

EPO Case Law

presentation FICPI – Turkey webinar

17 June 2020

Derk Visser

Contents

Enlarged Board of Appeal

Appeal inadmissible or deemed not filed?	G1/18
Right to oral proceedings & Haar or Munich	G2/19
Art. 164(2) EPC / Pepper	G3/19

BoA decisions

How does case law develop?	
Selection from multiple convergent lists	T1621/16
Machine as inventor	EP18275163
Good faith in correcting payment	T703/19
Correction of payment	T317/19; J8/19
Measurements in drawings	T1943/15

Enlarged Board of Appeal

G1/18; Referral by President to EBA, Appeal inadmissible or deemed not filed?

When the notice of appeal is filed and/or the appeal fee paid after expiry of the 2-month appeal period of Art. 108, is the appeal deemed not filed, as held by [T1325/15](#) and the appeal fee reimbursed, or is the appeal inadmissible, as held by [T1897/17](#) and the appeal fee not reimbursed? The President [referred](#) the question to the Enlarged Board of Appeal (EBA), issued as opinion G1/18.

The same question was referred to the EBA in G1/14 and G2/14. The board did not answer the question in G1/14 because the patent application was deemed to be withdrawn and neither in G2/14 because the referral was found inadmissible.

The answer to the referred question hinges on the interpretation of the second sentence of Art. 108, which reads “Notice of appeal shall not be deemed to have been filed until the fee for appeal has been paid.” The EBA in its opinion G1/18 interpreted the second sentence of Art. 108 using several rules of interpretation.

The narrow literal interpretation of the sentence is, that the legal fiction ‘deemed to have been filed’ merely states that the notice of appeal is deemed to have been filed on the date the appeal fee is paid. If the appeal fee is paid after the two-month appeal period, the notice of appeal is regarded as filed also after the two-month period. In this example the appeal is not ‘deemed not to have been filed’, because after payment of the appeal fee it is regarded as filed, albeit late; instead the appeal is inadmissible under R. 101(1) as not complying with the requirements of Art. 108. (r. B.VI(2)(a))

In the broad literal interpretation, the legal fiction is that the notice of appeal is regarded as filed when the appeal fee is paid within the two-month period. According to the EBA the wording of the second sentence on the payment gives a temporal link with the first sentence, mentioning the two-month period for filing the notice of appeal. Hence, the appeal fee must be paid within the two-month period. The board made a comparison with a similar temporal link in R. 22(2): ‘The request shall not be deemed to have been filed until such time as an administrative fee has been paid’. A notice of appeal filed within the two-month period will initiate an appeal only if the appeal fee is also paid within that same two-month period. If the appeal fee is paid late or is not paid at all, the legal fiction comes into play and the notice of appeal is deemed not to have been filed or, in other words, the document produced as notice of appeal within the two-month period is deemed not to have been received (r. B.VI(2)(b)).

The EBA held that the broad literal interpretation is in keeping with the purpose of Art. 108. A systematic and a teleological interpretation both confirm the broad literal interpretation. The different boards that used the narrow and broad literal interpretation both based their arguments on the Travaux Préparatoires of the EPC 1973 on Art. 108. The EBA showed, that the statement in the Travaux Préparatoires on which the narrow literal interpretation was based was contradictory and could therefore not be used as basis for the interpretation of the second sentence (r. B.X).

Art. 108 does not expressly state that the consequence of late payment is that the appeal is deemed not to have been filed. However, the sanction ‘notice of appeal shall not be deemed to have been filed’ is intentionally covered by the general wording of R. 112, the sanction being a loss of rights caused by a legal fiction. That rule provides a simplified procedure, where a mere failure to observe a period allows closing of the file without the EPO having to give a reasoned decision. (r.B.V.3)

The EBA held that the case where the notice of appeal is filed after the two-month period is covered by R. 112 and that the notice is to be regarded as deemed not to have been filed. As a consequence, the appeal proceedings have not been initiated. (r. B.VI)

The appeal fee becomes due the date the notice of appeal is filed (consequence of Rfees4). If the payment of the appeal fee is made after the two-month period, it is paid at a time the notice of appeal is deemed not to have been filed. Hence, the appeal fee is no longer due and must therefore be reimbursed, being paid for no reason (r. B.VIII). If no notice of appeal has been filed, any payment of the appeal fee will have to be regarded as lacking legal basis and have to be reimbursed according to established case law. If the payment is made within the two-month period and the notice of appeal is filed after expiry of that two-month period, the payment is made before the due date and is postponed to the date of filing the notice of appeal. At that date, after said expiry, the appeal does not exist and the fee must be reimbursed, being paid for no reason (r. B.IX).

