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Date of decision	17 August 1987	Case number	J 0902/87 - 3.1.1
Application number	-		
IPC	-	Proceedings Language	FR
Title of the application			-
Applicant name	not published	Opponent name	-
Headnote		Articles and Rules	EPC Art 86 Art 96 Art 108 Art 121 Art 122 R 37 R 65(1) R 90

1. An appeal is to be considered sufficiently well-founded to satisfy the requirements of Article 108, third sentence, EPC, if it refers to a new circumstance which, if confirmed, will invalidate the contested decision.

2. In accordance with Rule 90 EPC, which the Office must apply of its own motion, the legal incapacity of an applicant or his representative has the effect of interrupting proceedings and, where appropriate, the time limit referred to in Article 122(2) EPC. Thus, if such incapacity is invoked where a decision based on such a time limit is appealed, that decision must be cancelled and the matter referred back to the first instance for a fresh decision that takes account of the new circumstance.

3. Rule 90(4) EPC has to be interpreted as deferring the payment date for renewal fees falling due during the period of incapacity of the applicant or his representative until the date

proceedings are resumed.

4. Article 86(3) EPC provides that where the EPO finds that a renewal fee has not been paid it must rule that the patent application in question is deemed to be withdrawn without power of discretion to assess the circumstances that led to non-payment. Where, however, no such ruling is taken and, on the basis of information supplied by the EPO, an applicant or his representative may in all good faith be led to believe that a renewal fee has been duly paid, such fee must be considered to be so paid for the purposes of the proceedings by virtue of the maxim "error communis facit jus".

Keywords

Cited J
Decisions 0022/86

Admissibility of appeal - no statement of grounds of appeal
Interruption of the the time limit referred to in Article 122(2) EPC

J
0007/83

Interruption - Due date of renewal fees deferred
Principle of good faith -
Erroneous information from the Office

Catchwords:

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- *Images are not displayed in the following full text*
- *Bilder sind in dem folgenden Voll-Text nicht dargestellt*
- *Le texte complet suivant de la décision ne comprend pas les images*

Summary of Facts and Submissions ▲

I. On ... the appellant filed, through a professional representative, European patent application No. ..., for which the priority of patent application No. ... was claimed.

II. The application was published with the European search report on ... under No. Since the appellant had already filed the request for examination and paid the appropriate fee, a formalities officer in the Receiving Section invited the representative on ..., in accordance with Article 96(1) and Rule 51(1) EPC, to indicate within six months of the publication date whether the appellant desired to proceed

further with the application.

III. As no reply was received by the EPO within the specified time limit, the Receiving Section informed the representative on ..., in accordance with Article 96(3) EPC, that the application was deemed to be withdrawn.

IV. A new representative, named in an authorisation which took effect on ..., applied in a letter dated ... and received by the EPO on ... for the patent application to be re-established. Although the fee for re-establishment was paid on ... and the fee for further processing followed on ..., neither a formal request for further processing (Article 121(2)) nor a formal declaration that the request for examination was to be maintained was filed. By letter dated ... the new representative explained in support of his application that the appellant who had instructed the first representative to handle the patent application in suit had learned only as a result of a telephone conversation with the EPO on ... that the first representative had failed completely in his duties. Enclosed with this letter were a number of documents purporting to show that the first representative had totally neglected his client's affairs. The new representative further stated in support of his application for re-establishment that in instructing a professional representative to handle its patents the appellant had, in accordance with Article 122 EPC, taken all due care required of it.

V. Moreover, although still possible no application for reestablishment of rights was made in respect of the renewal fee for the third year which fell due on ... and which had been paid neither by the first representative nor by the new representative, although the latter duly paid the fourth and fifth renewal fees on ... and ... respectively. The office did not inform the new representative that the third-year renewal fee had not been paid.

VI. In a decision taken on ... a formalities officer acting for the Examining Division refused the application for reestablishment on the grounds that it had not been filed within the year immediately following the unobserved time limit, i.e. that it had been filed after ...

.....

VII. The appellant appealed against this decision on ..., citing in support that it considered Rule 90(1)(c) EPC to be applicable to the circumstances of its case, the previous representative having been incapable of correctly carrying out his duties vis-à-vis his clients because of a serious deterioration in the state of his health. The fee for appeal was paid the same day.

