

Registry of the Enlarged Board of Appeal

For the attention of Mr Wiek Crasborn ( wcrasborn@epo.org).

Eindhoven, 8 October 2018,

Your reference: G 1/18

Our reference: case number G 1/18 - written statements in accordance with Article 10 RPEBA

Dear Sirs,

In OJ 2018, A71 (Online publication date: 31.08.2018), "Communication from the Enlarged Board of Appeal concerning case G 1/18 ", third parties were given the opportunity to file written statements in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal.

Topic is the referral in accordance with Article 112(1)(b) EPC, by the (former) President of the European Patent Office, who referred the following point of law to the Enlarged Board of Appeal:

If notice of appeal is filed and/or the appeal fee is paid after expiry of the two-month time limit under Article 108 EPC, is the appeal inadmissible or is it deemed not to have been filed, and must the appeal fee be reimbursed?

In my opinion the answer to the question should be that, if notice of appeal is filed and/or the appeal fee is paid after expiry of the two-month time limit under Article 108 EPC, it is deemed not to have been filed. The appeal fee must thus be reimbursed.

I submit my observations and viewpoints on the next pages.

Yours faithfully,



Roel van Woudenberg  
European Patent Attorney

**Referred question**

If notice of appeal is filed and/or the appeal fee is paid after expiry of the two-month time limit under Article 108 EPC, is the appeal inadmissible or is it deemed not to have been filed, and must the appeal fee be reimbursed?

**Overview**

1. I will first give my arguments based on the EPC provisions that directly apply, in particular Article 108 EPC itself and the EPC provisions that it refers to. I will also briefly discuss the role and effect of Rule 101 EPC.

Next, I will briefly discuss earlier decisions from the Boards of Appeal, in particular referring to J 21/80, T 2017/12 and T 1325/15.

Further, I will also comment on the Guidelines and legitimate expectations of (third) parties. Then, I will discuss the deviating decision T 1897/17 and the RPBA.

Finally, I will comment on other provisions in the EPC, Articles and Rules, which use similar wording as the second sentence of Article 108 EPC, before concluding my submission.

**Article 108 EPC itself**

2. Article 108 EPC reads:

**Article 108 Time limit and form**

Notice of appeal shall be filed, in accordance with the Implementing Regulations, at the European Patent Office within two months of notification of the decision. ***Notice of appeal shall not be deemed to have been filed until the fee for appeal has been paid.***

Within four months of notification of the decision, a statement setting out the grounds of appeal shall be filed in accordance with the Implementing Regulations.

3. Thus, a 2-month time limit is imposed on the filing of the notice of appeal. If the notice of appeal is not filed within that time limit and also not after that, no appeal is (validly) filed.
4. If the notice is filed *after* the 2-month time limit, it is filed too late to satisfy Art. 108, 1<sup>st</sup> sentence. The notice of appeal is thus not (validly) filed.
5. If the notice is received by the EPO within the 2-month time limit, the notice is only considered filed once the appeal fee is paid.

6. Hence, if the notice is received by the EPO *within* the 2-month time limit and the appeal fee is paid *within* the 2-month time limit, the notice is (validly) filed (assuming all other requirements are met, such as the notice being signed and the notice being filed in an official EPO language or by an Art. 14(4) EPC person in an admissible non-EPO language with the notice in the admissible non-EPO language being followed by a translation in an official EPO language within the time limit of Rule 6(2) EPC).
7. However, if the notice is received by the EPO *within* the 2-month time limit and the appeal fee is paid *after* expiry of the 2-month time limit, the appeal fee is paid outside the applicable period and thus considered not paid. As a consequence, the notice of appeal is not deemed to have been filed and can never be, because the appeal fee is not validly paid. As another consequence, the appeal fee must be refunded as lacking legal basis.

**EPC provisions related to (the filing of) the notice of appeal**

8. The Implementing Regulations referred to in Art. 108 EPC comprise in particular Rule 99 EPC:

**Rule 99 Content of the notice of appeal and the statement of grounds**

(1) The notice of appeal shall contain:

- (a) the name and the address of the appellant as provided in Rule 41, paragraph 2(c);
- (b) an indication of the decision impugned; and
- (c) a request defining the subject of the appeal.

(2) In the statement of grounds of appeal the appellant shall indicate the reasons for setting aside the decision impugned, or the extent to which it is to be amended, and the facts and evidence on which the appeal is based.

***(3) Part III of the Implementing Regulations shall apply mutatis mutandis to the notice of appeal,*** the statement of grounds and the documents filed in appeal proceedings.

9. Rule 99(1) EPC provides formal requirements imposed on the content of the notice of appeal, and has no immediate consequences on the issue whether the notice is deemed filed or not.
10. Rule 99(2) EPC does not relate to the notice, but just to the grounds.
11. Rule 99(3) EPC provides, via Rule 50(3) EPC (which is part of Part III), that the notice needs to be signed and is considered not filed if it is not validly signed (note: if initially not (validly) signed, this may be remedied following an invitation).
12. Rule 50(3) EPC provides:

**Rule 50 Documents filed subsequently**

(3) Documents filed after filing the application shall be signed, with the exception of annexed documents. **If a document has not been signed, the European Patent Office shall invite the party concerned to do so within a time limit to be specified. *If signed in due time, the document shall retain its original date of receipt; otherwise it shall be deemed not to have been filed.***

13. Rule 50(3) EPC, when applied to the notice of appeal, thus provides that:

- a validly signed notice of appeal must be received before the expiry of the 2-month term for filing the notice and paying the appeal fee, and
- a non-signed or invalidly signed notice of appeal must be received before the expiry of the 2-month term for filing the notice and paying the appeal fee and validly signed after an invitation by the EPO to do so within the time limit specified in the invitation (presumably 2 months – Rule 132(2) EPC). The notice then retains the date on which the original, non-signed or invalidly signed, notice was received.