In conclusion, a notice of appeal is deemed not to have been filed

- a) where notice of appeal was filed within the two-month period AND the appeal fee was paid after expiry of that period;
- b) where notice of appeal was filed after expiry of the two-month period AND the appeal fee was paid after expiry of that period;
- c) where the appeal fee was paid within the two-month period AND notice of appeal was filed after expiry of that period.

The EPO will reimburse the appeal fee in the above three cases and also in the case where the appeal fee was paid AND no notice of appeal was filed at all.

Comments

1) The three versions of Art. 108 differ substantially in their wording. Whereas the English version starts with ‘Notice of appeal shall be filed’, the German version begins with ‘Die Beschwerde ist ... einzulegen’ instead of ‘Die Beschwerdeschrift ist ... einzureichen’ and the French version: ‘Le recours doit être formé’ instead of ‘L’acte de recours doit être déposé’. The EBA held that ‘notice of appeal filed’ and ‘appeal filed’ are to be understood as synonyms; the same applies to the German and French versions (B.IV.1(1)).

It would have been preferable had the EBA stated that ‘appeal filed’ should be *read as* ‘notice of appeal filed’ instead of being *synonyms*. You cannot file an appeal, just as you cannot file a re-establishment; instead you file a notice of appeal to initiate an appeal and you file a request for re-establishment to remedy a loss of rights.

2) In its narrow literal interpretation of the second sentence of Art. 108, the EBA did not take its first sentence of the provision into account. Had the EBA done so, they might have arrived at a similar interpretation as the broad literal interpretation, but staying closer to the wording of the provision.

In its broad literal interpretation of the second sentence, the EBA did not analyse the status of the appeal during the two-month appeal period. Only after expiry of the period is the status determined: if both acts have been carried out within the period, the appeal is initiated; if one or both acts have not been carried out within the period, the appeal is not initiated and the notice of appeal is (deemed) not filed.

3) In reason B.I.2(a) of G1/18 the EBA emphasise the relevance of the answer to the referred question by noting that several provisions in the EPC use a legal fiction having the same wording as Art. 108. However, the EBA did apparently not check whether their answer was applicable to these provisions. In review case [R1/18](#), issued just two months after G1/18, the EBA arrived at the conclusion that the interpretation of the legal fiction given in G1/18 is not directly applicable to R. 136(1) about payment of the fee for re-establishment (see r. 14).

G2/19 Right to oral proceedings and Haar or Munich

A third party files five different observations, amongst others regarding clarity of the claims, during examination proceedings. Several observations are filed well after despatch of the last R. 71(3) communication; the examining division does not deal with their content, although according to the Guidelines they should have taken them into account.

The granted claims nor the documents in the file show that all observations on clarity had been taken into account. The third party files an appeal against the decision to grant with the request to reopen grant proceedings and examine the clarity of the claims. Since clarity objections against granted claims may not be raised in opposition, appealing the decision to grant is the only option for the third party to have the clarity examined. On receipt of summons for oral proceedings in Haar, the third party requests oral proceedings in Munich, because Haar is not a location mentioned in [Art. 6\(2\) EPC](#).

In decision [T831/17](#) the board of appeal refers three questions to the Enlarged Board of Appeal (EBA) (condensed by DV):

1. In appeal proceedings, is the right to oral proceedings limited if the appeal is manifestly inadmissible?
2. If the answer is yes, is the appeal in this particular case inadmissible?
3. Does holding oral proceedings in Haar infringe Article 116 EPC if the appellant has requested to move them to Munich?

Right to oral proceedings

In its decision [G2/19](#) the EBA did not answer the first question, because it was too general in view of the specific circumstances of the case.

In answering the combined question 1 & 2, the EBA holds, that the right to oral proceedings as laid down in Art. 116 EPC is not absolute, as held previously by some boards. Such an absolute character would not be compatible with the diversity of application of oral proceedings in the EPO procedures. There should be exceptions to this right if oral proceedings would not make sense. They do not make sense in the present proceedings. The third party is not a party to the proceedings according to Art. 115, second sentence. He also does not fulfil the requirement of Art. 107 to file an appeal, because he was not party to the previous proceedings. He is not party to the appeal proceedings and has, accordingly, no procedural rights, in particular no right to be heard. The third party is merely a de facto party, which position does not give him the right to oral proceedings.