VIII. In a letter marked "confidential" received at the EPO on ... the appellant submitted a medical report prepared on ... and also a sworn statement made by two witnesses before a notary on

IX. In a communication dated ... the rapporteur for the Legal Board of Appeal drew the appellant's attention to the fact that since the third renewal fee had not been paid the application would have to be deemed to be withdrawn and the appeal was hence without basis. Replying to that communication the appellant's representative explained that as soon as his client had appointed him as its new representative he had telephoned the European Patent Office to

enquire about the position with regard to the present application and also other European patent applications filed by the previous representative and for which the appellant had appointed him as the new representative. The Office had informed him that the renewal fees had not been paid in the case of some of the applications but on the question of the present application had simply told him that the application had been refused because the request for examination had not been confirmed. Presented with this situation the new representative had not sought written confirmation and had continued to prosecute the application, genuinely believing that the third renewal fee had been duly paid; thus, on ..., he had filed an application for re-establishment of rights in respect of the filing of confirmation of the request for examination and, on ..., had paid the fourth renewal fee. The third renewal fee was paid by the appellant on

Reasons for the Decision ▲

1. Admissibility of the appeal Before examining the merits of the appeal the Board must decide, in accordance with Rule 65 EPC, whether it is formally admissible.

1.1 In the present case the appeal was filed within two months of the decision to refuse the application for reestablishment of rights and the appeal fee was paid at the same time; the appeal was therefore validly filed under Article 108, first two sentences, EPC. However, the third sentence of that Article stipulates that a written statement setting out the grounds of appeal must be filed within four months of the date of notification of the decision. If no such statement is filed the appeal must be ruled inadmissible (Rule 65(1) EPC).

1.2 Although no document headed "Statement of Grounds of Appeal" was filed by the appellant, the notice of appeal filed by it on ... stated: "The essential ground of the present appeal is that the applicant considers Rule 90(1)(c) of the Implementing Regulations to be applicable to the circumstances of its case", and pointed out that proceedings before the EPO are interrupted in the event of a representative's incapacity. Moreover, the appellant sent the Board of Appeal a dossier under confidential cover received at the EPO on ... and purporting to prove the legal incapacity of the previous representative.

1.3 As a result, the Board considers it to emerge clearly from the notice of appeal, together with the supporting documents filed subsequently by the appellant, that the latter was asking for the decision of the formalities officer acting for the Examining Division to be set aside on the ground that the one-year time limit provided for in Article 122(2) EPC; ought to have been deemed to be interrupted under Rule 90 EPC. By virtue of this interruption the application for re-establishment of rights in respect of the confirmation of the request for examination had to be regarded as being filed within the time limits specified in Article 122 EPC, it ought not therefore to have been refused as inadmissible but examined as to its merits.

1.4 The Board considers that the grounds on which the appellant relies, although based on a new fact which from a legal point of view it would have been more appropriate to refer to the first instance, represent sufficient grounds of appeal to satisfy the requirements of

Article 108, third sentence, EPC, given that if this new fact is confirmed the contested decision will no longer have any legal basis (in this connection see Decision J 22/86 dated 7 February 1987 "Medical Biological Sciences", points 2 and 3). The appeal is therefore admissible.

2. Examination of the merits of the appeal

2.1 By letter dated ... the appellant pointed out that it was applying for re-establishment of rights in respect of the patent application in suit, citing in support that in entrusting the prosecution of the patent application to a professional representative before the EPO it had taken all due care required by the circumstances and that it could not be reproached for having had absolute faith in its representative. At the same time it paid the fee for re-establishment and two days later paid the fee for further processing, without indicating in any correspondence the time limit for which it was seeking reestablishment and paying the latter fee, contrary to the provisions of Article 122(2), second sentence, and Article 121(2) EPC.

2.2 In spite of this formal deficiency, the Board considers, in the context of the present case and bearing in mind in particular the telephone conversation between the appellant's new representative and the EPO on ..., that the two letters from the appellant must be interpreted as an application for re-establishment of rights in respect of the further processing of the patent application in suit, accordingly complying with Articles 96(1) and 121(1) EPC.

2.3 Thus, the duly substantiated application for reestablishment that was filed within two months of that telephone conversation, in the course of which the appellant was informed that the previous representative had failed to confirm the request for examination, satisfies the requirements of Article 122(2), first two sentences, and (3) EPC.

2.4 However, the time limit for filing a request for further processing, notified to the appellant by the Receiving Section in its communication dated ..., expired on The present application for re-establishment was therefore filed more than a year after that time limit had expired and must therefore be deemed to be inadmissible under Article 122(2), third sentence, EPC.

2.5 This one-year time limit provided for in Article 122(2), third sentence, EPC may nevertheless be interrupted in the cases provided for in Rule 90 EPC. In the present case the appellant claimed in support of its appeal the new fact that the representative was legally incapacitated at a time not clearly determined that could cover part at least of the period between ... and ... (see p.... of Dr. ...'s medical report).

2.6 Rule 90 EPC must be applied automatically by the EPO; no specific formalities are required. For the purposes of Rule 90(1)(c) EPC, the EPO must therefore establish whether and if so when the previous representative was legally incapacitated, and in the light of its findings specify the time limits which may have been interrupted and began again on the date proceedings were resumed.

2.7 In these circumstances the contested decision must be set aside

and the matter referred back to the first instance for a further decision that takes account of this new fact.

