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D E C I S I O N
of 21 October 1993

Case Number: J 0047/92 - 3.1.1

Application Number: 90310967.6

Publication Number: 0423993

IPC: A47F 7/24

Language of the proceedings: EN

Title of invention:
Improvements relating to support rails

Applicant:
Silver Systems Limited

Opponent:
-

Headword:
Further processing/SILVER SYSTEMS

Relevant legal norms:
EPC Art. 120, 121(1)
EPC R. 84, 85b

Keyword:
"Period of grace for filing request for examination"
"Further processing (no)"

Decisions cited:
J 00../87, J 0016/90, J 0042/89, J 0004/91, G 0003/91

Headnote:
I. Further processing under Article 121 EPC is available only in respect of those time limits the duration of which is to be determined or set by the EPO.

II. Though it is true that the actual date of expiry of the period of grace pursuant to Rule 85b EPC depends on an action performed by the EPO, this fact does not imply that the time limit is set by the EPO.



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Chambres de recours

Case Number: J 0047/92 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 21 October 1993

Appellant: Silver Systems Limited
1 Heston Drive
Carrickfergus
County Antrim BT3 9EL
Northern Ireland (GB)

Representative: Sorrell, Terence Gordon
Cardinal Court
23 Thomas More Street
London E1 9YY (GB)

Decision under appeal: Decision of the Receiving Section of the European Patent Office dated 23 July 1992 rejecting the request for further processing of the European patent application No. 90 310 967.6 pursuant to Article 121 EPC.

Composition of the Board:

Chairman: R.L.J. Schulte
Members: B.J. Schachenmann
J.-C.M. de Preter

Summary of Facts and Submissions

- I. The publication of the search report relating to the European patent application No. 90 310 967.6 was mentioned in the European Patent Bulletin on 24 April 1991. The six-month time limit pursuant to Article 94(2) EPC for filing the request for examination ended on 24 October 1991. The examination fee was not, however, paid by that date.
- II. The Receiving Section issued a communication pursuant to Rule 85b EPC on 29 November 1991 informing the Applicant of the missing examination fee and pointing out the possibility of rectifying the deficiency by paying the fee together with a surcharge within a period of grace of one month. Neither of these fees was, however, paid within the period of grace, which ended on 9 January 1992. Therefore, a notification pursuant to Rule 69(1) EPC was issued on 24 January 1992 stating that the European patent application No. 90 310 967.6 was deemed to be withdrawn.
- III. On 26 March 1992 the Applicant filed a request for further processing pursuant to Article 121 EPC and completed the omitted act. In the Applicant's view, the period of grace pursuant to Rule 85b EPC was a time limit set by the European Patent Office within the meaning of Article 121 EPC and was, therefore, open to further processing.
- IV. The Receiving Section, in its decision of 23 July 1992, refused the Applicant's request for further processing. The decision was based on the grounds that the period of grace pursuant to Rule 85b EPC was not a time limit set by the European Patent Office within the meaning of Article 121(1) EPC but a time limit set by the European

Patent Convention. Consequently, the Receiving Section confirmed that the application was deemed to be withdrawn and ordered the refund of the invalidly paid fees.

V. On 11 September 1992 the Applicant filed an appeal against the decision of the Receiving Section. The Appellant, in its written statement setting out the grounds of appeal and at the oral proceedings held on 21 October 1993, agreed that the examination fee had not been paid within the prescribed time limits. It was also accepted that, in the circumstances of the present case, *restitutio in integrum* was excluded under Article 122(5) EPC. The Appellant, however, maintained the view that the period of grace for the payment of the examination fee was a time limit set by the EPO rather than by the European Patent Convention and should, therefore, be open to further processing. In support of this position the Appellant submitted substantially the following arguments:

- (a) The EPO was not initially able to calculate the correct final date of the period of grace. Only after having been informed by the Appellant did the Receiving Office agree with the final date being 9 January 1992 instead of 10 January 1992. This illustrates that the time limit was not determined by the Convention but was set by the European Patent Office dispatching the notification of the communication pursuant to Rule 85b EPC. Therefore, the period of grace pursuant to Rule 85b EPC is a time limit set by the EPO within the meaning of Article 121(1) EPC.
- (b) The first instance, in order to refute this argument, falsely referred to the decision J .. /87 (OJ EPO 1988, 177) of the Legal Board of Appeal,

which stated in point 7 that the time limits laid down in Article 94(2) and Rule 85b EPC were those of the Convention and not set by the EPO. The decision was arrived at prior to the amendment to Rule 85b EPC with effect from 1 April 1989, when the statutory period of two months for payment of the examination fee with surcharge was revised to a period of one month of notification of a communication by the European Patent Office pursuant to Rule 85b EPC. Therefore, this decision does not apply to the present case.

