

DECISIONS OF THE BOARDS OF APPEAL

Decision of Technical Board of Appeal 3.2.5 dated 25 October 1999

T 517/97 - 3.2.5

(Translation)

Composition of the board:

Chairman: A. Burkhart

Members: W. Moser

C. G. F. Biggio

Patent proprietor/respondent: THE PROCTER & GAMBLE COMPANY

Opponent/appellant : Henkel KGaA

Intervener I: Unilever PLC

Intervener II: Lever Brothers Ltd

Headword: Intervention/UNILEVER

Article: 80, 105, 106(1), 107 EPC

Rule: 83(1) EPC

Keyword: "Faxed withdrawal of appeal by sole appellant, followed on same day by Intervener I's faxed declaration of intervention" - "Appeal proceedings pending (no)" - "Notices of intervention from Interveners I and II deemed filed (no)" - "Fees paid by Interveners I and II refunded (yes)"

Headnote

I. If the precise time of day at which the EPO receives notice of withdrawal of appeal can be established, then withdrawal is effective from that moment (Reasons point 4).

II. If the sole appellant's notice of withdrawal of appeal and a notice of intervention are filed by fax on the same day, the chronological order in which they arrive must be taken into account, because for a notice of intervention to be valid the appeal proceedings must be pending when it is filed (Reasons point 5).

Summary of facts and submissions

I. In its interlocutory decision dated 2 May 1997, the opposition division maintained European patent No. 0 343 069 in amended form.

II. On 10 May 1997, the sole appellant (opponent) lodged an appeal against that decision, and paid the fee for appeal. On 10 September 1997, a statement of the grounds of appeal was filed.

III. In a fax received by the EPO at 16.09 hrs on 29 May 1998, the sole appellant withdrew his appeal. On 2 June 1998, the EPO received a letter of confirmation reproducing the contents of the fax.

IV. In a fax received by the EPO at 20.12 hrs on 29 May 1998, Intervener I (Unilever PLC) filed a notice of intervention. On the same day, it paid opposition and appeal fees totalling DEM 3 200. On 12 June 1998, the EPO received written confirmation reproducing the contents of the fax.

V. In a letter received by the EPO on 27 July 1998, Intervener II (Lever Brothers Ltd) filed a notice of intervention. On the same day, it paid opposition and appeal fees totalling DEM 3 200.

VI. On 18 February 1999, the board issued a communication to the interveners and the patentee, expressing its provisional view that appeal proceedings were no longer pending when the notices of intervention were filed.

VII. On 25 October 1999, oral proceedings were held before the board.

VIII. The interveners' arguments, advanced in writing and at the oral proceedings, may be summarised as follows:

(a) Nothing in the EPC permitted distinctions to be drawn between events taking place at different times on the same day; otherwise patent attorneys would find themselves in very difficult positions in respect of their clients, and parties living in different time zones could not be treated fairly. Withdrawal of the appeal in the present case could therefore take place or come into effect only at midnight, not at some arbitrary point during the day. To accept that a procedural act could occur at a specific time in a day would lead to some very awkward situations.

(b) Nothing in the EPC or the historical documentation suggested that there was ever any intention of considering periods shorter than one day. All time limits were expressed in terms of years, months, weeks or full days; nothing shorter could be used. No time limit laid down in the Convention or set by the EPO expired at any other time than midnight.

(c) For the EPO, in virtually all cases, the only chronological demarcation between events was whether they occurred in Munich before or after midnight. The EPO made clear provision for this cut-off time, taking special measures accordingly. The EPC did not specify any shorter time-span, or allow for any "relativity" between events occurring during a single day - which, with the sole exception of oral proceedings, were considered as simultaneous.

(d) That events occurring on the same day were "simultaneous" was a general principle of patent law, recognised not only by the EPO but also by Europe's national legal systems. To arrange them in the chronological order in which documents reached the EPO would be in breach of the principle of equal treatment, because it could adversely affect parties living in different time zones.

(e) The reason why events occurring on the same day (eg receipt of documents) were generally held to be simultaneous was that long-standing practice sought to maintain procedural legal certainty and ensure equal treatment of all parties.

(f) Before filing an application, the applicant might disclose his invention to the whole world, but that disclosure was not novelty-destroying if he correctly filed his application that same day.

(g) According to point 7.1 of the Notice from the European Patent Office dated 2 June 1992 concerning the filing of patent applications and other documents (OJ EPO 1992, 306; hereinafter "EPO Notice"), on Fridays the EPO closed at 15.30 hrs. So the sole appellant's submission had also arrived late.

(h) The EPC and the EPO Notice both regarded any document received before midnight (Munich time) as having been filed the same day. Effectively, therefore, Intervener I's notice of intervention had reached the EPO on the same date - Friday, 29 May 1998 - as the sole appellant's letter, and had thus been filed whilst appeal proceedings were still pending.

