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Aktenzeichen / Case Number / N° du recours : T 149/87 - 3.4.1

Anmeldenummer / Filing No / N° de la demande : 79 302 464.7

Veröffentlichungs-Nr. / Publication No / N° de la publication : 0 011 948

Bezeichnung der Erfindung: Programmable cardiac pacemaker

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : A61N1/36

ENTSCHEIDUNG / DECISION

vom / of / du 21 July 1988

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet : Medtronic, Inc.

Einsprechender / Opponent / Opposant : Biotronik

Stichwort / Headword / Référence : German Patent Office/Medtronic

EPO / EPC / CBE Articles 10, 33, 99, 112

Schlagwort / Keyword / Mot clé : "Notice of opposition delivered to German Patent Office" - "filed at EPO after expiry of 9-month period" - "effect of Administrative Agreement dated 29 June 1981"

Leitsatz / Headnote / Sommaire

The following questions concerning important points of law are referred to in the Enlarged Board of Appeal:

(i) If the President of the EPO makes an agreement with an outside organisation (here: the German Patent Office), has he the power to include in such an agreement a term which requires the EPO in certain circumstances to treat a document which was filed at the EPO outside a time limit set by the EPC as if it had been filed within such time limit?

.../...

(ii) If the making of an agreement which includes such a term is not within the power of the President of the EPO, what is the legal effect of such a term in such an agreement, having regard to the fact that the agreement was published in the Official Journal in order that parties to proceedings before the EPO should be informed of and rely upon its contents?

(iii) In the present case, are time limit and place for filing the notice of opposition at the EPO governed by Article 99(1) EPC alone, or by Article 99(1) EPC in combination with Article 1, paragraph 3, of the Administrative Agreement dated 29 June 1981?

Europäisches
Patentamt
Beschwerdekammern

European Patent
Office
Boards of Appeal

Office européen
des brevets
Chambres de recours



Case Number : T 149/87 - 3.4.1

D E C I S I O N
of the Technical Board of Appeal 3.4.1
of 21 July 1988

Appellant :
(Opponent) Biotronik Meß- und Therapiegeräte
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Respondent:
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Representative : Tomlinson, Kerry John
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Decision under appeal : Decision of the Opposition Division of the
 European Patent Office dated 10 February 1987
 rejecting the opposition filed against
 European patent No. 0 011 948 pursuant to
 Article 102(2) EPC

Composition of the Board :

Chairman : K. Lederer
Members : G.D. Paterson
 H. Reich

Summary of Facts and Submissions

- I. On 30 July 1985, a notice of opposition to European patent 0 011 948 (Application No. 79 302 464.7) was delivered to the German Patent Office, but was addressed to the EPO. The 9-month period for giving notice of opposition to the EPO under Article 99(1) EPC expired on 31 July 1985. The notice of opposition was transmitted from the German Patent Office to the EPO in Munich and was received there on 1 August 1985.
- II. By an Administrative Agreement dated 29 June 1981 between the German Patent Office and the EPO (OJ EPO 9/1981, page 381) signed by the respective Presidents, certain matters were agreed concerning procedure on receipt of documents and payments. In particular paragraph 3 of Article 1 of this Agreement provides that the EPO shall treat documents which have been filed at the German Patent Office but which are intended for the EPO "as if it had received them directly".
- III. Pursuant to this Administrative Agreement, the EPO treated the notice of opposition as if it had been filed at the EPO on 30 July 1985. Thus the opposition was considered admissible by the Formalities Officer of the Opposition Division, and pursuant to Rule 57(1) EPC the opposition was communicated to the patent proprietor on 7 August 1985. In reply, by letter dated 14 August 1985 the patentee queried the admissibility of the opposition, having regard to the fact that the notice of opposition was actually filed at the EPO after the 9-month opposition period had expired. On 9 October 1985 the Formalities Officer issued a Communication which expressed the view that the Administrative Agreement applied to the facts of the case, and that the opposition was considered admissible. A

Decision was issued on 10 February 1987, in which the admissibility of the opposition was affirmed, and the opposition was rejected.