(The latter is subject to the condition of Art.108 EPC that the appeal fee must have been paid before the expiry of the same 2-month term as otherwise the notice is deemed not filed.)

14. Further, after the filing of an appeal, the admissibility of the appeal is checked under Rule 101 EPC:

**Rule 101 Rejection of the appeal as inadmissible**

(1) If the appeal does not comply with Articles 106 to 108, Rule 97 or Rule 99, paragraph 1(b) or (c) or paragraph 2, the Board of Appeal shall reject it as inadmissible, unless any deficiency has been remedied before the relevant period under Article 108 has expired.

(2) If the Board of Appeal notes that the appeal does not comply with Rule 99, paragraph 1(a), it shall communicate this to the appellant and shall invite him to remedy the deficiencies noted within a period to be specified. If the deficiencies are not remedied in due time, the Board of Appeal shall reject the appeal as inadmissible.

15. It is noted that the issue of admissibility only becomes relevant if the appeal is considered filed. If the appeal is (deemed) not filed, no appeal proceedings have been initiated and the title of the Rule (Rejection of the appeal as inadmissible) already indicates that Rule 101 EPC does not need to be checked for any further conditions or consequences, simply because admissibility is not a topic for an appeal that never came into existence.

16. Thus, the reference to “comply with Articles 108 EPC” in Rule 101(1) EPC can only be interpreted as “comply with Article 108 EPC as far as the appeal is deemed filed”. Interpreting this reference as also including the situation where the appeal is not filed fails to recognize that Article 108 EPC itself already provides when that is the case, supplemented with Rule 50(3) EPC. Rule 101(1) EPC’s reference to comply with Article 108 EPC” rather refers to the requirements to the content of the notice of appeal as prescribed in Rule 99(1) EPC and the formal requirements applicable to it as provided in Part III of the Rules via Rule 99(3) EPC (apart from the signature requirement of Rule 50(3) EPC for which the “notice is deemed not filed” sanction is given).
17. Thus, interpreting Rule 101 EPC as considering the appeal inadmissible if the appeal fee is paid too late or the notice is received too late is in my opinion incorrect. Rather, the legal consequence is given by Article 108 EPC itself: the appeal is not considered filed if the appeal fee is paid after the expiry of the 2-month period and/or if the notice of appeal is received by the EPO after the expiry of the 2-month period.

#### J 21/80

18. J 21/80 (Paiement tardif de la taxe de recours) of 26.2.1981 was decided in French. French is the authentic language of the decision as that was the language of proceedings. The first headnote of J 21/80 provides:

1. Si la taxe de recours n'a été acquittée qu'après le délai de 2 mois prévu par l'article 108 de la CBE, le greffier considère à bon droit que **le recours n'a pas été valablement formé**; il avise en conséquence le requérant de la perte d'un droit en application de la règle 69 (1) de la CBE.

19. The reasons of J 21/80 in **its authentic language** read:

#### Motifs de la décision

1. Il résulte du dossier que la taxe de recours d'un montant de 1330 FF a été perçue le 24 juillet 1980 par chèque joint au recours. Les requérants ne fournissent aucun élément pour contester ce fait, et semblent confondre, dans leur requête du 23 décembre 1980, taxe de recours et taxe annuelle.
2. Selon l'article 8 (1) c du règlement des taxes, en cas d'envoi d'un chèque, la date du paiement est celle à laquelle le chèque est reçu par l'Office. En conséquence, la taxe

de recours payée le 24 juillet 1980 l'a été après expiration du délai de deux mois imposé par l'article 108 de la CBE et expirant, en application de la règle 78 (3) de la CBE, le 22 juillet 1980.

3. 'est à bon droit dès lors que le Greffier a constaté le 15 décembre 1980, après la règle 69(1) de la CBE, que le recours daté du 2 juillet 1980 devait **être considéré comme non formé**.
4. En raison de l'inexistence d'un recours valable, le montant de la taxe de recours payée tardivement doit être restitué.

## DISPOSITIF

2. Le recours contre la décision de la Section de dépôt du 12 mai 1980 est **considéré comme non formé**.

20. Thus, the decision concludes in reason 3, as well as in its order, that the appeal was deemed not filed and never came into existence, because the appeal fee was paid after expiry of the 2-month period of Article 108 EPC. This is also reflected in the first headnote of the decision.

21. The decision also clearly indicated that the appeal fee was to be reimbursed because of the non-existence of an appeal.

22. It seems like this decision is the leading decision (see below).

23. The headnote and reasons are -in my understanding- correctly **translated into German** as:

Leitsatz 1. Wird die Beschwerdegebühr erst nach Ablauf der in Artikel 108 EPÜ vorgesehenen 2-Monatsfrist entrichtet, so stellt der Geschäftsstellenbeamte zu Recht fest, dass die Beschwerde **nicht wirksam eingelegt worden ist**; er unterrichtet daher den Beschwerdeführer von dem Rechtsverlust nach Regel 69(1) EPÜ.

## Entscheidungsgründe

1. Aus den Akten ergibt sich, daß die Beschwerdegebühr in Höhe von FF 1.330,- am 24. Juli 1980 mit einem der Beschwerde beigefügten Scheck entrichtet worden ist. Die Beschwerdeführer haben nichts gegen diese Feststellung vorgebracht und scheinen in ihrem Antrag vom 23. Dezember 1980 die Beschwerdegebühr mit der Jahresgebühr zu verwechseln.

