reasons, OJ 1989, 323; J 4/97, point 2 of the reasons).

On the other hand, the Boards of Appeal considered that Rule 88 EPC acknowledges as a further legal value the **desirability of having regard to true as opposed to ostensible party intentions** in legal proceedings (T 824/00, point 6 of the reasons, OJ EPO 2004, 005) in appropriate circumstances.

6. As a result of the conflict between these two legal principles, the case law reads Rule 88, first sentence EPC so that it confers a **discretion** on the competent instance to allow or not to allow a correction of an error since it is only stated in this rule that a respective error "may be corrected". Moreover, the fact that the provision is framed as a discretionary power in a rule rather than as an article is evidence that the principle underlying Rule 88, first sentence EPC is seen as a subordinate one which should not prevail in a serious conflict with other values underlying the

articles of the EPC such as **procedural certainty or legitimate interests of the public.**

7. In order to weigh the necessity for **legal certainty and the interests of the public** against the interest of an applicant, the jurisprudence developed **criteria** concerning when a correction of procedural acts may be allowable or not. ... the Board considers it necessary to provide a **more complete list** of these criteria as follows:

a. whether an **erroneous** procedural act occurred and was made due to an **excusable oversight**;

b. whether the request for correction of a procedural act was made **immediately** when the representative became aware of the erroneous procedural action;

c. whether the **public** had been **officially notified** of the withdrawal by the EPO at the time the retraction of the withdrawal was applied or whether the **interest of the public** was safeguarded **even after this notification** (J 14/82, point 8 of the reasons, OJ EPO 1983, 121; J 3/91, point 4 of the reasons); [referred to as "time restriction" or "time limitation" in other decisions; cf. e.g. J 16/08, points 5 and 14 of the reasons]

d. whether the requested correction results in a **substantial delay of the proceedings**

(as regards **point a. to d** cf. J 10/87, point 14 of the reasons, OJ EPO 1989, 323); and

e. whether the requested correction violates **fundamental legal procedural principles** (cf. T 824/00, point 8 of the reasons, OJ EPO 2004, 005), in particular whether it **circumvents defined statutory procedures as for example laid down in Article 122 EPC** (cf. J 6/02, point 15 of the reasons, not published in OJ EPO).

f. In any case, it must be pointed out that the **foregoing prerequisites are not exhaustive and the balance of interest has to be determined in each case on the basis of its own facts** (cf. the considerations in J 8/01, point 3.5 of the reasons, OJ 2003, 003). In particular, when weighing the interests of the public against those of the applicant, the Board has to consider the criteria **"excusable oversight" and "immediately made request"** (see section a. and b. above) although these requirements are not mentioned in Rule 88, first sentence EPC at all.

g. Finally, the admissibility of a request for correction was denied in cases where the **pendency** of application or opposition proceedings before the EPO had **ended before the request was filed** (cf. J 42/92, point 6 of the reasons for a request for correction under Rule 88, second sentence EPC) **or** the requested correction would have had **no legal effect** on the outcome of the proceedings and **no legitimate interest** to take action was approved (cf. J 23/03, point 2.2.1 of the reasons).

Comments

The criteria set out in J 8/80 (point D.2.1 above) are neither included in the above factors nor mentioned as separate criteria, possibly because they are basic conditions for allowing any request for correction and the board therefore presupposed their validity.

Re criterion a., this board draws attention to its application in case J 10/87 which was cited as a source for that criterion: "Hence, the confusion of the two applications can be put down to a genuine and isolated human error" (see point 14(ii)).

This reasoning recalls the interpretation of the requirement of "all due care" of Article 122(1) EPC in the case law (cf. Case Law of the EPO Boards of Appeal, 10th edition 2022, section III.E.5.4).

Regarding criterion b., this board notes that J 10/87 - cited as a source for that criterion as well - required "no undue delay" in seeking the correction (in that case, retraction), not that the request be made "immediately" after becoming aware of the error; see point 13(iii).

Furthermore, criteria b.: "immediately made request", correctly: "request made without undue delay", and c.:

"notification of the public" are sometimes conflated. In this regard, attention is drawn to J 16/08 relating to the correction of designations. The board in that case held (emphasis added):

13. ... the request was made without **undue delay** after the error was discovered. This requirement is clearly designed to ensure that, so far as possible, **requests for corrections are made before publication** (cf. "made early enough to enable **publication of a warning** together with the European patent application" - see the last sentence of the passage from J 7/90 quoted in point 5 above). Thus whether or not there has been **delay must reflect the facts of the particular case**. In the present case there is the highly **unusual fact** that, due apparently to an oversight on the part of the EPO, all publications of the application or of its data showed and still show today all contracting states as designated. The consequence of this is that a change in the published information will **not**, as regards the correction sought, show the **published information** to have been **misleading**... Thus, while the request for correction could probably have been **filed more speedily** than in fact it was [*i.e. on 19 June 2007, the error having been noticed on 28 March 2007*, see point 12 of the reasons], it cannot be said it was done with **undue delay**.

In addition, it is noteworthy that the board concluded from the wording of Rule 88 EPC 1973 "... may be corrected", in cases J 19/03 (cf. point 6), J 3/01 (cf. point 7) and J 6/02 (cf. point 4, under "Thirdly..." and point 16) that the EPO had **discretion** to allow a correction.

Finally, J 19/03 held (in point 7.f.) that the list of pertinent factors was open-ended and, in weighing the factors identified as pertinent in a specific case, the balance had to be struck between the interests of the public and those of the applicant (on balancing interests cf. also J 6/02, point 5).

