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D E C I S I O N
of 26 June 2001

Case Number: J 0014/96 - 3.1.1

Application Number: 93201821.1

Publication Number: -

IPC: E04B 1/00

Language of the proceedings: EN

Title of invention:
Securing of building elements without using mortar or glue

Applicant:
De Haan-Van Medevoort, Maria Aletta

Opponent:
-

Headword:
De Haan/FEES

Relevant legal provisions:
EPC Art. 81, 91(3)(5), 121
EPC R. 69(1), 78(3), 85a(1)

Keyword:
Rule 85a(1) fees paid in time (yes)"
"Principle of protection of reasonable expectations -
designation of inventor - deemed in time"

Decisions cited:
G 0005/88, G 0007/88, G 0008/88, J 0018/96

Catchword:
-



Case Number: J 0014/96 - 3.1.1

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D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 26 June 2001

Appellant: De Haan-Van Medevoort, Maria Aletta
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Representative: 't Jong, Bastiaan Jacobus
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Decision under appeal: Decision of the Receiving Section of the EPO
dated 8 February 1996 deciding in the matter of
European application No. 93 201 821.1 that the
Notification of loss of rights pursuant to
Rule 69(1) EPC (EPO Form 1090 dated 20 April
1995) was maintained, and that the application
was deemed withdrawn due to non-payment of filing
and search fees pursuant to Article 78(2) EPC
with effect from 24 July 1993.

Composition of the Board:

Chairman: J.-C. Saisset
Members: S. C. Perryman
M. Aúz Castro

Summary of Facts and Submissions

- I. Application 93 201 821.1 claiming the priority of a Dutch application of 24 June 1992 was filed on 23 June 1993 by joint applicants with principle place of business in the Netherlands without using a representative. On the application form neither section 22 indicating that the applicants were the sole inventors, nor section 23 indicating designation of inventor attached was completed, and no separate designation of inventors was attached.

- II. A communication dated 17 September 1993 on EPO Form 1135 pursuant to Rule 85a(1) EPC was sent indicating that the filing, search and designation fees had not been paid in due time, but could be paid within a period of grace of one month after notification. The fees were received by the EPO on 22 November 1993.

- III. A communication dated 4 May 1994 on EPO Form 1045 concerning deficiencies concerning the designation of inventor was sent by registered post. It drew the applicants' attention to the section of the form concerning the case where the applicant is not the inventor or the sole inventor and where a separate document containing the designation drawn up according to Rule 17(1) and Article 81 EPC has to be filed. No attention was drawn to the section of the form concerning the case where the applicant is the sole inventor and where designation is missing in the request for grant.

The applicants were invited to remedy the deficiency within 2 months and were informed that otherwise the application would be deemed to be withdrawn pursuant to Article 91(5) EPC.

- IV. The communication dated 4 May 1994 was returned undelivered and the EPO took steps to find out the new address, and resent the same communication dated 26 July 1994. No reply from applicants was received.
- V. On the same date another communication was sent to the applicants, informing them that the Abstract had not been filed and inviting them to remedy the deficiency within 2 months, informing them at the same time that in case of non-compliance the application would be refused pursuant to Article 91(3) EPC.
- VI. On 19 September 1994 a notification pursuant to Rule 41(1) EPC was sent to the applicants drawing their attention to the fact that a copy of the previous application from which priority was claimed as well as a translation of this application into one of the official languages of the EPO were missing. They were further informed that in the event of failure to remedy the indicated deficiency within 2 months the right of priority would be lost for the application pursuant to Article 91(3) EPC.
- VII. By decision dated 12 December 1994 the EPO refused the European patent application pursuant to Article 91(3) EPC for failure to file an abstract. The applicants were informed of the possibility of further processing pursuant to Article 121 EPC.
- VIII. By a communication dated 20 January 1995 on EPO Form 1070 the applicants were informed of a loss of rights pursuant to Rule 69(1) EPC relating to the priority claimed, for failure to supply a copy and translation. The first applicant on receipt telephoned the EPO and was strongly advised to appoint a representative.