2. Nach Artikel 8 (1) c der Gebührenordnung gilt als Tag des Eingangs der Zahlung bei Übersendung eines Schecks der Tag, an dem der Scheck beim Amt eingeht. Daher ist die am 24. Juli 1980 entrichtete Beschwerdegebühr nach Ablauf der in Artikel 108 EPÜ vorgeschriebenen 2-Monatsfrist, die nach Regel 78 (3) EPÜ am 22. Juli 1980 abgelaufen ist, gezahlt worden.
3. Der Geschäftsstellenbeamte hat daher zu Recht am 15. Dezember 1980 nach der Regel 69 (1) EPÜ festgestellt, daß die Beschwerde vom 2. Juli 1980 **als nicht eingelegt gilt**.
4. Da somit keine wirksame Beschwerde vorliegt, ist die verspätet gezahlte Beschwerdegebühr zurückzuzahlen.

#### ENTSCHEIDUNGSFORMEL

2. Die Beschwerde gegen die Entscheidung der Eingangsstelle vom 12. Mai 1980 gilt **als nicht eingelegt**.

24. So, the original French decision and its German translation both provide that the appeal is deemed not filed, and not that it is inadmissible.

25. Unfortunately however, the translation of the headnote into English was -in my view- not correct and this incorrect translation was published, together with the authentic French text and the correctly translated German translation, in OJ EPO 1981, 101.

26. The first headnote **was translated into English** as:

I. If the appeal fee has not been paid until after the expiry of the period of two months provided for in Article 108 EPC, the Registrar has good reason to consider that **the appeal is inadmissible**; he will therefore advise the appellant of the loss of a right, pursuant to Rule 69(1) EPC.

27. The reasons were however translated correctly (even though it did not use the words “filed” but “lodged”):

#### Reasons for the Decision

1. It appears from the file of the case that a cheque for the amount of the appeal fee (FF 1330) was received on 24 July 1980, attached to the notice of appeal. The

appellants have provided no evidence or argument to the contrary and, in their letter of 23 December 1980, appear to have confused the appeal fee with the renewal fee.

2. In accordance with Article 8(1)(c) of the Rules relating to Fees, when a cheque is sent in payment of fees, the date of payment is the date of receipt by the Office.

Consequently, the appeal fee paid on 24 July 1980 had been paid after the expiration of the period of two months prescribed by Article 108 EPC, which, by virtue of Rule 78(3) EPC, had ended on 22 July 1980.

3. The Registrar had good reason to find, as he did on 15 December 1980, in accordance with Rule 69(1) EPC, that ***the appeal dated 2 July 1980 must be considered not to have been lodged.***
4. ***As there is no admissible appeal in existence, the appeal fee paid late must be reimbursed.***

Order

2. The appeal against the Decision of the Receiving Section dated 12 May 1980 ***is inadmissible.***

28. Later submissions by parties and/or decisions in English may thus have relied on a wrongly translated (English) headnote or order, thereby concluding on “inadmissible” rather than “not filed” (or “not lodged”).

29. The authentic text of the decision is however the French version, which concludes on “not filed” and “not coming into existence” – terms that have substantially the same meaning.

#### **T 2017/12**

30. T 2017/12 is the decision that made referral G 2/14.

31. T 2017/12 also noted the translation error in the English translation of J 21/80.

32. T 2017/12 considered the majority interpretation in r.3.1.1:

***The leading decision is J 21/80.*** In this case the appeal fee had been paid late. The board held that, "En raison de l'inexistence d'un recours valable, le montant de la taxe de recours payée tardivement doit être restitué." There is no further reasoning. The order, originally in French, contains the following statement: 'Le recours contre la décision de la Section de dépôt du 12 mai 1980 est considéré comme non formé.' The English



translation of this, "The appeal against the Decision ... is inadmissible", is incorrect, whereas the German translation is accurate: "Die Beschwerde ... gilt als nicht eingelegt."

The decision J 24/87 as cited by the appellant comes to the same conclusion but also without any reasoning.

The decision J 2/78 as also cited by the appellant is not pertinent for the issue in question because in that case no appeal fee had been paid at all.

J 16/82 followed J 21/80, stating (reasons 2, 9 and 10):

"2. Zu den Voraussetzungen einer rechtswirksamen Beschwerde gehört, daß die Beschwerdegebühr innerhalb der nach Artikel 108 EPÜ vorgeschriebenen 2-Monatsfrist entrichtet wurde. Andernfalls gilt die Beschwerde nach Artikel 108 Satz 2 EPÜ nicht als eingelegt (siehe Entscheidung der JurBK J 21/80 vom 26. Februar 1981, ABl. EPA 1981, 101). ...

9. Da eine Wiedereinsetzung somit nicht stattfinden kann, gilt die Beschwerde gem. Artikel 108 Satz 2 EPÜ als nicht eingelegt. Artikel 108 Satz 2 EPÜ ist entsprechend seiner Entstehungsgeschichte in Zusammenhang mit Satz 1 in dem Sinne zu verstehen, dass die Beschwerde nicht als eingelegt gilt, wenn die Beschwerdegebühr nicht innerhalb der in Satz 1 genannten Beschwerdefrist entrichtet worden ist (siehe auch die bereits unter Nr. 2 erwähnte J 21/80 vom 26. Februar 1981, ABl. EPA 1981, 101).

10. Gilt eine Beschwerde gem. Artikel 108 Satz 2 EPÜ deswegen als nicht eingelegt, weil die Beschwerdegebühr erst nach Ablauf der Beschwerdefrist gezahlt wurde, so kann der mit der Zahlung der Gebühr verfolgte Zweck nicht mehr erreicht werden. Die Beschwerdegebühr ist daher zurückzuzahlen, ohne daß es einer besonderen Anordnung der Beschwerdekammer bedarf."