2.5 **G1/12** (*correction of the name of an appellant in the notice of appeal*)

In G 1/12 the question was referred to the EBA whether a correction of the name of an appellant in the notice of appeal pursuant to Rule 101(2) EPC is possible (question 1). After having answered that question in the affirmative, the EBA turned to the further conditional question of whether such correction would be possible on the basis of Rule 139 EPC (emphasis added):

32. Question (3)

"If the answer to the first question is **no**, may the appellant's intention nevertheless play a role and justify the application of Rule 139 EPC?"

Even though the answer to question (1) was yes, the Enlarged Board of Appeal wishes to respond to question (3) on whether Rule 139, first sentence, EPC can apply if the **name of the appellant was incorrect and the correction to be allowed involves "substitution" of the appellant**, a question on which the appellant (patentee) and the respondent (opponent) have commented extensively and argued in support of differing points of view.

33. First of all, it is important to point out that Rule 139 EPC provides for the correction of errors in documents filed with the EPO. This appears in Chapter VI of Part VII of the Implementing Regulations to the EPC, which covers Rules 137 to 140 EPC. Part VII of the Implementing Regulations relates to Part VII of the EPC (Articles 113 to 134a EPC), which is headed "Common provisions".

34. Rule 139, first sentence, EPC allows the correction of "linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office". This list and the rule's heading ("Correction of errors in documents filed with the European Patent Office") make clear that the rule deals with cases in which an error of expression in a declaration has occurred or a mistake in a document is the consequence of an error.

35. Since it applies to **any document filed with the EPO**, the Enlarged Board of Appeal sees no reason why it should not apply to **appeals**.

36. The first sentence of Rule 88 EPC 1973, or now (with the **same** wording) of Rule 139 EPC, applies generally (see J 4/85, OJ EPO 1986, 205, and subsequent case law). This follows 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.

37. The **boards** of appeal, in particular the Legal Board of Appeal, have developed a **large body of case law** on corrections under the first sentence of Rule 88 EPC 1973 (first sentence of Rule 139 EPC) and **established the following principles**:

(a) The correction must introduce **what was originally intended**. For example, an applicant wishing to add a designation not originally intended on filing cannot rely on the first sentence of Rule 88 EPC 1973 (**J 8/80**, OJ EPO 1980, 293, in particular Reasons No. 7). The possibility of correction cannot be used to enable a person to give effect to a change of mind or development of plans (**J 8/80**, loc. cit., Reasons No. 6; **J 6/91**, OJ EPO 1994, 349). 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 (**J 8/80**, loc.cit., Reasons No. 6).

(c) The error to be remedied may be an incorrect statement or an omission.

(d) The request for correction must be filed without delay.

Furthermore, an allowable correction under Rule 139 EPC has **retrospective effect** (J 4/85, loc. cit., Reasons No. 13; as endorsed in several subsequent decisions, for example J 2/92, OJ EPO 1994, 375, Reasons No. 5.2.2; J 27/96 of 16 December 1998, Reasons No. 3.2; J 6/02 of 13 May 2004, Reasons No. 2; J 23/03 of 13 July 2004, Reasons No. 2.2.1 and J 19/03 of 11 March 2005, Reasons No. 3).

38. Consequently, if correction of the error is allowed, the appeal will be found admissible and the condition of Article 107 EPC will have been satisfied

within the two-month period according to Article 108, first sentence[,] EPC.

...

40. For the above reasons, the Enlarged Board of Appeal's response to question (3) is that, in cases of an error in the appellant's name, the general procedure for correcting errors under Rule 139, first sentence, EPC is available. The **well-established case law** of the boards of appeal on the application of Rule 88, first sentence, EPC 1973 and/or Rule 139, first sentence, EPC **provides the necessary guidance** on its application in the event of an error in the appellant's name.

Comments

This portion of G 1/12 will be analysed in point D.3.2 below.

2.6 **T 317/19** (*error in a duly filed form for paying the appeal fee*)

In the more recent decision in case T 317/19, the board applied "principles" (a) to (d) of G 1/12 (cf. point 2.4; see also the similar reasoning in T 444/20 and J 8/19). The board saw no need to decide whether this list of "principles" was exhaustive (cf. point 2.4.4). The board however considered three additional criteria in point 2.4.3 set out below (emphasis added).

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**.

Comments

Only criterion (c) of T 317/19 is in addition to the criteria mentioned in J 19/03 (see point D.2.4 above). Criterion (a) corresponds to criterion f. of J 19/03 (embodying a general principle) and criterion (b) to criterion c.

2.7 *Concluding remark*

Against the above backdrop, the board believes that, as a basis for the analysis of the case law of the boards of appeal that has emerged since J 8/80 was issued in 1980, it is justified to rely on the summary of criteria provided in J 19/03, which is open-ended (see criterion f.), together with criterion (c) of T 317/19.

3. *Analysis of the case law*

3.1 *Background*

3.1.1 *The boards' case law*

In this board's view, J 8/80 lays down basic criteria for assessing a request for correction under Rule 88 EPC 1973, first sentence, now Rule 139, first sentence, EPC. As detailed above, in the wake of J 8/80, the boards of appeal have set out general principles governing the correction of errors and adopted, in addition, several specific criteria for allowing a correction of procedural acts; see the overview in J 19/03 under point D.2.4 above, which mentions among other criteria that the requested correction should not violate fundamental procedural legal principles.

While the boards used the terms retroactive, retrospective, *ab initio* and *ex tunc* synonymously, a distinction between "retroactive" and "retrospective" has been made in the context of legislation; see the definitions referred to in *Burlington (City) v. Burlington Airpak Inc.* (Ont CA, 2017) [para 39], accessed at <http://www.isthatlegal.ca/index.php?name=statutes.temporal-application>). Applying those definitions *mutatis mutandis* to corrections under Rule 139 EPC, they would read as follows (terms in italics added, terms struck through deleted from the original):

A retroactive ~~statute~~ *correction* operates as of a time prior to its *acceptance enactment*. It therefore operates backwards in that it changes the *document law* from what it was. A retrospective *correction statute* operates for the future only. It is prospective, but imposes new results in respect of a past event.

