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DECISION
of 23 February 2004

Case Number: J 0013/03 - 3.1.1

Application Number: 99909848.6

Publication Number: -

IPC: E21B 23/00

Language of the proceedings: EN

Title of invention:

Actuator apparatus and method for downhole completion tools

Applicant:

Halliburton Energy Services, Inc.

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 78(2), 79(2), 112(1), 122(5), 150(3), 157(2)(b),
158(2)

PCT Art. 11(3), 22(1)(2), 39(1)a)b), 48(2)

EPC R. 85(1), 85a, 104b(1), 104c(1)

PCT R. 61.3

Keyword:

"Principle of protection of legitimate expectations"

"Restitutio -Euro - PCT applications - EPO designated Office"

Decisions cited:

G 0003/91, G 0005/93

Catchword:

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Case Number: J 0013/03 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 23 February 2004

Appellant: Halliburton Energy Services, Inc.
2601 Beltline Road
Carrollton
TX 75006 (US)

Representative: Curtis, Philip Anthony
A.A. Thornton & Co.
235 High Holborn
London WC1V 7LE (GB)

Decision under appeal: Decision of the Receiving Section of the
European Patent Office dated 31 July 2002
deciding that European patent application
No. 999098486 be deemed withdrawn as of
7 December 1999 and refusing three requests for
restitutio in intergrum under Article 122(1)
EPC.

Composition of the Board:

Chairman: J.-C. Saisset
Members: S. U. Hoffmann
E. Lachacinski

Summary of Facts and Submissions

- I. International patent application PCT/US99/04840 was filed by the appellant's US professional representative with the U.S. Patent Office acting as receiving Office on 4 March 1999. The appellant's place of business was in the United States.
- II. The application claiming priority from the previous application US98/076806 of 4 March 1998 designated *inter alia* the EPO for the purposes of obtaining a European patent.
- III. On 20 September 1999 EPO Form 1201 was sent by the EPO to the appellant's US patent attorney informing him of the procedural steps to be taken for entry into the regional phase after expiry of the 21st or 31st month before the EPO acting as the designated Office.
- IV. On 6 October 1999 a request for international preliminary examination was signed by the appellant's US representative and filed with the U.S. Patent Office on the same date.
- V. On 25 October 1999 the appellant's US attorney received a communication dated 22 October 1999 from the U.S. Patent Office as International Preliminary Examining Authority (Form PCT/IB/332) giving the 6 October 1999 as date of receipt of the demand for international preliminary examination. A pre-printed standard text in paragraph 3 of this form was not crossed which would have drawn the reader's attention to the fact that the date of receipt was after the expiration of 19 months from the priority date.

VI. On 12 November 1999 the appellant's US attorney received from the International Bureau a communication under PCT Rule 61.3 dated 3 November 1999 by which the appellant was informed that the elections of the national Offices had been made after the expiration of 19 months from the priority date and that the applicant was reminded that he had to enter the national phase before the expiration of 20 months from the priority date before the Offices concerned whereby some Offices had fixed time limits expiring later than 20 months.

VII. By communication dated 17 March 2000 sent directly to the applicant, the Receiving Section of the EPO informed him pursuant to Rule 85(a)(1) EPC that the national basic fee, the search fee and the designation fees for entry into the regional phase had not been paid within the time limit laid down in Rule 104b(1) EPC and that these fees could be validly paid together with a surcharge within a period of grace of one month of notification of that communication.

It was pointed out as additional important information that the European Patent Office was acting as designated/elected Office and since no professional representative entitled to practise before the EPO had been appointed so far (Article 133(2) EPC), that the communication was being sent directly to the Applicant.

Furthermore, it was indicated that if the communication had been dispatched upon expiration of 21 months from the priority date, the international preliminary examination under PCT Chapter II having been requested

- within the prescribed time limit and EP having been elected thereby extending the time limit for entry into the regional phase before the EPO to 31 months, applicants were invited to inform the EPO immediately.
- VIII. On 9 June 2000, a communication pursuant to Rule 69(1) EPC was also addressed directly to the appellant notifying him that the European patent application was deemed to be withdrawn because the national basic fee and search fee had not been validly paid within the prescribed time limits.
- IX. On 29 August 2000, EPO Form 1200 was filed by a European patent attorney on behalf of the appellant for entry into the regional phase before the EPO as designated Office in which it was indicated that all fees due should be paid by debit order.
- X. With letter of 15 September 2000 the EPO sent a copy of the notification of loss of rights of 9 June 2000 to the European patent attorney and pointed out that apparently the demand for preliminary examination had been sent late and therefore the entry into the regional phase had been foreseen on 4 December 1999 at the latest.
- XI. With letter received on 16 November 2000 a newly-appointed European patent attorney took over the representation of the case in suit and submitted three requests for *restitutio in integrum* under Article 122 EPC having paid three fees for *restitutio in integrum* on 13 November 2000.