Whereas the EBA formulates its first question quite narrowly by restricting it to this particular case, the reasons of the decision give a broad answers, not restricted to appealing a grant decision, requesting re-opening of the examination proceedings in order to take clarity objections into account. The broad answer in reason C.I is ‘.. the boards of appeal are not obliged .. to grant a request for oral proceedings if the procedure involves an obviously inadmissible appeal’ and in reason B.II.8 that Article 116(1) EPC must be interpreted narrowly in that a de facto party has no right to oral proceedings, if he was not authorized to file an appeal because he was not party to the previous proceedings or if he pursues a goal that is inadmissible in appeal.

Legality of oral proceedings in Haar

The relocation of the boards of appeal from Munich to Haar does not affect the jurisdiction of the boards, according to the EBA, even though the relocation may not be in accordance with the EPC. However, the relocation might affect the right of a party to be heard, which right includes to be heard at a correct location. The right to be heard might be violated if a place or time is chosen entirely outside the usual framework, which could be regarded as unwillingness of the boards to deal with a case. Such is seriously not the case with regard to the relocation of

the boards from Munich to Haar. The alleged violation of the right to be heard of the third party does not go beyond perceived lack of convenience.

Since there is no violation of the right to be heard in the specific location of proceedings, the EBA regards it legally unnecessary to check whether the legal basis of the relocation has flaws that affect party rights. Hence, the EBA will not examine whether the President and the Administrative Council were authorised to relocate the boards from Munich to Haar and whether Haar is covered by Art. 6(2) EPC. The EBA noted, that the awareness of independence of the boards was gradually raised only after establishment of the EPO. It would not be convincing to restrict the spatial separation of the boards to the city limits of Munich when emphasising the necessity of spatial separation of the boards from the administrative departments in view of their independence.

G3/19 Product of essentially biological process

Art. 53(b) excludes essentially biological processes from patenting. The EBA determined in G2/07 and G1/08 the interpretation of the phrase ‘essentially biological’. G2/12 and G2/13 held that the limitation of patentability in Art. 53(b) should be interpreted narrowly and that the exclusion only applies to essentially biological processes but not to products of essentially biological processes.

A subsequent Notice of the European Commission on the Biotech Directive stated that the intention of the EU legislator was to exclude from patentability products that are obtained by means of essentially biological processes. The EU council welcomed the statement and recommended member states and the EPO to follow the recommended practice. All 38 EU Contracting States declared that under their national law and practice the products of essentially biological processes are excluded from patentability. In response to the Notice, the Administrative Council of the EPO introduced a new R. 28(2), which excludes those products from patentability.

Decision [T1063/18](#) of 05-12-2018 held that new R. 28(2) is in conflict with Art. 53(b) as interpreted by the EBA in G2/12 and G2/13. The Notice of the European Commission is not a binding interpretation of EU law such as the Biotech Directive, only a decision of the Court of Justice of the EU would be binding. In accordance with Art. 164(2), the provisions of the Convention must prevail and R. 28(2) should be disregarded.

The President of the EPO referred two questions to the EBA: (1) Is a new clarification of Art. 53 in the Rules limited by an interpretation of the Article by an earlier decision of a BoA or the EBA? (2) If the clarification is indeed limited, is new R. 28(2) in conformity with Art. 53(b)?

The EBA holds in its opinion [G3/19](#) of 14-05-2020 that it cannot deduce from the doctrine of separation of powers that there is a general prohibition on adopting secondary legislation, here R. 28(2), which concerns the interpretation of a provision of primary legislation, here Art. 53(b), given by a court, here the EBA (r.XXV.3.1). The interpretation of Art. 53(b) is not settled once and for all by G2/12; later developments may require a different interpretation. Such change in interpretation is intrinsic to the ongoing development of the law by jurisprudence (r. XVIII-XX). Later developments can be taken into account using the dynamic interpretation of the law, which might give rise to an interpretation that diverges from the wording of the law (r. XXII).

The introduction of R. 28(2) by the Administrative Council is a development that substantially changed the situation underlying G2/12, which shows the evolution of the intention and aims of the Contracting States with regard to Art. 53(b). R. 28(2) extends the scope of Art. 53(b), which by its wording is restricted to exclude only processes, to exclude also the products of such processes.