3. Late payment of the third renewal fee

3.1 The third renewal fee fell due on ... and should have been paid, together with a penalty fee, within six months at the most of that date (Article 86 EPC). Under Article 122(2) EPC an application for reestablishment in respect of the payment of this renewal fee could have been filed up to

3.2 The new representative whose authorisation took effect from ... did not apply for re-establishment in respect of that renewal fee, which he did not pay until

3.3 In the circumstances most favourable to the appellant, i.e. where it is assumed that the previous representative was incapacitated at least during the time from ... to ... inclusive, the third renewal fee should have been paid by the new representative no later than ... or, together with a penalty fee, on The Board believes that there is no other reasonable interpretation of Rule 90(4) EPC.

3.4 In its decision J 07/83 (OJ EPO 1984, 211), the Board has already interpreted this rule as meaning that the time limit for filing the request for examination and paying the examination fee is suspended with effect from the first day of the representative's or applicant's incapacity and resumed for the time it still has to run on the date proceedings begin again.

3.5 Such an interpretation cannot be applied to renewal fees for which the EPC does not prescribe a payment time limit but simply dates on which they fall due. Moreover, Rule 37(1) EPC, which stipulates that renewal fees may not be paid more than one year before they fall due, cannot be considered to provide a one-year time limit for their payment. Its purpose is simply to ensure that applicants do not pay renewal fees too far in advance.

3.6 Therefore, the only time limit affecting renewal fees that may be suspended is the six-month period for paying the renewal fee together with a penalty fee referred to in Article 86 EPC, and Rule 90 (4) EPC has to be interpreted as deferring until the date proceedings are resumed the payment date for renewal fees which have fallen due during the period of the representative's or applicant's incapacity (see in this connection, Gall, Jahresgebühren für die EPA - Münchner Gemeinschaftskommentar, 7. Lieferung, May 1985, pp. 46-47).

3.7 This cannot be regarded as an excessively stringent interpretation of Rule 90(4) EPC, particularly as anyone, not just the professional representative, may pay renewal fees, with the result that there is nothing to stop the representative or the applicant paying them even before proceedings are resumed.

3.8 In the present case, as indicated above in point 3.2, the new representative did not pay the third renewal fee until ... whereas, according to the interpretation given above to Rule 90(4) EPC, he ought to have paid it with a penalty no later than ... - assuming, of course, that the EPO acknowledges that proceedings were

interrupted between ... and

3.9 Article 86(3) EPC provides that "If the renewal fee and any additional fee have not been paid in due time the European patent application shall be deemed to be withdrawn. The European Patent Office alone shall be competent to decide this".

3.10 The Board considers that this provision in the EPC does not empower the EPO when taking such a decision to assess the circumstances of the case that led to non-payment of the renewal fee but obliges it, when it notes a failure to pay a renewal fee, to rule that the application is deemed to be withdrawn. The only way in which the applicant can then have his rights re-established is by applying for restitutio in integrum in accordance with Article 122 EPC.

3.11 It results from this that once ... had passed the EPO should have noted that the third renewal fee had not been paid in due time with an additional fee and should have issued a decision stating that the application was deemed to be withdrawn.

3.12 However, such a decision would have no legal basis were the European Patent Office to recognise that the proceedings had been interrupted between ... and Were such to be the case, the position on the day proceedings were resumed would have to be considered. As mentioned in point 3.3 above it is on that date, or within the following six months on payment of an additional fee, that the appellant should have paid the third renewal fee outstanding.

3.13 However, the oral information given to the appellant's new representative by the EPO and corroborated by the contents of the dossier, a copy of which he requested by telex on ..., led the new representative to believe in good faith that the third renewal fee had been duly paid. It cannot be held against him that he did not request written confirmation of the renewal fee position in respect of the application, as he had no reason to suppose that the verbal information given to him was incomplete or erroneous.

3.14 Thus, taking as its basis the maxim "error communis facit jus", the Board considers that, should it be recognised that proceedings had been interrupted, the third renewal fee must be deemed to have been duly paid, the payment made by the appellant on ... quite simply being in settlement of a debt vis-à-vis the EPO. Since the new representative was entitled to accept that the information given him by the EPO was correct and complete the EPO could not, in its dealings with the new representative, invoke the failure to pay the third renewal fee in due time without infringing the principle "nemini licet venire contra factum proprium".

ORDER ▲

For these reasons, it is decided that:

The decision of the formalities officer acting for the Examining Division dated ... is set aside. The matter is referred back to the first instance for the latter to establish whether incapacity on the part of the appellant's representative gave rise to an interruption of the proceedings in respect of European patent application No. ... and if

so, when such incapacity occurred, and to decide in the light of its findings whether the appellant's application for re-establishment of rights is admissible and can be allowed.

Remarks: The Case Number given above is a fictitious number necessary for database purposes, as the bibliographic data must comply with the format defined for the data base. The actual Case Number will not be published.

O.J. EPO issue: 1988,323

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