In the board's case law, the above four terms, used synonymously in the context of requests for corrections, have been given the meaning expressed, e.g., in J 19/03, point 3 (quoted in point D.2.4 above), that "the document containing the error has to be regarded as if it was filed in the corrected form". As a consequence, in this decision the board will only use the term "retroactive" in its own analysis below.

The case law, however, qualified the "retroactive" effect in that correction under Rule 88 EPC did not allow to set aside previous procedural effects, but only caused the document corrected to be considered from the time of correction and for future as filed *ab initio* in the corrected version."To cancel procedural effects after failure to meet a time limit would be to apply Rule 88 EPC beyond its clear and unambiguous wording (cf. J 25/01 supra) and would violate the scope of application of Article 122 EPC which stipulates specific requirements for grant of re-establishment of rights." (See J 6/02, point 15, fourth paragraph and point 4, under "Secondly ..."; see also J 19/03, points 5 and 7.e.; these points are reproduced in points D.2.3 and D.2.4 above.)

3.1.2 *The EBA's decision in case G 1/12*

Further to a referral under Article 112(1)(a) EPC, the EBA in G 1/12 discussed question (1), i.e. whether the name of an appellant in a notice of appeal could be corrected under Rule 101(2) EPC. Having answered this question in the affirmative, the further question (3) of whether a correction under Rule 139 EPC was also available no longer arose. The EBA nevertheless "wished to respond" to this further question on which the parties had made extensive submissions (see point 32)

and did so in point 37. Since the response is part of the order of the EBA's decision, the question arises whether it is not merely *dictum* but binding, independent of whether or not the EBA had jurisdiction to decide on this theoretical point in the referral before it. The board leaves the question open whether the response to question (3) is binding. As the analysis below will show, the conclusions that the board will arrive at will be compatible with this response.

3.2 *Analysis of G 1/12*

3.2.1 *"Retrospective" effect of a correction*

In G 1/12, the EBA held that corrections of errors under Rule 139, first sentence, EPC were generally applicable.

The EBA also held that an allowable correction under Rule 139 EPC had "retrospective" effect and based this conclusion on a number of decisions by the boards (point 37 *in fine*). The EBA referred in particular to point 2 of J 6/02 and point 3 of J 19/03 without addressing the concerns raised in those decisions and mentioned in point D.3.1.1 above about whether fundamental legal procedural principles would be violated by allowing the correction.

It can remain an open question, whether the EBA was right in not addressing those concerns. This is because, in the case under consideration, i.e. the correction of a debit order, in this board's view, accepting the rationale of T 152/82, these concerns do not arise. As held in T 152/82, the correctness of any amount authorised to be paid in time may be scrutinised

(a substantial time period) after expiry of the corresponding time limit. If a clear intention to pay the regular appeal fee can then be established from the payer's instructions, payment will be accepted in the correct amount. This acceptance will by implication have retroactive effect.

The reason is that it is only upon the EPO stating what its assessment is that the public will become aware of how the statement in question was meant. Given the availability of Rule 139 EPC as an alternative to the assessment, applying the logic of T 152/82, it follows that a correction must also have retroactive effect.

This means that as long as this scrutiny has not been carried out, the question of whether payment is correct or not is in legal limbo. The concerns raised by the Legal Board whether fundamental legal procedural principles would be violated will therefore not arise.

This conclusion must also apply to cases in which the intention to pay the regular appeal fee was not clear from the debit order itself, but was established only after lapse of the appeal period. This is because the finding of whether the intention is clear will only be made, possibly a long time, after payment has been received. There is no reason why a different conclusion should be reached depending on whether the intention could be established before or after lapse of the appeal period. Regardless of this, there will be a delay before payment is accepted in the correct amount and, until then, the public cannot be certain as to how the EPO will attribute the payment.

The above discussion presupposed that correction of a debit order under Rule 139 EPC was available at all, which this board accepts for the following reasons. This board considers that the contrary view expressed in T 170/83 and T 152/85 is not persuasive (both decisions are referred to in point 20 of T 1474/19). The reason given in T 152/85 (in point 2) was that only "documents" could be corrected, while fee payment was a factual requirement to be fulfilled within the time limit which could not be rectified later if it had been omitted. Similarly, in T 170/83 it was held (in point 8 *in fine*) that "To make a payment is to perform an act, namely to make a given amount available to the EPO at a particular time ... This applies also to payments via deposit accounts." This view is not persuasive as to payment via deposit accounts because reception of the "document", i.e. the form authorising the debiting of the account, itself effectively constitutes payment: see Articles 5(2), 7(2) RFees in conjunction with point 5.4.1 ADA 2019. 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, if a correction under Rule 139 EPC, in a debit order, of the type of appeal fee to be paid has retroactive effect, this correction must be deemed to have authorised the EPO to debit the corrected fee on the original date of receipt of the uncorrected debit order (see T 1474/19, point 29, page 28, first full paragraph and T 317/19, points 2.5.2 and 2.5.3; see also T 1146/20, point 6.2.2).

3.2.2 *Criteria for applying Rule 139 EPC*

In G 1/12 relating to an error in the appellant's name, the EBA noted that the boards had developed a large body of case law on corrections under the first sentence of Rule 88 EPC 1973 (first sentence of Rule 139 EPC) and established "principles" that the EBA set out in four sub-points ((a) to (d)) in point 37 (see point D.2.5 above; hereinafter: "principles" (a), (b), (c), (d)). In so doing, the EBA did not distinguish between the various cases of correction (such as the correction of the designation of Contracting States or the retraction of a notice of withdrawal of an application) and did not expressly connect these "principles" with the question the EBA wished to answer, which related to the correction of an appellant's name.

