

**Internal distribution code:**

- (A) [ ] Publication in OJ  
(B) [ ] To Chairmen and Members  
(C) [X] To Chairmen  
(D) [ ] No distribution

**Datasheet for the decision  
of 20 December 2006**

**Case Number:** J 0001/04 - 3.1.01

**Application Number:** 01906468.2

**Publication Number:**

**IPC:** A61B 8/00

**Language of the proceedings:** EN

**Title of invention:**  
Disposable needle guide system

**Applicant:**  
Ascendia AB

**Opponent:**  
-

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 133, 134  
EPC R. 81, 85a, 85b

**Keyword:**  
"Communication sent to the applicant in the absence of an appointed representative, not being representative in the sense of Article 134 EPC - notified correctly (yes)"  
"Communication perhaps not in registered envelope - supposition without further factual basis - insufficient for consideration in appeal"

**Decisions cited:**  
G 0004/95, J 0011/92, J 0005/04

**Catchword:**  
-



Case Number: J 0001/04 - 3.1.01

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.01  
of 20 December 2006

**Appellant:** Ascendia AB  
Turebergsvägen 5  
S-191 47 Sollentuna (SE)

**Representative:** Thiel, Christian  
Schneiders & Behrendt  
Rechts- und Patentanwälte  
Huestraße 23  
(Westfalenbankgebäude)  
D-44787 Bochum (DE)

**Decision under appeal:** Decision of the Receiving Section of the  
European Patent Office of 29 August 2003.

**Composition of the Board:**

**Chairman:** M. Günzel  
**Members:** J. Willems  
G. Weiss

## Summary of Facts and Submissions

- I. The appeal is against the decision of the Receiving Section declaring the application No. 01906468.2 deemed to be withdrawn.
- II. This application was originally filed with the Swedish Patent Office as international application, international application No. PCT/SE01/00313, having an international filing date of 14 February 2001 and claiming a priority of 25 February 2000. In the international phase the applicant was represented by its Swedish representative, not being a professional representative in the sense of Article 134 EPC.

By standard letter of 6 September 2001 the Swedish representative was *inter alia* informed by the Receiving Section that an authorisation for the international phase did not comprise an authorisation for the European phase and that disregard thereof could lead to a loss of rights.

- III. For the reason that no written request for examination had been filed and that the national fee, the examination fee and the designation fees had not been paid, the Receiving Section issued communications pursuant to Rules 85a and 85b EPC. These communications were sent by registered post directly to the applicant on 13 May 2002.
- IV. No payments were made. A notification of loss of rights pursuant to Rule 69(1) EPC was sent to the applicant on 14 August 2002, stating that the application was deemed

- to be withdrawn because the national basic fee was not validly paid within the time limit.
- V. On 12 September 2002 the applicant authorised a professional representative within the meaning of Article 134 EPC (hereafter "the European representative"), who with letter of 9 October 2002 paid the fees for the "application, designation, claims and examination" and requested that the finding of loss of rights be reversed because no communication in accordance with Rule 85a(1) EPC had ever been received by the applicant or his Swedish representative.
- VI. A postal inquiry was undertaken by the EPO. The European representative was informed thereof by letter dated 25 October 2002.
- VII. With letter dated 4 November 2002, in which reference was made to the letters of 25 October 2002 and 9 October 2002, the European representative requested a decision on the matter and auxiliarily filed a request for re-establishment of rights pursuant to Article 122 EPC.
- VIII. On 3 February 2003 the Receiving Section issued a communication pursuant to Article 113 EPC, informing of the result of the postal inquiry that the Rule 85a and 85b communications had been delivered to the applicant on 15 May 2002. Thus, both communications had been duly delivered. Furthermore, the time limits concerned were not covered by Article 122 EPC.
- IX. After having received a written reaction thereto dated 13 May 2003, the Receiving Section issued on 29 August

2003 the decision under appeal. In the decision the request to set aside the finding of loss of rights was rejected (1.), the auxiliary request for re-establishment of rights was rejected as inadmissible (2.), the application was declared deemed to be withdrawn as of 27 November 2001 (3.) and it was declared that all fees would be refunded once the decision of the Receiving Section had become final (4.).

- X. Notice of appeal was filed on 29 October 2003 and the appeal fee was paid on the same day. The statement setting out the grounds of appeal was filed on 8 January 2004.
  
- XI. In the grounds of appeal no arguments were brought forward against the decision to reject the request for re-establishment of rights as inadmissible.
  