The requests read as follows:

(1) We request *restitutio in integrum* in respect of the failure to respond to the EPO notification dated 9 June 2000. We also request under Rule 69(2) EPC that the EPO issues a decision on the loss of rights notified in the EPO notification dated 9 June 2000.

(2) We request *restitutio in integrum* in respect of the failure to pay the national fee and the search fee in response to the EPO notification dated 17 March 2000. We know that the present view of the EPO is that *restitutio in integrum* is not possible in respect of the failure to pay the national and search fee. Nevertheless, the applicant wishes to proceed with this request.

(3) We request, under Articles 26 and 48 PCT, as implemented under Articles 150 to 158 EPC, that the EPO excuses the delay in filing the demand within the 19 month period set under Article 39(1) PCT, thereby delaying the deadline for entering the regional phase in the EPO until 31 months from the priority date, and we request *restitutio in integrum* under Article 122 EPC of the failure to file the demand in time.

In the statement presented in respect of these requests the appellant submitted the following facts:

The person within the applicant's company responsible for handling the application on behalf of the applicant delegated the filing of the application to a US law firm where a US patent attorney became responsible for prosecuting the application and who was instructed to

file the demand for international preliminary examination which expired on 4 October 1999. It was argued that the 19-month period for filing the demand, although correctly entered in the applicant's US attorney's reminder system, had not been observed due to the mistake of a properly selected, instructed and supervised assistant. The fact that the demand had been filed late remained unnoticed, even on receipt of the communication from the International Bureau of 3 November 1999 (Form PCT/IB332) indicating that the demand had been filed outside the 19-month period, so that the reminder system indicated the 30-month deadline for entry into the national phase.

As no communication from the EPO was expected by the applicant prior to the expiration of the 30-month period, both the communication pursuant to Rule 85a(1) EPC dated 17 March 2000 and the communication pursuant Rule 69(1) EPC dated 9 June 2000 were not attended to. Additionally, it was argued that these communications were not addressed to any specific person and did not indicate the applicant's file reference. Moreover, the applicant's attorney had informed the appellant that the national phases would be initiated in, *inter alia*, Europe prior to the 30-month deadline.

It was only on 18 September 2000, on receipt of the EPO communication dated 15 September 2000 that the applicant's European representative became aware of the loss of rights in respect of the application. Accordingly, it was submitted that this was the date of removal of the cause of non-compliance with the time limits missed. The requests for *restitutio in integrum* having been filed within two months of this date, they

were claimed to be admissible and should be allowed because under the circumstances of this case, all persons involved in handling the application were considered to have taken the necessary due care.

XII. On 31 July 2002 the Receiving Section issued a decision and decided as follows:

(1) The request for *restitutio in integrum* under Article 122 EPC into the two-month period for responding to the loss of rights communication under Rule 69(1) EPC (EPO FORM 1205 dated 9 June 2000) is rejected.

(2) The request for *restitutio in integrum* under Article 122 EPC into the 21-month period for payment of the national fee and search fee in accordance with Article 22 PCT in conjunction with Rule 104b(1) EPC (in force until 29 February 2000) is rejected as inadmissible.

(3) The request for *restitutio in integrum* into the 19-month period for filing a demand for international preliminary examination (Article 39(1) PCT) is rejected as inadmissible.

(4) The application is deemed to be withdrawn as of 7 December 1999.

(5) All fees paid after 6 December 1999, except for the fee for re-establishment of rights, will be refunded once this decision has become final.

The reasons of the decision were based on the statement that the 21 month time limit under Rule 104(b)(1) EPC (the then valid version) extended by Rule 85a(1) EPC for entry into the regional phase before the EPO had not been met by the appellant. The 31 month limit under this rule could not apply because the request for international preliminary examination had not been filed with the US PTO prior to the expiration of the 19th month from the priority date as prescribed by Article 39(1) PCT.

As regards the request for *restitutio in integrum* into the two-month period for responding to the loss of rights communication under Rule 69(1) EPC the Receiving Section stated that the requirement of "all due care" within the meaning of Article 122(1) EPC had not been met by the appellant.