Thus, beyond a not further explained reference to the Article's "Entstehungsgeschichte", none of these decisions gave any reasoning for this interpretation of Article 108, second sentence. Later decisions generally add nothing to the minimal reasoning of these leading decisions.

In T 489/93, the board, when rejecting the appeal as "unzulässig" or inadmissible, for late payment of the appeal fee, stated, "Die Beschwerde war daher als unzulässig zu verwerfen, Regel 65(1) EPÜ [1973]. Der Wortlaut in Regel 65(1) EPÜ als 'unzulässig' ist in

einem weiten Sinn verwendet, d. h. umfasst sowohl den Fall der existenten (aber 'unzulässigen') wie den der nicht existenten Beschwerde." Considering the case to fall in the latter category, and citing J 21/80, it ordered the repayment of the appeal fee.

33. T 2017/12 considered the dissenting decisions in r.3.1.2. It observed that only T 79/01 have a reasoning, whereas T 1289/10, T 1535/10 and T 2210/10 did not give a reasoning why they considered the appeal inadmissible rather than not filed.

34. T 2017/12 cited T 79/01 as:

In decision T 79/01 the appeal was found inadmissible after an incomplete payment of the appeal fee and the incomplete fee was not reimbursed. The board argued (reasons 9 and 10) that this led to a consistent interpretation of Rule 65(1) EPC 1973 and that:

"There is no reason to provide the appellant with a more favourable treatment in case of late (or insufficient, as in the present case) payment of the appeal fee (ie the appeal is deemed not been filed and the appeal fee is reimbursed) as in case of, for example, late filed statement of grounds (inadmissibility of the appeal). Moreover the 'travaux préparatoires' seem to support this interpretation. In the 'Materialien zum EPÜ' (IV/6514/61-D) is provided for, with reference to the "Entscheidungsmöglichkeiten der Beschwerdekammer' that 'Die Kammer kann feststellen, dass die Beschwerde wegen Nichtentrichtung der Gebühr unzulässig ist'."

35. It is observed that the argumentation rather relies on preventing an (subjective) favourite treatment rather than on objectively considering the wording of Art.108.

#### T 1325/15

36. T 1325/15, issued shortly after G 1/14 and G 2/14 proceedings were ended, could be seen as answering the question.

37. T 1325/15 wrote in r.35:

Both referral decisions [G 1/14 and G 2/14] concentrated on the meaning of Art.108, second sentence, which reads "Notice of appeal shall not be deemed to have been filed until the fee for appeal has been paid". ***In numerous decisions the BoAs had interpreted this provision as meaning that an appeal did not come into existence, i.e. the notice of appeal was deemed not to have been filed, if the appeal fee was not paid within the***

**two-month time limit of Art. 108, first sentence.** In a smaller number of deviating decisions, the boards of appeal dismissed the appeal as inadmissible where the notice of appeal was filed and the appeal fee paid after expiry of the time limit.

38. T 1325/15 wrote in r.41.

Art.108, first sentence, requires that notice of appeal be filed within two months of notification of the decision. If no notice of appeal is filed, then no appeal comes into existence. Although the position that R.101(1) means that a late-filed notice of appeal brings into existence an inadmissible appeal may be not unreasonable, ***in view of the general rule that no distinction is to be made between the late filing and the non-filing of a document, the Board considers that no appeal exists where a notice of appeal was not (deemed to be) filed in due time.***

39. T 1325/15 wrote in r.42:

The Board notes that its approach, ***although it has not always consistently been applied in the jurisprudence of the boards of appeal, is also in line with the reasoning in earlier decisions which have argued that an appeal is deemed not to have been filed where the appeal fee was paid in time but the notice of appeal was filed only after expiry of the two-month period of Art.108(1)*** (see in particular decisions J 19/90, r.1.2.2 and 4; T 445/98, r.1.2, 5, 6 and 7; and T 778/00, section V of the facts and submissions and point 6 of the reasons).

40. The Case Law Book, 8<sup>th</sup> edition, III.A.1.1 provides that:

***The case law of the boards of appeal may also be a source of legitimate expectation, in particular, if it is established case law which has become enshrined in the consistent practice of the department of first instance*** (see J 27/94, OJ 1995, 831; see also in this chapter III.A.5).

41. Thus, in view of J 21/80 being the leading case law, as embraced explicitly also by T 2017/12, and followed by the vast majority of other decisions, as indicated by T 1325/15, the principle of the protection of legitimate expectations requires in my view that J 21/80 (in its original language) needs to be followed.

**Guidelines and the principle of the protection of legitimate expectations**

42. The Case Law Book, 8<sup>th</sup> edition, III.A opening paragraph provide that:

The principle of the protection of legitimate expectations is a general principle well established in European Community law and generally recognized in the EPC contracting states and board of appeal case law (G 2/97; R 4/09). Its application to procedures before the EPO implies that measures taken by the EPO should not violate the reasonable expectations of parties to such proceedings (G 5/88, G 7/88, G 8/88).

43. The Case Law Book, 8<sup>th</sup> edition, III.A.1 opens with:

The principle of the protection of legitimate expectations applies to all procedural actions – whether formal or informal – taken by EPO employees vis-à-vis parties to proceedings (T 160/92; T 343/95; T 460/95; T 428/98).