"Principles" (a) to (c) corroborate the criteria of J 8/80. A fourth criterion (d) was added, i.e. that the request for correction must be filed "without delay". As to "principles" (a) and (b), G 1/12 identified J 8/80 as the source, but identified no source for "principles" (c) and (d). "Principle" (a) corresponds to point 4, first sentence, (not point 6 as stated in G 1/12), of J 8/80, "principle" (b) to its point 6 (as said in G 1/12).

It should be noted in this respect that "principle" (b) only lays out the standard of proof, not also that the requester must provide evidence, as in J 8/80. This requirement however is general and therefore need not be expressly mentioned.

"Principle" (c) was also mentioned in point 4, second sentence, of J 8/80. On the other hand, the source of

"principle" (d) is not clear; J 8/80 left the question an open one (see point 10). The final sentence in principle (a) ("It is the party's actual rather than ostensible intention which must be considered") may relate to T 824/00, point 6 (referred to in J 19/03, point 5, reproduced under point D.2.4 above).

The fourth established "principle" corresponds to one of the seven criteria identified in J 19/03, point 7, items a. to g. This fourth "principle" "without delay" of point 37(d) of G 1/12 may be considered to paraphrase criterion b. of J 19/03 ("immediately after becoming aware of the error") itself mirroring the "no undue delay" criterion established in previous decision J 10/87 (see point D.2.4 above, under "Comments").

None of the remaining six criteria of point 7 of J 19/03 have been mentioned, in particular not criteria a. and e.

Criterion a. of J 19/03 ("excusable **oversight**"), established in particular in J 10/87 (see point 13(ii) of the reasons) and relied on in numerous subsequent decisions, is not mentioned in G 1/12.

Criterion e. of J 19/03 relates to the fundamental legal procedural concerns referred to above (in point D.3.2.1), expressed, in particular, in the statement "To cancel procedural effects after failure to meet a time limit would be to apply Rule 88 EPC beyond its clear and unambiguous wording (cf. J 25/01 above) and would violate the scope of application of Article 122 EPC which stipulates specific requirements for grant of re-establishment of rights." (See J 6/02, point 15, reproduced above, in point D.2.3). As stated in

point D.3.2.1 above, the EBA did not address these concerns.

Furthermore, the additional criterion that correction under Rule 139 EPC should no longer be available as a legal remedy if an application was withdrawn, because otherwise an application would potentially remain pending *ad infinitum* as held in J 20/12 of 18 March 2013 (in points 5.2 and 5.3) is not mentioned in G 1/12 of 30 April 2014.

Against this backdrop, it is difficult to identify the reason behind the EBA's selection of established "principles" (in point 37(a) to (c)), which restricts the principles, or preferably criteria, of the case law to essentially the three criteria of J 8/80 and adds the principle "without delay" (in point 37(d)). It comes as no surprise, therefore, that boards have left the question of whether the list of "principles" for accepting a request under Rule 139, first sentence, EPC is exhaustive an open one (see e.g. T 317/19, where additional criteria in the case law were identified in point 2.4.3 and discussed *arguendo* in point 2.4.4).

As a consequence, this board is of the opinion that point 37 in G 1/12 is indeterminate and thus of limited avail in assessing whether a request for correction under Rule 139 EPC can be granted.

3.3 *Criteria for applying Rule 139 EPC: this board's position*

3.3.1 *In general: four pertinent criteria*

Given the fact that the question whether the list of criteria set out in point 37 of G1/12 is an open one,

this board proceeds to identify the criteria to be assessed in the light of the case law that has been adopted since the first decision on the matter, i.e. the decision in case J 8/80, was handed down. The wording of Rule 139, first sentence, EPC (Rule 88, first sentence, EPC 1973) shall be recalled to this end:

Linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request.

In this board's view, the criteria of J 8/80 laid out in its points 4 and 6, in essence "principles" (a) to (c) of point 37 of G 1/12 (see point D.3.2.2 above), are persuasive and must be adhered to. Point 4, first and second sentence, of J 8/80 defines a "mistake", point 6 deals with proof of the asserted mistake and the applicable standard of proof. The three criteria laid out in point 4, first and second sentence, and point 6 of J 8/80 correspond to "principles" (c), (a) and (b), in that order, respectively, with "principle" (b) only laying out the standard of proof.

This board shares the view of the case law (see e.g. J 6/02, point 4, "Thirdly..." and point 16; J 19/03, point 6) that the language of Rule 139 EPC according to which errors and mistakes "may" be corrected means that a correction may or may not be allowed. This is because, on the one hand, corrections having an *ab initio* effect may adversely impact on the interests of the public, including third parties, in legal certainty. On the other hand, a party has an interest in having regard to its true as opposed to its ostensible intentions (cf. J 19/03, point 5). The board considers this interest to be legally protected by the right to fair proceedings for any party and, for a

patent applicant or proprietor, in addition, by the right to property vested in its patent application or patent.

The public's interest in legal certainty and the party's interest in having its true intentions heeded must be balanced. This balance must be struck on a proper weighting of the factors that are relevant in addition to those of J 8/80. These additional factors may differ from case to case depending on the facts relating to the kind of correction requested. The **umbrella notion of balancing interests** gives meaning to the term "may" in the context of Rule 139, first sentence, EPC: if, upon balancing interests, the interests of the party requesting correction weigh more heavily than the public interest, then the request for correction **must** be granted and thus the deciding body has no discretion in this regard. This board is of the view that the use in the case law of the term discretion in the context of interpreting the term "may" in Rule 139 EPC is merely imprecise and this board's approach does not contravene this use.

