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Aktenzeichen / Case Number / N° du recours : T 170/83

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Bezeichnung der Erfindung: Oriented polypropylene with linear low density
Title of invention: polyethylene copolymer coating
Titre de l'invention :

ENTSCHEIDUNG / DECISION

vom / of / du 12 September 1984

Anmelder/Patentinhaber: Mobil Oil Corporation
Applicant/Proprietor of the patent:
Demandeur/Titulaire du brevet :

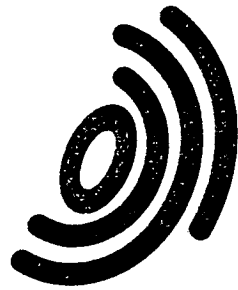
Stichwort / Headword / Référence : Debit order III

EPÜ / EPC / CBE

"Debit order - appraisal of circumstances"
"Costs of oral proceedings - apportionment"
"Enlarged Board of Appeal - referral to"

Leitsatz / Headnote / Sommaire

If a national Office form is used in error to effect a debit order, with the result that the particulars given (e.g. addressee, account number, amount) are incorrect, the debit order is effective provided it at least gives particulars (in this instance, the patent number) attributable to an EPO dossier which when consulted establishes without doubt the particulars intended and thereby that the form addresses the EPO.



Case Number: T

170 / 83

DECISION
of the Technical Board of Appeal 3.3.1
of 12 September 1984

Appellant: Naamloze Vennootschap DSM
(Opponent) van der Maesenstraat 2
NL-6411 LP Heerlen

Representative: Hoogstraten, Willem Cornelis Roeland
OCTROOIBUREAU DSM
Postbus 9
NL-6160 MA Geleen

Respondent: MOBIL OIL CORPORATION
(Proprietor of the patent) 150 East 42nd Street
New York, New York 10017
U.S.A.

Representative: Jones, Alan John
CARPMAELS & RANSFORD
43, Bloomsbury Square
GB-London, WC1A 2RA

Decision under appeal: Decision of the Formalities Section
of the European Patent Office
dated 13 July 1983, stating that
the Opposition is deemed not to
have been filed pursuant to
Rule 69(2) EPC.

Composition of the Board:

Chairman: K. Jahn

Member: G. Szabo

Member: O. Bossung

SUMMARY OF FACTS AND SUBMISSIONS

- I. On 21 January 1983, the last day of the period for opposition to European patent No. 0 002 606, the appellant, represented by a professional representative, filed a notice of opposition containing the number of the European patent, the application number, the name of the proprietor of the patent, a request that the patent be revoked and a statement of the grounds for the opposition. Beneath his signature the professional representative drew attention to his general authorisation and added the following text: "Enclosures: debit order" (the word "Enclosures" was underlined).

Annexed was a Netherlands Patent Office debit order form in Dutch issuing by virtue of the representative's signature a debit order to the "Netherlands Patent Office" and adding in typescript that the purpose of the payment was an opposition against the grant of "Netherlands patent application No. 0 002 606", together with the name of the proprietor of the above-mentioned European patent, the reference of the notice of opposition referred to above and the amount of the Netherlands Patent Office's opposition fee, Hfl 355.00. The Netherlands Patent Office having telephoned the opponent's representative on 4 February 1983 to draw his attention to the matter, he instructed the EPO by telex of 7 February 1983 to debit an opposition fee of DM 520.00.

- II. On 11 February 1983, the Formalities Section of Directorate-General 2 of the EPO wrote to the opponent's representative on a standard form indicating that the opposition was deemed not to have been filed, because the fee had not been paid in due time. The representative

thereupon requested correction of the debit order under Rule 88 EPC and a decision under Rule 69(2) EPC.

