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Bezeichnung der Erfindung: Radiation and static electricity suppression device
Title of invention:
Titre de l'invention :

Klassifikation / Classification / Classement : H05F 3/02

ENTSCHEIDUNG / DECISION

vom / of / du 9 October 1990

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

DACA International B.V.

Einsprechender / Opponent / Opposant :
1) Coe, Adrian Brian
2) Savio Plastica S.r.l., 3) Systemdienst Gerd Nitzsche
4) VDU Products AB, 5) Cominvest System AB
6) Focus Computer Products 7) Swiss-Can Agencies Ltd.

A/S

Stichwort / Headword / Référence : Fee reduction/SAVIO PLASTICA

EPO / EPC / CBE Art. 14(2), Rule 6(3), Rule 55(c), Art. 9(1) R.r.t.F.
Art. 99(1), Rule 56(1)

Schlagwort / Keyword / Mot clé :
"Accelerated processing of appeal"
"Admissibility of opposition (yes)"
"Fee reduction/Non-official-authorized
language"
"Lacking of a small amount of a fee"

Leitsatz / Headnote / Sommaire

I. If infringement proceedings in a designated State have been commenced or are contemplated by the patentee (here, commenced and thereafter stayed pending decision in an opposition before the EPO), it is justified to give priority to an appeal in opposition proceedings and to decide it in advance of other pending appeals.

II. In a multiple opposition, where an appeal has been filed concerning the existence or admissibility of one of the oppositions, the examination stage of the opposition proceedings should be prepared and processed in parallel with the appeal with the participation of all the opponents up to the point when it is ready to be decided; as soon as the appeal is decided, the opposition may also be decided.

III. To be granted the benefit of a 20% reduction of the opposition fee under Rule 6(3) EPC, that part of a notice of opposition which is governed by Rule 55(c) EPC should always be filed in a non-official authorised language.

IV. Whether or not it may be considered justified to overlook a small amount of a fee which is lacking, under Article 9(1) Rules relating to Fees, must be decided on an objective, not a subjective, basis.



Case Number : T 290/90 - 3.4.1

D E C I S I O N
of the Technical Board of Appeal 3.4.1
of 9 October 1990

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Decision under appeal : Decision of the Formalities Officer of the
Opposition Division of the European Patent
Office dated 29 January 1990 rejecting the
notice of opposition filed against European
patent No. 0 092 308 as inadmissible pursuant
to Rule 69(2) EPC.

Composition of the Board :

Chairman : K. Lederer
Members : G.D. Paterson
R. Shukla

Summary of Facts and Submissions

- I. Following the grant of European patent No. 92 308 on 27 July 1988, notices of opposition were filed by seven opponents within the nine-month opposition period which expired on 27 April 1989. There is no dispute that six of these seven oppositions were filed in time and are admissible. However, the notice of opposition of Opponent 2 has been held by the Formalities Officer of the Opposition Division in a Decision dated 29 January 1990 under Rule 69(2) EPC as not having been filed under Article 99(1) EPC, having regard to the facts set out in the next paragraph.
- II. Opponent 2 filed a letter dated 12 April 1989 both in English (the language of the proceedings) and in Italian. Although entitled "Notice of Opposition", the letter does not contain any reference to any ground of opposition and could not conceivably be considered as a "written reasoned statement" within the meaning of Article 99(1) and Rule 55(c) EPC. The letter states that "The original of the present notice is written in Italian since the Opponent, an Italian Company, intends to avail itself of the option provided in Article 14(4) and Rule 6(3) EPC". A copy payment voucher in respect of the opposition fee less a 20% reduction (Article 12 "Rules relating to Fees") was enclosed with the letter, showing payment on 11 April 1989.

Subsequently, on 24 April 1989, Opponent 2 filed a formal notice of opposition including a written reasoned statement six pages long setting out facts, evidence and arguments in support of the grounds of opposition, entirely in English.