In sum, the board holds that the four criteria for assessing whether a request for correcting a document filed with the EPO pursuant to Rule 139 EPC can be granted are

- the three criteria mentioned in point 4 together with points 5 and 6 of J 8/80, in essence "principles" (a) to (c) of G 1/12, in the logical order, i.e. (c) and (a) relating to the facts, or, if (b) relating to proof of those facts is applicable, (c) and (a)/(b) combined,

together with

- the criterion of balancing of the public interest in legal certainty with the interest of the party requesting correction, together with the factors (i.e. sub-criteria of this criterion) relevant to a specific case to be balanced (see next point).

3.3.2 *The criterion "balancing interests": factors that may be relevant in a specific case*

This board shares the view expressed in J 19/03 (in point 7.f.) that the relevant factors in balancing the public interest with those of a party must be determined in each case, i.e. each request for correction, on the basis of its own facts. This board nevertheless believes that some factors mentioned in that decision are generally not relevant and others should be re-phrased while, as also said in factor f., the list is not exhaustive. Thus, additional factors may be relevant. In the following this board addresses each of the factors set out in points 7 a. to g. of J 19/03 in turn.

Factor a.: "excusable oversight" should not be applied because it pertains to Article 122(1) EPC. This can be gleaned from the wording of J 10/87, point 14(ii), applying the criterion of excusable oversight set out in point 13(ii): "Hence, the confusion of the two applications can be put down to a genuine and isolated human error". As already said in point D.2.4 above (see "*Comments*"), this was language appropriate for assessing "due care" in the framework of Article 122(1) EPC 1973. However, "due care" was not a requirement under Rule 88 EPC 1973, and now under Rule 139 EPC. Thus, whether the oversight is excusable or not should

not play a role when assessing whether a request for correction under this rule is allowable or not.

J 8/19 arrives at the same conclusion. In point 2.4.3(c) of that decision the board noted that

... the boards of appeal imposed in some cases the requirement that an erroneous withdrawal of the designation of a contracting state had to be due to an **excusable oversight**. This proviso followed from the need to weigh up the interests of a third party against those of the applicant and to take into account the requirement for fair proceedings before the EPO (see J 10/87, Reasons 13; J 16/08, Reasons 5, 10, 11). (Emphasis added.)

In point 2.4.4(c) the board further said:

As far as the "excusable oversight" requirement is concerned, the board notes that it is related in nature to the "due care" requirement for re-establishment of rights under Article 122 EPC. However, a correction under Rule 139, first sentence, EPC is a **generally applicable legal remedy** and is thus **available independently of whether the conditions for re-establishment of rights are met** (see point 2.3.2 above). This general applicability would appear to be circumvented if the above requirement were to be applied to corrections under Rule 139, first sentence, EPC. The exact criteria according to which an oversight should be excusable or not are also not clear to the board.

The recent decision in case J 5/19 (in points 2.2 to 2.6) expressed a similar opinion.

Factor b.: "**immediately** upon awareness" should be adapted because there is no apparent justification for an application of this strict criterion independent of the circumstances. Contrary to what was stated in J 19/03, this criterion was not mentioned as a general criterion in J 10/87. The former decision took criteria a. to d. from point 14 of J 10/87 (see the sentence in brackets between points d. and e.), even though that

point discussed the **application** of the general criteria, while those criteria were set out in the preceding point 13. Item (iii) of point 13 mentions the requirement that "there is no **undue delay** in seeking retraction" (emphasis added). Therefore, the criterion of "immediately upon awareness" should be adapted to read "**no undue delay** upon awareness". See also the comments on J 19/03 in point D.2.4 above.

Factor c.: "whether the public had been officially notified of the withdrawal by the EPO at the time the retraction of the withdrawal was applied or whether the interest of the public was safeguarded even after this notification" should preferably be conflated with adapted factor b. and phrased in more general terms. The board shares the **view expressed in J 16/08, point 13**, that the requirement of no **undue delay** after the error was discovered is designed to ensure that, so far as possible, **requests for corrections are made** before publication of a patent application, and considers that the same applies, more generally, **before** an event affecting rights derived from a patent application, patent or opposition has become part of the **public file**, such that the public is in a position to rely on the correctness of the content of the documents included in that file. This encompasses (adapted) factor b. and factor c.

As a consequence, whether or not there has been **undue delay must reflect the facts of the particular case** (see also T 1146/20, point 7.1, last paragraph). This cannot be determined generally in terms of specific time frames.

In case J 16/08 relating to a request to replace the designation of France with the designation of Sweden, a

change in the published information would **not have**, as regards the correction sought, shown the **published information** to have been **misleading** (the application when published showed all possible contracting states as designated; see point 14). Thus, the board found that the request for correction filed on 19 June 2007, i.e. nearly three months after the date on which the error was discovered (28 March 2007), was not filed with **undue delay**.

In sum, factors b. and c. are conflated to the factor "without undue delay". The board considers that the qualification "undue" must be read into the term "without delay" in those decisions where that latter term is used.

The factor "without undue delay" will as a rule be found to have been complied with if there was no specific information in the public file that the public was entitled to rely on, e.g.,

- when two events that appear to be contradictory occurred as in case J 5/19: the appellant withdrew the application and, five days later, filed a divisional application. Both the withdrawal of the parent application and the filing of the divisional application were mentioned on the same date in the public file of the parent application.
- when the information on an event is unclear, or
- when the public must assume that the resolution of a specific issue is in the balance.

In such cases, the public interest will, as a rule, be unaffected, so that there can be no undue delay.

A time limit for making the request may however be imposed by the factor d.: "no substantial delay of the proceedings". See the next factor.

In conclusion, there will be no undue delay if a correction did not show the published information to have been misleading to the public.

Factor d.: "no substantial delay of the proceedings" should be accepted as it provides a safeguard in cases in which there was no undue delay within the meaning defined in previous factors b. and c., but the request for correction was filed many months or even some years after the error was detected.

