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Boards of Appeal
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Aktenzeichen

File Number

Numéro du dossier

J 10 1 93 - 3.1.1.

In der Anlage erhalten Sie

eine Kopie des Berichtigungsbeschlusses

Interner Verteilerschlüssel der berichtigten Entscheidung

A B C

ein korrigiertes Vorblatt (Form 3030)

einen Leitsatz / Orientierungssatz (Form 3030)

Please find enclosed

a copy of the decision correcting errors

Internal distribution code of the corrected decision

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a corrected covering page (Form 3030)

a headnote / catchword (Form 3030)

Veillez trouver en annexe

une copie de la décision rectifiant des erreurs

Code de distribution interne de la décision rectifiée

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une page de garde (Form 3030) corrigée

un sommaire / une phrase vedette (Form 3030)

Anmeldung Nr. / Patent Nr.:

(soweit nicht aus der Anlage ersichtlich)

Application No. / Patent No.:

87 201 334.7

(if not apparent from enclosure)

Demande n° / Brevet n°:

(si le n° n'apparaît pas sur l'annexe)

("Technical Board" should read "Legal Board")



Europäisches
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Boards of Appeal

Chambres de recours

Case Number: J 0010/93 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 14 June 1996

Appellant:

Collapsible Bottle of America, A California
Limited Partnership
7940 Silverton Avenue, Suite 101
San Diego, California 92126 (US)

Representative:

Eismann, Henning, Dr.
Rechtsanwälte
Dr. Berg & Dr. Eismann
Grosse Bockenheimer Strasse 43
D-66013 Frankfurt am Main (DE)

Decision under appeal:

Decision of the Legal Division of the European
Patent Office posted 17 May 1993 rejecting the
requests dated 6 May 1992 for recording the
transfer and re-establishment of rights filed in
connection with European patent application
No. 87 201 334.7

Composition of the Board:

Chairman: J.-C. Saisset
Members: B. Schachenmann
S. Perryman

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen

D E C I S I O N
of 14 June 1996

Case Number: J 0010/93 - 3.1.1
Application Number: 87201334.7
Publication Number: 0263536
IPC: B65D 1/32

Language of the proceedings: EN

Title of invention:

Improved collapsible hollow articles and dispensing configurations

Applicant:

Touzani, William

Appellant:

COLLAPSIBLE BOTTLE OF AMERICA

Headword:

Transfer/COLLAPSIBLE BOTTLE OF AMERICA

Relevant legal provisions:

EPC Art. 20(1), 60(3), 71, 72, 111(1), 122
EPC R. 20, 67, 69(2)

Keyword:

"Registering a transfer after deemed withdrawal of the patent application"
"Possible if requested together with an application for restitutio in integrum"

Decisions cited:

J 0010/82, G 0001/90, J 0018/84, J 0034/86

Headnote:

A transfer can be recorded in the Register of European Patents even after deemed withdrawal of a patent application, if it is still possible that restitutio is available and the successor in title has taken, together with his request for registering the transfer, procedural steps suitable for restoring the application.



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Summary of Facts and Submissions

- I. On 12 August 1991 the Examining Division informed Mr William Touzani, a US citizen having his residence in the US, that his European patent application No. 87 201 334.7 was deemed to be withdrawn pursuant to Article 96(3) EPC because the invitation of the Examining Division to file observations under Article 96(2) EPC was not complied with within the set time limit ending on 9 July 1991.
- II. On 6 May 1992 Collapsible Bottle of America (CBA), a California Limited Partnership, filed a request for recording the transfer of the patent application referred to above. Simultaneously, CBA filed a request for re-establishment of rights in respect of the unobserved time limit. The request for recording the transfer was based on an "Assignment of Letters Patents" dated 19 February 1992 and signed by a clerk of the Superior Court, County of San Joaquin, State of California, for Mr William Touzani. This document was filed as exhibit 6.
- III. With decision of 17 May 1993 the Legal Division rejected CBA's request for recording the transfer of the patent application referred to above on the ground that the application no longer existed at the time the assignment was executed and the request was filed.

It also rejected CBA's request for re-establishment of rights as inadmissible on the ground that such request could not be validly filed by a third party which was not the applicant.

IV. On 15 July 1993 CBA filed an appeal against this decision. It was requested that the decision be set aside, that the transfer of the patent application to CBA be recorded and that the application for re-establishment be granted. The appellants further requested reimbursement of the appeal fee.

