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**Datasheet for the decision  
of 18 August 2010**

**Case Number:** T 2414/09 - 3.3.10

**Application Number:** 05750957.2

**Publication Number:** 1831153

**IPC:** C07C 237/04

**Language of the proceedings:** EN

**Title of invention:**

Compounds derived from lidocaine, pharmaceutical compositions,  
use and method of treatment, prevention or inhibition of  
diseases

**Applicant:**

Fundacao Oswaldo Cruz - Fiocruz

**Opponent:**

-

**Headword:**

Impossibility of validating late payment of fee for re-  
establishment

**Relevant legal provisions:**

EPC Art. 122  
EPC R. 136

**Relevant legal provisions (EPC 1973):**

EPC Art. 122(2)

**Keyword:**

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**Decisions cited:**

J 0018/03, T 0046/07

**Catchword:**

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Case Number: T 2414/09 - 3.3.10

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.10  
of 18 August 2010

**Appellant:** Fundacao Oswaldo Cruz - Fiocruz  
Avenida Brasil, 4365  
Manguinhos  
CEP-21045-900 Rio de Janeiro (BR)

**Representative:** Ramos Lucas, Maria Manuel  
MarquesMarcas, Lda  
Largo de São Domingos, 1  
PT-2910-092 Setúbal (PT)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 15 July 2009  
refusing European application No. 05750957.2  
pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman:** R. Freimuth  
**Members:** D. S. Rogers  
C. Komenda

## Summary of Facts and Submissions

- I. The appeal is directed against the decision of the Examining Division dated 15 July 2009. This decision rejected a request for re-establishment of rights into the time limit for payment of the third renewal fee and surcharge.
- II. On 14 February 2008 the Examining Division sent a Communication pursuant to Rule 112(1) EPC to the representative of the applicant informing them that the European patent application was deemed to be withdrawn under Article 86(1) EPC as the third renewal fee and the surcharge had not been paid in due time.
- III. As the time limit for the payment of the third renewal fee and surcharge had not been met, on 25 February 2008 the representative filed a request for re-establishment of rights under Article 122 EPC into the time limit for payment of the third renewal fee and surcharge. The representative filed the grounds for re-establishment with its request but did not pay the fee for re-establishment of rights.
- IV. In a communication dated 9 October 2008 the Examining Division stated that the fee for re-establishment of rights had not been paid, and that therefore the request for re-establishment of rights was deemed not to have been filed. This communication went on to say:

"Therefore your request for re-establishment of rights will have to be deemed not to have been filed, unless you can prove that the fee had, in

fact, been paid within two months after notification of the communication dated 14.02.08".

V. The appellant did not reply to the above communication. The Examining Division issued a decision on 15 July 2009 rejecting the request for re-establishment of rights upon the basis of the non-payment of the fee for re-establishment of rights.

VI. The appellant appealed against the decision of the Examining Division. In its statement of grounds of appeal, the appellant stated:

"...

5° The Applicant did not fulfil the payment of the Re-establishment of Rights Fee in due time because in said date was not able to make it due to the fact that he was passing throughout severe financial difficulties.

...

9° The Applicant requires in the revocation of this decision and the possibility to fulfil the payment of Fees in delay".

VII. The fee for re-establishment was neither paid prior to, on, or subsequent to the date of filing of the statement of grounds of appeal.

VIII. On 11 May 2010 the Board sent a communication to the appellant setting out its preliminary opinion on the appeal. In a letter sent on 7 July 2010 the appellant responded to the communication in the following terms:

"...

2. Was assumed by EPO that the 3rd Annuity was paid one day after due date.

3. However, the 3rd Annuity payment was filed on 02 January 2008.

4. Indeed, instructions to file the payment of 3rd Annuity were received by us from the Applicant in the afternoon of the 02/01/2008 day. At this time Bank has already closed. The only way to file payment in the 02/01/2008 day was to do it through on-line bank.

5. We know that one day after is sufficient to withdraw the EP, however, in the present case, there was no other possibility to do the payment directly to the bank in cash.

6. Why EPO asks for payment of subsequently annuities 4th and 5th when he doesn't consider the 3rd annuity was paid on due date?

7. In our opinion the late payment cannot be imputed to us but to the bank.

8. ...."

IX. The appellant has not requested oral proceedings. In its statement of grounds of appeal the appellant requested that the decision under appeal be set aside and that it be re-established into its right to pay the third renewal fee and surcharge.

## **Reasons for the Decision**

### *Admissibility and oral proceedings*

1. The appeal is admissible.

The appellant has not requested oral proceedings under Article 116 EPC. The Board itself does not consider it expedient to hold oral proceedings as all the necessary facts are established and the appellant has been given the opportunity to file arguments in support of its case.

### *Re-establishment of rights (Article 122 EPC and Rule 136 EPC)*

2. As the time limit for the payment of the third renewal fee and surcharge had not been met, on 25 February 2008 the representative filed a request for re-establishment of rights under Article 122 EPC into the time limit for payment of the third renewal fee and surcharge.
3. The last sentence of Rule 136(1) EPC provides that:  
"The request for re-establishment of rights shall not be deemed to have been filed until the prescribed fee has been paid".

This means in the context of the preceding text of Rule 136(1) EPC that the fee for the application for re-establishment of rights has to be paid within the time limit for filing the application for re-establishment of rights (the text of Rule 136(1) EPC was formerly in Article 122(2) EPC 1973, therefore the case law on Article 122(2) EPC 1973, see J 18/03, point 3.3 and T 46/07, point 1.3.2, also applies to Rule 136(1) EPC).

In the present case no fee for re-establishment has been paid. In accordance with Rule 136(1) EPC, the last possible theoretical date for paying this fee would have been 31 December 2008.

4. It is provided in Article 122(4) EPC that:  
"Re-establishment of rights shall be ruled out in respect of the time limit for requesting re-establishment of rights".

It is provided by Rule 136(3) EPC that:  
"Re-establishment of rights shall be ruled out...in respect of the period for requesting re-establishment of rights".

It is provided by Article 122(4) EPC that. "Further processing shall be ruled out in respect of the time limits...for requesting re-establishment of rights".

Thus there is no possibility to validate for any reason whatsoever a payment of a fee for re-establishment of rights outside the prescribed time limit.

5. The appellant's letter of 7 July 2010 did not address the issue of the non-payment of the fee for re-establishment of rights. This letter contained a discussion concerning the payment of various renewal fees. Whether or not the bank or the representative was responsible for failure to pay the renewal fee and surcharge on-time is irrelevant in the present case as the appealed decision concerns the non-payment of a fee for re-establishment of rights, not the payment of a renewal fee.



6. Consequently, the Appellant cannot be granted re-establishment into the time limit for payment of the third renewal fee and surcharge. The appeal therefore fails.

## **Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

C. Rodríguez Rodríguez

F. Freimuth