- IX. The representative, now appointed by the applicants, on 15 February 1995 paid a fee for further processing and submitted an abstract, and by letter of 28 February 1995 argued that the notification of 26 July 1994 concerning deficiencies as to the designation was incorrect, as it did not cover the case here applicable of the applicants being the sole inventors. Accordingly the time limit set for remedying the deficiency was void, and non-compliance could not rightfully lead to a finding that the application was deemed withdrawn.
- X. On 20 April 1995 the EPO issued a communication on Form 1090 noting a loss of rights pursuant to Rule 69(1) EPC, in that the European patent application was deemed withdrawn for failure to pay the filing, search and designation fees within the due time limits.
- XI. On the same date a decision to allow the request for further processing dated 15 February 1995 concerning the late filing of the abstract was issued.
- XII. By letter, received on 26 June 1995 the applicants' professional representative alleged that having received the notification about the missing fees the applicants had given their bank an order to transfer the required amount to an account of the EPO within the one month time limit required by the notification. But the bank did not carry out that order due to the fact that at the time the order was processed, the balance of the account was insufficient. The bank did not inform the applicants of this fact.

As soon as the applicants noted that the order had not been executed they effected the payment through another bank.

The applicants alleged that since the order to the bank was duly given, the requirements of Article 8(3)(a)(ii) RRFees concerning the time limit had to be considered as being fulfilled.

XIII. By a decision dated 8 February 1996, the Receiving Section held that the relevant fees having been paid outside the time limit provided for by Rule 85a(1) EPC, the loss of rights had occurred, and maintained the notification of loss of rights dated 20 April 1995 and stated that the application was deemed withdrawn with effect from 24 July 1993. On 2 November 1995 common applicant De Haan, Tette Hotze has assigned his parts of the rights in the present application to De Haan-Van Medevoort Maria Aletta.

XIV. The applicant appealed filing a Notice of Appeal on 9 April 1996 together with the appeal fee and Statement of Grounds on 17 June 1996, asking that the decision to refuse to set aside the notification of loss of Rights be set aside.

It submitted that the first Office action after payment of the required fees was the notification pursuant to Rule 41(1) EPC of 19 September 1994 concerning the failure to file a copy of the priority document. From the issuance of this notification it followed that the examination pursuant to Article 90(3) EPC had been accomplished and that the filing and the search fee had been considered to have been paid in due time. Otherwise the Receiving Section could not have proceeded to the examination as to formal requirements pursuant to Article 91 EPC.

Applicants must be able to rely on the conclusion of the examination on filing pursuant to Article 90 and on that these issues could not become a subject of debate again.

Alternatively, the appellant relied on its previous allegations, that Article 8(3)(a)(ii) RRFees was applicable to their situation.

Reasons for the Decision

1. The appeal is admissible.

2. The board concurs with the appellant that, in principle, the entrance into the examination as to formal requirements pursuant to Article 91 EPC presupposes the positive accomplishment of the examination on filing pursuant to Article 90 EPC. In the case under consideration, however, the Receiving Section has not followed the chronological order as foreseen by these provisions but has examined certain requirements pursuant to Article 90 EPC and 91 EPC side by side, namely whether the payment of the filing and search fee (Article 90(1)(b) EPC) as well as of the designation fees (Article 91(1)(e) EPC) had been performed in due time. Therefore, the question whether a requirement pursuant to Article 90 EPC can be taken up once the examination pursuant to Article 91 EPC has started, does not even arise in this case.

3. Contrary to the applicant's allegation the filing, search and designation fees were not paid in due time.

According to Article 8(1) RRFees the date on which payment shall be considered to have been made to the Office is the date on which the amount of the payment or of the transfer is actually entered in a bank account or a Giro account held by the Office.

Where payment of a fee is not considered to have been made in due time, it shall nevertheless be considered as having observed the period if evidence is provided that the payment was initiated before the time limit expired and a surcharge of 10% of the relevant fee was paid, Article 8(3) RRFees. This means that the amount the payment of which is initiated within the time limit must enter the account of the Office.

This did not happen in the case under consideration. There the amount the payment of which was initiated within the time limit did not proceed to the account of the Office, but another amount the payment of which was initiated only after the expiry of the time limit. Therefore, Article 8(3) RRFees cannot serve as a remedy in this case.

