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D E C I S I O N
of 19 April 1994

Case Number: T 0748/93 - 3.3.3

Application Number: 87118561.7

Publication Number: 0320521

IPC: D01F 6/02

Language of the proceedings: EN

Title of invention:

Artificial hair and reproduction thereof

Patentee:

Kuraray Co., Ltd.

Opponent:

Hoechst AG

Headword:

-

Relevant legal norms:

EPC Art. 99(1), 122

Keyword:

"Re-instatement of opponent in missed opposition term (no)"

Decisions cited:

-

Catchword:

-



Case Number: T 0748/93 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 19 April 1994

Appellant:
(Opponent)

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Respondent:
(Proprietor of the patent)

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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office dated 2 July 1993 rejecting
the request for re-establishment of rights with
respect to payment of the full fee for the
opposition filed against European patent
No. 0 320 521 pursuant to Article 102(2) EPC.

Composition of the Board:

Chairman: F. Antony
Members: F. Benussi
P. Kitzmantel

Summary of Facts and Submissions

- I. On 15 July 1992 an announcement was made in the European Patent Bulletin of the grant of European patent No. 0 320 521.
- II. On 15 April 1993 the Appellant filed notice of opposition and paid, at the same time, DM 700 as opposition fee.
- III. In a communication pursuant to Rule 69(1) EPC dated 13 May 1993, the Formalities Officer of the Opposition Division notified the Appellant that the opposition fee had not been paid in full within the required nine month period, and that the notice of opposition was therefore deemed not to have been filed, in accordance with Article 99(1); Article 9(1) of the Rules Relating to Fees (RFees) and Article 2 of the Decision of the Administrative Council (DAC) of 5 June 1992 amending the Rules relating to Fees (OJ EPO 1992, 344) being inapplicable to the present case.
- IV. In a letter received on 24 May 1993, the Appellant requested re-establishment of rights under Article 122 EPC in respect of the period for paying the full amount of the opposition fee and paid the outstanding DM 500 as well as the fee of DM 150 for re-establishment of rights. He also explained why, in spite of all due care taken, he was unable to observe the missed time limit.
- V. In its decision dated 2 July 1993, the Opposition Division decided to reject the request for re-establishment as inadmissible, and held that the notice of opposition was deemed not to have been filed, on the basis of the principle that the notice of opposition had to be filed within nine months from the publication of

the mention of the grant of the European patent, and that it could only be deemed to have been filed if the opposition fee had been paid in due time and in the full amount (Article 9(1) RFees).

As stated in its communication of 13 May 1993, the missing amount of DM 500 could not be regarded as "small amount" within the meaning of Article 9(1) RFees, fourth sentence, and the period of grace of six months in accordance with Article 2 of the DAC of 5 June 1992 had expired on 1 April 1993.

The request for re-establishment of rights was inadmissible because re-establishment of rights for an opponent concerning the time limit for filing an opposition was not laid down in the EPC, and the exceptional situation envisaged by the Enlarged Board's decision G 1/86 did not apply, there being no opposition procedure in existence.

- VI. On 13 August 1993, the Appellant lodged an appeal against that decision, submitting a Statement of Grounds and paying the prescribed fee at the same time. He requested that the decision of the Opposition Division be set aside and that the notice of opposition be regarded as effectively filed.

While the decision G 1/86 could not be interpreted to apply quite generally to missed opposition terms, the present case was special in that detailed opposition grounds and an opposition fee (in an amount applicable up to 1 October 1992) were provided in good time; what was missed was, in essence, the period of grace granted by the Administrative Council. In these special circumstances the late payment of DM 500 should be permissible.

