

ET0167.97- 990360006

Decision of Technical Board of Appeal 3.2.2 dated 16 November 1998

T 167/97 - 3.2.2

(Language of the proceedings)

Composition of the board:

Chairman: W. D. Weiß

Members: C. Holtz

M. Bidet

Patent proprietor/Appellant: NN AG

Opponent/Respondent: YY GmbH

Headword: Admissibility

Article: 108, 122 EPC

Keyword: "Re-establishment - inadmissible" - "Omitted act - inadmissible grounds of appeal" - "Appeal - inadmissible"

Headnote

I. The requirement of Article 122(2), second sentence, EPC that the "omitted act" must be completed within the prescribed period implies that the completed act also must meet the requirements of the EPC - ie in the present case that the statement of grounds of appeal is admissible for the purpose of Article 108, last sentence, EPC.

II. Where the statement of grounds filed with the request for re-establishment is insufficient for the appeal to be declared admissible, the request for re-establishment must itself be declared inadmissible.

Summary of facts and submissions

I. This decision concerns the appellant's request for re-establishment as regards the time limit for filing the statement of grounds of appeal under Article 108 EPC, and the admissibility of the appeal as a whole.

The decision under appeal is dated 19 December 1996. The appellant filed a notice of appeal on 11 February 1997 and paid the appeal fee on 14 February 1997.

II. On 19 December 1997, the registrar of the Boards of Appeal despatched a communication pursuant to Article 108 EPC and Rule 65(1) EPC, informing the appellant that a written statement setting out the grounds of appeal against the decision of the opposition division had not been filed. The appellant's representative responded in a letter received on 14 February 1998, in which he set down the reasons why the grounds of appeal had not been submitted, requesting re-establishment and enclosing two letters, one being a copy of the notice of appeal which had been received by the EPO on 11 February 1997 via fax, and the second being a statement, entitled "Statement of Grounds for refuting Opposition by YY GmbH." The fee for re-establishment was paid on 5 February 1998.

III. The Board of Appeal issued a communication, provisionally holding that the request was not allowable, mainly on the grounds that there was doubt as to whether all due care had been taken as required by the circumstances (Article 122(1) EPC) and that Article 122(2), second sentence, EPC seemed not to have been met, since the statement enclosed with the request appeared to be a copy of the appellant's original response to the opposition, filed in the opposition proceedings before the opposition division, but not dealing with the issues of the decision under appeal.

IV. The representative of the appellant explained that the delay in filing the statement of grounds was caused by a heart condition from which he had suffered for a number of years, starting in 1992/93. Shortly before filing the notice of appeal in February 1997, he had visited his client and while there had been taken ill. His original intention was to have checked the statement of grounds before filing it. As a result of his heart attack, however, he sent the statement of grounds already the next day. Having received the notice of appeal back, since the address had not been adequate, but not the statement of grounds although equally inadequately addressed, the representative assumed that the latter had been received by the EPO. He had therefore been very surprised to find out, almost a year later through the communication of 19 December 1997 from the registrar of the boards of appeal, that this statement was missing.

In response to the communication by the Board, the appellant pointed out that he had taken precautions to have someone to look after his work in case he fell ill. In the present case, he denied having fallen ill, but he had had symptoms of high blood pressure, which was the reason why he decided to send the draft grounds without checking them further. These grounds contained several pages of responses to the opponent's objections. From them it should be realised that to produce such a document took time and more than likely consultation with other persons.

Since the representative had sent the grounds within the specified time scale, had been advised by the EPO that all the requisite papers had been filed (although the EPO receipt had not specified the papers received, as the representative had not used a standard form), the EPO had ignored the grounds of appeal on file, and the representative had sent replacement documents by effective return of post, he was of the opinion that he had filed adequate explanations or reasons relating to the situation.

Reasons for the decision

1. The request for re-establishment and the corresponding fee have been submitted within the time limit stipulated in Article 122(2) and (3) EPC. However, Article 122(2), second sentence, EPC also requires that the omitted act must be completed within this time limit. The Board must therefore examine whether the omitted act, ie for the present case a statement of grounds of appeal, was duly filed.

2. The question arises whether the omitted act, in this case the grounds for appeal, to be completed under Article 122(2) EPC not only must be filed within the time limit given in that Article, but also must meet the same criteria for admissibility as grounds of appeal filed in due time, to be sufficient in content to serve as a proper foundation for the appeal review. In other words, if the grounds of appeal are considered insufficient, should the request for re-establishment be rejected as inadmissible?

3. The object of re-establishment is to enable the proceedings to be resumed as if the omitted act had been undertaken within the prescribed time limit. This is the main reason for the requirement in Article 122(2), second sentence, EPC that the omitted act be completed. If this act - in the present case a statement of grounds for the appeal - is considered in itself to be inadmissible by virtue of the established case law of the Boards of Appeal, having regard to the minimum standards for such grounds, the proceedings cannot be resumed as intended. A decision to allow the request for re-establishment in spite of such a deficiency would have to be followed by an examination of the same grounds, which would lead to a rejection of the appeal itself as inadmissible, which seems to include an unnecessary step. It is therefore concluded that where the statement of grounds filed with the request for re-establishment is insufficient for the appeal to be declared admissible, the request for re-establishment must itself be declared inadmissible. The requirement of Article 122(2), second sentence, EPC that the "omitted act" must be completed within the prescribed period therefore implies that the completed act must meet the requirements of the EPC - ie in the present case that the statement of grounds of appeal is admissible for the purposes of Article 108, last sentence, EPC. If this is not the case, the substantial prerequisite for re-establishment that the party in question

must have shown all due care required by the circumstances (Article 122(1) EPC) is not to be examined.