III. On 2 June 1989 the Formalities Officer issued a communication under Rule 69(1) EPC stating that the opposition fee had not been paid in full. Following correspondence between the Formalities Officer and Opponent 2 during which Decision J 4/88 (dated 23 May 1988, to be published) was referred to by the Formalities Officer and discussed by Opponent 2 (and during which the missing amount of the opposition fee was in fact paid, on 19 July 1989), the Formalities Officer issued a further communication on 1 August 1989 stating that "The matter has been passed on to the Legal Department". Subsequently, on 29 January 1990 a Decision was issued in the name of the Formalities Officer, pursuant to Rule 69(2) EPC.

The Decision sets out the detailed facts of the case and the submissions of Opponent 2 and states that "The purpose of Article 14 and Rule 6 EPC is to provide a compensation for the nationals of those Contracting States which have accepted to renounce their official language being one of the official languages of the EPO. If this non-official authorised language is not used, then the benefit of the reduction of the fee cannot be granted. The right to the reduction is attached to the fact that said language is used and not only to the nationality or principal place of business of the requesting person.

In principle therefore, to be granted the benefit of the reduction of the opposition fee under Rule 6(3) EPC, the notice of opposition should be entirely written in a non-official authorised language".

After referring to Decisions J 7/80 (OJ EPO 1981, 137) and J 4/88, the Decision goes on to hold that that part of a notice of opposition which is governed by Rule 55(c) EPC "should always be filed in a non-official authorised language".

- IV. Furthermore, it was held that it was not considered justified to overlook the lacking amount of the opposition fee pursuant to the final sentence of Article 9(1) Fees Rules, because the opponent had had the opportunity to preserve his rights, and had not paid the full amount of the opposition fee on purpose. The question whether the lacking amount, being 20% of the opposition fee, was a "small amount" for the purpose of Article 9(1) Fees Rules was not decided.
- V. Opponent 2 duly filed an appeal on 21 March 1990. In his grounds of appeal he contended in particular:
- (a) that the present case concerning a notice of opposition was analogous to that of a request for examination, and that Decisions J 7/80 and J 4/88 should be distinguished, because both were concerned with the filing of an application in an unofficial language;
 - (b) that a representative has a duty to make all possible efforts to preserve his client's rights (in this case, to preserve his client's right to pay a reduced opposition fee);
 - (c) that if the payment of a reduced opposition was not justified under Article 14(4) and Rule 6(3) EPC, the amount lacking should be disregarded, under Article 9(1) Fees Rules, so as to preserve Opponent 2's interest in opposing the patent.
- VI. Subsequently, in a letter filed on 10 August 1990, (possibly filed as a consequence of the notice concerning accelerated processing of oppositions dated 11 June 1990 (OJ EPO 1990, 324)), the Respondent (the Patentee) requested urgent action to decide the appeal as rapidly as possible, essentially on the following grounds:

- (a) There is a substantial market for the patented product in the eight designated States, and it is estimated that sales of allegedly infringing products are greater than sales by the Patentee;
- (b) Infringement proceedings in Germany against Opponent 3 had already been stayed pending the outcome of the opposition proceedings before the EPO, and any infringement proceedings in other designated States would also be liable to be stayed on the same basis;
- (c) If the patent is maintained at the end of the opposition proceedings, the longer that these take, the more difficult it will be for the Patentee to enforce the patent against established allegedly infringing competitors. Manufacture and/or importation and distribution of the patented product requires only a small capital outlay.

Furthermore, Opponent 6 filed observations indicating that there should be no delay in deciding the opposition proceedings as a result of the appeal by Opponent 2.

Reasons for the Decision

1. The appeal is admissible.
2. Processing of the appeal and of the opposition

The facts and matters set out in paragraph VI above fully justify the Board of Appeal giving priority to this appeal and deciding it in front of other pending appeals, having

regard to the general principles which also underlie the Notice concerning accelerated processing of oppositions dated 11 June 1990 referred to in paragraph VI above.

So far as general principles are concerned, a "raison d'être" for a patentee obtaining and maintaining a patent is in order that he can enforce it when appropriate, and in a case such as the present, the timing of enforcement proceedings within Contracting States can be of real importance. Delays in such proceedings can be prejudicial both to the patentee's interests and to those of his competitors.

The general rule under the EPC is that after grant, a European patent is no longer within the competence of the EPO and becomes a bundle of national patents within the jurisdiction of national courts, but opposition proceedings before the EPO constitute an exception to this general rule. Against this background, particularly when infringement proceedings before a national court have been commenced or are contemplated (or as in the present case, have been commenced and stayed) the speedy processing of opposition proceedings in respect of the relevant European patent becomes especially important.