Furthermore, it was stated that the request for *restitutio in integrum* under Article 122 EPC into the 21-month period for payment of the national fee and search fee in accordance with Article 22(1) and (3) PCT in conjunction with Rule 104b(1) EPC was to be rejected as inadmissible under Article 122(5) EPC in accordance with the reasoning of the decision of the Enlarged Board of Appeal in G 3/91.

The request for *restitutio in integrum* into the 19 month period for filing a demand for international preliminary examination (Article 39(1) PCT) was rejected as inadmissible since due to the optional character of the filing of a demand, the non-observance of the time limit for doing so prior to the expiration of the 19 months from the priority date

(Article 39(1)(a) PCT) was not a time limit which, if not observed, would lead to any loss of rights within the meaning of Article 122(1) EPC.

XIII. The applicant lodged an appeal against that decision on 27 September 2002, and requested that the decision be set aside. The appeal fee was paid on the same day.

The statement of grounds of appeal was filed on 9 December 2002.

During the appeal proceedings the appellant submitted further facts and arguments.

The appellant invoked the principle of the protection of legitimate expectations and claimed that the application should be treated as validly filed.

The appellant admitted that the 19 month time limit for filing an international preliminary examination demand was not met due to, in the view of the appellant, an excusable mistake which occurred at the US law firm acting for the appellant during the international phase of the application. The appellant explained that this mistake remained unnoticed by the US representative because the original receipt-form for the demand had been incorrectly completed by the U.S. Patent Office in that the appropriate box indicating that the demand had been filed late had not been checked. It was additionally stated that form PCT/IPEA/407 had not been issued, which would have specifically notified the appellant's representative of the fact that the demand was deemed not to have been filed. Rather, the IPEA had issued requests to correct defects in the international

preliminary examination demand on 22 October 1999 and the Written Opinion on 7 January 2000. The appellant pointed out that he had not been specifically advised even in a Rule 85a EPC communication that the filing of the demand was not valid. The person responsible at the appellant's company for this case had been a US attorney at that time not familiar with the PCT and Euro-PCT procedures so that he and his staff had failed to understand the significance of the Rule 85a EPC communication believing that a copy of this communication would also have been sent to the US representative who would deal with this communication. This communication could be considered as unclear because it did not indicate that the 19 month time limit for filing an international preliminary examination demand had not been met. Therefore, the appellant believed that had the EPO made the mistakes and omissions which had been actually made by the IPEA, the principle of protection of legitimate expectations of applicants would have applied particularly with regard to the complexity of the procedures relating to Euro-PCT applications. By virtue of Article 38(2) PCT, PCT applicants should receive the same treatment as applicants under the national law and, therefore, his application should proceed as if the demand for international preliminary examination had been validly filed.

During the appeal proceedings the appellant maintained his view that he as well as his US representative had taken "all due care" within the meaning of Article 122(1) EPC and filed copies of affidavits sworn by five persons who were involved in dealing with the case in suit at the appellant's company and at the US

law firm. The appellant argued that *restitutio in integrum* in respect of the failure to pay the national fee and the search fee in response to the EPO notification dated 17 March 2000 should be granted. The appellant referred to the decisions of the Enlarged Board of Appeal G 3/91 and G 5/93 and requested that the question of whether or not Article 122(5) EPC applied to PCT applications on entry into the regional phase should be reviewed by the Enlarged Board of Appeal as regards the new facts and arguments presented in the case under appeal. The appellant argued that the Enlarged Board of Appeal did not have all the facts in front of it when it reached its decision and in particular it did not consider the complex and unique procedures which had to be carried out if one utilised PCT in order to make a European application. The fact that the procedures were complicated was proven by the current wording of EPO Form 1201 wherein it was noted that due to the complexity of the procedure, applicants were strongly advised to appoint a representative whose name appeared on the EPO list of representatives. Contrary to the view expressed by the Enlarged Board of Appeal, the appellant believed that the time limits mentioned in Article 122(5) EPC were not comparable to the time limits to be observed by entry into the regional phase having filed an international application and the consequences of missing the time limits were not the same. If a regular EPC applicant failed to meet the time limits, and the application was deemed to be withdrawn, he could re-file the application because it was at an earlier stage of the application procedure. As a result, he had a fair degree of certainty that no prior art was available which would invalidate his application. In the case of

a Euro-PCT applicant who failed to meet the time limits, the fact that his PCT application had already been published, precluded him from re-filing and so all patent rights were inevitably lost. The appellant further argued that a Euro-PCT applicant who had made use of a professional firm of attorneys did not expect to receive correspondence from the EPO and had had no dealings with any Patent Office whatsoever and in most cases would not know that a European patent application was technically on file and that the only action required was payment of fees in the case of the international application being in one of the official languages of the European Patent Office. Communications sent directly by the EPO to applicant would result in confusion and mistakes being made.