4. The case law of the boards of appeal has developed the principle of the protection of the legitimate expectations of users of the European patent system. Its application to procedures before the EPO implies that measures taken by the EPO should not violate the reasonable expectations of parties to such proceedings (G 5/88, G 7/88 and G 8/88, OJ EPO 1991, 137).

It has to be examined whether this principle has to be applied in the case under considerations.

- 4.1 Pursuant to Rule 85a EPC the filing fee, the search fee and the designation fees which were not paid in due time may still be validly paid within a period of grace of one month from notification of a communication pointing out the failure to observe the time limit, provided that within this period a surcharge is paid.

The Receiving Section having sent the corresponding communication on 17 September 1993, the one month time limit expired on 27 October 1993 pursuant to Rule 78(3) EPC (in force till 31 December 1998) in connection with Rule 83(2), (4) EPC.

Thus, the payment of the fees on 22 November 1993 was late. To this fact the Receiving Section should have reacted and should have informed the applicants that pursuant to Article 90(3) EPC was deemed to be withdrawn.

4.2 Instead, three further communications were sent to the applicants drawing their attention to various deficiencies, the first two on 26 July 1994 concerning the designation of inventor and the failure to file an abstract, the third communication on 19 September 1994 concerning the failure to supply a copy of the priority document together with a translation thereof (this third communication was erroneously considered as first communication by the applicants).

On 20 April 1995 even a decision was issued allowing a request for further processing.

On that same date only the communication pursuant to Rule 69(1) that the application was deemed withdrawn for failure to pay the fees was sent to the applicants.

4.3 Thus, more than 1½ year the applicants were left to believe that they had effected the payment of the fees in time, all the more because deficiencies listed in Article 91 EPC were drawn to their attention, these deficiencies being normally only examined if the application was not deemed withdrawn pursuant to Article 90(3) EPC, as pointed out correctly.

- 4.4 Furthermore, it has to be taken into account that because the application has not yet been published, the public could not take notice that EPO proceedings are under way (Article 128(1) EPC) and is therefore not directly affected by their outcome.
- 4.5 In view of the foregoing, the Board concludes that in this case the measures taken by the Receiving Section violated the reasonable expectations of the applicants insofar as they made them believe that their application still existed. Therefore, their legitimate expectations must be protected and the payment of the filing, search and designation fees must be considered to have been effected in due time (compare J 18/96, OJ EPO 1998, 403).
5. The decision under appeal did not deal with the question of whether the failure to answer the communication of 26 July 1994 concerning deficiencies as to the naming of inventors would also inevitably have the consequence that the application is deemed withdrawn pursuant to Article 91(5) EPC. Since the application as a whole is pending before the Board, the Board as a matter of procedural economy, decides to deal with the question itself. The communication of 26 July 1994 was defective in that it did not inform the applicants of what was needed, in that it did not cover the case of the applicants being the inventors, as was indeed the fact here. The communication as sent would hardly be understandable by applicant/inventors who had already given their names in the application for grant. The Board considers that only a communication in which this possibility had been marked would have allowed the applicants to understand the matter and take the necessary action. As no such communication was sent, no time limit started to run.

This case shows that it is in the interest of applicants having no experience in patent matters to be represented by someone familiar with the complicated procedural requirements of the EPC. The case, however, also shows that if the Receiving Section is going to send notices concerning deficiencies and losses of rights, that these should be sent in a timely fashion and with procedural economy as far as possible in one communication and that notices concerning later deficiencies or losses of rights should refer to earlier notices on other deficiencies or losses of rights which have not yet been corrected, in order that procedural chaos is avoided.

Order

For these reasons it is decided that:

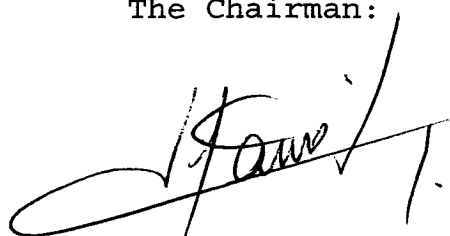
1. The decision under appeal is set aside.
2. The notification of 20 April 1995 of loss of rights pursuant to Rule 69(1) EPC is set aside.
3. The designation of inventors is to be deemed in time.
4. The matter is remitted to the first instance for further prosecution.

The Registrar:



M. Beer

The Chairman:



J.-C. Saisset