In the present case, for the above reasons it is clearly important not only that this appeal is decided quickly, but also that the complete substantive opposition of which this appeal forms a procedural part should be decided quickly. In this connection, although the Formalities Officer's decision has held that the opposition by Opponent 2 has not been brought into existence, nevertheless Article 106 EPC provides that the filing of an appeal from such decision has a suspensive effect. In the context of a case such as the present, this means that

Opponent 2, the Appellant, should be treated as though he had duly filed an opposition, unless and until the Board of Appeal decides otherwise. Thus at the same time as the appeal is examined and decided, the opposition should be prepared and processed with the participation of the Appellant up to the point when it is ready to be decided (obviously the opposition cannot be decided until it has been decided in the appeal whether or not Opponent 2 can take part in the opposition: in such circumstances an appeal will always normally be expedited). The files concerning the opposition should in principle remain with the Opposition Division for such activities to be controlled, and only those documents which are relevant to the appeal should be remitted to the Board of Appeal (with copies retained by the Opposition Division where appropriate). The parties may then address correspondence to the Opposition Division or the Board of Appeal as the case may be, and such correspondence can be properly and expeditiously dealt with by the appropriate department having possession of the relevant files.

In the present case, it is to be hoped that relatively little delay in the progress of the substantive opposition proceedings has been caused by the appeal by Opponent 2, and that the opposition can now receive accelerated processing.

3. **Legality of the reduction in the opposition fee**

In the Board's judgment it is very clear that a reduction of the opposition fee in the circumstances of the present case is not allowable. The Board fully agrees with what was said in this respect in the Decision under appeal, the most relevant passages of which are set out in paragraph III above.

4. Justification for overlooking the small amount lacking

- (a) The Board does not agree, however, with the approach taken to this question by the Formalities Officer in the Decision under appeal, as summarised in paragraph IV above. Whether or not, under Article 9(1) Fees Rules, it may be considered justified to overlook a small amount of a fee which is lacking without prejudice to the rights of the person making the payment, must be decided on an objective basis (having regard to all the relevant circumstances of the case), and not on a subjective basis.

In the Decision under appeal, the fact that a reduced opposition fee was paid on purpose was considered as the sole and decisive point against the Appellant, justifying a refusal to overlook the amount which was lacking and thus causing him to lose his right to be an opponent at all. However, in the Board's view, while it is necessary to decide whether the Appellant's contentions concerning a reduction in the opposition fee are correct, it is inappropriate to punish him merely for making the contentions.

While it would have been more prudent if the Appellant had paid the full amount of the opposition fee within the nine-month opposition period, with a reservation in respect of the 20% reduction pending a decision as to whether or not he was entitled to such a reduction, it is nevertheless in practice understandable that he withheld payment of 20% in the belief that it was only by so doing that the question as to whether he was entitled to such a reduction would be decided at all. In any event, apart from the

failure to pay the full amount of the opposition fee, the Appellant had fully complied with the other requirements under Article 99 and Rule 55 EPC, and his contentions in respect of the grounds of opposition raised should therefore be taken into account in examining and deciding the opposition. This can best be done if the Appellant remains a party to the opposition.

- (b) Furthermore, in this context in the Board's judgment 20% of the opposition fee can properly be regarded as a small amount for the purpose of Article 9 Rules Fees.
- (c) In the Board's judgment, it is therefore justifiable under Article 9(1) Rules relating to Fees to overlook the amount of the opposition fee which was lacking without prejudice to the rights of the Appellant to be an opponent, having regard also to the fact that the missing 20% was in fact paid within two months of expiry of the opposition period during the course of correspondence relating to it.

The opposition fee is therefore deemed to have been paid in due time.

Order

For these reasons, it is decided that:

1. The appeal is allowed.
2. The Decision of the Formalities Officer dated 29 January 1990 is set aside.

3. The opposition fee is deemed to have been paid and the notice of opposition of the Appellant filed, in due time.

The Registrar:

The Chairman:

P. Martorana

K. Lederer