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Decision of 18 July 1980

J 09/80

EPC Articles 91(1) (2) (3) (5), 122(1). Rules 38(3), 41(1), 42(1), 67, 84. "Failure to file priority documents" - "Deficiency" - "Restitutio in integrum".

Headnote

As an applicant may file certified copies of priority documents at any time before the end of the sixteenth month after the date of priority, there is only a deficiency which he must be given an invitation to correct when that period has expired.

Europäisches
Patentamt

European Patent
Office

Office européen
des brevets

Juristische
Beschwerdekammer

Legal Board
of Appeal

Chambre de
recours juridique



Case No: J 09/80

DECISION

of 18 July 1980

Appellant:

MPD Technology Limited
Thames House, Millbank
London SW1P 4QF
England

Representative:

Barbara A. Lockwood
Thames House, Millbank
London SW1P 4QF
England

Decision under appeal:

Decision of the Receiving Section of
the European Patent Office dated 7
February 1980 rejecting a request for
restitutio in integrum.

Members of the Board:

- Dr. R. Singer, Chairman
- P. Ford, Member
- L. Gotti Porcinari, Member

FACTS AND SUBMISSIONS OF THE APPELLANT

- I. On 12 March 1979 the appellant filed a European patent application at the United Kingdom Patent Office, London, claiming priority from an application for a United States patent made on 14 March 1978.

- II. On 5 April 1979 the Receiving Section of the European Patent Office drew the attention of the appellant to the fact that the copy of the previous application required for claiming priority should be filed before the end of the sixteenth month after the date of priority, i.e. not later than 14 July 1979. These documents, however, with a covering letter, were sent only on 14 August 1979 and received by the Office on 17 August 1979. The appellant explained that the delay was due to an administrative error, as could be supported by evidence, if necessary.

- III. On 31 August 1979, the Receiving Section informed the appellant that the claimed right of priority had been lost as a certified copy of the priority documents had not been filed in time. The appellant was also informed that the letter dated 14 August 1979 would be considered as an application for a decision under Rule 69(2) EPC. The appellant was invited to support its application by evidence.

On 22 October 1979 a statutory declaration of the professional representative concerned and two affidavits from US associates were therefore submitted to the Office.

- IV. On 31 October 1979, as a result of a telephone call from the Receiving Section, on that date, the appellant sent a telex, confirmed by letter, asking for the previous letter and evidence to be considered as a request for re-establishment of rights under Article 122 EPC. The fee for re-establishment of rights was also duly paid.

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- V. The Receiving Section issued a decision dated 7 February 1980 rejecting the application for restitution of rights on the ground that from the Statutory Declaration filed it appeared that the date of the removal of the cause of non-compliance should be considered to be 6 August 1979 and, as the time limit referred to in Article 122(2) EPC had, therefore, expired on 6 October 1979, the application for restitutio in integrum had been filed after expiry of the two months period provided by Article 122(2), first sentence.
- VI. On 25 February 1980, the appellant lodged an appeal against this decision. Notice of the appeal was received on 29 February 1980. The statement of grounds of the appeal was received on 27 May 1980 and the appeal fee was duly paid. In the statement of grounds the appellant contends that it was entitled to rely upon the advice of the Receiving Section and that Article 122 EPC had been complied with.

REASONS FOR THE DECISION

1. The appeal complies with Articles 106 to 108 and Rules 1, paragraph 1, and 64 of EPC, and is, therefore, admissible.
2. The decision under appeal resulted from a request made by the appellant at the suggestion of the Receiving Section, which was of the opinion that the appellant's right of priority had been lost. That opinion, which reflected the general view of the Receiving Section at the time, can be seen to be erroneous.
3. Article 88, paragraph 1 and Rule 38, paragraph 3, EPC, permit an applicant to file certified copies of priority documents at any time before the end of the sixteenth month

.../...

after the date of priority. The effect of Article 91, paragraphs 1(d), 2 and 3, together with Rules 41 and 84, EPC, is that there is only a deficiency if the priority documents have not been filed before the end of that period and that the applicant must then be given an opportunity to remedy the deficiency within a further period, which cannot be less than two months.

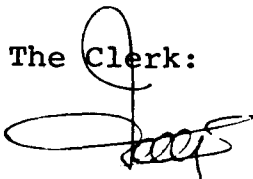
4. In fact the appellant did file the missing documents within a period of less than two months after the deficiency arose, namely on 17 August 1979, without receiving an invitation to do so.
5. It follows that the appellant's request for re-establishment of rights that had never been lost had no basis and that the Receiving Section erred in inviting the appellant to make it. Article 122, paragraph 1, EPC, is clearly applicable only where there is a loss of a right or of a means of redress. As there was no legal basis for the appellant's request and for the decision given, the latter will be set aside.
6. In consequence, the fee paid in respect of the request for restitution of rights was wrongly accepted by the European Patent Office and must be refunded to the appellant. The Legal Board of Appeal has the power to order refund of this fee, by virtue of Article 111, paragraph 1, second sentence, EPC, which authorises the Board to exercise a power within the competence of the Receiving Section.
7. There were substantial procedural errors on the part of the Receiving Section, first in notifying the appellant that the right of priority had been lost and secondly in inviting the appellant to apply for restitution of rights.
8. As the appeal succeeds and it is clearly equitable to order reimbursement of the appeal fee in accordance with Rule 67 EPC, that can be ordered.

For these reasons,


it is decided that:

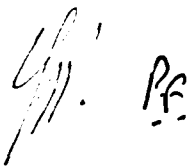
1. The decision of the Receiving Section of the European Patent Office dated 7 February 1980 is set aside.
2. The procedure before the Receiving Section is to be continued on the basis that no loss of the right of priority occurred as a result of the mere expiry of the period of sixteen months.
3. Reimbursement of the fee for restitution of rights is ordered.
4. Reimbursement of the appeal fee is ordered.

The Clerk:


J. Bergeron

The Chairman:


R. Singer


P.F.