44. The Case Law Book, 8<sup>th</sup> edition, III.A.1.1 provides that:

***Sources of legitimate expectations include*** information provided by the EPO in individual cases (e.g. in the form of communications to the party), ***information contained in official statements of general applicability and published by the EPO*** (e.g. ***the Guidelines*** and the Official Journal), established practice of departments of the EPO, and decisions taken by the Enlarged Board because of its special role (see J 25/95 and the decisions given on the same day, namely J 14/95, J 15/95, J 16/95, J 17/95 and J 24/95; see also T 905/90, OJ 1994, 306, Corr. 556)

45. Thus, in view of the principle of legitimate expectations, procedures and legal consequences should be performed as outlined in the Guidelines for Examination in the European Patent Office if there is no reason to assume that the procedures and legal consequence as sketched there are correct. A deviation from the Guidelines should therefore be exceptional and should be well-explained. A change in procedures should be announced prior to the execution of the changed proceedings. The Guidelines would need to be adapted at the earliest possible occasion.

46. The Guidelines (November 2017) read:

**E-XII, 6. Time limit and form of appeal**

Notice of appeal must be filed with the EPO within two months of the date of notification of the decision appealed from. ***The notice is not deemed to have been filed until after the fee for appeal has been paid in the amount laid down in the Rules relating to Fees under the EPC.*** Within four months after the date of notification of the decision, a written statement setting out the grounds of appeal must be filed.

**A-X, 5.2.6 Fees for limitation/revocation, opposition, *appeal*, petition for review**

All of these fees are ***due on the date that the document in question is filed*** (request for limitation, request for revocation, notice of opposition, ***notice of appeal*** and petition for review).

**A-X, 10.1.1 Fee payments lacking a legal basis**

There are two conditions for a fee payment to be fully valid:

- (i) it must relate to pending proceedings; and
  - (ii) it must be made in due time, i.e. the date of payment (see A-X, 4) must be on or after the due date (see A-X, 5.1.1).
- [...]

If the payment is made before or on the due date and if, no later than that date, the legal basis ceases to exist (e.g. because the patent application is deemed to be withdrawn or is withdrawn), the amount paid is to be refunded.

**A-X, 10.1.2 Late payments**

***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.

47. The Guidelines thus provides that a payment of the appeal fee after expiry of the 2-month is not valid. As the payment is not valid, the notice is not considered filed. As the payment lacks legal basis, the paid appeal fee must be refunded.
48. As there is no reason for any party or other person to believe that the EPO would deviate from what is written in the Guidelines concerning these issues, also not when reading Article

108 EPC, the principle of protection of legitimate expectations requires that the interpretation given by the EPO is used.

**Deviating decision: T 1897/17**

49. In the referral, reference is made to T 1897/17 as Minority case law.

50. In T 1897/17, main reasons are:

“13. In accordance with R. 126 (2) EPC, the examining division's decision was deemed to be delivered on 11 June 2017, with the time limit for the notice of appeal (Art. 108 EPC) expiring on 11 August 2017, a Friday and regular working day of the European Patent Office. **From this follows that the notice of appeal, which was undisputedly filed on 14 August 2017, together with the payment of the appeal fee, was filed too late.**

14. **The legal consequence of this finding, as will be explained below, is that the appeal has to be rejected as inadmissible (R. 101 (1) EPC in conjunction with Art. 108 EPC; T 79/01, T 122/02, T 1289/10, T 1535/10 and T 2210/10; cf. T 264/88, T 489/93).**

15. The board does not concur with the majority interpretation in decisions of the Boards of Appeal that an appeal is 'deemed not to have been filed', if the notice of appeal or the payment of the appeal fee were received outside the two-month time limit of Art. 108 EPC (Case Law IV.E.8, J 16/82, T 804/95, T 445/98, J 9/00, T 778/00, T 314/01, T 1691/06, T 1026/06 [regarding the appeal fee, with a different assessment as to the fee for the request for re-establishment of rights] T 46/07, T 327/17, T 1553/13 of 23 November 2016, T 181/14, T 1946/15, T 2406/16; cf. J 21/80, T 2017/12 and T 1553/13 of 20 February 2014).

**According to the clear wording of R. 101 (1) EPC, which is an Implementing Regulation of Art. 106 to Art. 108 EPC, if an appeal does not fulfil the legal requirements of (here) Art. 108 EPC, the board of appeal shall reject it as inadmissible. The legal fiction of Art. 108 EPC, second sentence, that the notice of appeal shall not be deemed to have been filed until the appeal fee has been paid, can, in the board's view only be understood as setting an additional (implicit) condition for an appeal to be admissible, namely the (timely) payment of the appeal fee. No procedural consequences follow from Art. 108 EPC, second sentence; these are exclusively governed by R. 101 (1) EPC, providing for the rejection of the**

appeal as inadmissible if the appeal does not comply with Art. 108 EPC, i.e. also in the case of late payment of the appeal fee (cf. T 79/01, quoting the travaux préparatoires to the EPC, IV/6514/61-D : "Die Kammer kann feststellen, dass die Beschwerde wegen Nichtentrichtung der Gebühr unzulässig ist").

[...]

It is true that the wording of Art. 108 EPC, second sentence, '... not be deemed to have been filed ...', is also used in other provisions of the EPC, notably Art. 112a (4) EPC, last sentence and Art. 99 (1) EPC (further examples are listed in T 2017/12).

**There is, however, a fundamental difference between these three provisions on the one hand, and other provisions of the EPC using the same or similar wording on the other hand: in these three cases, specific procedural (implementing) rules exist, namely R. 101 (1) EPC, R. 77 (1) EPC and R. 108 (1) EPC.** They confirm and complement the (clear) wording of Art. 108 EPC, second sentence, Art. 99 (1) EPC, second sentence, and Art. 112a (4) EPC, last sentence respectively: to reject as inadmissible a legal remedy (appeal, opposition or petition for review) attacking an EPO decision, if it does not fulfill the requirements for admissibility, which, in the system of the EPC, include the timely payment of the respective fee. In all three cases, EPO decisions would become finally bin-ding on the parties, if not attacked by means of the respective legal remedy. The rejection of a legal remedy found inadmissible is a requirement to ensure legal certainty, a principle also generally recognised in the EPO's Contracting States."