- III. By decision of 13 July 1983 under Rule 69(2) EPC, the Formalities Section of the EPO found that the opposition was deemed not to have been filed because the fee had been paid late, on the grounds that the Netherlands Patent Office debit order form annexed to the notice of opposition and received by the EPO completed as described above could not be considered a valid debit order within the meaning of the Arrangements for deposit accounts (OJ No. 1/1982, p. 15 et seq.). Even accepting that the opponent's representative had signified an intention to pay, this did not make good his failure to comply with the formal requirements for valid payment. Correction of the debit order under Rule 88 EPC was not possible because it had been addressed to the Netherlands Patent Office; nor was Hfl 355.00 the amount of any EPO fee.
- IV. On 8 September 1983, the opponent's representative filed notice of appeal against this decision, at the same time paying the fee for appeal and enclosing a Statement of Grounds.
- V. The patent proprietor and the opponent were informed by the Rapporteur of the Board that the former was also a party to the appeal proceedings, and their attention was drawn to earlier decisions ("Debit order I", T 152/82, since published in OJ 7/1984, p. 301 et seq.; "Debit order II", T 17/83, since published in OJ 7/1984, p. 306 et seq.), with the patent proprietor in particular being given an opportunity to comment and make submissions.

- VI. At the request of the patent proprietor, oral proceedings before the Board of Appeal were held on 24 May 1984, with the Board deciding to give its decision in writing.
- VII. The parties' written and oral submissions gave rise to detailed discussion of whether Rule 88, 1st sentence, EPC applied to debit orders at all and - if so - whether in the present case the Dutch form as filled in (see I above) could be so corrected as to constitute a valid debit order under the Arrangements for deposit accounts. In this connection the patent proprietor argued that the opponent could not benefit from correction under Rule 88, 1st sentence, EPC for the simple reason that the enclosure to his notice of opposition was in Dutch and as such under Article 14(5) EPC deemed not to have been received.
- VIII The appellant based his submissions on the "Debit order II" decision, arguing that his notice of opposition had clearly signified an intention to pay, and that the kind of error made was evident from the enclosure.

The appellant (opponent) requested that

the contested decision be set aside.

- IX. The respondent (patent proprietor) requested that
- (1) the appeal be dismissed;
 - (2) whatever the decision reached by the Board the costs incurred by him as a result of oral proceedings be reimbursed;

- (3) in the alternative to (1), the following point of law be referred to the Enlarged Board of Appeal:

"Is a notice of opposition, lodged at the EPO by the due date and accompanied by something intended by the opponents as a debit order for the opposition fee but not recognised by the EPO as such, filed within the meaning of Article 99(1) EPC?"

The respondent argued that the present case was different from the "Debit order I and II" cases. The notice of opposition alone did not constitute a valid debit order within the meaning of point 6.2 of the Arrangements for deposit accounts. The requirements of points 6.1 and 6.3 of the Arrangements (indication of an amount, purpose of the payment and the account number) had not been met. The notice of opposition and enclosure could at best be regarded as evidence of an intention to pay, but not as payment within the meaning of point 6.3, 3rd sentence, of the Arrangements. That EPO staff had not considered the notice of opposition and enclosure as constituting a debit order also proved that those items were certainly not clear within the meaning of the "Debit order I" decision (Headnote, paras. II and III). The present case resembled J 03/81 (OJ 3/1982, p. 100 et seq.), Headnote para. III of which said that a fee could only be considered to have been paid when the EPO had been instructed to allocate the appropriate amount to the payment of that fee. To regard the present opposition as having been filed in due time would therefore "be ultra vires the EPC".

Reasons for the Decision

1. The contested decision is one under Rule 69(2) EPC noting a loss of rights by deeming the notice of opposition under Article 99(1), 2nd sentence, EPC not to have been filed (re. this fiction - exemplified by an appeal - see decision J 21/80 of 26 February 1981, OJ 4/1981, p. 101 et seq.). It was taken by an EPO Formalities Officer in the exercise of his powers under point 4 of the Notice of 8 January 1982 (OJ 2/1982, p. 61).

The appeal is in accordance with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.