Factor e.: "whether the requested correction violates fundamental legal procedural principles" as a rule should be addressed immediately after the criteria of J 8/80 or "principles" (c), (a) and, if applicable, "principle" (b), have been assessed.

This board agrees with the statement in **factor f.** of J 19/03 that factors a. to e. are not exhaustive and the balance of interest has to be struck in each case of a request for correction on the basis of its own facts. Factors cannot be fully determined in the abstract but must be chosen according to the facts of each specific case.

This board also agrees to **factor g.:** "end of the pendency of application or opposition proceedings before the request was filed". This criterion was generalised in T 317/19 (point 2.4.3(c)) as a further requirement such 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.

4. *Application of the analysis of the case law to the case in hand*

4.1 At the outset, the board recalls that the relevant and exhaustive criteria are those set out in J 8/80, points 4 and 6, which are substantially identical to "principles" (a) to (c) of G 1/12, together with its fourth "principle" "without delay", constituting a sub-category, or factor, of the general criterion "balancing of the public interest in legal certainty with the interest of the party" not mentioned in either decision. In the case in hand, this general criterion comprises an additional factor, i.e. "substantial delay of the proceedings" (factor d. of J 19/03). No further factors need to be assessed in the case under consideration. The pertinent factors will be addressed in points D.4.3 and D.4.4 below.

4.2 In assessing whether the criteria for correction under Rule 139 EPC have been met, the relevant person in the case in hand is the professional representative, not the applicant/appellant. The former filed the appeal and paid the appeal fee further to emails by the U.S. instructing attorney on the applicant's/appellant's behalf (see, in particular, the letter of 24 November 2021, point VIII. above).

4.3 *The three basic "principles" (a) to (c) of G 1/12, i.e. essentially those of J 8/80, points 4 and 6*

The three basic "principles" (a) to (c) of G 1/12 are recalled below:

(a) The correction must introduce what was originally intended.

(b) Where the original intention is not immediately apparent, the requester bears the burden of proof, which must be a heavy one. The same applies, pursuant to J 8/80, point 6, where the making of the mistake is not self-evident.

(c) The error to be remedied may be an incorrect statement or an omission.

As stated above (in point D.3.3.1 *in fine*), these criteria need to be assessed in their logical order (c), (a) and, if applicable, (b).

"Principle" (c), corresponding to J 8/80, point 4, second and third sentences

The applicant/appellant in essence asserted that the reduced appeal fee selected in the second box of EPO Form 1038 (see point II. above) was not the one intended, but the regular appeal fee should have been selected. The applicant/appellant thus requests that a statement in a document filed with the EPO be corrected. Therefore, "principle" (c) is met.

"Principles" (a) and (b), corresponding to J 8/80, point 4, first sentence, and point 6

Given that an appeal was filed and the reduced appeal fee paid, the evidence supporting the applicant's/appellant's intent to file an appeal need no further consideration.

The question rather is whether its professional representative did originally intend to pay the regular appeal fee and not the reduced fee, i.e. did intend to select the corresponding item in EPO Form 1038 instead of the item relating to an appeal fee for an appeal filed by a natural person or an entity referred to in Rule 6(4,5) EPC. The professional representative, not the applicant/appellant, was the responsible person, because he was tasked to pay the appeal fee in filing the appeal.

The question of whether such intention was **immediately apparent** on the basis of the documents on file at the end of the appeal period can only be answered once the legal nature of the applicant/appellant has been ascertained as a preliminary matter. The board in its communication of 23 November 2021, against the backdrop of Internet resources, even raised doubts as to the applicant's/appellant's very existence at the point in time when the appeal was filed and thereafter, because, according to those resources, the applicant/appellant became defunct prior to its merger (see point VII. above).

Subsequent to the board's further communications of 17 December 2021 and 7 January 2022, the professional representative, with a letter of 10 January 2022 (see point X. above), submitted, and produced corresponding evidence, that the applicant/appellant Raytheon Company following a merger had become a wholly-owned subsidiary of the parent company Raytheon Technologies Corporation (see Annex C to that letter) and that this corporation was a very large company.

The board is satisfied that the professional representative thus proved that the applicant/appellant

existed at the point in time of filing the appeal. The evidence also showed that it was a wholly-owned subsidiary of its large parent company. As stated by the applicant/appellant, as a wholly-owned subsidiary thereof, the applicant/appellant Raytheon Company clearly was not an entity under Rule 6(4,5) EPC upon filing the appeal. This is because the 25% threshold specified in Article 3, point 2 of the definition of micro, small and medium-sized enterprises mentioned in Rule 6(5) EPC (see point A.4.1 above) was clearly exceeded. Therefore, the applicant/appellant did not benefit from the fee reduction pursuant to item 11 of Article 2(1) RFees.

While the applicant's/appellant's existence and size could not be gleaned from the file at the end of the appeal period, it is accepted that, upon filing the appeal, these facts were known to the professional representative. Upon filing the appeal for Raytheon Company, he was thus aware that this applicant/appellant was not entitled to a reduction of the appeal fee.

In the above point C.3.2 *in fine*, this board considered that T 1474/19 presupposed that a clear intention to pay the regular as opposed to the reduced fee would be found if it was established that the applicant/appellant was a large company not benefiting from the fee reduction of Article 2(1) RFees, item 11. While this board holds that, generally, the size of a company cannot be gleaned from the applicant's/appellant's name alone, this board agrees that once the large size of the company or, as in this case, the fact that at least 25% of its capital are held by a non-SME, has been established, then an applicant/appellant having authorised the debit of the reduced appeal fee can be

assumed to have had the clear intention to pay the regular appeal fee. The reason, as stated above in point C.3.2 *in fine*, is simply that otherwise the condition of Article 108, second sentence, EPC would not be met and the appeal, under G 1/18, conclusion 1(a), be deemed not filed. An applicant, a patent proprietor or an opponent, however, must be considered clearly intending to file a valid appeal.