As an auxiliary request CBA requested that the following question be referred to the Enlarged Board of Appeal:

"Can the transfer of a European patent application be registered and a re-establishment of rights in respect of the time limit under Article 96(2) EPC be granted,

- if the application has been assigned to an assignee by a Court decision at a date when the application was already deemed to be withdrawn under Article 96(3) EPC, but the one-year-term for re-establishment of rights under Article 122(1) EPC has not yet lapsed,
- and if the request for transfer and the request for re-establishment of rights are simultaneously filed by said assignee?"

V. In support of their requests the appellants submitted substantially the following arguments:

In the decision under appeal the request for registering the transfer and the request for re-establishment of rights were treated as completely independent requests. However, these requests had been filed together and are mutually dependent.

It was not correct therefore to examine them independently from each other without taking their interdependence into account.

At the time the assignment was drafted the applicant Touzani was still entitled to file a request for re-establishment of rights. This procedural right was assigned to the appellants together with the application and still existed when the rejected requests were filed. In these circumstances the appellants should be considered the new applicants entitled as such to file a request for re-establishment of rights even if the application was deemed to be withdrawn.

Reasons for the Decision

1. According to Article 20(1) EPC the Legal Division is responsible for decisions in respect of entries in the Register of European patents, in particular entries concerning the transfer of rights over a European patent application (see Rule 92(1)(w) EPC). It was therefore competent to decide on the appellants' request for recording the transfer of the patent application referred to above.

However, the Legal Division did not only decide on this request but also dealt with the appellants' application for re-establishment of rights which it rejected as inadmissible.

According to Article 122(4) EPC an application for restitutio in integrum shall be decided upon by the department competent to decide on the omitted act. In the circumstances of the present case, the omitted act was the applicant's failure to reply to a communication of the Examining Division issued pursuant to Article 96(2) EPC. Consequently, the department competent to decide on the application for restitutio was the Examining Division.

In dealing with this issue the Legal Division therefore exceeded its powers. This cannot be justified by any need to decide on the request for restitutio as a preliminary issue to be answered before examining the request for registering the transfer. It follows that the decision under appeal must be set aside on this ground alone and that the request for restitutio be remitted to the Examining Division for examination (see J 10/82, OJ EPO 1983, 94).

2. As regards the request for recording the transfer, the Board exercises its power within the competence of the Legal Division according to Article 111(1) EPC. The further issue to be considered is therefore whether the Legal Division was right in rejecting the appellants' request for recording the transfer of the European patent application No. 87 201 334.7.

According to the decision under appeal the patent application no longer existed on the date of the assignment and could therefore not be transferred. But even if it had been transferred on a date at which it still existed, the registration of such transfer was no longer possible since at the time the transfer documents were filed the application was already deemed to be withdrawn. Thus, the question arises whether or not a patent application can be transferred and the transfer can be registered even after deemed withdrawal thereof.

3. First, it is to be taken into consideration that deemed withdrawal of a patent application does not result in a complete and immediate loss of all the applicant's rights.

Although it is true that the **grant procedure** as such is terminated by a communication noting the deemed withdrawal (see G 1/90, OJ EPO 1991, 275, points 5 and 6

of the reasons), there still remains a bundle of **procedural rights**, as e.g. the applicant's right to apply for a decision under Rule 69(2) EPC (followed by the possibility to file an appeal having suspensive effect) and his right to avail himself of any of the legal remedies provided for in Article 121, Article 122, Rule 85a or Rule 85b EPC, as the case may be. Thus, following deemed withdrawal, there is a period of time during which the applicant is entitled to make use of his procedural rights referred to above with the aim of having his patent application restored.

It is important to note in present context that, pursuant to Article 60(3) EPC, the applicant alone is deemed to be entitled to exercise the right to the European patent for the purposes of proceedings before the European Patent Office. According to Rule 20(3) EPC a transfer shall have effect vis-à-vis the European Patent Office only when and to the extent that the transfer documents have been produced. Thus, the transfer of the patent application is a necessary precondition for any successor in title to exercise his rights vis-à-vis the EPO. However, if after deemed withdrawal such transfer were no longer possible and could not be registered, a successor, as e.g. the rightful heir of the applicant, would be prevented from exhausting the still existing procedural rights referred to above.

Moreover, it can hardly be questioned that an applicant who, after deemed withdrawal of his application, avails himself of any means of redress, e.g. by requesting a decision under Rule 69(2) EPC and filing an appeal, may transfer his application pending such proceedings.