Finally, the appellant maintained his request for *restitutio in integrum* in respect of failure to file the international preliminary examination demand within the time limit of 19 months under Rule 39(1) PCT on the basis of facts and arguments already presented before the first instance.

At the oral proceedings before the Board the appellant submitted requests as follows:

Main request:

"Restoration of European patent application no. 99909848.6 on the basis of the principle of the protection of legitimate expectations of applicants due principally to errors and omissions on the part of the International Preliminary Examination Authority and

also due to the complexity of the procedures relating to Euro-PCT applications."

Auxiliary request 1:

"*Restitutio in integrum* in respect of the failure to pay the national fee and the search fee in response to the EPO notification dated 17 March 2000 whereby the appellant admitted that the present view of the EPO is that *restitutio in integrum* is not possible in respect of the failure to pay national and search fees but wished to proceed with the request assuming that this question will be put to the Enlarged Board of Appeals."

Auxiliary request 2:

"We request, under Article 26 and 48 PCT, as implemented under Article 150 to 158 EPC, that the EPO excuses the delay in filing the demand within the 19 month period set under Article 39(1) PCT, thereby delaying the deadline for entering the regional phase in the EPO until 31 months from priority date, and we request *restitutio in integrum* under Article 122 EPC in respect of the failure to file the demand in time."

Reasons for the Decision

1. The appeal complies with the formal requirements of Articles 106 to 108 and Rules 1(1) and 64 EPC. It is therefore admissible.

Main request

2. The main request was not the subject matter of the appealed decision but challenged point 4 of the order of the decision that the application be deemed withdrawn as of 7 December 1999.

- 2.1 Starting from the dates recorded on file (priority date 4 March 1998, filing date of the application 4 March 1999, filing date of the international preliminary examination demand 6 October 1999 and the payment of the national basic fee, the search fee and the designations fees 29 August 2000), which were not disputed by the appellant, the Board agrees with the first instance that the time limit for entry into the regional phase before the EPO expired on Saturday 4 December 1999 in applying the 21 month period prescribed by Rule 104b(1), first alternative, EPC (in the then valid version) in conjunction with Article 22(1)(2) PCT. This time limit was extended pursuant to Rule 85(1) EPC to Monday 6 December 1999. The 31 month time limit under Rule 104b(1) EPC could not apply since the demand for international preliminary examination was filed two days after the expiry of the 19 month period stipulated by Article 39(1)a) PCT. The appellant conceded that the national basic fee, the search and the designation fees were also not paid within the period of grace of one month after notification pursuant to Rule 85a EPC. Therefore, the application was deemed to be withdrawn pursuant to Article 157(2)(b) and Rule 104c(1) EPC (in the then valid version) as of 7 December 1999.

2.2 The Board agrees with the appellant that the principle of protection of legitimate expectations could be applied to a delay in meeting the time limit according to Article 39(1) PCT. This principle is admitted by the established jurisprudence of the Boards of Appeal as regards the failure of time limits under the European Patent convention and, according to Article 48(2) PCT, it has to be applied to international applications as far as time limits have to be considered under EPC. The same conclusion results from Article 150(3) EPC because an international application, for which the European Patent Office acts as designated Office (as in the present case) shall be deemed to be a European patent application.

2.3 According to the jurisprudence (see Case law of the Boards of Appeal, 4th edition, pp 251 - 254) the principle of protection of legitimate expectations governing procedures between the EPO and applicants requires that communications addressed to applicants must be clear and unambiguous so that any misunderstanding on the part of a reasonable addressee is avoided. It further applies to cases where the EPO made a mistake or gave wrong information to the applicant or where the EPO continued the proceedings by ignoring that the application was no longer valid so that the applicant could rely on its validity. As a result of the application of this principle the party misled or incorrectly informed must be treated as having fulfilled the necessary requirements. Under Article 48(2) PCT and Article 150(3) EPC the principle of protection of legitimate expectations has to apply accordingly to acts performed by other authorities concerned in the proceedings during the international

phase such as the U.S. Patent Office acting as Receiving Office or as International Preliminary Examining Authority in the present case.