There is no longer a conflict between Art. 53(b) and R. 28(2) because of the new interpretation of Art. 53(b) (r. XXVII). The new interpretation has no retroactive effect and applies only to applications filed on or after 01-07-2017. The relevant date is the date of filing or, if priority has been claimed, the priority date. (r. XXIX)

BoA decisions

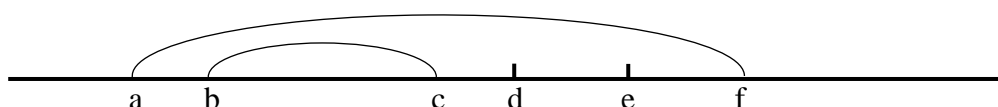
How does case law develop?

In the Case Law presentation of June 2019, we looked at the criteria for novelty of a sub-range. The months following the presentation showed the process of how the EPO modified the criteria by changing the interpretation of the EPC.

The usual three criteria for novelty of a selection of a sub-range from a broad range are (G-VI, 8(ii), 2018 edition):

1. the selected sub-range is narrow;
2. the selected sub-range is sufficiently far removed from known examples and from the end points;
3. the selected area is not an arbitrary specimen from the prior art, i.e. not a mere embodiment of the prior description, but another invention (purposive selection).

Presented graphically, in a known, broader range a-f with known examples d and e,



a sub-range b-c is novel if b-c is narrow compared to a-f; b-c is far removed from the known examples d, e and the from end-points a, f; and another technical effect occurs in b-c than the known effect in a-f.

These criteria were formulated for the first time in decision [T198/84](#), r.4-7 of February 1985. However, the ‘far removed from the end points’ criterion is not mentioned in T198/84 nor in any later decision of the boards. In 2005, when the three criteria were included for the first time in the Guidelines, the endpoints were also introduced. As a consequence, the end points have been treated differently by departments of first and second instance since 2005. Although the boards have recognised this difference (see [T261/15](#) r.2.3.2), the Guidelines still mention the end points.

In decision [T1233/05](#), r.4.4, issued April 2008, a board held for the first time, that criterion 3 on the different technical effect should not be used for novelty but instead for inventive step. Some later decisions followed the new line of interpretation of T1233/05, whereas other decisions maintained the third criterion for the assessment of novelty.

The 7th edition of the book *Case Law of the Boards of Appeal of the EPO* (CLBA 2016) repeats the three criteria, of course not mentioning the end-points in criterion 2. In July 2019 the 8th edition was published ([CLBA 2019](#)), mentioning the same three criteria as in the 7th edition and again several decisions with divergent views on the third criterion.

During the summer of 2019 it became clear, that the EPO was going to amend section G-VI,8(ii) of the Guidelines by dropping the third criterion, but maintaining that the effect in the sub-range can be used to ‘confirm’ that the sub-range is novel. This would mean, that the criteria for novelty of a sub-range in the Guidelines would differ even more from those in the CLBA 2019.

The differences between the Guidelines and the CLBA and, additionally, the recent proposed amendments of the Guidelines gave rise to two articles, one¹ recommending to refer all three criteria to the Enlarged Board of Appeal because none of them complies with the interpretation of novelty set out in recent EBA decisions², the other³ proposing to maintain the third criterion.

The epi was also concerned about the lack of clarity in the information coming from the EPO about the use of the third criterion. The president of the epi sent a letter⁴ to the president of the EPO on 17-10-2019, pointing out the confusing status of the third criterion and requesting to refer the question of the criteria for novelty of a sub-range to the EBA.

The following month the director of the Directorate Patent Law in DG5 responded in a letter⁵ to the epi by explaining why the third criterion was removed in the 2019 edition of the Guidelines. Since 2008 there have been two lines of decisions by boards, the traditional one using the third criterion for novelty of a sub-range and a new line using the third criterion in the assessment of inventive step. The directorate has closely monitored the case law and noticed that there are four boards that usually deal with sub-ranges. Three of these boards have dropped the third criterion in the past few years. The fourth board, which consistently maintained the traditional line since 2008, shifted to the new line in its decision [T261/15](#) of 7-2-2018. DG5 regarded this as a 'clear trend' towards abandoning the third criterion. Since the EPC must be interpreted according to the boards' latest findings, they decided to amend the Guidelines accordingly, thereby clearly showing how the EPO departments assess novelty of sub-ranges.

