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DECISION
of 17 November 1997

Case Number: T 0343/95 - 3.3.4

Application Number: 88111017.5

Publication Number: 0306655

IPC: A23L 1/182

Language of the proceedings: EN

Title of invention:
Rice product

Patentee:
SOCIETE DES PRODUITS NESTLE S.A.

Opponent:
Riviana Foods, Inc.

Headword:
Rice/NESTLE

Relevant legal provisions:
EPC Art. 102(4)
EPC R. 58(5), 58(6)

Keyword:
"Legitimate expectations"
"Balance of probabilities"

Decisions cited:
G 0005/88, G 0007/88, G 0008/88, G 0001/90, J 0010/84,
J 0003/87, J 0001/90, T 0160/92, T 0069/95

Catchword:
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Chambres de recours

Case Number: T 0343/95 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 17 November 1997

Appellant: SOCIETE DES PRODUITS NESTLE S.A.
(Proprietor of the patent) Case postale 353
1800 Vevey (CH)

Representative: -

Respondent: Riviana Foods, Inc.
(Opponent) P.O. Box 2636, HOUSTON
TEXAS 77252 (US)

Representative: Frankland, Nigel Howard
FORRESTER & BOEHMERT
Franz-Joseph-Strasse 38
80801 München (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office dated 3 April 1995
revoking European patent No. 0 306 655 pursuant
to Article 102(4) EPC.

Composition of the Board:

Chairman: L. Galligani
Members: R. E. Gramaglia
J.-C. Saisset

Summary of Facts and Submissions

- I. European patent Nr. 0 306 655 based upon European application Nr. 88 111 017.5 was granted by a decision of the examining division dated 28 April 1992 with effect from 3 June 1992.
- II. An opposition was filed on 2 March 1993 by Riviana Foods Inc.. In the interlocutory decision within the meaning of Article 106(3) EPC, announced at the oral proceedings on 15 March 1994 and posted on 18 April 1994, the opposition division found that, after taking into account the amendments made by the patent proprietor during the opposition proceedings, the patent met the patentability requirements of the EPC. The patent was therefore maintained in amended form.
- III. On 24 June 1994 the patent proprietor requested permission to use the automatic debiting procedure and filed a list of the applications concerned. The present application was not included in the list.
- IV. By a communication pursuant to Rule 58(5) EPC dated 2 August 1994, the patent proprietor was informed that the interlocutory decision had become final and he was requested inter alia to pay the fee for the printing of the new specification of the European patent and to file the translations of the amended claims within the prescribed time. On page 3 of the communication there was a note to users of the automatic debiting procedure saying that the fee would be debited on the last day of the period for payment.
- V. The translations of the amended claims were filed within the prescribed time. However, since the printing fee was not paid in due time, a communication pursuant to Rule 58(6) EPC dated 15 December 1994 was sent to

the patent proprietor informing him that the printing fee was not paid and that this act could still be validly performed within two months of notification of that communication, provided that a surcharge was paid within this two-month period. On page 2 of this communication there was a note to users of the automatic debiting procedure informing the patent proprietor that the normal time limit for payment of the above fee had already expired on receipt of the automatic debit order that the fee and the surcharge would be debited automatically on the last day of the period of grace.

- VI. On 23 January 1995, the appellant telephoned the EPO and was informed that the present application was not listed in the request for the automatic debiting of fees. He then requested that the case be added to the list and the required fee debited automatically. He was told that this could be done and that no written instructions were necessary since the EPO Cash and Account Directorate already possessed details of the number and holder of the deposit account.
- VII. In spite of this, the fee and the surcharge were not paid within the time limit and the opposition division revoked the patent for failure to comply with the requirements under Article 102(4) EPC in a decision dated 3 April 1995.
- VIII. The patent proprietor lodged an appeal, received on 22 April 1995, against the decision of the opposition division. He requested that the decision under appeal be set aside, that the EPO debit his account in respect of the appeal fee as well as the printing fee and the

appropriate surcharge and that this case be entered in the records for automatic debiting. He also requested oral proceedings if the board intended to take any decision other than that of reversing the decision to revoke the patent.