Contrary to the appellant's contention, in the case under consideration none of these requirements are met.

- 2.4 Generally, the complexity of the Euro-PCT proceedings before the EPO does not justify the application of the principle of protection of legitimate expectations because the responsibility to be informed about the proceedings lies with the applicants who wish to proceed under EPC, otherwise every time limit could be circumvented by referring to this complexity.
- 2.5 The notification of 22 October 1999 issued by the U.S. Patent Office as International Preliminary Examining Authority (see point V above) giving the 6 October 1999 as date of receipt of the demand for international preliminary examination was fully correct as it did not positively inform the appellant that the 19 month time limit had been met. The omission to check the pre-printed text of paragraph 3 in this form was only an omission of a courtesy service because at that time no regulations under the PCT were in force requiring that the applicant be informed about the failure to meet the time limit under Article 39(1)a),b) PCT. The omission of a courtesy service by the authority concerned cannot justify the application of the protection of the principle of good faith because such an omission did not render the information about the correctly stated date of receipt unclear or ambiguous and the responsibility for monitoring whether or not the time limit under Article 39(1)a),b) PCT was met remained

with the appellant. In this respect the appellant's submissions that the International Bureau omitted to notify the appellant by form PCT/IPEA/407 that the International preliminary examination was deemed not to have been filed was wrong and had no basis in the then valid version of the PCT. The provision concerning the legal effect that a late filed international preliminary demand is deemed not to be filed was only introduced by the new Rule 54bis 1(a) PCT in force as of 1 January 2004. On the contrary, under the PCT in force before that date, the International Preliminary Examination Authority was obliged to proceed with a demand which was filed after the 19 month period under Article 39(1)a),b) PCT and to issue the Written Opinion. Accordingly, the PCT Applicant's Guide-Volume I-International Phase (edition 1 January 2003) stated under paragraph 331 that "*there are no time limits in the PCT before or after which the demand must be submitted.*"

- 2.6 Additionally, it has to be pointed out that the US attorney received a communication under Rule 61.3 PCT, dated 3 November 1999, on 12 November 1999 from the International Bureau by which the appellant was clearly and unambiguously informed that the elections of the national Offices were made after the expiration of 19 months from the priority date. Furthermore, the appellant was reminded that he had to enter the national phase before the expiration of 20 months from the priority date before the Offices concerned and it was mentioned that some Offices had fixed time limits expiring later than 20 months thereby indirectly referring to the 21 month time limit under Rule 104b

EPC which had not yet expired on the date of notification of that communication.

Therefore, the Board concludes that the facts presented in this case in no way constitute any legal basis for applying the principle for protection of the legitimate expectations.

Auxiliary request 1

3. The appellant admitted that according to the decisions of the Enlarged Board of Appeal in G 3/91 (OJ EPO 1993, 8) and G 5/93 (OJ 1994, 447) the request for *restitutio in integrum* in respect of the failure to pay the national basic fee and at least one designation fee under Rule 104b, paragraph 1(b) EPC in response to the EPO notification dated 17 March 2000 is to be rejected as inadmissible under Article 122(5) EPC. Nevertheless, the appellant wished to proceed with the request assuming that this request will be referred to the Enlarged Board of Appeal.
- 3.1 Article 112(1)a) EPC stipulates that in order to ensure uniform application of the law (first choice of the alternative, see below point 3.2), or if an important point of law arises (second choice of alternative, see below point 3.3) the Board of Appeal shall, during proceedings in 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.

3.2 The first provision of this alternative "to ensure uniform application of the law" is not fulfilled because the Board does not consider there to be any deviation from the decision of the Enlarged Board of Appeal in G 5/93 (supra).

The appellant did not submit new facts which differed from the facts in G 5/93 (supra) but only presented "new" arguments not discussed in the decision of the Enlarged Board of Appeal. The Board holds that these "new" arguments have no relevance with respect to the reasoning of the decisions of the Enlarged Board of Appeal in G 3/91(supra) and G 5/93 (supra) which was based on the conclusion that Article 122(5) EPC is applicable to the time limits provided for in Rule 104b(1)(b) EPC in conjunction with Articles 157(2)(b) and 158(2) EPC because these time limits had the same legal nature as the time limits provided for in Articles 78(2) and 79(2) EPC and were in their procedural function identical to them.