VII. The Respondent (Patentee), having argued against any re-establishment before the first instance at the appeal stage submitted further remarks in a letter received on 6 December 1993. In that letter he pointed out that *restitutio in integrum* under Article 122 EPC is not available to an opponent when opposition proceedings - as in the present case - have not come into existence.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. According to Article 99(1) EPC, third sentence, an opposition "shall not be deemed to have been filed until the opposition fee has been paid", the term "paid" meaning, according to Article 9(1) RFees, first sentence, "paid in full", subject only to the provisions of Article 9(1) RFees, third and fourth sentences.
3. In the present case, it is out of dispute that the full opposition fee, in the amount applicable at the date concerned, was not paid within the opposition term expired on 15 April 1993. Furthermore, the notice of opposition having been submitted on the last day of said term, the EPO was not in a position to make use of the possibility of Article 9(1) RFees, third sentence.
4. In Decision T 130/82 "Vehicle Guidance System/ Bell & Howell" (OJ EPO 1984, 172) it was held that an underpayment of just over 10% may be considered to be a small amount within the meaning of Article 9(1) RFees, fourth sentence. Decision J 11/85 (OJ EPO 1986, 1) has confirmed this. The opinion of the Opposition Division in the present case, where only DM 700 instead of

DM 1200 were paid within the opposition term, that the missing amount cannot be termed "small" in the above sense, is not contested by the Appellant and shared by the Board. The period of grace of Article 2 DAC of 5 June 1992 having expired on 1 April 1993 (equally uncontested), the only possibility for the appeal to succeed would consist in re-establishment being granted in respect of the time limit for filing the opposition.

5. As correctly stated in the decision under appeal, the provisions of Article 122 EPC only make reference to the **applicant or proprietor** of a European patent as to the possibility of having his rights re-established if, in spite of all due care, he was unable to observe a time limit non-observance of which would result in a loss of rights or means of redress.

6. The meaning and the consequences of the lack of reference to the opponent in the mentioned provision have been considered by the Enlarged Board of Appeal in its decision G 1/86 (OJ EPO 1987, 447). This decision for the first time enabled the opponent to benefit from the provisions of Article 122 EPC in the event of late filing of the Statement of Grounds of Appeal, whereas previously this possibility would appear to have been limited to the patent proprietor. The reasons for this decision were however based on the differences between the rights which can legitimately be invoked, both by the opponent and the applicant or patent proprietor, depending on whether the legal process has been initiated or not (cf. point 9 of the decision). In appeal proceedings, this process starts when the appeal has been filed and the appropriate fee has been paid (cf. point 8, second sub-paragraph). For the same reasons as those given by the Enlarged Board of Appeal, this Board maintains that, in accordance with Article 99(1) EPC, the legal process in opposition

proceedings begins when the notice of opposition is filed and the appropriate fee is paid.

In its decision the Enlarged Board of Appeal clarified that the remedy of re-establishment of rights (Article 122 EPC) is normally available only to patent proprietors and applicants, and not to opponents except in respect of the time limit for filing the Statement of Grounds of Appeal where an effective appeal has previously been filed. In such circumstances the exclusion of the opponent from the possibility to be re-established in his rights would result in an unjustifiable discrimination against the opponent not apparently intended by the legislator (point 8, third to fourth sub-paragraphs). This conclusion was derived from the recognition of the principle that all parties to proceedings before a court must be accorded the same procedural rights.

This principle presupposes that the opponent had previously become a party to the proceedings or, in other words, that proceedings were actually in existence. However, before a prospective appellant has lodged the appeal and paid the appeal fee, or equally before a prospective opponent has effectively filed a notice of opposition and paid the opposition fee, he does not assume the role of a party, because the respective proceedings are not yet in existence.

7. Consequently, the request for re-establishment of rights by the Opponent, who has failed to observe the nine-month time limit under Article 99(1) EPC for filing the notice of opposition and paying the appropriate fee, must be rejected as inadmissible under Article 122 EPC, irrespective of whatever arguments are put forward to explain the reasons for not paying the full amount of the opposition fee, which arguments would be a matter

for consideration in connection with an assessment of the merits and not the admissibility of the request for re-establishment.

Order

For these reasons, it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

E. Görgmaier

F. Antony