

*Amicus Curiae Brief*

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to the Enlarged Board of Appeal of the EPO  
concerning referral G1/18

Dear Chair and Members of the Enlarged Board,

In the question referred in case G1/18, three scenarios are identified:

- A) a Notice of appeal is filed after expiry of the appeal period, but the appeal fee is paid within the appeal period;
- B) the appeal fee is paid after expiry of the appeal period, but the Notice of appeal is filed within the appeal period;
- C) the appeal fee is paid after expiry of the appeal period and the Notice of appeal is filed after expiry of the appeal period.

The question asked is whether in each of these scenarios, the appeal is inadmissible or is deemed not to have been filed, and whether the appeal fee must be reimbursed (OJ 2018 A71).

**Scenario B: only appeal fee late**

- 1) For scenario B, it appears relevant that according to the EPO Guidelines for Examination 2018 (GL), A-X 10.1.2, “[the] payment of a fee after expiry of the applicable time limit is not valid and must be refunded, unless a valid request for further processing has been filed.”  
The Enlarged Board is of course by no means bound by the Guidelines. I discuss whether the Enlarged Board should overrule GL A-X 10.1.2 hereinafter (in para. 13).
- 2) According to GL A-X 10.1.2, a payment of an appeal fee (on its own) is not valid if the payment act is carried out by the payer after expiry of the appeal period (i.e. the two-month period under Article 108 EPC).
- 3) It appears that if the payment of the appeal fee is invalid, the second sentence of Article 108 EPC continues to apply, and any earlier filed Notice of appeal “shall not be deemed to have been filed”. This is so irrespective of the reason why the payment is invalid, for instance because it is made by cheque or in a currency other than Euro, and hence also if the payment is invalid under GL A-X 10.1.2.
- 4) In particular, it seems that the phrase “until the fee for appeal has been paid” in Article 108 EPC, second sentence, is to be understood as referring to a legally valid payments only, thereby excluding invalid payment acts.

In my view, it is a basic principle that references to acts in law texts (such as the EPC) are to be interpreted as referring to legally valid acts; however, in the context of the referred question it seems desirable that this is analysed explicitly in G1/18.

- 5) An appeal fee as such therefore cannot be validly paid after expiry of the appeal period. Accordingly, the appeal fee can neither be “paid” in the sense of Article 108 EPC, second sentence after expiry of the appeal period.<sup>1</sup>
- 6) Accordingly, scenario B appears to be not possible if in the referred question, a valid payment is meant with the phrase “the appeal fee is paid after expiry of the two-month time limit under Article 108 EPC”, rather than mere attempted payment. Because the referred question is a legal one, I assume that the more legalistic meaning of “valid payment” is intended in it. I discuss the situation under the alternative interpretation, of mere attempted payment hereinafter (in para. 15).
- 7) The decision leading to the referral (T1897/17) concerned a case of a request for re-establishment of rights in view of a missed appeal period (this was also the case in T2017/12 which led to G2/14, however not in T1553/13 which led to G1/14). GL A-X 10.1.2 indicates that a fee can be validly paid after expiry of the period if a valid request for further processing is filed. Because the referred question does not indicate that a request for re-establishment is part of any of the three indicated scenarios, I do not consider the issue to be part of scenario B. Nevertheless I analyse the question of how this rule applies (by analogy) to re-establishment of appeal fees hereinafter (in para. 17).

**Scenario A: only Notice of appeal late**

- 8) As to scenario A, it is submitted that the appeal fee cannot be paid (in the legal sense, i.e. validly) before the fee becomes due. In particular, GL A-X 5.1.1 states that “[a] fee may not be validly paid before the due date. (...) Payments made before the due date which are not valid may be refunded by the EPO.” Rule 51(1) EPC gives an exception for renewal fees, but that exception is not relevant here.  
Furthermore, an appeal fee becomes due upon the filing<sup>2</sup> of the Notice of appeal (GL A-X 5.2.6), i.e. not already on the date the appealable decision is issued. In scenario A, it is assumed that the appeal fee is “paid” before the Notice of appeal is filed. However, if payment of the appeal fee is attempted before the Notice of appeal is filed, and hence before the appeal fee is due, the payment is invalid according to GL A-X 5.1.1.
- 9) Hence, scenario A is not possible, in the sense that the fee cannot be validly paid in the given circumstances.
- 10) There is a nuance in GL A-X 5.1.1. In particular, “[if] payment is made shortly before the due date, it is possible that the EPO will not return the payment. In this case, however, payment only takes effect on the due date” (GL A-X 5.1.1). Still, even if the EPO retains the appeal fee amount for the remaining part of the appeal period, or even until the filing of the Notice of appeal after expiry of the appeal period, this does not change the date of payment, which is the date on which the Notice of appeal is filed, this being the due date (leaving aside the question of whether or not the payment on the due date is invalid under GL A-X, 10.1.2 if the due date