(i) G 4/91 (OJ EPO 1993, 339) had ruled that a third party could not intervene by filing documents several weeks after opposition proceedings had effectively been closed, but it did not say how the precise moment of closure was to be determined.

(j) G 1/94 (OJ EPO 1994, 787) had ruled that a third party could intervene before appeal proceedings had been closed, and said that appeal and opposition proceedings were to be considered as equivalent in this respect. It did not however indicate how the precise moment of closure of appeal proceedings was to be determined. G 4/91 and G 1/94 were not at odds with the view that withdrawal of an appeal took effect at the end of the day on which notice of withdrawal had been filed.

(k) According to G 8/91 (OJ EPO 1993, 346), appeal proceedings could not be pursued simply because a board believed it had reasons to do so. Nor, according to G 8/93 (OJ EPO 1994, 887), might they be pursued - where the sole appellant had withdrawn his appeal - because the board or the patentee so wished. However, G 8/93 did not specify when withdrawal took effect; its English text said only that it led "directly" to closure of the proceedings, whilst the word "unmittelbar" in its German text did not mean "instantaneously".

(l) According to G 8/91, in trying to ensure that it granted and maintained only valid European patents the EPO was constrained by generally recognised procedural principles, unless there were serious reasons for making exceptions. Consequently, its established practice was to regard documents received the same day as having arrived simultaneously. In such cases, therefore, the EPO had no call to take account of precisely when they had been received - which it usually could not determine with certitude anyway.

(m) J 28/94 (OJ EPO 1997, 400) had established that after proceedings had been initiated a third party could prevent the performance of subsequent procedural acts. However, this did not mean that withdrawal of an appeal took effect at the precise moment when the intention to withdraw it became apparent; rather, it showed how third parties could intervene in EPO proceedings "at the eleventh hour".

(n) The present case was not comparable to those in which a sole appellant withdrew his appeal during oral proceedings, before notice of intervention had been filed. Had oral proceedings been scheduled, the interested parties would have been informed beforehand.

(o) It was not possible to be certain whether the EPO fax machine recorded the date of a document's actual receipt or that on which it was printed on paper from a temporary electronic memory. Nor should parties be penalised if a fax machine could establish the order in which documents arrived.

IX. The patentee's arguments, advanced in writing and at the oral proceedings, may be summarised as follows:

(a) Intervener I's faxed letter of intervention had reached the EPO after the sole appellant's letter. So when the EPO had received it, the appeal proceedings had already been closed. Also, it had arrived at 20.12 hrs, ie outside normal EPO working hours (see also T 798/95 of 6 December 1995).

(b) G 8/93 merely confirmed the principle established by G 8/91.

According to G 8/93, if the opponent was sole appellant, receipt of the notice withdrawing the opposition gave rise to immediate closure of the appeal proceedings. It had to be stressed that it was the receipt of the notice of withdrawal which resulted in immediate termination of the proceedings.

(c) J 28/94 primarily concerned an appeal's suspensive effect. The underlying circumstances were completely different from the present case.

(d) In T 798/95, the board had ruled on procedural acts occurring the same day. It had found the request for amendment to be inadmissible because it had been filed after the normal hours during which the EPO post room despatched grant decisions.

(e) Faxing of documents was a method of communication, explicitly authorised by the EPO and acknowledged as reliable by its President, which happened to indicate the precise date and time of a document's arrival at the EPO. So the board could rule in the present case on the legal consequences of established facts.

X. Interveners I and II ask that their interventions be ruled admissible, and the patent in suit be revoked.

The patentee asks that the interventions be ruled inadmissible.

Reasons for the decision

1. Intervention of the assumed infringer in appeal proceedings under Article 105 EPC presupposes that those proceedings are still pending when the notice of intervention is filed (see G 1/94); otherwise, the notice is deemed not filed.

2. An intervening assumed infringer who becomes an independent appellant may pursue the appeal proceedings if the sole (original) appellant withdraws his appeal after the notice of intervention is filed (see T 1011/92 of 16 September 1994). But if those proceedings are no longer pending when the notice of intervention is filed, that notice is deemed not filed (see point 1 above) and the appeal proceedings are closed (see G 8/91).

3. So the issue here is whether the appeal proceedings were still pending when Intervener I filed notice of intervention.

3.1 Withdrawal of an appeal by an opponent who is sole appellant gives rise to immediate closure of the appeal proceedings in respect of the substantive issues decided by the opposition division (see G 8/91 and G 8/93). The appeal's suspensive effect under Article 106(1) EPC then lapses, and the opposition division's decision becomes final for the substantive issues (see G 8/91, Reasons point 11.2).

3.2 Such withdrawal may be effected either orally, if it occurs in oral proceedings, or in writing. In the former eventuality, the appeal proceedings as regards the substantive issues are closed immediately withdrawal is declared; in the latter, they are closed as soon as the EPO receives the notice of withdrawal. Consequently, if the exact time of day when the EPO receives a faxed notice withdrawing an appeal can be established with certainty, then that is when the appeal proceedings cease to be pending.