- (c) As regards the revised Rule 85b EPC attention should be paid to the decision J 16/90 (OJ EPO 1992, 260) of the Legal Board of Appeal which is particularly relevant to this matter. In this case the Legal Board has recognised that the amendment to Rule 85b EPC may have altered the legal situation and that further processing should be allowable in a situation as detailed above. The Enlarged Board of Appeal did not deny this view since it did not, in its decision G 3/91 (OJ EPO 1993, 8), exclude the periods of grace pursuant to Rule 85a and 85b EPC from further processing.
- (d) On the other hand, the decision J 42/89 (not published), according to which the period of grace pursuant to the amended Rule 85b EPC is excluded from further processing, was based on a wrong interpretation of this Rule and of Article 121 EPC. When construing these provisions the Board did not consider that the amended Rule 85b EPC results in indeterminate time limits (depending on the date on which the communication pursuant to Rule 85b EPC was dispatched), the observation of which is much more susceptible to mistakes than it was under the former Rule 85b EPC. The fact that the revised

Rule 85b EPC is potentially an enduring source of errors and loss of rights should thus be taken into account when construing the respective provisions as was acknowledged by the decision J 4/91 (OJ EPO 1992, 402, point 2.6).

- (e) In any case, the time limit of Rule 85b EPC is not, as stated by the first instance (point 5 of the Reasons), a time limit set by the European Patent Convention, since it was, in fact, introduced by the Administrative Council.

VI. Based on the arguments referred to above the Appellant requested that the decision of the first instance be set aside and that further processing be allowed. As an auxiliary request the Appellant requested that the question of the allowability of further processing with regard to the time limit laid down in Rule 85b EPC be referred to the Enlarged Board of Appeal.

Reasons for the Decision

1. The appeal is admissible.
2. The Appellant never contested the finding of the notification dated 24 January 1992 according to which the European patent application in suit was deemed to be withdrawn because the examination fee had not been paid within the time limits pursuant to Article 94(2) and Rule 85b EPC. In particular, the Appellant did not, with regard to this finding, apply for a decision pursuant to Rule 69(2) EPC. The Appellant's letter dated 8 July 1992, which was considered by the first instance to be a request for such a decision (point 1 of the Reasons), did not arrive at the EPO within the two-month time

limit provided in Rule 69(2) EPC. The first instance was, therefore, wrong in assuming that a (valid) request for a decision under Rule 69(2) EPC had been filed.

3. The Appellant, however, filed a timely request for further processing pursuant to Article 121 and completed the omitted act within the prescribed period. The Receiving Section refused this request on the grounds referred to above (cf. point IV).

The only issue to be considered by the Legal Board of Appeal is, therefore, the allowability of the request for further processing in the present circumstances. The main point of law raised by the Appellant in this context is whether or not the period of grace pursuant to Rule 85b EPC is a time limit set by the European Patent Office within the meaning of Article 121 EPC.

- 3.1 Before specifically dealing with the issue referred to above some general remarks have to be made regarding the concept of time limits such as those which are laid down in Article 120 and Rules 83 to 85b EPC. According to these provisions time limits are characterised by:

- the **relevant event**, being either a procedural step or the expiry of another period, which defines the starting point for the computation of the time limit (cf. Rule 83(2) EPC), and
- the **duration**, which, counted from the relevant event, defines the date on which the time limit shall expire (cf. Rules 83(2) to 83 (5) EPC). It may be laid down in terms of full years, months weeks or days (cf. Rule 83(1) EPC).

According to Article 120(b) and Rule 84 EPC the Convention or the Implementing Regulations may specify

time limits to be determined by the European Patent Office. This means that for such time limits the European Patent Office itself can fix the **duration**, as clearly follows from Rule 84 EPC headed "**duration** of time limits". Time limits of this type can be recognised in the Convention either by an explicit indication that a period "is to be set" (cf. Rules 51(4) and (6) EPC) or "determined" (cf. Article 96(1) EPC) by the EPO, or by the fact that the fixing of the duration is left, within certain limits, to the EPO's discretion (cf. Rule 71(1) EPC).

Obviously, in the context of Article 120(b) and Rule 84 EPC the "relevant event" does not come into play.

- 3.2 Turning now to Article 121 EPC, further processing under this Article is possible following non-observance of "time limits set by the European Patent Office". Bearing in mind the above general remarks on the concept of time limits (cf. point 3.1), it is evident that Article 121(1) EPC refers to the type of time limits the **duration** of which are to be determined by the EPO as defined in Article 120(b) and Rule 84 EPC.

This is confirmed by the French and German versions of the Convention. In these texts the language used in Article 121(1) EPC ("einer vom Europäischen Patentamt bestimmten Frist"; "d'un délai imparti par l'Office européen des brevets") corresponds to the language used in Article 120(b) and Rule 84 EPC. Even if in the English version there are slight differences between the wording used in the provisions referred to above (Article 121(1) EPC: "a time limit **set** by the EPO"; Article 120(b) and Rule 84 EPC: "time limits ... **determined** by the EPO"), there can be no doubt that the words "set" and "determined" have the same meaning in

this context (cf. e.g. Rule 51(4) and Article 96(1) EPC).