The above trend with different lines of case law over a period of more than ten years is a normal development of the case law rather than a contradiction, according to DG5 and the EBA⁶. Hence, there is no need for a referral to the EBA to have them review the case law.

Comment

Whereas the EPO regards two different lines of decisions by boards as a normal development of case law, rather than a contradiction, users of the system, however, will regard the decisions as contradictory, causing a long period, possibly more than ten years, of uncertainty about the direction a board will go. Most users do not have the resources to review years of decisions and establish trends as done by DG5; they have to rely on what the EPO communicates.

The above course of events shows that the Legal Research Service of the Boards of Appeal, who update the CLBA each three years, had not carried out the same investigation of the third criterion as DG5 had done and DG5 had apparently not discussed their findings with them to reach a common view. Hence, both directorates general communicated different messages to the users of the EPC. Had the letter from the EPO to epi not been published, the confusion about the case law on the third criterion would have continued for quite some time.

Legal certainty of the users would benefit from a better internal communication within the EPO and a clearer statement to the users of the EPC why an interpretation of the EPC was changed instead of a mere amendment of the Guidelines. The clarity offered in the present case was accidental, being just a collateral benefit of a response by the EPO to a question for referral.

¹ *Novelty Test for Sub-Ranges*, D. Visser, [epi Information 04/2019, page 27](#)

² See e.g. [G1/16](#), r.17

³ *Guidelines November 2019: Purposive selection no longer needed for novelty of sub-ranges?*, R. van Woudenberg, [epi Information 04/2019, page 34](#)

⁴ Letter to the president of the EPO by Francis Leyder, [epi Information 04/2019, page 10](#)

⁵ Letter to the president of the epi by Heli Pihlajamaa, [epi Information 04/2019, page 13](#)

⁶ G3/08, r. 7.3.1 and 7.3.6

T1621/16 Selection from multiple convergent lists

The decision relates to the allowability of a selection made from two convergent lists. The main claim includes several selections, but the essence of the decision is best illustrated by the following simplified claims:

Claim 1 as originally filed:

Dishwashing detergent comprising

0.1% to 20% of surfactant A; at least 5% of surfactant B; ...

Claim 1 as amended in opposition

Dishwashing detergent comprising

0.2% to 3% of surfactant A; 15% to 25% of surfactant B; ...

Description of application as published:

A: “from 0.1% to 20%, preferably from 0.2% to 5%, more preferably from 0.2% to 3%”

B: “at least 5%, preferably from 5% to 40% and more preferably from 15% to 30% and even more preferably at 15% to 25%”

The amendment of claim 1 is among others a selection from two lists, both disclosed in the description. The lists distinguish from the usual lists by being convergent, i.e. each element of the list is completely contained in the preceding element, narrowing down from less preferred to most preferred options.

The amendment only complies with Art. 123(2), if the selection does not introduce subject-matter that was not disclosed in the application as filed. In its assessment, the board analysed the case law for making selections from multiple lists (see r.1.6 – 1.7).

It is established case law, that an amendment based on a combination of elements taken from two or more lists in general extends subject-matter, violating Art. 123(2). However, the combination does not extend subject-matter if the application contains a pointer to the combination, e.g. the description discloses the combination or dependent claims define the combination.

This case law is based on non-converging lists. Each element in such lists is an individual, distinct feature. A combination of specific elements from such lists leads to a singling out of an invention from among several distinct alternatives, which might provide an unwarranted advantage if there is no way to anticipate which of the different inventions will eventually be protected.

In contrast, the elements of a converging list are not distinct features but more or less restricted features of one and the same feature. A selection from such a list does not single out an invention from a plurality of distinct options, but leads to a more or less restricted version of the feature (r.1.7.2). Case law on the allowability of a selection from multiple converging lists is not consistent (r.1.6.3).

The present board considered that there is an analogy between selecting elements from multiple converging lists and deleting elements from multiple non-converging lists, in that both lead to a restriction of the scope. Deleting elements from non-convergent lists is allowable according to consistent case law, provided that not a specific undisclosed invention is singled out, and that the selected combination does not generate another undisclosed invention by providing a technical contribution to the application as filed. An example of deleting elements from multiple lists is to delete elements A1 and B2 from the two lists A1, A2, A3 and B1, B2, B3.