- XII. The submissions of the appellant are essentially that the practice of the EPO to send communications directly to the applicant - even if he has appointed a national representative in the international phase - is discriminative, that a representative who is not a European representative can very well receive communications on behalf of an applicant, that Rule 81 EPC was contravened and, finally, that it was not certain that the envelopes handed to the employee of the applicant really contained the communications of 13 May 2002.
  
- XIII. The Board sent a communication to the appellant on 15 March 2006, stating its provisional opinion. The appellant reacted in writing to this communication with letter dated 25 July 2006.

- XIV. Oral proceedings were held before the Board on request of the appellant on 20 December 2006.
- XV. The appellant requested that the decision under appeal be set aside as far as orders 1, 3 and 4 of the decision under appeal are concerned and that the fees paid for entry into the European phase be regarded as paid in time. Furthermore he requested that the question submitted by him during the oral proceedings be referred to the Enlarged Board of Appeal.

### **Reasons for the Decision**

1. The appeal satisfies the requirements of Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. The appeal does not concern the Receiving Section's decision to reject the appellant's request for re-establishment of rights.
3. The appellant did not file a request for international preliminary examination. Therefore, the 21-month period for entry into the regional phase before the EPO applied and expired on 26 November 2001 (Article 22 PCT in conjunction with Rule 107(1) EPC in its version applicable before 2 January 2002 and with Rule 85(1) EPC, 25 November 2001 having been a Sunday) without any payments having been made by the appellant. Thus, the Rule 85a and b communications were rightly issued by the Receiving Section.

4. In the appeal proceedings the appellant no longer contested that the registered letters had come into the hands of an employee of the appellant who had picked them up at a local post office. In this respect the appellant only maintained that for unknown reasons the letters never came into the hands of an "officer" of the appellant. This is, however, irrelevant (for details, see J 5/04 of 29 November 2005, reasons point 3.2, having dealt with a case comparable to the present one).

In support of its requests the appellant submitted essentially two lines of argumentation:

First, the appellant criticised the practice of the EPO to send communications directly to the applicant, even if the applicant had appointed a national representative in the international phase, as being discriminative and as disregarding the express wish of the applicant not to handle matters himself.

Second, the appellant submitted that in the circumstances of the present case it remained uncertain what actually was in the mailed envelopes. The appellant's representative had himself received in the past mail from the EPO addressed to him but obviously intended to be received by others.

5. Article 133 EPC makes it clear that there is no obligation for an applicant - having a principal place of business within a Contracting State to the EPC - to be represented in proceedings established by the Convention. If, however, the applicant wishes to be represented he has to authorise either an employee or a professional representative or a legal practitioner. Whatever possibility the applicant prefers, if he does

not wish to handle matters himself and he therefore wishes to be represented, he has to appoint a representative who is, in accordance with the provisions of Article 134 EPC, entitled to undertake representation before the EPO. In the case at hand the applicant had not done so, although the EPO with letter of 6 September 2001 had expressly pointed out to the applicant that an authorisation for the international phase did not comprise an authorisation for the European phase and that disregard thereof could lead to a loss of rights.

The requirement that only persons fulfilling the conditions for representation before the EPO under Article 134 EPC are entitled to undertake representation before the EPO is not of a discriminative nature. Any national representative who fulfils the conditions set out in Article 134 EPC has a right to be entered on the list of professional representatives and will thereafter be entitled to undertake representation before the EPO.

The conditions for acquiring such entitlement as set out in Article 134 EPC have not been chosen arbitrarily. The purpose underlying these regulations is to ensure that proceedings before the EPO are conducted efficiently and effectively by properly qualified professional representatives, who are therefore fully knowledgeable in the law and practice under the EPC, and who are thus professionally competent to represent parties to such proceedings (G 4/95, OJ EPO 1996, 412, reasons point 6.).



As long as the applicant does not appoint a representative who is entitled to represent him before the EPO, the general principle applies that procedural acts have to be performed by the EPO in relation to the registered applicant as being the party to the proceedings. Thus, notifications have to be addressed to the registered applicant and they have been correctly made if they were addressed to him (see also J 5/04, reasons points 2.5 and 2.6). By such a notification the legal effect of the notified document is triggered, which is in the present case that the time limit for filing the written request for examination and for paying the fees concerned with surcharge under Rules 85a and b EPC started to run from the date on which the notifications became effective and expired one month from the said date.