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<sup>1</sup> Hence, I agree with the observations in para. 7 of the *amicus* brief of DeltaPatents in the present case G1/18.

<sup>2</sup> The term “filing” appears to be used in GL A-X 5.2.6 notwithstanding Art. 108, second sentence.

Article 4(1) Rfees uses a different phrase, namely: “the date of receipt of the request for the service incurring the fee concerned”. Even if a request is deemed to be not filed, it will have a date of receipt.

is after expiry of the period). Hence, this nuance does not change the above conclusion that scenario A is not possible.

### **Scenario C: appeal fee and Notice of appeal both late**

- 11) As discussed for scenario B, the payment of a fee after expiry of the applicable time limit is not valid (GL A-X 10.1.2). Hence, the appeal fee is not validly paid. It seems that in this respect, there should be no difference between a timely filed Notice of appeal and a late filed Notice of appeal, and any case not in the disadvantage of the timely filed Notice of appeal.
- 12) Hence, scenario C appears to be not possible, in the sense that the appeal fee cannot be validly paid in such a way.

### **Further remarks**

#### Comments on GL A-X 10.1.2

- 13) The President's referral and the underlying decision T 1897/17 both do not challenge GL A-X 10.1.2. The present *amicus* brief also does not aim for a change of the EPO practice according to which "the payment of a fee after expiry of the applicable time limit is not valid and must be refunded", even though this rule does not seem to have explicit legal basis in the EPC. As indicated in the *amicus* brief of Mr. Mayo in the present case (G1/18), Article 125 EPC can possibly be seen as providing the legal basis.
- 14) Considering that GL A-X 10.1.2 has a broad scope of application, it is suggested that the Enlarged Board explicitly mentions that it overrules GL A-X 10.1.2 if it should reach the conclusion that an appeal fee can validly be paid (of its own) after expiry of the appeal period.

#### Attempted payment

- 15) If the question is modified to pertain to cases wherein the appeal fee is *attempted to be* paid, then the appeal fee payment is invalid by operation of GL A-X 10.1.2 in the case that the payment is attempted after expiry of the appeal period (scenarios B and C). Accordingly the Notice of appeal is deemed to be not filed under Article 108 EPC, second sentence. For scenario A, the appeal fee payment can take effect only on the day of filing of the Notice of appeal under GL A-X 5.1.1, but then the payment appears still invalid under GL A-X 10.1.2. Hence the appeal is (again) deemed to be not filed under Article 108 EPC, second sentence.
- 16) In case a payment of an appeal fee is invalid, the sanction is given by Article 108 EPC, second sentence, even though Rule 101(1) EPC specifies that an appeal is rejected as inadmissible if it does not comply with Article 108 EPC. Rule 101(1) EPC is indeed fully applicable for the third sentence of Article 108 EPC about the statement of grounds of appeal. However Rule 101(1) EPC does not overrule the second sentence of Article 108 EPC which itself already gives a sanction if an appeal fee is not paid: the appeal "*gilt erst als eingelegt, wenn die Beschwerdegebühr entrichtet worden ist*".