4. The circumstances in which European patent applications may be transferred and transfers be recorded are governed by Articles 71 and 72 and Rule 20 EPC. Neither of these provisions defines a point in the procedure after which the transfer of a patent application and its recording in the Register of European Patents is no longer possible. However, in view of the observations in point 3 (supra), the Board is convinced that these provisions cannot be interpreted to the effect that any transfer of a European patent application and its registering will automatically be excluded after an event causing deemed withdrawal thereof. In contrast, as long as there remains a possibility of restoration of the application, there is a legitimate interest of the users of the EPC to have transfers recorded in the Register of European Patents.

On the other hand, the interests of the public in respect of legal security are not affected, if, at the time of recording the transfer, it is apparent from the files that suitable steps for restoring the application have been taken.

Thus, if a legal remedy is still available and the successor in title has taken, together with his request for registering the transfer, procedural steps suitable for restoring the application, the transfer and its recording in the Register of European Patents should still be allowed provided that all formal requirements were satisfied.

Similar interpretations of the corresponding national provisions were adopted in some of the Contracting States (see e.g. **Benkard**, Patentgesetz, 9.Aufl., §123 Rdn 48; **Schulte**, Patentgesetz, 4.Aufl., §123 Rdn 6; **Blum/Pedrazzini**, Das schweizerische Patentrecht, 2.Aufl., Art.47, Nachtrag Anm 4A).

5. In the circumstances of the present case the request for recording the transfer of the patent application and the application for re-establishment of rights were both filed on 6 May 1992, i.e. within one year following the expiry of the unobserved time limit on 9 July 1991. At the time of filing these requests restitutio in integrum pursuant to Article 122 EPC was still available (see Article 122(2) EPC, second sentence).

As an instrument of transfer the appellants filed - inter alia - exhibit 6 which does not, however, constitute a voluntary contract between the appellants and Mr Touzani but is a unilateral assignment ordered by the Superior Court in and for the County of San Joaquin, State of California, USA, signed by the clerk of the Court on behalf of Mr Touzani. Exhibit 6 does not formally comply with the requirements of Article 72 EPC, because it was not signed by **both** parties (cf. J 18/84, OJ 1987, 215).

However, according to the findings of the Legal Board of Appeal in case J 34/86 of 15 March 1988 (not published in the OJ EPO), an assignment constituting a unilateral transfer as ordered by a Court following proceedings in a State which is not a Contracting State to the EPC can be accepted as a basis for transferring the right to file a divisional application to the assignee, in particular, if the assignor had left free the subject matter claimed in the divisional application.

In the present case, applicant Touzani did not reply to the communications of the Examining Division nor did he make use of any legal remedy available after deemed withdrawal of the application. At the beginning of the present proceedings Mr Touzani's professional representative laid down the representation and all letters directed to Mr Touzani were returned as

undeliverable. From this situation it has to be concluded that Mr Touzani indeed has left free the subject matter of his application. Under these particular circumstances the filed instrument of transfer, even if formally not in full conformity with Article 72 EPC, can be accepted as an instrument of transfer.

The conditions referred to in point 4, above, are therefore complied with and the appellants' request for recording the transfer of the European patent application No. 87 201 334.7 in the Register of European patents can be allowed.

6. The auxiliary request to refer a point of law to the Enlarged Board of Appeal (see point IV of the summary of facts and submissions) does not need considering since the point of law raised by the appellants was decided in their favour.

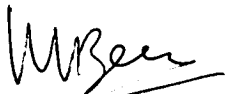
7. The appellants further requested reimbursement of the appeal fee under Rule 67 EPC. As set out in point 1, above, the Legal Division, in purporting to decide on the application for restitutio in integrum, ignored Article 122(4) EPC. This alone would have made it necessary to set the impugned decision aside and remit the case to the competent department. In the Board's opinion this irregularity amounts to a substantial procedural violation within the meaning of Rule 67 EPC which makes it equitable to order the reimbursement of the appeal fee (see decision J 10/82, OJ EPO 1983, 94).

Order

For these reasons it is decided that:

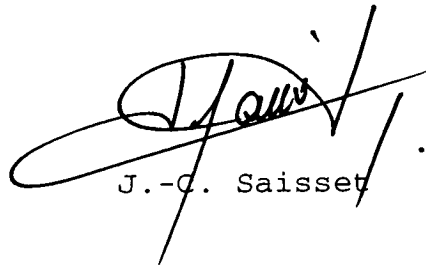
1. The decision under appeal is set aside.
2. The case is remitted to the Legal Division with the order:
 - to record the transfer of the European patent application No. 87 201 334.7 to Collapsible Bottle of America in the Register of European Patents, and
 - to transmit the file to the Examining Division for the examination of the application for restitutio in integrum.
3. Reimbursement of the appeal fee is ordered.

The Registrar:



M. Beer

The Chairman:



J.-C. Saisset