6. The argument of the appellant, that its national representative could very well receive communications on its behalf, cannot succeed.

The issue here is not whether somebody would be able to receive communications on behalf of the appellant but rather whether the EPO correctly notified the said communications to the appellant. As has been set out above this was the case.

7. The appellant complained unsuccessfully that Rule 81 EPC had been contravened. The appellant has pointed out that Rule 81 EPC states that communications should be addressed to the representative of the applicant and that it, the applicant, had appointed a Swedish (national) representative, to whom therefore the communications should have been sent.

8. The appellant appears to overlook in this regard that Rule 81 EPC clearly envisages professional representatives within the meaning of Article 134 EPC only (J 11/93 of 6 February 1996, reasons point 3.2, implicit in J 5/04, reasons points 2. et seq.) and that there was no such representative appointed for the European phase, although the necessity of such an appointment was expressly pointed out to the appellant by the letter of 6 September 2001, addressed to the representative of the appellant for the international phase.
  
9. In the oral proceedings the professional representative of the appellant submitted that he did receive, in a telephone conversation with an employee of the Office, the advice to file a request for re-establishment of rights and that this advice had created legitimate expectations which should be honoured by the Office.
  
10. The Board fails to see how this argument could support the requests of the appellant.  
Even if such an erroneous advice had been given, it must have been clear to the professional representative (on the grounds mentioned in point 8 of the reasons of the decision under appeal) that it was erroneous and it could not, therefore, give rise to legitimate expectations.  
Moreover, any such legitimate expectations could only be relevant in the context of the appellant's original request for restitutio in integrum, and not in relation to the requests of the appellant pursued in this appeal, that are only directed against the orders 1, 3 and 4 of the decision under appeal.

11. Finally the appellant has stated that it remained uncertain what actually was inside the envelopes that were handed out to its employee. This position of the appellant has insufficient factual basis to be considered in this appeal: In the present case there is no hint whatsoever either in the submissions or derivable from the file which would cast doubt on the fact that the communications of 13 May 2002, copies of which are in the file, were actually contained in the envelopes sent by the registered mail of that date. It was due to a lack of care in the sphere of the appellant's responsibility that the envelopes concerned got lost. Therefore, the onus of showing or at least substantiating facts which could establish a minimum of plausibility that the envelopes might not have contained the communications is on the appellant (see also J 5/04, reasons point 3.2). In the present case this applies all the more since the necessary coincidence of facts would have had to be that none of the two letters addressed to the appellant had contained a communication because receipt of only one of them suffices to trigger the legal consequence that the application is deemed to be withdrawn failing the relevant payment by the appellant within the time limit.

12. The appellant has requested during the oral proceedings that the following question should be referred to the Enlarged Board of Appeal:

"Does the EPC exclude the notification of the communication pursuant to Rule 85a(1) EPC to the

international representative upon entry into the regional phase?"

13. The Board fails to see that the question drafted by the appellant has any relevance for the outcome of the present appeal. The appeal was directed against the findings of the Receiving Section that a loss of rights occurred due to the non payment of fees within the applicable time limit after notification of the Rule 85a and b communications to the appellant and that the application was therefore deemed to be withdrawn as from 27 November 2001. The relevant question in the present appeal was whether the notifications of the communications were rightly addressed to the appellant which was the case for the reasons given above. For that question it is irrelevant whether the EPC excludes or would on the contrary allow that communications pursuant to Rule 85a EPC might be notified to the representative in the international phase.

Moreover, the issue possibly underlying the question in its wording as drafted by the appellant ie as to whether Rule 81 EPC should or could be applied to a representative appointed for the international phase of a PCT application, in particular to a representative not being a European representative, with respect to procedural acts upon entry into the regional phase before the EPO has already clearly been answered in the negative in the above cited jurisprudence of the Legal Board of Appeal.

Therefore the Board fails to see that there has arisen an important point of law requiring a decision by the Enlarged Board of Appeal or that a decision of the

Enlarged Board on this point would be necessary in order to ensure uniform application of the law within the meaning of Article 112(1)(a) EPC.

14. Because none of the grounds of appeal brought forward by the appellant can succeed and the Board finds no fault with the decision under appeal, the appeal has to be dismissed.

## **Order**

### **For these reasons it is decided that:**

1. The request for a referral to the Enlarged Board of Appeal is refused.
2. The appeal is dismissed.

The Registrar

The Chairman

S. Fabiani

B. Günzel