Because of the analogy, a combination of selections from converging lists should also be allowable. The board requires that the selection complies with two requirements. Firstly, the combination of elements selected from the converging lists must be supported by the application as filed; the restriction of the scope must not be arbitrary but purposeful by converging to

a preferred form of the invention. This support should be by a pointer in the application as filed, e.g. by an example disclosed in the description or by a specific embodiment disclosed in the dependent claims, both of which fall within the subject-matter of the amended claim. In such a case the multiple selections are not arbitrary but purposeful by converging towards the most preferred form of the invention. Secondly, the combination should not have an undisclosed technical contribution to avoid an unwarranted advantage of the applicant. (r.1.7.3)

The amended claim 1 in the present case included selections from ten lists, one of which was non-convergent and nine convergent. The board allowed the amendment (r.1.8)

Comment

The requirement on technical effect of the combination in T1621/16 does not follow the present trend of boards to disregard the technical effect in the novelty assessment of sub-ranges.

Note, that the same disclosure test is used for allowability of amendments and novelty.

The decision suggests that it is advantageous to make lists convergent when drafting a patent application, e.g. by adding ‘preferred, more preferred, ...’. It appears to allow any combination of selections from multiple lists. The selection from a converging list need not be the most preferred element, as is shown in the present case.

EP18275163 Machine as inventor

The applicant had indicated in his patent application an artificial intelligence machine ‘Dabus’ as inventor. He had acquired the right to the patent from the inventor by being its owner. The applicant held, that the machine was the actual deviser of the invention and naming the applicant instead would be contrary to the requirement that the actual deviser must be indicated.

The Receiving Section refuses the application, because the requirements of R. 19(1) have not been complied with, such as providing the family name and given name of the inventor. A machine cannot be designated as inventor. The EPO considers that the inventor must be a natural person. The legislators of the EPC agreed that the term ‘inventor’ refers to a natural person only. This is also an internationally applicable standard; various national courts have issued decisions to this effect.

Only an inventor having a legal personality can exercise and enjoy rights, such the right to be mentioned before the EPO (Art. 62) and in the application and patent specification (Art. 81). A machine does not have a legal personality and can therefore not exercise and enjoy rights. Giving a name to a machine is not sufficient to give it legal personality.

The applicant has appealed the decision of the Receiving Section.

The application appears to be a test case for having a machine as inventor. Artificial intelligence may be able to devise non-obvious solutions and this application is an attempt to have its status as inventor recognised.

T703/19 Good faith and warning of missing payment

The notice of appeal states “The appeal fee is herewith paid via Online fee payment”. The attached debit order mentions the appeal fee and the correct amount but does not indicate the method of payment. After expiry of the two-month appeal period, the appellant notices the error, pays the appeal fee and files an additional request to regard the late-paid appeal fee as being timely paid, because the EPO should, based on good faith, have warned the appellant of the missing payment.

In its decision of August 2019 the board held that the debit order was filed correctly, but the information provided in the order was insufficient to complete the payment. The board

explained that any additional information about payment contained in the notice of appeal cannot be taken into account, because according to ADA 5.1.1 ‘Debiting occurs only on the basis of an electronic debit order signed by the account holder or the authorised representative’ (T703/19 r.8, 9). In the present case, the EPO should have sent the appellant a warning, so he could correct the deficiency before expiry of the two-month appeal period (r.21).

In the examination whether the payment could be remedied using good faith, the board gave a summary of case law on good faith in relation to missing payments.

Since a party is responsible to take all necessary steps to avoid a loss of rights, the EPO is not obliged to warn the party for any deficiency. However, the principle of good faith, also referred to as the principle of the protection of legitimate expectations, requires the EPO to warn a party of any loss of rights caused by a deficient act of the party if such a warning can be expected in all good faith. That is the case if the EPO can readily identify the deficiency and the party can correct it in due time. (G2/97 r.4)

1. Readily identifiable

A notice of appeal that does not make reference to a payment of the appeal fee and has no debit order attached will not be regarded as deficient because of a missing payment. Many payments are made in a way which is not apparent from the letter of the party and are often carried out close to the expiry of a period. Hence, the EPO can only establish that the payment was made once the period has expired. In such a case there is no readily identifiable deficiency and good faith does not require the EPO to issue a warning of a missing payment after receipt of the notice of appeal. (G2/97 r.3.3)

However, if the notice of appeal states that payment is made herewith and the payment is not carried out, the EPO should warn the party (G2/97 r.4.1). Hence, it is recommended to refer to the intended payment in a letter to the EPO. The EPO should also notify a party of a readily identifiable deficiency in a submitted debit order (T703/19 r.21). A missing indication of the method of payment in a debit order, where the intention of the party to pay is evident, is a readily identifiable deficiency (T703/19 r.16).