4. Sufficiency of the grounds of appeal

4.1 Grounds of appeal may be declared insufficient when they are deficient to the extent that they do not allow the Board or the other party to prepare the case properly; see for example decisions T 220/83 (OJ EPO 1986, 249) and T 432/88 of 15 June 1989, which established that mere references to earlier submissions or documents do not suffice. Decision T 250/89 (OJ 1992, 355) contains an overview of pertinent case law. Under this case law, grounds of appeal should as a rule set out the legal and factual reasons why the decision under appeal should be set aside. They should also according to decision J 22/86 (OJ EPO 1987, 280), set out fully the reasons why the appeal should be allowed and the decision under appeal be set aside. The Board in decision T 250/89 concluded that while it was permissible to look for the grounds of appeal in the notice of appeal, the latter must still meet the same requirements, as in cases where the grounds had been submitted in a separate statement.

4.2 In the decision under appeal, the opposition division found EP-A-0 334 594, a prior art document under Article 54(3) and (4) EPC, to be novelty-destroying with regard to claim 1, whereas claim 6 lacked inventive step, having regard to document DE-A-3 047 538. The patent was revoked on the basis of these two main arguments.

4.3 As is already established under the case law of the Boards of Appeal, the distinction between the sufficiency of the presentation of a party's case, eg what is needed for the appeal to be properly understood as to its intent and limitation, and the strength of that same party's case must be upheld (see decisions related to the sufficiency question in connection with admissibility of notices of opposition, eg T 222/85, OJ EPO 1988, 128). Parallel to this case law, it would seem appropriate to set the standard that grounds of appeal filed for the purposes of Article 122(2), second sentence, EPC should be rejected as inadmissible if it is clear from the

submission itself that it does not contain anything to make it possible to understand what is to be reviewed on appeal. Grounds of appeal containing references to questions discussed before the department of first instance, but which on closer examination reveal that they are not relevant or convincing enough, could therefore, depending on the facts of that case, be considered sufficient in this respect. In other words, the statement of grounds of appeal should make it possible for the deciding body to understand it without having recourse to other file material than the decision under appeal.

4.4 In the present case, the submissions filed on 14 February 1998 with the request for re-establishment contain a letter consisting of five pages, dated 9 February 1998 and setting out the reasons why the statement of grounds was not filed on time, an undated letter of two pages, which is a copy of the fax by which the notice of appeal was originally filed, and a second undated statement, consisting of five pages, which is a copy of a statement that was filed during the opposition proceedings.

4.5 The latter, titled "Statement of Grounds for refuting Opposition by YY GmbH", contains a discussion of some points made in the notice of opposition. This statement was originally filed by telecopy on 22 July 1996 in response to an invitation by the opposition division to comment on the notice of opposition.

4.6 Self-evidently, given the early stage of the opposition proceedings at which this statement was filed, the findings of the opposition division are not discussed, nor is there a discussion of the significance of any of the documents cited by the opponent. If the Board were to venture a conclusion, it would be that the appellant filed the wrong grounds as a response to the registrar's communication of 19 December 1997.

4.7 Turning now to the notice of appeal, the Board finds that, while mentioning the finding of the opposition division as to the novelty of claim 6, to which the appellant agrees, this submission only sets out the *intention* of the appellant to argue that "the Examiners have totally failed to appreciate the many practical significances of the

technical advance of the Applicant's invention over the various items of prior art". The notice does not contain any discussion of any of the technical teachings of this prior art as discussed either by the opponent or the opposition division, but only enumerates the documents cited.

4.8 Neither the notice of appeal, nor the document purporting to constitute the grounds of appeal thus contains anything regarding the decision under appeal or the issues discussed in the opposition proceedings which would reveal any arguments of the appellant pertinent to this decision, nor any other substantiation of the appeal. The Board and the opponent are therefore left to conjecture what the issues are that are being raised by the appeal which should be reviewed by the Board. In other words, the appeal is not substantiated as required by, for example, decisions T 432/88 (point 3 of the reasons) or T 222/85. The Board must therefore conclude that the "omitted act" was not completed in accordance with the conditions set out in Article 122(2), second sentence, EPC.

5. The statement filed with the request for re-establishment not being sufficient to establish an admissible appeal, and no other grounds of appeal having been filed within the time limit for appeal, the request for re-establishment has to be rejected as inadmissible.

6. Accordingly, the substantive question whether all due care was taken as required under Article 122(1) EPC cannot be examined.

Order

For these reasons it is decided that:

1. The request for re-establishment is rejected as inadmissible.
2. The appeal is rejected as inadmissible.