

European Patent Office

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Registry of the Enlarged Board of Appeal
attn: mr Wiek Crasborn

Tilburg, 30 November 2018

E-MAIL only: wcrasborn@epo.org

Your ref: G1/18
Our ref: T2018OG079
RE: Third Party Statement

**Third Party Statement
regarding case
G1/18**

Dear Sirs,

With reference to the Communication in Official Journal 2018, A71, relating to case G1/18, the Enlarged Board of Appeal is respectfully requested to give consideration to the following.

The question put before the Enlarged Board of Appeal in case G1/18 is actually a combination of three questions:

- 1) If the appeal fee is paid in time but the **notice of appeal is filed** after expiry of the time limit under Art.108, is the appeal to be considered as inadmissible or deemed not filed?
- 2) If the **notice of appeal is filed and the appeal fee is paid** after expiry of the time limit under Art.108, is the appeal to be considered as inadmissible or deemed not filed?
- 3) If the notice of appeal is filed in time but **the appeal fee is paid** after expiry of the time limit under Art.108, is the appeal to be considered as inadmissible or deemed not filed?

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It is my view, as I will explain in the following, that there is no legal difference between the above situations.

The question put before the Enlarged Board of Appeal has implications wider than the situation of filing an appeal. I will therefore indicate similar situations, with similar legal provisions.

At various locations, the EPC defines the payment of a fee as being required within a certain time limit. As an example, the filing fee may be mentioned [Art.78(2) j° R.38(1)]. The time limit is explicitly specified for the payment of that particular fee, and the legal consequence of not paying that particular fee is also explicitly specified.

On the other hand, there are instances in the EPC where a procedural step requires the combination of an action to be completed (i.e. a request to be filed) and a fee to be paid, while no separate time limits are defined for such action on the one hand and such fee payment on the other hand.

Those instances are:

- a- filing the request for examination and paying the examination fee
[Art.94(1) j° R.70(1)]
- b- filing a notice of opposition and paying the opposition fee
[Art.99(1)]
- c- filing a notice of intervention and paying the opposition fee
[Art.105 j° R.89]
- d- filing a request for limitation or revocation, and paying the limitation or revocation fee
[Art.105a]
- e- filing a notice of appeal and paying the appeal fee
[Art.108]
- f- filing a petition for review and paying the review fee
[Art. Art.112a(4)]
- g- filing a request for re-establishment and paying the fee for re-establishment
[Art.122 j° R.136(1)]
- h- filing a request for conversion and paying the conversion fee
[Art.135(3) j° R.155(1)]

Perhaps the above overview is incomplete.

In all those cases, the EPC defines the time limit by referring to the corresponding procedural step to be completed, or by referring to the corresponding action to be completed:

- a- R.70(1) examination may be requested up to 6m after
- b- Art.99(1) any person may give notice of opposition within 9m of
- c- R.89(1) notice of intervention shall be filed within 3m of
- d- --
- e- Art.108 notice of appeal shall be filed within 2m of
- f- Art.112a(4) petition for review shall be filed within 2m of
- g- R.136(1) request for re-establishment shall be filed within 2m of
- h- R.155(1) request for conversion shall be filed within 3m of

It is to be noted that there is of course no time limit for requesting limitation or revocation.

In those cases, a distinction may for instance be made between procedural steps to be taken in the context of an existing application procedure on the one hand (a, h), and procedural steps that start a "new" procedure (b, c, d, e, f, g).

In respect of the first type of situations (a, h), the legal consequence of not performing the procedural step in time is defined in terms of the "fate" of the patent application in question:

- a- Art.94(2) if no request for examination has been made in due time, the application shall be deemed to be withdrawn
- h- R.155(1) if the request is not filed in due time, the effect under Art.66 shall lapse

In respect of the second type of situations (b, c, e, f, g), a specific legal consequence of not performing the procedural step in time is not explicitly defined.

This makes sense, if one considers that the relevant procedure has not legally come into existence if the requirements (request + fee) have not been met within the relevant time limit.

The above situations (b, c, e, f, g) have in common that it is evident that the party concerned should not be allowed to start the relevant procedure after expiry of the relevant time limit. *Mutatis mutandis*, the same can be said to the situations a) and h).

Reading the respective provisions literally, it could be argued that the EPC only defines a time limit for filing the relevant request, and not for paying the relevant fee. However, it is evidently not intended that the party concerned can submit the written request within the time limit and pay the corresponding fee at any time after expiry of the time limit.

It is therefore perhaps better to interpret that the EPC treats submitting the written request and paying the corresponding fee as a unitary procedural act. The time limit given relates to the unitary procedural act as a whole, not only to the written request. In the EPC, this effect is achieved, in all of the above cases, by the wording that the request shall not be deemed to have been filed until the relevant fee has been paid.