2. Correction in due time

The EPO need only send a warning if the party can still correct the deficiency within the applicable period, e.g. the two-month appeal period when paying the appeal fee. A deficient debit order filed one month before expiry of the period is sufficient time for the EPO to send a warning and for the applicant to correct the deficiency (e.g. T703/19 r.21 and T14/89). However, a party should not expect a warning if there is a deficiency in an act carried out on the last day of the period (see e.g. J13/11). T642/12 held that one week is too short; T445/98 held that two weeks is also too short for issuing a warning and correcting a deficiency.

See chapter [III.A.3.3.1](#) of the book Case Law of the EPO Boards of Appeal for cases where the EPO need not send a warning because the deficiencies are wholly within the responsibility of the party and chapter [III.A.3.3.2](#) for deficiencies that are not readily identifiable.

T317/19 Correction of payment

Since 1984 the EPO holds that payments cannot be corrected using R. 139. This is clearly reflected in the latest edition of the Guidelines (November 2019), [A-X, 7.1.1](#):

“Payment is a matter of fact whereby a certain amount is transferred to and put at the disposal of the EPO. It is not, therefore, a procedural declaration which may be corrected pursuant to Rule 139. The same applies to debit orders (see [T 170/83](#), reasons 8). Therefore, time limits for payment are in principle deemed to have been observed only if the full amount of the fee has been paid in due time.”

The need for correcting instructions for payment has decreased by the introduction of electronic debit orders, in which the EPO fills in the correct wording and amounts of the fees. However,

if a payer does not fill in all boxes or does not use the fee amounts filled in by the EPO but enters the amounts himself, the debit order may be deficient.

In the present case, the appellant electronically filed a notice of appeal and indicated in the notice that it was ‘paying the appeal fee from our deposit account no. [XX] by way of the attached fee sheet’. The fee sheet or debit order was filed in the correct format and indicated the appeal fee and the correct amount, but the box ‘Method of payment’ stated ‘Not specified’ instead of a permitted method. The EPO informed the appellant after the appeal period in a communication, that the debit order was considered invalid because it was not filed in a prescribed electronically processable XML format and was therefore not to be carried out.

The patent attorney called the EPO to clarify the situation. They told him that the debit order was not carried out, because the method of payment was missing. The EPO did not explain why they sent the communication, in spite of the fact that the debit order was filed in the correct format. The patent attorney deduced from the facts that, since the debit order could not be carried out because of the missing information, the indication in the notice of appeal was regarded as a payment instruction; however, this instruction was not filed in the correct XML format and could therefore neither be carried out. This also explains the communication about using the incorrect format. It should be noted that this explanation of the error is neither included in the report of the telephone consultation in the EPO file nor in the decision of the board; the above decision T703/19 is much clearer about the actual nature of the error.

In response to the communication, the appellant made a correct payment after the 2-month appeal period. The appellant requested a correction of the debit order under R. 139 and auxiliary re-establishment under Art. 122. The requested correction was to indicate ‘Debit from deposit account’ as method of payment and add the number of the deposit account. The appellant pointed out that in contrast with the above statement in the Guidelines, the correction under R. 139 is broadly applicable, following decision G1/12, and should also apply to correcting a debit order.

The board in its decision of October 2019 allowed the correction of the error in the debit order under R.139.

The board showed that in earlier decisions boards denied that R. 139 could be applied generally, because it would circumvent the requirements for re-establishment of rights under Art. 122. R. 139 should not be used to cancel procedural effects after failure to meet a time limit.

However, decision G1/12 of the EBA, issued 30-04-2014, changed the applicability of R. 139. The EBA made it possible to correct the appellant’s name provided in the notice of appeal applying R. 139. The rule may be applied to any document filed with the EPO. The present board therefore applied R. 139 to correction of the debit order filed by the applicant. (r. 2.3.3)

The EBA imposed the following four requirements on a correction under R. 139, first sentence (r.2.4):

1. The correction of an error must introduce what was originally intended.
2. Where the original intention is not immediately apparent, the requester bears the burden of proof, which must be a heavy one.
3. The error may be an incorrect statement or an omission.
4. The request must be filed without delay.