3.3 In the present case, the sole appellant's appeal was withdrawn by fax sent by his duly authorised professional representative and received by the EPO on 29 May 1998 at 16.09 hrs. On 2 June 1998, a letter confirming the fax was filed. Intervener I's notice of intervention was likewise sent by fax by his duly authorised professional representative on 29 May 1998, but not received by the EPO until 20.12 hrs. On 12 June 1998, written confirmation reproducing the contents of the fax was filed.

3.4 Under point 2.1 of the EPO Notice, in any EPO proceedings subsequent to the filing of a European or international application, documents may be filed *inter alia* by fax. Documents relating to pending appeal proceedings must be filed with the filing offices in Munich (*ibid.*, point 2.2). Unless they are annexes, such documents must be signed; in the case of faxes, reproduction of the signature counts as a signature (*ibid.*, point 3). Lastly, subsequent written confirmation reproducing the contents of faxed documents is necessary only in the cases specified in point 4.2 of the EPO Notice.

3.5 The faxes from the sole appellant and Intervener I comply with the EPO Notice. Under the terms of the EPO Notice, subsequent written confirmation reproducing the contents of the two faxes was not actually required. Consequently, they are considered to have been received by the EPO on 29 May 1998 at 16.09 and 20.12 hrs respectively.

3.6 From this it follows that the sole appellant's appeal had been withdrawn before Intervener I's notice of intervention was filed. The appeal proceedings were therefore no longer pending when the notice was submitted.

4. The interveners argue that the appeal's withdrawal could not take effect until midnight, on the grounds that nothing in the EPC allows a procedural act to take effect at some specific time during the day. The board does not share this view.

According to generally recognised principles of procedural law, the appellant alone decides whether his appeal is to stand; other parties to the proceedings within the meaning of Article 107, second sentence, EPC - like the present patentee - have no independent right of their own to continue appeal proceedings if the appellant withdraws his appeal (see G 2/91 [OJ EPO 1992, 206], Reasons point 6.1). Furthermore, in accordance with the principle of free disposition of parties, an appellant's withdrawal of his appeal is a procedural act not requiring the consent of the relevant board (see G 8/91, Reasons point 8) or of the other parties to the proceedings. Nor can the latter challenge such withdrawal. Lastly, no time limit applies here which would require taking account of Rule 83(1) EPC. Consequently, withdrawal of an appeal is an act of procedure which has immediate effect; it may be validly performed even outside EPO office hours.

Thus if an appellant gives oral notice of withdrawal during oral proceedings, the withdrawal is valid with immediate effect as soon as he does so. By the same token, if he gives it in writing it is valid as soon as the EPO receives it.

The board takes the view that these two acts of procedure must be regarded as equivalent. Consequently, if the exact time of day when the EPO receives notice of withdrawal of an appeal can be established, that is when the withdrawal takes effect. Nothing in the EPC - notably Article 80 and Rule 83(1) EPC (see above) - or the EPO Notice stands in the way of that.

5. If, therefore, during the same day, the sole appellant gives notice of withdrawal and a notice of intervention is filed, and if, furthermore, the chronological order of both events can be established with certainty, then that order must be taken into account, because a notice of intervention is only valid if the appeal proceedings are still pending when it is filed (see point 1 above). If, on the other hand, that order cannot be determined, the appeal proceedings must be regarded as pending when the notice of intervention was received.

6. The view that an appeal's withdrawal can take effect at a specific time of day is wholly compatible with the reasons and orders of G 8/91 and G 8/93. G 8/93 in particular makes clear that an act of procedure which really does constitute notice of the sole appellant's withdrawal of his appeal gives rise immediately to closure of the appeal proceedings.

The other decisions cited by the interveners are not relevant, because they do not relate to withdrawal of an appeal and its effects.

7. According to point 5.2 of the EPO Notice, documents filed by fax at an EPO filing office are considered to have been filed on the date on which they are received at the EPO. As certain documents have to be filed within specific time limits, the date and time given on a fax cannot be anything other than the exact moment of its receipt by the EPO.

8. In the light of the foregoing, the notices of intervention from Interveners I and II were filed after the sole appellant's withdrawal of his appeal had taken effect. Accordingly, they are deemed not to have been filed, and the appeal proceedings are closed (see point 2 above). The interlocutory decision appealed against by the sole appellant therefore becomes final as regards the substantive issues (see point 3.1 above).

9. Since the notices of intervention are deemed not filed, the fees paid for them by Interveners I and II were not due and must be refunded.

Order

For these reasons it is decided that:

1. The notices of intervention from Interveners I and II are deemed not filed.
2. The fees paid by Interveners I and II, totalling DEM 3 200 per intervener, are to be refunded.
3. The appeal proceedings are closed.