- IV. On 9 April 1987 the opponent filed a notice of appeal. The Respondent (the patentee) has not challenged the decision as to the admissibility of the opposition during the appeal proceedings. Nevertheless, pursuant to Articles 111(1) and 114(1) EPC, having regard to the facts of the case the Board of Appeal should consider and decide whether the opposition is admissible before it decides upon the substantive grounds raised in the opposition. If the opposition was inadmissible, there is no basis for the appeal proceedings.

Reasons for the Decision

1. Article 112(1)(a) EPC empowers a Board of Appeal to refer any question to the Enlarged Board of Appeal of its own motion if it considers that a decision is required on an important point of law which is raised by that question.
2. Article 99(1) EPC provides a period of 9 months within which notice of opposition must be filed at the EPO if an opposition is to be admissible. In the present case, the effect of the Formalities Officer following paragraph 3 of Article 1 of the Administrative Agreement is to extend that 9-month period for filing an admissible opposition. The EPC does not expressly give the President of the EPO the power to extend a time limit such as that set out in Article 99(1) EPC. Under many national laws, a public authority which is created by a written law can only exercise the powers which that written law gives to it. If the authority exercises powers which are not given to it by the written law which created it (whatever its motives in

so doing, whether good or bad), such acts are considered to be ultra vires and void and of no legal effect. This doctrine of ultra vires is an important principle of administrative law.

The EPC does not expressly provide that the doctrine of ultra vires is part of the law of the EPC. Nevertheless, Article 10 EPC sets out the functions and powers of the President of the EPO, from which it could be implied that the Contracting States did not intend him to have powers beyond what are there set out. Article 10 EPC in combination with Article 33 EPC suggest that a time limit laid down by the EPC can only be amended by the Administrative Council.

This case therefore raises the question as to whether, insofar as a particular provision of the Administrative Agreement requires the EPO to treat a document which was in fact filed at the EPO outside a time limit set by the EPC as if it had been filed within that time limit, that provision is void and has no legal effect. If so, it would seem that prima facie as a matter of law the time limit set by Article 99(1) EPC should prevail, and the notice of opposition in the present case should be held to be inadmissible.

3. However, the Board is aware that the Agreement was made in the context of a desire to avoid procedural problems which arose especially during the initial years of operation of the EPO, and that it was published in the Official Journal in order to inform parties and potential parties to proceedings before the EPO of its terms. Furthermore, since its publication in the Official Journal in 1981, the Agreement has been relied upon by such parties, in particular by the Appellant in the present case. The further question therefore arises, if and insofar as the

particular provision may be void when its effect is to extend a time limit set by the EPC, as to the legal effect of that provision in relation to a party to inter partes proceedings who has filed a document at the German patent Office in reliance upon that provision. In this connection various decisions of the Boards of Appeal have emphasised that the principle of good faith governs the relationship between the EPO and parties to proceedings before it.

4. The above questions involve important points of law both as to the extent of the power of the President of the EPO, and as to the legal effect of an agreement made by the President of the EPO insofar as its effect is to extend a time limit which is set by the EPC when that agreement has been published in the Official Journal.

For these reasons, it is decided that:

The following questions concerning an important point of law shall be referred to the Enlarged Board of Appeal for decision:

- (i) If the President of the EPO makes an agreement with an outside organisation (here: the German Patent Office), has he the power to include in such an agreement a term which requires the EPO in certain circumstances to treat a document which was filed at the EPO outside a time limit set by the EPC as if it had been filed within such time limit?
- (ii) If the making of an agreement which includes such a term is not within the power of the President of the EPO, what is the legal effect of such a term in such an agreement ,

having regard to the fact that the agreement was published in the Official Journal in order that parties to proceedings before the EPO should be informed of and rely upon its contents?

- (iii) In the present case, are time limit and place for filing the notice of opposition at the EPO governed by Article 99(1) EPC alone, or by Article 99(1) EPC in combination with Article 1, paragraph 3, of the Administrative Agreement dated 29 June 1981?

The Registrar:

The Chairman:

F. Klein

K. Lederer