IX. The respondent (opponent) requested that the appeal be dismissed and that oral proceedings be appointed if the board intended to take a decision to maintain the patent.

X. The appellant argued as follows:

It was clear from his behaviour that he wanted the patent to be maintained. He had not paid the fee due to the fact that he had wrongly assumed that these fees would be debited automatically in accordance with his request. The case did not figure in the list of cases for the automatic debiting procedure because it had already been granted and, therefore, the file had been considered closed by the appellant's automatic control system for fees payable to the EPO. After having spoken with the EPO on 23 January 1995, he further assumed that the fee and the surcharge would be debited. The failure to pay the fee was, therefore, due to a combination of factors, partly because of the patent proprietor's haste to take advantage of the automatic debiting procedure which led to the omission of those granted patents which had been opposed, and partly because of the natural "teething" problems in the early stages of this new procedure which led to confusing and misleading information being given by the EPO. The appellant further submitted that the damage inflicted on the patent proprietor if this appeal were dismissed would be out of all proportion to the moderate sum required for the printing fee and surcharge.

XI. The respondent argued as follows:

The opinion given by the Enlarged Board of Appeal in G 1/90 (OJ EPO 1991, 275) had clarified the procedural requirements for revocation of a patent following non-payment of the printing fee. It was made clear throughout this opinion that non-payment of the printing fees led to the issuance of an appealable decision revoking the patent. This made any dispute concerning the legal requirements impossible. Thus, the only matter which could give rise to questions of facts as well as of law in appeal proceedings against a decision revoking the patent because of non-payment of the printing fee would be the matter of observance of the time limits for procedural acts. In the present case it was not disputed that the fee had not been paid in due time. Indeed, the fee had not been paid solely as a result of errors on the part of the patent proprietor. The decision under appeal was therefore correct in both law and fact. The facts of the case were more appropriate to a request for re-establishment of rights which, however, was not for the board of appeal to decide. The request for re-establishment of rights should have been filed with the first instance within the time limit under Article 122 EPC.

Furthermore, the applicant was aware that the parallel case T 69/95 of 12 January 1996 (not published in the OJ EPO) was already giving rise to similar problems, so that he should have taken all the due care required by the circumstances to avoid them in the present case.

XII. In his last letter received on 11 March 1997, in reply to a board's communication, the respondent developed his argumentation relating to the parallel case T 69/95 (supra) and announced that he wished to have a decision issued on the basis of the file instead of oral proceedings being arranged.

Reasons for the Decision

1. The fact that a request for re-establishment of rights may be filed does not exclude the possibility of filing an appeal against a decision of the opposition division to revoke a patent. This was also made clear in opinion G 1/90 (supra). Furthermore, if, as in the present case, the appellant criticises the behaviour of the EPO, the appeal against the decision taken on the basis of this behaviour is the correct way to establish whether or not the criticism is well-founded. Moreover, because the appeal complies with Articles 106 to 108 and Rule 64 EPC, it is admissible.

2. It is not disputed that the proprietor of the patent did not pay the printing fee within the relevant time limit. Under normal circumstances, this would result in the revocation of the patent under Article 102(4) EPC.
 - 2.1 However, a general and well-founded principle recognised in the case law of the boards of appeal is that of the protection of legitimate expectations. This principle is applicable having regard to the good faith existing between the EPO and its users. Its application to a procedure before the EPO implies that measures taken by the EPO should not violate the reasonable expectations of parties to such proceedings (J 10/84, OJ EPO 1985, 71; G 5/88, G7/88, G8/88, OJ EPO 1991, 137). According to the case law of the boards of appeal, the application of the principle of the protection of legitimate expectations implies inter alia that an applicant must suffer no disadvantage as a result of having relied on a misleading communication of the EPO; on the contrary, if his actions were based on a misleading communication, he is to be treated as if he has satisfied the legal requirements (see J 3/87,

OJ EPO 1989,3 and J 1/90, OJ EPO 1992, 17). The principle of the protection of legitimate expectations governs all procedural actions taken by EPO employees vis-à-vis parties to proceedings including telephone calls, which are not part of the formal procedure (see T 160/92, OJ EPO 1995, 345).