The fundamental idea of this reasoning excludes consideration in this respect of the economic consequences of a final loss of a patent application for the applicant or the likelihood of whether or not the patent protection for an invention can be re-obtained by re-filing this application or even consideration of the complexity of the Euro-PCT proceedings because these considerations do not concern the legal nature of the time limits concerned. The Enlarged Board of Appeal did not decide that it was discretionary whether or not Article 122(5) EPC was to be applied analogously to the time limits under Rule 104(b) and Article 157 (2)(b) EPC, but stated that

Article 122(5) EPC had to be interpreted. In the opinion of the Enlarged Board of Appeal, "*the time limits for Euro-PCT applicants and those for direct European applicants do not differ in their legal nature because of their equivalent function. This function makes both time limits in essence identical. The fact that they differ in their respective duration does not affect their equivalent legal nature*" (cf. point 1.1.7 in G 5/93, supra). The last sentence clarifies that aspects and facts not relating to the legal nature of the time limits were not decisive points.

Thus according to this reasoning, Article 122(5) EPC refers directly to the time limits provided for in Rule 104b(1)(b)(i) and (ii) and Article 157(2)(b) EPC by virtue of Articles 150(3)(b) EPC and 11(3) PCT and cannot be interpreted as being without effect as regards Euro-PCT applications. Consequently, the Enlarged Board of Appeal had and would have no reason to discuss distinctions between the different proceedings. The absence of those considerations in the two decisions G 3/91 (supra, point 3) and G 5/93 (supra, point 3) of the Enlarged Board of Appeal cannot be regarded as a basis to assume that the reasoning of these decisions did not cover all arguments relevant to the application of Article 122(5) EPC to the time limits provided for in Rule 104(b)(1) and Article 157(2)(b) EPC.

Furthermore, the Enlarged Board discussed in its decision G 3/91 (supra, point 3) the possibility of *restitutio in integrum* as regards the period of grace pursuant to Rule 85a EPC stating that this period of grace was closely linked to the normal periods laid

down in Article 78(2), 79(2) and Rule 104b(1)b) and c) EPC and was consequently also excluded from re-establishment under the provisions of Article 122(5) EPC. Consistently, this reasoning fully applies to the present case.

3.3 According to the conclusion given above, the second provision of the alternative under Article 112(1)a) EPC that "*an important point of law . . . requires a decision of the Enlarged Board of Appeal*" is not fulfilled with regard to the present case because the question to be referred to the Enlarged Board had already been decided by it and the allegedly "new" facts and arguments submitted by the appellant are not appropriate to the question of the application of the decision of the Enlarged Board of Appeal in G 5/93 (*supra*, point 3) to the present case.

3.4 Therefore, the Board holds that the appellant's assumption that the case should be referred to the Enlarged Board of Appeal cannot be justified under Article 112(1) EPC and, consequently, has to be disregarded by the Board.

4. As a result, the auxiliary request 1 is to be rejected as inadmissible because *restitutio in integrum* under Article 122(1) EPC is neither applicable to the time limits provided for in Rule 104b(1)b)(i)and(ii) and Article 157(2)b) EPC nor to the period of grace under Rule 85a EPC. In this respect the Board fully agrees with the reasoning given in the decision under appeal.

Therefore, any explanations by the Board that in this case the requirement of "all due care" according to Article 122(1) EPC was not fulfilled are not decisive for the present decision.

Auxiliary request 2

5. When the Applicant requested *restitutio in integrum* on 16 November 2000 more than one year had lapsed since the 4 October 1999 deadline for filing a request for international preliminary examination with the U.S. Patent Office allowing the deferred entry into the regional phase provided for in Article 39(1)(a) PCT, so that the request for re-establishment in respect of this time limit must be considered as inadmissible under Article 122(2), second sentence, EPC.
6. As none of appellant's requests succeed, the appeal has to be dismissed.

Procedural matters

7. The first instance decided under point 5 of the order of its decision that "*all fees paid after 6 December 1999, except for the fee for re-establishment of rights, will be refunded once this decision has become final*".

The Board has to clarify that the non-reimbursement concerned each of the three fees for re-establishment paid by the appellant during the first instance proceedings because each of them related to a separate right which was requested to be re-established. Furthermore, the Board points out that point 5 of this order only decided on fees paid up to the date of the

decision, but not to fees due after that date. The appeal and its dismissal by the Board do not change this legal situation so that it is clear that the appeal fee is not to be refunded.

Order

For these reasons it is decided that:

The appeal is dismissed

The Registrar:

The Chairman:

S. Fabiani

J.-C. Saisset