51. It is hard to understand how, in T 1897/17, the Board could conclude -in the second paragraph of reason 15- that "The legal fiction of Art. 108 EPC, second sentence, that the notice of appeal shall **not be deemed to have been filed** until the appeal fee has been paid, can, in the board's view only be understood as setting an additional (implicit) condition for an appeal **to be admissible**, namely the (timely) payment of the appeal fee": the Board explicitly refers to a legal fiction that clearly and explicitly indicates that the notice of appeal is **not deemed filed** under some conditions (payment of the appeal fee) but nevertheless concludes that it does not effect the filing yes or no, but only the **admissibility**. Just the grammar of the reasoning makes it difficult, it not impossible, to understand.
52. In T 1897/17, the Board seems to rely on the legal effect mentioned in Rule 101(1) EPC without taking note of higher-ranked provisions, in particular Art. 108 EPC. Herein, the Board does not seem to take into account that the Rules can only supplement the Articles, but never overrule them. Article 108 itself clearly provides that the appeal is not considered filed if the notice is filed (received by the EPO) after the 2-month time limit, nor if the payment is

done too late, as argued above. Thus, Rule 101(1) EPC never comes into play: it only becomes relevant where Articles 106 – 108 EPC themselves do not yet indicate the legal effect or sanction.

53. Even though the Board expressed in reason 15 of T 1897/17 that the Board deviate from earlier decisions, and even explicitly expressed that they do not concur from the majority interpretation, the Board did not seem it fit to refer to the Enlarged Board of Appeal under Art.112(1)(a) EPC. It is difficult to understand how a Board can in this situation not consider it necessary to refer to the Enlarged Board, but to decide to take its own opinion as correct and to considers that of many other Board incorrect. Instead of choosing to settle the debate by putting the question to the right forum, i.e., the Enlarged Board, to let the Enlarged Board decide on the correct interpretation of a key provision relating to procedures with major impact and wish for certainty to parties as well as third parties, the Board increased uncertainty by choosing a deviating and conflicting route. A review by the Boards as well as by the Enlarged Board as to when a referral should be made when a Board has a different opinion than earlier decisions (and certainly, if deviating from the majority opinion!), and when a Board would be allowed to deviate from earlier decisions, seems appropriate. A petition for review of the T 1897/17 decision would probably not have been successful: the appellant has thus no means for redress if a Board decides to use a conflicting opinion, even if it deviates from the majority opinion, such that maximum care and attention is to be expected from the Board – thus, when there are such pronounced differences in interpretations of legal provisions, the only appropriate forum is the Enlarged Board and not any normal Board of Appeal, irrespective of the degree of certainty that the Board may have about its own opinion.
54. It is noted that Article 112 EPC does not leave any discretion to the Board as to whether to refer or not: Article 112(1)(a) EPC reads:
  - (1) In order to ensure uniform application of the law, or if a point of law of fundamental importance arises:
    - (a) the Board of Appeal **shall**, during proceedings on a case and either of its own motion or following a request from a party to the appeal, refer any question to the Enlarged Board of Appeal if it considers that a decision is required for the above purposes. If the Board of Appeal rejects the request, it shall give the reasons in its final decision;
55. By indicating that the Board was aware that their own opinion deviated from the majority opinion, the Board indicated that they were not applying the law in a uniform manner. In



view of the word “shall” on Art.112(1)(a) EPC, it is hard to understand why the Board seemed themselves fit to decide how to interpret and apply the law, rather than to let the Enlarged Board decide on a decision for the purposes of a uniform application of the law and on the point of law of fundamental importance. (Note: The argument that a possibly delay, due to the referral, to finally decide on the case, is to be prevented whenever possible does not hold: a uniform application/interpretation of the law is of importance for all users of the EPC system, whereas some delay only has effect in the parties for the specific case. Further, with less conflicting case law, the efficiency of the appeal proceedings will only improve.)

56. I am aware that Article 20(1) of the Rules of Procedure of the Boards of Appeal of the European Patent Office does not provide such a binding nature of referring a question, and in T 1897/17, the Board followed its steps, i.e. to give the grounds for deviating from the majority decisions.

57. Article 20(1) RPBA provides that:

Should a Board consider it necessary to deviate from an interpretation or explanation of the Convention given in an earlier decision of any Board, the grounds for this deviation shall be given, unless such grounds are in accordance with an earlier opinion or decision of the Enlarged Board of Appeal. The President of the European Patent Office shall be informed of the Board's decision.

58. However, Art. 20(1) RPBA can not be read out without taking into account Art. 112(1)(a) EPC, which is of higher rank and binding to the Boards. Art. 20(1) RPBA is in my opinion not applicable for a case where uniform application of the law is at risk, or if a point of law of fundamental importance arises: Art. 112(1)(a) EPC then imposes a mandatory requirement on the Board to refer to the Enlarged Board.

59. Art. 20(1) RPBA is in my opinion only applicable in usual cases of “deviation” from earlier similar decisions, where a “deviation” without a referral may occur without any conflict with Art.112(1)(a) EPC if the facts of the case are different, whereby a seemingly slightly deviating interpretation or application may be explained – but they are not in T 1897/17 compared to the majority decisions.

