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**D E C I S I O N**  
of 28 November 1994

**Case Number:** J 0015/90 - 3.1.1

**Application Number:** 87309472.6

**Publication Number:** 276544

**IPC:** C22B 9/16

**Language of the proceedings:** EN

**Title of invention:**

Method for induction melting reactive metals and alloys

**Applicant:**

The Duriron Company, Inc.

**Opponent:**

-

**Headword:**

**Relevant legal provisions:**

EPC Art. 94, 121, 122

EPC R. 85(b)

**Keyword:**

**Decisions cited:**

J 0013/90, T 0014/89

**Catchword:**

An insufficient payment of a fee does not result in a loss of rights if the error occurred 18 days before the period expired and the EPO failed to inform the applicant (J 13/90 Castleton OJ 1994, 456 followed).



Case Number: J 0015/90 - 3.1.1

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.1  
of 28 November 1994

**Appellant:** The Duriron Company, Inc.  
450 North Findlay Street, Box 1145,  
Dayton, Ohio 45401 (US)

**Representative:** Warren, Anthony Robert  
Baron & Warren  
18 South End, Kensington  
London W8 5BU (GB)

**Decision under appeal:** Decision of the Receiving Section of the European  
Patent Office dated 14 September 1989 refusing the  
request for further processing under Article 121  
EPC and the request for re-establishment of  
rights, both filed 22 July 1989.

**Composition of the Board:**

**Chairman:** R. L. J. Schulte  
**Members:** S. C. Perryman  
J. C. M. de Preter

Summary of Facts and Submissions

- I. European patent application No. 87 309 472.6 was filed on 27 October 1987 together with a Request for examination under Article 94 EPC on Form 1001.1. The European Patent Bulletin mentioned the publication of the European Search Report on 3 August 1988. The fee for examination was not paid by the due date under Article 94(2) EPC of 3 February 1989. By a registered letter dated 13 April 1989 pursuant to Rule 85b EPC, the Appellant was informed that the examination fee had not been paid but that he still had an opportunity of rectifying the deficiency within a period of one month after the notification provided a surcharge was paid, otherwise he would be informed, in accordance with Rule 69(1) EPC, that the application would be deemed to be withdrawn. Taking into account Rule 78(2) EPC, the period by which the examination fee and the surcharge had to be paid thus expired on 23 May 1989.
- II. A fee form and the examination fee for DM 2120 were received by the European Patent Office on 5 May 1989 as evidenced by the acknowledgement of receipt returned by the EPO, some 18 days before the period expired. On 26 May 1989 a member of the staff of the Receiving Section telephoned the representative to tell him that the request could not be processed because only the examination fee but not the surcharge had been paid by the due date. Nothing should be done until a communication from the EPO to that effect was received.
- III. In accordance with Article 94(3) and Rule 69(1) EPC the Receiving Section informed the representative on 30 May 1989, by communication EPO Form 1097, that the application was deemed to be withdrawn because of non-payment of the examination fee within the prescribed

time limits and that he might apply for a decision on the matter within two months after notification of the said communication.

IV. By letter of 18 July 1989, received at the EPO on 22 July 1989, the representative requested further processing according to Article 121 EPC and re-establishment of rights under Article 122(5) EPC. The corresponding fees were paid on 30 June 1989 and the omitted act was completed on 30 June 1989 by payment of the surcharge of 50% of the examination fee. Evidence was filed in support of the requests showing inter alia that the Appellant's representative by fax dated 20 April 1989 asked for instructions whether the examination fee and surcharge of 50% should be paid, that he received instructions to do so by fax dated 2 May 1989, and that the amount of the examination fee of DM 2,120 and that of the surcharge DM 1,060 were noted on the fax received. But for some inexplicable reason the payment of the surcharge was omitted despite the fact that it was intended to be made.

V. By a decision dated 14 September 1989 the Receiving Section rejected the request for further processing under Article 121(1) EPC on the basis that the patent application was not deemed to be withdrawn because of non-observation of a time limit set by the EPO, but on the grounds of non-observation of a time limit set by the European Patent Convention, and the request for re-establishment of rights on the basis that Article 122(5) EPC excluded "Restitutio in integrum" not only where the time limit provided for in the specifically mentioned Article 94(2) EPC was not observed, but also where the period of grace laid down in Rule 85b EPC, extending the normal period for the request for examination was not observed.

- VI. On 9 November 1989 the Appellant filed a Notice of Appeal and paid the appeal fee, and on 15 January 1990 filed Grounds of Appeal.
  
- VII. By a decision dated 4 September 1992 the Board of Appeal of its own motion in this case referred the following question to the Enlarged Board of Appeal: Is Article 122 EPC applicable to the time limit of Article 94, paragraph 2, EPC in the case of European applications? This question was asked specifically in respect of this case, but the referral was made in the context of the referral also of three other linked questions being referred in other cases. By decision G 0006/92 of 27 September 1993 the Enlarged Board gave the answer that: The time limit under Article 94, paragraph 2, EPC is excluded from the restitutio in integrum by the provisions of paragraph 5 of that Article.
  
- VIII. By letter dated 22 September 1994, the Appellant referred to the headnote of the decision J 0013/90 CASTLETON of 10 December 1992, appearing in the EPO Official Journal of July 1994, and submitted that the principle of good faith enunciated in that decision should be applied in the present case so that the surcharge be deemed to be paid in due time. The failure to pay the surcharge was an obvious error. On noticing this error, the EPO should have afforded the Appellant an opportunity to correct it, which would certainly have been done as required.

## Reasons for the Decision

1. The appeal is admissible.
  
- 2.1 The principle of good faith as enunciated in the decision J 13/90 CASTLETON (EPO OJ 1994, 456) applies in this case. In complying with this principle of protection of legitimate expectations, the Office must behave towards the applicant in such a way that, wherever possible, an avoidable loss of rights does not occur. This means that the EPO must not omit any acts which the party to the proceedings could legitimately have expected and which might well have helped avoid a loss of rights (J 13/90 (loc. cit.), T 14/89 (OJ 1990, 432)).
  
- 2.2 On the facts it can be assumed that if the applicant had been informed immediately on 5 May 1989 that the payment made was insufficient, because the amount of the surcharge was lacking, the deficient amount would have been paid forthwith well before the allowed period expired on 23 May 1989.
  
- 2.3 The principle of good faith only allows an obvious error to be corrected (J 13/90 (loc. cit.)). The error in this case is obvious because the examination fee was paid without surcharge. The EPO had knowledge of the deficiency 18 days before the period expired. In such cases the EPO is obliged to warn the users of the European patent system. If it fails to inform the applicant, it cannot claim that a loss of rights has ensued if the deficiency is later corrected. Thus the surcharge is deemed to be paid in due time in this case.


3. The application of the principle of good faith creates a situation where the requests for further processing and for restitutio in integrum under Article 122 EPC are shown to have been unnecessary, and the appeal relating to the decision on these aspects need not to be considered.

Order

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

1. The decision under appeal is set aside.
2. The request for examination for European patent application No. 87 309 472.6 together with the surcharge is deemed to be filed in due time.
3. The case is remitted to the Receiving Section for further processing.

The Registrar:



M. Beer

The Chairman:



R.L.J. Schulte