In my view, Article 108 EPC, second sentence, can be interpreted as providing firstly for the legal fiction that the (actually received) Notice of appeal is not filed (which legal fiction is applied until the appeal fee is paid) and secondly for the legal fiction that the Notice of appeal

is filed at the date of payment of the appeal fee (which date can very well be within the appeal period); this second legal fiction is applied once the appeal fee is validly paid.<sup>3</sup>

*Payment of an appeal fee with re-establishment*

- 17) It may be asked whether a fee can be validly paid after expiry of a period if a request for re-establishment is filed. I realize that this is not what is asked in the referral; the referral question does not mention re-establishment (paras. 80-84 of the referral memorandum merely deal with late filed requests for re-establishment). I still consider the issue relevant to discuss here, because in both T 1897/17 and G 2/14 the case concerned a (refused) request for re-establishment of rights in view of a missed appeal period. Since an appeal fee can (beyond doubt) validly be paid after expiry of the appeal period if a request for re-establishment is granted, re-establishment clearly can make a difference for the second part of the referral question, which asks whether the appeal fee must be reimbursed.
- 18) GL A-X 10.1.2 provides that the payment of a fee after expiry of the applicable period is not valid and must be reimbursed “unless a valid request for further processing has been filed.”<sup>4</sup> It appears that this “unless clause” applies equally for a granted request for re-establishment: the payment is valid and is not reimbursed. The more difficult question is whether the appeal fee is to be reimbursed if the request for re-establishment is rejected. For this question, it seems useful to first analyse by which mechanism the payment of an appeal fee after expiry of the appeal period can be made valid by re-establishment.
- 19) The (written) request for re-establishment makes the re-establishment fee due according to Article 4(1) Rfees (“[if] no due date is specified, the fee is due on the date of receipt of the request for the service incurring the fee concerned”). This does not necessarily mean that only the fee for re-establishment becomes due. In particular, a request for re-establishment can possibly be seen as also making the appeal fee due (again), if payment thereof is the omitted act of Rule 136(2) EPC. In this way, the possibility to validly pay the appeal fee after expiry of the appeal period with a request for re-establishment would be fully consistent with GL A-X 10.1.2.  
Alternatively, Rule 136(2) EPC, second sentence, can be seen as providing an exception to GL A-X 10.1.2, in that it states that “[the] omitted act shall be completed within the relevant period for filing the request [for re-establishment]”. In case that the omitted act is payment of a fee, this may provide for valid payment of the fee after expiry of the missed period even if the fee is no longer due.
- 20) GL A-X 10.1.2 does not address the effect of an invalid request for further processing or of an invalid request for re-establishment. The following is observed. The re-establishment fee is refunded if it is paid after expiry of the period for requesting re-establishment (GL A-X 10.1.2); it is submitted that the same may apply for an underlying fee which is paid as part of a late filed request for re-establishment. If the request for re-establishment is refused as admissible but unallowable (e.g. because the requirement of due care was not met), the appeal fee was in my

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<sup>3</sup> The English and the French version are formulated in the negative and hence express less clearly that the second sentence of Art. 108 creates a legal fiction.

<sup>4</sup> The quotation is from GL A-X 10.1.2. Under Rule 135 EPC, payment of the further processing fee constitutes the request for further processing and no written request for further processing needs to be filed.

view paid duly and timely as part of the re-establishment request, or at least in close connection with that request. Refund of the appeal fee therefore does not seem to be fully justified. In case the request for re-establishment is refused as inadmissible, there appears to be no good reason to treat the two fees differently: both became due by the request for re-establishment (or at least payable thereby) and both were paid as part of that request (or at least in connection with it). However, irrespective of how these more difficult cases are analysed, it is submitted that at least a granted request for re-establishment has a clear-cut and highly relevant effect: with re-establishment granted, the appeal fee is not reimbursed even if paid after expiry of the appeal period, whereas the fee is reimbursed (as not validly paid) in the absence of any request for re-establishment.

Comments on the referral

- 21) ara. 41 of the referral appears to say that a *conditio sine qua non* for an appeal to be considered as filed, is the payment of the appeal fee. Para. 41 also appears to say that reasoning *a contrario* of said *conditio sine qua non*, it can be concluded that if the appeal fee is not paid or is paid late, the appeal is not deemed to be filed, and hence is legally non-existent. This remark seems unfortunate, for two reasons. Firstly, it suggests that valid payment after expiry of the period is possible. Secondly, if the *conditio sine qua non* is merely payment of the appeal fee, and if an appeal fee is validly paid late (as is implied in para. 41), then the appeal fee *is* paid and the *conditio sine qua non* (in its literal wording in para. 41) is fully complied with. The opposite conclusion in para. 41 appears to be somewhat of a *non sequitur*.
- 22) The above observations are my personal views only.

Respectfully submitted,

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