The board thus finds that, with the legal nature of the applicant/appellant as a non-privileged entity having been ascertained, the original intention is immediately apparent from the file at the end of the appeal period, not only immediately apparent to the professional representative. As a consequence, "principle" (b) is not applicable.

The board therefore accepts that it was the professional representative's **intention** to pay the regular and not the reduced appeal fee (cf. point XIII. above, under the heading "Re requirement that the correction must introduce what was originally intended"). The board agrees that this intention "was **immediately apparent** from the information known to the [applicant/appellant's] professional representative, as set out in [his] declaration" (*ibid.*, emphasis added; for the professional representative's declaration, see point XIII. above, under the heading "Re requirement that the request is filed 'without delay'").

The final sentence in the notice of appeal reading "Any additional fees that may be required can be debited from our deposit account [xxx]" (see point III. above) is not a persuasive argument in favour of a finding that payment of the regular fee was clearly intended. This phrase merely corroborates the professional

representative's intention to pay the regular appeal fee once it had been established that the applicant/appellant did not benefit from a fee reduction.

Conversely, the missing declaration under the Notice on which the applicant relied as evidence of its intention to pay the regular fee (see points XII.(b) and XIII. *in fine* above) is immaterial because it is not required by law and, apart from that, its non-filing may simply have been a mistake (see point C.3.1 above).

Conclusion

"Principles" (a) and (c) of G 1/12 corresponding to J 8/80, points 4 and 6, have been met. "Principle" (b) is not applicable.

This outcome also shows that the question asked in T 1474/19 whether, in the absence of a clearly recognisable intention to order debit of the correct appeal fee obviating the need for a request for correction under Rule 139 EPC, such correction might be available at all, must be answered in the following sense: what needs to be established as a preliminary matter is that the applicant/appellant is not entitled to the reduced appeal fee because it does not meet the requirements of Rule 6(4,5) EPC. As stated, it is not apparent from T 1474/19 how the board arrived at such a finding in that case. As stated above, once such lack of entitlement to the reduced fee is established, the mistake made in authorising the debit of only the reduced fee and, conversely, the intention to authorise debit of the regular fee, is clearly recognisable, without any need for further evidence. This means that the "heavy burden of proof" of a not clearly

recognisable intention pursuant to J 8/80 as ratified by G 1/12 does not apply.

4.4 *The fourth criterion: balancing interests*

4.4.1 *Without undue delay*

(a) *The date when the error is considered to have been detected*

As to the date on which knowledge of an event was imparted, the board follows the rationale of J 1/20 (in point 3.7) regarding a request for re-establishment of rights. That is, what matters is when the responsible person, in this case the professional representative, actually became aware of the error, not when this person ought to have noticed the error. In this respect, the requirement of "due care" plays no role, neither for Article 122(1) EPC nor *a fortiori* for Rule 139 EPC.

However, under point 3.7.1 of that decision the board held that there was a rebuttable presumption that actual knowledge (of a loss of rights in that case) was obtained on the date of receipt of the EPO's communication (which was a communication under Rule 112(1) EPC in that case).

The examining division's communication of Friday, 24 September 2021 entitled "Debiting of fees" (EPO Form 2935) was received on that date, and the communication of Monday, 27 September 2021, cancelling that earlier communication was received on that later date.

It is true that one may fairly ask the question raised in the applicant's/appellant's letter of 4 April 2022, whether a letter received on a Friday that is cancelled the following Monday must be reported at all to the responsible attorney who was not in the office on that Friday. The responsible professional representative stated that he was alerted to the error by the board's communication of 23 November 2021 only. One day later already he filed the request for correction.

The applicant/appellant argued that it was "entirely reasonable, as indeed occurred, to understand the communication of 27 September 2021 that all was in order with the appeal. This also explain[ed] why the authorised representative was not alerted as to a possible deficiency in the appeal by the representative's inhouse paralegals." (See point XIV. above).

However, in the board's view, this is doubtful. From the communication of 24 September 2021, it followed clearly that the debiting instructions given on EPO Form 1038 were for the reduced appeal fee. Given the applicant's/appellant's statement that Raytheon Company "clearly was not an entity under Rule 6(4,5) EPC" (see point X. above), it could be argued that the paralegals should have forwarded the two EPO communications to the professional representative, even after the first communication had been cancelled by the second one (without any reason having been given why that communication had been sent "in error"). One might further consider that, since the communications had reached the area of responsibility of the professional representative, he should not be able to rely on not having received them. Otherwise a representative could benefit from misunderstandings or errors made by the

law firm's support staff or by incorrect instructions given to that staff or even from instructions to deliberately refrain from forwarding documents to the representative, i.e. could benefit from acting in bad faith. Deeming a document that has reached the area of responsibility of a representative to have been received by the representative would however constitute an exception to the rule enunciated in the first paragraph under heading (a) above that only actual knowledge of the responsible person matters. Thus, it would have to be held in the case in hand that the professional representative is deemed to have received the two communications and, as a further consequence, have spotted the error in the amount of payment.

In any case, the applicant's/appellant's extensive submissions regarding the application of the principle of **legitimate expectations** to the case in hand in its letter received on 10 March 2022 (see point XIII. above) contradict its reasoning just discussed and are therefore plainly beside the point. This applies in particular to the statement that "the appellant had suffered a disadvantage as a result of having relied on erroneous information or a misleading communication received from the EPO". If the professional representative was not made aware of the two EPO communications of 24 and 27 September 2021 (see the extracts of the representative's declaration reproduced in point XIII. above), how could he possibly have relied on them and been "misled into believing that the correct appeal fee had been paid" (*ibid.*)?

