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Aktenzeichen / Case Number / N<sup>o</sup> du recours : J 15/89 - 3.1.1

Anmeldenummer / Filing No / N<sup>o</sup> de la demande : 85 900 344.4

Veröffentlichungs-Nr. / Publication No / N<sup>o</sup> de la publication : 0 162 920

Bezeichnung der Erfindung: Method of catalyzing chemical reactions

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : C12P 39/00

**ENTSCHEIDUNG / DECISION**  
vom / of / du 8 March 1990

Anmelder / Applicant / Demandeur : IGEN, INC.

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPÜ / EPC / CBE Articles 121, 122

Schlagwort / Keyword / Mot clé : "Re-establishment - time barred"  
"Further processing (no)"

**Leitsatz / Headnote / Sommaire**

Europäisches  
Patentamt  
Beschwerdekammern

European Patent  
Office  
Boards of Appeal

Office européen  
des brevets  
Chambres de recours



Case Number : J 15/89

**D E C I S I O N**  
of the Legal Board of Appeal  
of 8 March 1990

**Appellant :** IGEN, INC.  
1530 East Jefferson Street  
Rockville, Maryland 20852  
USA

**Representative :** Cropp, John Anthony David  
MATHYS & SQUIRE  
10 Fleet Street  
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**Decision under appeal :** Decision of the Receiving Section  
of the European Patent Office dated  
10.01.89 refusing re-establishment.

**Composition of the Board :**

**Chairman :** P. Ford  
**Members :** J. Stephens-Ofner  
E. Persson

## Summary of Facts and Submissions

- I. Euro PCT application No. 85 900 344.3 (PCT-US 8 401 951) was filed on behalf of the Appellant, a US corporation, by a US patent attorney. The international filing date of the application was 27 November 1984.
- II. On 26 July 1985, the Receiving Section wrote to the US patent attorney informing him that pursuant to Article 133(2) EPC the Appellant had to be represented by a European professional representative.
- III. On 27 September 1985, the Receiving Section wrote to the Appellant to explain that the national, search and designation fees had not been paid within the period laid down by Article 22 PCT and Rule 104(b)(1) EPC, and further to point out that it was still possible to pay these fees, together with a surcharge, within the two months period of grace (expiring on 29 October 1985) provided for by Rule 85a EPC.
- IV. On 5 December 1985, there having been no response from the Appellant to the communication dated 27 September 1985, the Receiving Section notified the Appellant pursuant to Rule 69(1) EPC that the application was deemed to be withdrawn in accordance with Article 24(1)(iii) PCT. This notification invited the Appellant to apply for a decision on the matter through a European patent attorney, as provided for by Rule 69(2) EPC.
- V. On 17 January 1986, the Receiving Section sent a further communication to the Appellant, to advise that it had been noted that no written request for examination had been filed within the period laid down by Article 150(2) EPC, and that this deficiency could still be rectified within the period of grace of two months provided by Rule 85b EPC.

- VI. On 28 June 1988, the Appellant did finally appoint a European professional representative who, on 14 July 1988, filed alternative requests for re-establishment under Article 122 EPC; for further processing under Article 121 EPC, and that both the above requests be treated as an appeal within the meaning of Articles 106 and 108 EPC against the Receiving Section's notification of deemed withdrawal dated 5 December 1985.
- VII. By the decision under appeal, dated 11 January 1989, the Receiving Section rejected the requests for further processing and re-establishment. As regards further processing, it based its decision on the EPO's inability to 'set' time-limits already expressly delimited by the EPC and the PCT. As regards the request for re-establishment of rights, it found that the request was inadmissible (Article 122(2), third sentence, EPC). It also held that these requests could not be dealt with as appeals under Article 106(1) EPC, because the communications which such a purported appeal would have contested (i.e. the communications of 5 December 1985 and 17 January 1986) did not have the status of appealable decisions.
- VIII. On 9 March 1989, the Appellant appealed against the above decision, and subsequently filed his grounds of appeal on 19 May 1989.

#### Reasons for the Decision

1. The appeal is procedurally admissible.
2. The Appellant does not formally challenge the Receiving Section's decision that the requests under Articles 121 and 122 EPC could not be treated as appeals within

Articles 106 and 108 EPC. Nonetheless, the Board wishes to confirm the Receiving Section's decision in this respect.

3. Turning to the request for further processing under Article 121(1) EPC, it is quite clear that the time-limits covered by the Article are only those that can be set by the European Patent Office itself. The Article cannot, therefore, extend to time limits expressly laid down by the PCT and EPC, in respect of which the EPO cannot have any discretion. The Board therefore confirms the Receiving Section's decision on this point.
4. As regards the request for re-establishment under Article 122 EPC into the periods of grace provided by Rules 85(a) and 85(b) EPC, the second sentence of Article 122 (2) EPC constitutes an absolute bar to it. The wording of this subsection of the article is peremptory: "The application shall only be admissible within the year immediately following the expiry of the unobserved time limit". The request was not filed until 14 July 1988: the unobserved time-limits had expired in 1985 and 1986 respectively. Accordingly, the appeal under this heading is rejected.
5. Lastly, in paragraph II.13 of his Statement of Grounds of Appeal, the Appellant "reserves the right" to request oral proceedings if the Board is inclined to reject the appeal, or any part of it. As a matter of language as well as logic, this is not in itself a request for oral proceedings. Furthermore, even if it were such a request, the Board would be entitled to refuse it if it did not consider oral proceedings to be expedient (applying Article 116(2) EPC pursuant to Article 111(1) EPC: cf. Decision J 20/87, "Refund of Search Fees/UPJOHN", OJ EPO 1988, 393). Were it necessary for the Board to decide the question of expediency in the present case, it would have

to decide it against the Appellant, bearing in mind the absolute bar to the request for re-establishment and the inapplicability of the procedure for further processing.

**Order**

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

The appeal is dismissed.

The Registrar:

*J. Kee*

The Chairman:

*Paul Ford*