- 2.2 If this principle applies in the present case, then the appellant must be treated as if he has satisfied the legal requirements and the decision of the opposition division should be set aside.
3. The appellant asserts that he failed to pay the printing fee in due time because an employee of the EPO had assured him he would add the file to the list of those subject to the automatic debiting procedure and thus payment would be made automatically without further written instructions being required. The appellant considers he had no reason to doubt the veracity of this statement.
 - 3.1 The appellant states he received this information during a telephone call on 23 January 1995 at 11.15 to extension number 4235 of the EPO, which corresponds to the Cash and Accounts Department. He does not remember the name of the employee to whom he spoke, but to support his submissions he attached a copy of the computer printout of telephone calls from his extension number including the registration of the telephone call with the EPO.
 - 3.2 The board is satisfied that the telephone call took place. Furthermore, the board verified that the extension telephone number 4235 corresponds to the Cash and Accounts department.

3.3 Even if it is not possible to establish beyond any reasonable doubt a posteriori the content of the telephone call in question, the board is of the opinion that, in a case like the present one, it is sufficient that the board is satisfied on the basis of a balance of probabilities, i.e. that one set of facts is more likely to be true than the other.

4. There are many circumstances in favour of the submission of the appellant.

4.1 The board knows that the appellant has had a similar problem in a parallel case (T 69/95 supra). In both cases, he wrongly thought that the file was included in the list of files for which automatic debiting proceedings was applicable. In both cases also he did not pay the printing fee because he relied on the communications from the EPO, which gave him the impression that the files were on this list. However, it is clear from case T 69/95 (supra) that it was only the decision of the opposition division dated 10 January 1995 which made the patent proprietor aware of the fact that the printing fees had not actually been paid in both cases. Immediately after receiving this decision the patent proprietor filed an appeal against it (i.e. appeal file T 69/95 supra) and called the EPO in order to request that the present case be added to the list and that the required corresponding fee be debited automatically.

4.2 In the opinion of the board it is very likely that he called to ask for an explanation and to make sure that in the present case he would not have the same problem as in case T 69/95 (supra). On that date, the present case was at an earlier stage of the proceedings than T 69/95 (supra) and it would therefore still have been possible to find a remedy.

4.3 The telephone call took place a long time before the expiry of the time limit for the payment of the printing fee. The board can find no logical reason, especially taking into account the fact that his interest in the file had made him contact the EPO, why he would not have made the payment, had he known it was not to be processed automatically. The appellant's interest in the file and willingness to comply with all the necessary requirements for the printing of the new specification are supported by his filing in due time the translations of the amended claims. This was done with a standard letter in which the last line "payment voucher for the grant and printing fees" was crossed out since he assumed that the fees would have been debited automatically.

4.4 The board is therefore satisfied that the content of the telephone call with the EPO is more likely to have been as the appellant said. It considers that it is not necessary to have a sworn statement of the applicant on this point.

5. The reply by the EPO's employee was not misleading in itself, but the fact that it was not followed by the action expected by the appellant according to the communication has the same effect and must therefore be considered in the same way.

5.1 The appellant had no reason to doubt the correctness of the communication. On the contrary, it would seem perfectly reasonable to him, particularly at this late stage of the proceedings and where the amount of the fee required was very little, since the object of the automatic debiting procedure is to simplify matters and avoid unnecessary administration. In addition, he knew that the EPO Cash and Accounts Department already possessed details of the number and holder of the deposit account.

6. Calling the EPO to make sure that no problems would arise, the appellant did all that was necessary from his point of view to find a remedy for the situation. In the board's opinion, the reason why the fee was not paid is because the EPO's employee did not do what he had said he would do.

7. Since the conditions for the application of the principle of legitimate expectations are fulfilled, the appellant should be treated as if he had complied with the procedural requirements. The decision of the opposition decision is therefore to be set aside.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the first instance for further prosecution.

The Registrar:



D. Spigarelli

The Chairman:



L. Galligani