Apart from that, in the hypothetical case that the professional representative still became aware of the communications of 24 September 2021 and 27 September 2021, the board is not persuaded that he could have

been misled into believing that the correct appeal fee had been paid. As stated above, from the communication of 24 September 2021, it followed clearly that the debiting instructions given on EPO Form 1038 were for the reduced appeal fee. However, it was clear to the representatives that the applicant/appellant was not entitled to the reduction of the appeal fee because that is what is stated several times in the submissions on appeal. See, e.g., the applicant's/appellant's letter of 10 March 2022, reproduced in pertinent part in point XIII. above, in the section entitled "Re requirement that the request for correction is to be filed 'without delay'", and the following section "Re requirement that the correction must introduce what was originally intended".

On the other hand, the board concedes that if the professional representative had been made aware of the communication of 27 September 2021 and had perceived it as suggesting that all was fine with the appeal, it would not have been his duty to not take the communication at face value and remind the EPO of a "discount" given without any legal basis, i.e. to take care of the EPO's financial interests.

It would have been preferable if a short explanation of the cancellation had been given in order not to leave its addressee in the dark as to the reasons therefor, e.g. that the communication was rescinded because it was not the examining division but the Boards of Appeal that had jurisdiction on the matter.

As will be shown below, the question of whether the representative must be presumed to have become aware of the error on 24 or 27 September or on 23 November 2021 only can be left open. Even assuming that 24 or 27

September 2021 was the relevant date, the request for correction received on 24 November 2021, i.e. two, or around two, months later, would still have to be considered as having been filed without undue delay.

(b) Applying the criterion "without undue delay"

As stated above (in point D.3.3.2), the factor "without undue delay" must reflect the facts of the case. It cannot be determined generally in terms of specific time frames.

Assuming that 23 November 2021, i.e. the date of receipt of the board's first communication, was the date when knowledge of the error was imparted, given that the applicant/appellant filed the request for correction the following day, no delay could obviously be found.

In the alternative, assuming that 24 or 27 September 2021 was the date when a possible irregularity regarding payment of the appeal fee became apparent to the public and, at the same time, knowledge of the error was imparted on the applicant/appellant, the public inspecting the EPO's electronic file would have gathered that the status of the appeal as regards fee payment was in the balance given that, in the wake of the communication and its cancellation no payment form debiting any appeal fee was included in the electronic file. The public could thus not have been misled by the two communications into believing that the appeal received on 6 September 2021 was deemed not to have been filed. The appellant and the public were expressly alerted by the board's communication of 23 November 2021 as to the possible irregularity regarding payment of the appeal fee. This communication

was the very first communication of the board following the filing of this appeal. Filing the request for correction only one day after the issue had been highlighted again in that communication, that is two months after the first time the mistake was detected, can therefore not have caused an adverse impact on the public's perception that the issue of payment of the appropriate appeal fee, and thus the existence of the appeal, remained in the balance.

Given that under both of the two alternative assumptions, there was no conceivable adverse impact on the public having access to the electronic file, the applicant's/appellant's interests logically prevail and no balancing of interests is required. The interests would have needed to be balanced only if the public's interest had been affected under either of the two above hypotheses.

The factor "without undue delay" is therefore complied with.

4.4.2 *No substantial delay of the proceedings*

The same result applies to the criterion "**no substantial delay of the proceedings**". The decision under appeal was handed down on 6 July 2021, and the appeal was filed on 6 September 2021, the request for correction on 24 November 2021. Given that substantive examination of the appeal would usually not start before at least one year after the appeal was filed, allowing the correction would cause no delay of the proceedings, let alone a substantial one. In this respect, the interests of the public are therefore not adversely affected, and no balancing is possible either.

5. *Conclusion*

The criteria for correction applicable in this case have all been met.

Furthermore, on 6 September 2021, when the erroneous instruction to debit the reduced appeal fee was given, there were sufficient funds in the deposit account not merely for the reduced but the regular appeal fee to be debited.

The applicant's/appellant's first alternative request that EPO Form 1038, filed on 6 September 2021, be corrected under Rule 139 EPC to indicate that the regular appeal fee for an appeal filed by an entity other than those referred to in Rule 6(4) and (5) EPC (EUR 2 705) should be debited should be granted. The same goes for the request that the regular appeal fee should be taken from the law firm's deposit account and retroactively deemed to have been paid on 6 September 2021.

On 6 September 2021, there were sufficient funds in the deposit account for debiting the regular appeal fee, i.e. EUR 2 705 (see point III. above).

As a consequence, payment of the regular fee is deemed to have been made retroactively on 6 September 2021.

This means that the conditional request for oral proceedings does not become operational.

It is true that this request was made on condition that the primary request to reinstate the examining division's communication of 24 September 2021 was not

accepted. Thus, formally speaking, the condition for conducting oral proceedings was met. However, the applicant/appellant has no legitimate interest in the conduct of oral proceedings because the grant of the first alternative request, in substance, leads to the same result as the primary request, i.e. that payment is considered retroactively to have been made in the regular amount on 6 September 2021. The only difference to the primary request is that a two-month period for opposing the examining division's finding is not allowed. The applicant having however expressed its clear wish to pay the regular amount on several occasions has no legitimate interest in being afforded the two-month time limit, as making use of that time limit to oppose payment of the regular appeal fee would contradict its submissions on appeal.

Order

For these reasons it is decided that:

1. EPO Form 1038, filed on 6 September 2021, is corrected to indicate that the regular appeal fee for an appeal filed by an entity other than those referred to in Rule 6(4) and (5) EPC (EUR 2 705) should be debited.
2. The fee for re-establishment of rights is to be reimbursed.

The Registrar:

The Chair:



K. Boelicke

B. Willems

Decision electronically authenticated