Taken by itself, out of context, it seems that this wording can be interpreted in two ways, as will be illustrated in the following example.

Assume the filing of written request on date D_w before the relevant time limit, and assume payment of the relevant fee on date D_f after the relevant time limit.

The first interpretation is that the request is not deemed to have been filed on date D_w , because the relevant fee has not been paid yet. The request is deemed to have been filed on date D_f . This is after the relevant time limit, hence the request is filed too late.

The second interpretation is that, as long as the relevant fee has not been paid yet, the filing of the request is ignored, but as soon as the relevant fee has been paid, the request can be taken into account. Thus, if the situation is assessed after date D_f , the observer will find that a request filed on date D_w exists, which is before the relevant time limit. In other words, the payment of the fee becomes a validation of the written request.

If this second interpretation is followed, it also follows that the party concerned can wait as long as he likes before making the fee payment. The filing of the written request could be done precautionary, before expiry of the relevant time limit, and at any later moment

the party concerned could decide to pay the relevant fee. As such, the late payment of the relevant fee does not conflict with any provision in the EPC, because the EPC does not contain any specific provision that gives a time limit for the payment itself.

Since the systematic wording of the provisions indicated is the same for all these provisions, it follows that the interpretation must be the same. Projected on for instance the situation of requesting examination, it would mean that the "late" paying of the examination fee would not be subjected to a further processing fee. After all, there is no provision in the EPC specifying that the examination fee must be paid within 6m from publication of the search report; the provision of R.70(1) only applies to the request for examination.

The consequences would be absurd. The second interpretation can not be correct.

It is evident that the above provisions all must have the same interpretation: BOTH the written request AND the fee payment must be performed before expiry of the relevant time limit. This effect is achieved, legally, only if the phrase "*shall not be deemed to have been filed until the relevant fee has been paid*" is interpreted as a combination of
A] if the relevant fee has not been paid, the request is deemed not filed, and
B] if the relevant fee has been paid later than the filing of the request, the request is deemed filed on the date of payment of the fee.

It then follows, logically, that if the appeal fee is filed after expiry of the time limit of Art.108, the situation is equivalent to the situation when the notice of appeal would be filed after expiry of the time limit of Art.108, with or without simultaneous payment of the appeal fee.

A similar statement applies, for instance, to the filing of a notice of opposition after expiry of the time limit of Art.99(1).

It is of course true that any party can file a notice of appeal after expiry of the time limit of Art.108. While such notice may need to be processed administratively and hence give

rise to an appeal file, it can not give rise to appeal proceedings effectively coming into existence. Consequently, the appeal can not be examined and rejected as inadmissible under R.101(1), since there is no appeal to examine.

If it were to be considered that the opposite is true, i.e. that a late-filed notice of appeal does effectively open appeal proceedings which only come to an end once the Board rejects the appeal as inadmissible, there is in any case the fact to be considered that the appeal has suspensive effect. After all, Art.106(1) does not define the suspensive effect as being dependent on the appeal being admissible or not.

It would thus be possible for an applicant, LONG after his application has been rejected, to file a divisional application because the suspensive effect of the appeal makes the application "pending" again for the purposes of R.36.

It may be noted in this respect that the Enlarged Board of Appeal, in G1/09, in slightly different wording, has decided that first instance decisions become final when the time limit for filing an appeal expires. This also seems to suggest that, after expiry of said time limit, it is not possible any more to open appeal proceedings at all.

It may also be noted that the Legal Board of Appeal, in J22/13, took the reasoning of G1/09 and projected it on a situation where an appeal against a decision to refuse the application was timely filed, but the grounds of appeal were not filed within the relevant time limit. The Legal Board took the view that, in terms of G1/09, the decision to refuse was *res judicata*. This, in other words, means that the suspensive effect of the appeal has ended. This could be taken to mean that, if a notice of appeal is filed after the relevant time limit, and if it were to be considered that such late-filed notice of appeal does open appeal proceedings, such appeal would be without suspensive effect.

It is my opinion that the Enlarged Board of Appeal should answer the question(s) before it by deciding that :

1) if the appeal fee is paid after the filing of the notice of appeal, the notice of appeal is deemed filed on the date of payment of the appeal fee;

2) if the notice of appeal is (deemed) filed after expiry of the time limit in Art.108, such notice does not open appeal proceedings and the appeal fee is to be reimbursed.

If the Enlarged Board of Appeal would come to the conclusion that a late-filed notice of appeal does open appeal proceedings but that the appeal should be rejected as inadmissible, it would be extremely helpful if the Enlarged Board of Appeal could give guidance as to how the question of suspensive effect should be interpreted in such case.

Kind Regards

Onno Griebeling
OG