Further processing under Article 121 EPC is therefore available only in respect of those time limits the duration of which is to be determined or set by the EPO. This interpretation of Article 121 EPC is supported by leading textbooks on the Convention (cf. e.g. P. Mathély, *Le droit européen des brevets d'invention*, Paris 1978, page 354; R. Singer, *Europäisches Patentübereinkommen*, Köln 1989, N.3 to Article 121 EPC, page 554 and N.2 to Article 120 EPC, page 537; G. Paterson, *The European Patent System*, London 1992, page 279).

- 3.3 As regards the period of grace pursuant to Rule 85b EPC it has to be noted that its duration is defined by the Rule itself as being one month. Neither is there any indication in this Rule that this time limit is to be set or determined by the EPO, nor is the fixing of its duration left to the discretion of the EPO. The period of grace, therefore, clearly does not belong to the class of time limits as defined by Article 120(b) and Rule 84 EPC (cf. point 3.1 above). The Board, therefore, comes to the conclusion that the period of grace pursuant to Rule 85b EPC is a time limit which is not open to further processing under Article 121 EPC.
4. The arguments submitted by the Appellant are not such as will change the view of the Legal Board.
- 4.1 Though it is true that the actual date of expiry of the period of grace pursuant to Rule 85b EPC depends on an action performed by the EPO, this fact does not imply that the time limit is set by the EPO. It only means that the action of the EPO influences the date of the **relevant event**. However, it does not mean that the EPO

thereby determines the **duration** of the time limit (cf. above point 3.1).

- 4.2 The amendment to Rule 85b EPC, which came into force on 1 April 1989, mainly concerned the definition of the **relevant event** in Rule 85b EPC. Whereas, in the old version, the relevant event was defined as being the expiry of another time limit, it is now defined by a procedural step (cf. Rule 83(2) EPC). The amendment did not, however, alter the fact that the **duration** of the period of grace is laid down in Rule 85b EPC itself (two months in the old version, one month in the amended version). Thus, by the amendment to Rule 85b EPC the legal situation with regard to further processing was not changed. The finding of the decision J .. /87 (OJ EPO 1988, 177) arrived at prior to the amendment of Rule 85b EPC, that the period of grace of Rule 85b EPC was not a time limit set by the EPO, still applies to the amended version of this Rule.

This is confirmed by the preparatory documents for the amendment to Rule 85b EPC (cf. CA/79/88 Add. 1), according to which the amendment to this Rule was not intended to change anything with regard to the exclusion of the period of grace from further processing.

- 4.3 The Appellant drew the Board's attention to decision J 16/90 (OJ EPO 1992, 260) as being particularly relevant to this matter. This decision concerns the question whether or not the new versions of the Rules 85a and 85b EPC, under which the period of grace is set in motion by a communication, were still covered by the exclusion of Article 122(5) EPC (cf. point 6.1 of the Reasons). The legal issues arising in that context were, however, completely different from those of the present case. In particular, Article 122(5) EPC does not, in contrast to Article 121 EPC, rely on the

question of whether or not a time limit was set by the EPO. The decision referred to by the Appellant, therefore, dealt with a completely different issue and nothing can be derived therefrom in favour of the Appellant.

- 4.4 On the other hand, the Appellant's critical comments on decision J 42/89 (not published) do not appear to be well-founded. In the Appellant's opinion, that decision had not sufficiently taken into account the fact that the amendment to Rule 85b EPC had created additional difficulties for the users. However, even if the amended Rule 85b EPC resulted in difficulties for the users (a contention for which the Board has no evidence at all), this would not allow the Board to deviate from the clear and unequivocal meaning of the provisions referred to above.
- 4.5 The fact that the time limit of Rule 85b EPC was introduced by a decision of the Administrative Council is not important in the present context. It is only from the content of Rule 85b EPC itself that it has to be derived whether or not the period of grace is a time limit set by the EPO within the meaning of Article 121 EPC (cf. above points 3.1 and 3.2).
5. The present findings of the Legal Board of Appeal are in conformity with the jurisprudence of the Boards of Appeal (J .. /87, point 7, OJ EPO 1988, 177; J 42/89, point 5, not published). Therefore, it is not necessary, in order to ensure uniform application of the law, to refer any question to the Enlarged Board of Appeal. Nor does the present case raise an important point of law which would justify a referral to the Enlarged Board of Appeal. For this reason, the Appellant's request to refer the issue in suit to the Enlarged Board of Appeal cannot be allowed.

Order

For these reasons, it is decided that:

1. The appeal is dismissed.
2. The request to refer the legal question to the Enlarged Board of Appeal is rejected.

The Registrar:

The Chairman:

M. Beer

R. Schulte