2. An earlier Board of Appeal decision has laid down that a fee which has fallen due cannot be regarded as paid by virtue of the mere existence of a deposit account with the EPO containing sufficient funds (J 03/81 of 7 December 1981, OJ 3/1982, p. 100 et seq.). In decision T 152/82 of 5 September 1983 ("Debit order I"; OJ 7/1984, p. 301 et seq.), the Board took the view that an otherwise complete and correct debit order was clearly intended to refer not to the sum indicated (earlier fee) but to the fee as since increased. In decision T 17/83 of 20 September 1983 ("Debit order II"; OJ 7/1984, p. 306 et seq.), the appellant's statement in the notice of appeal that he had already issued a debit order was itself considered such a debit order.
3. Points 6.1 to 6.3 of the Arrangements for deposit accounts (OJ 1/1982, p. 15 et seq.) prescribe various requirements which the debit order must meet. These requirements are not of equal significance as regards the making of payment within the meaning of point 6.3, 3rd

sentence. Point 6.1 of the Arrangements, it should be remembered (cf. "Debit order I" decision, Reasons for the Decision, point 6), requires not necessarily an indication of an amount to be debited but rather - as the English and French texts show more clearly - lays down the purpose of the account ("payment of fees or costs"). The requirement under point 6.2 of the Arrangements that the debit order be in writing or by telex is, on the other hand, essential. Point 6.3 adds that "the debit order must contain the particulars necessary to identify the purpose of the payment" (see point 5 below).

4. This raises once again (cf. the "Debit order I and II" decisions mentioned) the question of what a debit order's minimum requirements - all formalities aside - actually are or, in other words, what the EPO must have before it to be able to debit funds deposited with it, with the result that on a particular day payment is made within the meaning of point 6.3, 3rd sentence, of the Arrangements for deposit accounts.
5. Payment by debit order from a deposit account differs substantially from other forms of payment; unless insufficient within the meaning of point 6.4 et seq. of the Arrangements for deposit accounts, the funds to be drawn on are already with the EPO, which must merely be authorised in due time to avail itself of a certain amount for a clearly specified purpose. For other forms of payment (cheques, cash etc.), it suffices that a sufficient amount be received in due time; under Article 7(2) of the Rules relating to Fees, the purpose of the payment may be notified at a later date, notwithstanding the fact that their Article 7(1) requires that the payment indicate its purpose.

6. The problem in the case of payment via deposit account debit order is thus not whether the EPO is holding funds or receives them in due time, but whether it is authorised in due time to avail itself for a clearly specified purpose of funds deposited with it. The holder of a deposit account has entered into a special legal relationship with the EPO, with the result that notwithstanding formal deficiencies the necessary authorisation in due time of the EPO to avail itself of deposited funds may be based on an appraisal of the circumstances. Such circumstantial authorisation of the EPO to avail itself of funds deposited with it presupposes firstly that the person issuing the debit order (account-holder) is known and it is clearly intended that specific fees falling due in known proceedings before the EPO be paid by debit order (and not in some other way). There may therefore be no doubt as to the account-holder's identity and intention. Not only that, but the circumstances must clearly show that the EPO may, and indeed must, consider itself authorised to effect the debit without reference back to the account-holder.
7. If these principles are applied to the present case it is found that:

The signed debit order, which because of EPO organisational constraints is removed from the notice of opposition and forwarded to the Cash and Accounts Department, is as regards form, language, account number and currency addressed to the Netherlands Patent Office. The section specifying the purpose of payment contains a reference to an enclosed notice of opposition to a patent granted to the Mobil Oil Corporation. The patent opposed is referred to as "Netherlands patent application No. 0

002 606". Such a low number of this type is clearly neither that of a Netherlands patent application (the two last digits of which give the year of filing) nor of a Netherlands patent still opposable. Instead, the low serial number would suggest a patent number allocated by a relatively new patent office, such as the EPO, particularly since the adjacent section of the debit order form contains the applicant's reference "OEP 1358" indicating an opposition (O) to a European patent (EP).

That reference number alone would not however have enabled the Cash and Accounts Department to establish that the form related to particular proceedings before the EPO and for which a fee was payable, because this type of reference number - usually added to each document - is not indentifiable. However, given the final digits "2 606" suggesting a patent number, it could have done so by making a straightforward enquiry to the Registry or interrogating the bibliographical data using the terminal, which would have established that there was an opposable European patent with the number and proprietor indicated. In conjunction with the notice of opposition, it would then have become clear that the particulars in the form - at first sight confusing - had been caused by an obvious error - the use of a Netherlands Patent Office debit order instead of an EPO one - in the office of the opponent's representative.