60. It would be appreciated and in my opinion to the benefit of all parties, third parties and other users of the EPC system, including first and second instance divisions of the EPO, if Art.112(1)(a) EPC is used more consistently to refer to the Enlarged Board in case of conflicting interpretation of the law or fundamental points of law, and if Art. 20(1) RPBA is only used to explain why the circumstances are different justifying a seemingly different interpretation of the law and not to circumvent a referral.

**Other observations**

61. As was indicted in the referring letter from the President, various other provisions in the EPC use the same or very similar wording for the effect of a fee payment on initiating new proceedings. For all of these fees, it is generally accepted that a payment of the fee after the expiry of the relevant period has the effect that the associated request/document is not considered filed.

***Examination fee and request for examination***

62. With respect to the Examination fee and request for examination, the EPC provides:

**Article 94 Examination of the European patent application**

(1) The European Patent Office shall, in accordance with the Implementing Regulations, examine on request whether the European patent application and the invention to which it relates meet the requirements of this Convention. ***The request shall not be deemed to be filed until the examination fee has been paid.***

**Rule 70 Request for examination**

(1) The applicant may request examination of the European patent application up to six months after the date on which the European Patent Bulletin mentions the publication of the European search report. The request may not be withdrawn.

(2) If the request for examination has been filed before the European search report has been transmitted to the applicant, the European Patent Office shall invite the applicant to indicate, within a period to be specified, whether he wishes to proceed further with the application, and shall give him the opportunity to comment on the search report and to amend, where appropriate, the description, claims and drawings.

63. The wording of the last sentence of Article 94(1) EPC substantially corresponds to that of Article 108 EPC.

64. For Article 94(1) EPC it has -to my knowledge- never been questioned what the effect is of a payment of the examination fee after expiry of the period of Rule 70(1) EPC: the effect is well-recognized to be that the request for examination is deemed not filed, not that it would be inadmissible.

65. There is no reason why the effect of non-payment or too late payment of the appeal fee should not be the same: the effect is that the notice is not considered filed.

**Re-establishment**

66. With respect to re-establishment, the EPC provides:

**Rule 136 Re-establishment of rights**

(1) Any request for re-establishment of rights under Article 122, paragraph 1, shall be filed in writing within two months of the removal of the cause of non-compliance with the period, but at the latest within one year of expiry of the unobserved time limit. However, a request for re-establishment of rights in respect of any of the periods specified in Article 87, paragraph 1, and in Article 112a, paragraph 4, shall be filed within two months of expiry of that period. ***The request for re-establishment of rights shall not be deemed to have been filed until the prescribed fee has been paid.***

67. The wording of the last sentence of Rule 136 EPC substantially corresponds to that of Article 108 EPC.

68. For Rule 136(1) EPC it has -to my knowledge- never been questioned what the effect is of a payment of the re-establishment fee after expiry of the 2-month period from the removal of the cause of non-compliance: the effect is well-recognized to be that the request for re-establishment is deemed not filed, not that it would be inadmissible.

69. There is no reason why the effect of non-payment or too late payment of the appeal fee should not be the same: the effect is that the notice is not considered filed.

**Further processing**

70. It is observed that there is no such phrasing for further processing, as no written request needs to be filed for further processing: Rule 135(1) EPC provides that "Further processing under Article 121, paragraph 1, shall be requested by payment of the prescribed fee within two months of the communication concerning either the failure to observe a time limit or a loss of rights. The omitted act shall be completed within the period for making the request."

**Opposition**

71. With respect to the notice of opposition and the opposition fee, the EPC provides:

**Article 99 Opposition**

(1) Within nine months of the publication of the mention of the grant of the European patent in the European Patent Bulletin, any person may give notice to the European Patent Office of opposition to that patent, in accordance with the Implementing Regulations. ***Notice of opposition shall not be deemed to have been filed until the opposition fee has been paid.***

**Rule 77 Rejection of the opposition as inadmissible**

(1) If the Opposition Division notes that the notice of opposition does not comply with Article 99, paragraph 1, or Rule 76, paragraph 2(c), or does not sufficiently identify the patent against which opposition has been filed, it shall reject the opposition as inadmissible, unless these deficiencies have been remedied before expiry of the opposition period.

- 72. It is observed that Rule 77(1) EPC on inadmissibility also makes reference to Article 99(1) EPC, which includes a “deemed not filed until opposition fee has been paid”.
- 73. The situation in Article 99 EPC is similar to that in Article 108 EPC as far as the notices and the fees are concerned.
- 74. For Article 99 EPC it has -to my knowledge- never been questioned what the effect is of a payment of the opposition fee after the opposition period: the effect is well-recognized to be that the opposition is deemed not filed, not that it would be inadmissible.
- 75. There is no reason why the effect of non-payment or too late payment of the appeal fee should not be the same: the effect is that the notice is not considered filed.
- 76. Thus, the same legal sanction shall apply when the appeal fee is paid too late, i.e. notice of appeal is deemed not filed.

***Intervention***

- 77. With respect to intervention, the EPC provides:

**Rule 89 Intervention of the assumed infringer**

(2) Notice of intervention shall be filed in a written reasoned statement; Rules 76 and 77 shall apply mutatis mutandis. ***The notice of intervention shall not be deemed to have been filed until the opposition fee has been paid.***

78. The wording of the last sentence of Rule 89(2) EPC substantially corresponds to that of Article 108 EPC.
79. For Rule 89(2) EPC it has -to my knowledge- never been questioned what the effect is of non-payment or a payment outside the 3-month period of Rule 89(1) EPC of the opposition fee: the effect is well-recognized to be that the notice of intervention is deemed not filed, not that it would be inadmissible.
80. There is no reason why the effect of non-payment or too late payment of the appeal fee should not be the same: the effect is that the notice is not considered filed.