The present board added three more requirements taken from earlier case law to safeguard legal certainty and the interests of third parties and the public:

5. The need for legal certainty, according to which parties are, as a rule, bound by their procedural acts.
6. The public should, in general, be able to rely on the information published by the EPO.
7. The correction should not cause the application to have an unclear legal status for a long period.

The requested correction complied with all requirements: 1. The original intention was clear from the debit order and the indication in the notice of appeal. 2. The requirements as to the

appellant's burden of proof do not apply here. 3. The error, the wrong indication in the 'Method of payment' box is an incorrect statement. 4. The request for correction was filed nine days after the EPO communication. 5. Legal certainty for parties does not play a role, because it is an ex parte case without a respondent who may have relied on the original non-payment. 6. The public cannot necessarily infer that the published facts inevitably lead to certain legal consequences, in particular not if a request for correction has been filed. 7. There is no long unclear status.

The correction has retroactive effect. Hence, the debit order is regarded as being given on the date of the first payment. Since the balance of the deposit account was sufficient on that date to pay the full fee, that date is considered as the payment date. (r.2.5)

The credit for pointing out that G1/12 permits a broad application of R. 139 should be given to the patent attorney, who suggested it to the BoA (see point VII of Summary of Facts and Submissions).

J8/19 Correction of payment

In case J8/19 the appellant sent an electronic debit order to the EPO for paying the appeal fee. The form for the debit order normally shows the latest applicable amounts of the fees. However, the paralegal making the payment selected the option 'Edit fee amounts' on the form and copied an amount of the appeal fee from an earlier notice of appeal, which was used as template for the present submission. As a consequence, an amount of € 1860 was paid instead of € 2255.

Immediately following a warning of the underpayment from the EPO, the appellant paid the outstanding part of the appeal fee, albeit after expiry of the 2-month appeal period, and requested that the electronic form used for paying be corrected under R. 139, first sentence.

The board in its decision of November 2019 allowed the correction of the error in the debit order. Large parts of the reasoning in the decision are literally identical to that of the above decision T317/19. However, the board added a fourth requirement from earlier case law:

8. The error should be caused by an excusable oversight. The present boards regarded this requirement as impairing the general applicability of R. 139. The exact criteria for the oversight are not clear to the board.

Comment

Section [A-X, 7.1.1](#) of the next update of the Guidelines, in April 2021, should be checked on whether DG1 takes over the broad applicability of R. 139 and in particular which of the above eight requirements. There is apparently support for the broad applicability because two different boards have used it. It is not certain whether the requirements 5-8 will be maintained in future corrections.

The present decision, which was issued one month after the above decision T317/19, added the requirement on excusable oversight. This requirement appears inappropriate for a correction under R. 139. The possibility that boards add extra requirements to the application of R.139 could make a correction using this rule an uncertain affair.

The question whether a R. 139 correction is applicable to a payment by bank transfer has not been answered. In such a case instructions are given to a bank (and not to the EPO) and in an separate notice, the EPO may be informed of the payment. Is the payer's statement of purpose of the payment on the bank transfer regarded as a document filed with the EPO and therefore corrigible under R. 139?

T1943/15 Measurements in drawings

The invention relates to a self-locking threaded connection between two tubes. The teeth of the threads have a width that varies in axial direction. The main claim defines two relations between the measures u , v , x and y of the width of the teeth: $y \leq 5x$ and $x/y \leq u/v$.

In the examination of novelty, the board examines whether prior art drawings disclose measures of teeth that fall within the claimed two ranges. The overview of case law on measuring in drawings given by the board is the reason for including T1943/15 in this presentation.

The two cases in the table where a ratio of dimensions is derivable from a schematic drawing are exceptions to the general rule, that dimensions and ratios of dimensions cannot be derived from schematic drawings.

Type of drawing	dimension derivable?	ratio of dimensions x and y derivable?	comment
Construction drawing	yes	yes	T204/83
Precise schematic drawing	no	yes	if the patent drawing resembles a construction drawing, T422/95
Schematic drawing	no	no	T204/83; T1664/06; T451/88
		yes	if the measured features are essential items of the invention, T748/91
		yes	if $x \gg y$, T748/91; T422/95; T1313/04
		no	if $x > 0.2y$, T1943/15 r.4.5
		no	if $x = y$, T1943/15 r.4.5