Given all circumstances apparent when the debit order was received, it was without doubt addressed to the EPO for payment of the correct amount of the opposition fee. The respondent is incorrect in contending that payment was merely intended; it was actually effected. This means that on the last day of the period for opposition

and, therefore, in due time, an effective notice of opposition was filed. The opposition is therefore deemed to have been filed within the meaning of Article 99(1), last sentence, EPC.

That the Cash and Accounts Department in fact forwarded the form to the Netherlands Patent Office, and that Formalities Section took a view different to that of the Board, was the result of failure to take into consideration all the relevant circumstances.

8. The respondent argues that the debit order form in Dutch is a document requiring translation under Article 14(4) EPC and that because no translation was made it must be deemed under Article 14(5) EPC not to have been filed. The Board cannot accept this.

The running of deposit accounts is a service provided by the EPO outside the grant or opposition procedures (cf., re. payments in general, Legal Advice No. 6/80, OJ 9/1980, p. 303 et seq.) under special provisions which Article 5(2) of the Rules relating to Fees empowers the President of the Office to adopt. In doing so, he is not bound by the EPC's principles governing the grant and opposition procedures. This is why it was possible, notwithstanding Rule 36(5) EPC, to provide that payment may be made by unconfirmed telex (point 6.2 of the Arrangements for deposit accounts) and, notwithstanding Article 6(4) of the Rules relating to Fees - which provides for equivalents in other currencies - that it may be made only in Deutsche Mark (point 3 of the Arrangements for deposit accounts). Nor does Article 14 EPC regarding the official languages and language of the proceedings apply; a debit order does not have to contain text in a

language at all, as it may for example consist solely of numbers and generally recognised abbreviations (e.g. currency, legal texts etc.) whilst remaining quite clear. The Board takes the view that even without its text parts the essential import of the present debit order is comprehensible and can be acted upon by the Cash and Accounts Department. The question whether a debit order in a non-official language is effective therefore does not arise.

By the same token, and contrary to the view advanced by the appellant, because the running of deposit accounts falls outside the grant or opposition procedures it is not governed by Rule 88, 1st sentence, EPC. To make a payment is to perform an act, namely to make a given amount available to the EPO at a particular time (Article 9(1), 1st sentence, Rules relating to Fees). This applies also to payments via deposit accounts; it would be alien to this factuality of payment for parties to be in a position to use requests for correction to feign, after the event, payment in due time of fees not in fact paid.

9. The Board sees no reason to award against the appellant (opponent) the costs of oral proceedings conducted at the request of the respondent (patent proprietor). Although the office of the opponent's representative made a clerical error giving rise to a time-consuming formalities examination and subsequent appeal, with the result that the respondent too has incurred costs, Article 104(1) EPC provides that each party to proceedings bears his own costs. Any departure from this principle requires special circumstances such as improper behaviour which make it equitable to award costs against one of

the parties. As a rule, such circumstances arise from a party's conduct in proceedings. In the present case the appellant has merely attempted before the Board of Appeal to avert the threat of loss of rights following an error made by his representative's office. This does not substantiate the charge that he has culpably caused the respondent to incur unnecessary costs (cf. Mathély, *Le Droit Européen des Brevets d'Invention*, Paris 1978, p. 311; Singer, *Das Neue Europäische Patentsystem*, Baden Baden 1979, p. 79).

10. Referral to the Enlarged Board of Appeal of the question formulated by the respondent is not necessary, because the present Board has not departed from earlier decisions of the Boards of Appeal of the European Patent Office (see point 2 above).

For these reasons,

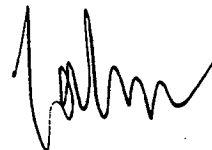
it is decided that:

1. The contested decision is set aside and the matter referred back to the first instance.
2. The request that costs be awarded against the appellant (opponent) is refused.
3. The request that the matter be referred to the Enlarged Board of Appeal is refused.

The Registrar



The Chairman



14/9/84

By 12.9.