### ***Limitation or revocation***

81. With respect to limitation and revocation, the EPC provides:

#### **Article 105a Request for limitation or revocation**

(1) At the request of the proprietor, the European patent may be revoked or be limited by an amendment of the claims. The request shall be filed with the European Patent Office in accordance with the Implementing Regulations. ***It shall not be deemed to have been filed until the limitation or revocation fee has been paid.***

82. The wording of the last sentence of Article 105a(1) EPC substantially corresponds to that of Article 108 EPC.
83. For Article 105a(1) EPC it has -to my knowledge- never been questioned what the effect is of a payment non-payment of the limitation or revocation fee: the effect is well-recognized to be that the request is deemed not filed, not that it would be inadmissible.
84. There is no reason why the effect of non-payment or too late payment of the appeal fee should not be the same: the effect is that the notice is not considered filed.

### ***Registration of transfers***

85. With respect to registration of transfers, the EPC provides:

#### **Rule 22 Registration of transfers**

(2) ***The request shall not be deemed to have been filed until an administrative fee has been paid.*** It may be rejected only if paragraph 1 has not been complied with.

86. The wording of the first sentence of Rule 22(2) substantially corresponds to that of Article 108 EPC.

87. For Rule 22(2) EPC it has -to my knowledge- never been questioned what the effect is of non-payment of the administrative fee: the effect is well-recognized to be that the request is deemed not filed, not that it would be inadmissible.

88. There is no reason why the effect of non-payment or too late payment of the appeal fee should not be the same: the effect is that the notice is not considered filed.

***Fixing the amount of cost after apportionment of costs in opposition***

89. With respect to Fixing the amount of cost after apportionment of costs in opposition, the EPC provides:

**Rule 88 Costs**

(3) A request for a decision by the Opposition Division may be filed within one month of the communication on the fixing of costs under paragraph 2. The request shall be filed in writing and state the grounds on which it is based. ***It shall not be deemed to be filed until the prescribed fee has been paid.***

90. The wording of the last sentence of Rule 88(3) substantially corresponds to that of Article 108 EPC.

91. For Rule 88(3) EPC it has -to my knowledge- never been questioned what the effect is of non-payment or too late payment of the prescribed fee: the effect is well-recognized to be that the request is deemed not filed, not that it would be inadmissible.

92. There is no reason why the effect of non-payment or too late payment of the appeal fee should not be the same: the effect is that the notice is not considered filed.

***Conservation of evidence***

93. Fixing the amount of cost after apportionment of costs in opposition, the EPC provides:

**Rule 123 Conservation of evidence**

(3) ***The request shall not be deemed to have been filed until the prescribed fee has been paid.***

94. The wording of the last sentence of Rule 123(3) substantially corresponds to that of Article 108 EPC.
95. For Rule 123(3) EPC it has -to my knowledge- never been questioned what the effect is of non-payment or too late payment of the prescribed fee: the effect is well-recognized to be that the request is deemed not filed, not that it would be inadmissible.
96. There is no reason why the effect of non-payment or too late payment of the appeal fee should not be the same: the effect is that the notice is not considered filed.

### **Comment**

97. A somewhat strange situation may seem to occur if the notice of appeal is filed within the 2-month time limit of Article 108 EPC, the appeal fee is paid after expiry of the 2-month time limit but before the expiry of the 4-month time limit of Article 108 to file the grounds, and the grounds are filed within the 4-month time limit.
98. It may seem that the 'appellant' gets here into a situation where he can only get 50% of the appeal fee reimbursed under Rule 103(2) EPC as in force since 01.04.2014 if the appeal is withdrawn after filing of the grounds (whereas he could have gotten a full reimbursement if he withdraws before filing the grounds and before the expiry of the 4-month period). I.e., it may seem as he may at best get 50% reimbursed and he would not be able to get a full reimbursement under Rule 103(1) EPC.
99. However, as the appeal fee is paid too late, the appeal is deemed not filed. Thus, its status is not deemed to be withdrawn or withdrawn. As a consequence, the full appeal fee is reimbursed, not under the provisions of Rule 103 EPC, but because the appeal is deemed not filed / never came into existence such that there is no legal basis for payment.

### **Conclusions**

100. The answer to the question should be that, if notice of appeal is filed and/or the appeal fee is paid after expiry of the two-month time limit under Article 108 EPC, it is deemed not to have been filed. The appeal never came into existence. The question of admissibility is not to be addressed, as that requires the appeal to be in existence.
101. If the notice of appeal is filed after expiry of the two-month time limit under Article 108 EPC, the notice is filed too late and hence considered not validly filed, such that no appeal came into existence and there is no legal basis for payment of the appeal fee, whereby the appeal fee must be reimbursed.

102. If the notice of appeal is received by the EPO within the two-month time limit and the appeal fee is paid after expiry of the two-month time limit under Article 108 EPC, the payment is too late such that it is not valid – as a result, the notice of appeal is not considered filed and the appeal fee must be refunded.

103. These conclusions derive from the wording of Article 108 EPC itself, and are supported by case law. Some deviations in case law may be explained from a wrong English translation of J 12/80, of which the authentic text is French. Some deviations may be explained due to a lack of acknowledgement of the precedence of an Article over its implementing Regulations, and/or ignoring that Article 108 itself already provides for the effect of a lack of payment within the 2-month time limit. Further, several other provisions in the EPC (Articles and Rules) use substantially the same wording; for those provisions, the associated notices or requests are generally and well understood to be deemed not filed if the associated fee is not paid within the time limit set. There is no reason to conclude differently for the notice of appeal and the appeal fee than for these other notices/requests and their fees.

Looking forward to your considerations and your decision/opinion,

Kind regards,



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