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D E C I S I O N
of 18 January 1994

Case Number: G 0005/93

Application Number: 90914566.6

Publication Number: WO91/03727

IPC: G01N 21/35

Language of the proceedings: EN

Title of invention:
Method for analyzing agent gas

Applicant:
Nellcor Incorporated

Opponent:
-

Headword:
Re-establishment/NELLCOR

Relevant legal norms:
EPC Art. 122(5), 150, 157(2)(b), 158(2)
EPC R. 104b(1)(b)

Keyword:
"Applicability of Article 122(5) EPC"

Decisions cited:
-

Headnote:
The provisions of Article 122(5) EPC apply to the time limits provided for in Rule 104b(1)(b) (i) and (ii) EPC in conjunction with Articles 157(2)(b) and 158(2) EPC. This nothwithstanding, Euro-PCT applicants may be re-established in the time limit for paying the national fee provided for in Rule 104b EPC in all cases where re-establishment of rights was applied for before Decision G 3/91 was made available to the public.

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: G 0005/93

D E C I S I O N
of the Enlarged Board of Appeal
of 18 January 1994

Appellant: Nellcor Incorporated
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Decision referring a point of law: **Decision of the Legal Board of Appeal of the European Patent Office of 24 May 1993 in case J 0004/93.**

Composition of the Board:

Chairman: P. Gori
Members: C. Payraudeau
F. Antony
G.D. Paterson
E. Persson
R. Schulte
P. van den Berg

Summary of the Facts of the Case

I. The Legal Board of Appeal in its decision J 4/93 of 24 May 1993, has referred to the Enlarged Board of Appeal the following questions of law in application of Article 112(1)(a) EPC:

1. Is the EPO and are the Boards of Appeal, in the light of Article 172 EPC, competent to exclude, by way of interpretation of Article 122(5) EPC, the time limit provided for in Rule 104b(1)(b) EPC from re-establishment of rights?

2. If the answer is yes (and Decision G 3/91 is confirmed with regard to the time limit provided for in Rule 104b(1)(b) EPC):

   Is the former constant practice of the EPO regarding the applicability of Article 122 EPC to the time limit referred to in Rule 104b(1)(b) EPC a sufficient basis for the legitimate expectation of a party to have its request for re-establishment examined according to this former practice, if the request was filed before the party was duly informed of Decision G 3/91?

3. If the answer to question 2 is yes:

   From which date can the users of the EPO be assumed to have been duly informed of Decision G 3/91?

II. In the reasons for its decision, the Legal Board held that the Enlarged Board of Appeal will have "to consider the fact that Article 122(5) EPC provides an exception to the general rule of Article 122(1) to (4)

EPC and, applying general principles of interpretation, cannot just be extended to cover situations to which it does not specifically apply."

The Legal Board drew also attention to the fact that in the case of the "claims fees", the application of the principle of Decision G 3/91 would, in its opinion, bring the danger that Euro-PCT applicants would be put to a disadvantage compared with Euro-applicants since the latter were entitled to re-establishment of rights for the claims fees. In this connection, the question arose whether re-establishment of rights in respect of the time limit for the payment of the "national" fee referred to in Rule 104b(1)(b) EPC could be granted on the ground that part of this composite fee, namely the claims fees, was not excluded from re-establishment.

The Legal Board of Appeal also submitted, as regards the third question, that the date of publication of Decision G 3/91 in the Official Journal should be the date after which the Euro-PCT applicants could no more legitimately expect to be re-established in the time-limit of Rule 104b(1)(b) EPC.

III. Oral proceedings were held on the 1 December 1993, at which the Appellant was represented by Mr Brian Reid.

IV. In his submissions to the Enlarged Board of Appeal, the Appellant essentially argued as follows.

1. As concerns the first question:

(a) The part of Decision G 3/91 which concerns Euro-PCT applications was only an "*obiter dictum*" because, in the case concerned, a European application and not a Euro-PCT

application was involved. Therefore, this decision could not be considered as having created a precedent in this respect.

(b) Article 122(5) EPC was specifically restricted to the time limits referred to and should be interpreted narrowly. The exclusion of any time limit not mentioned would be a change of the EPC which, according to Article 172 EPC, can only be made by a Conference of the Contracting States. The same reasoning applied (*mutatis mutandis*) to the Rules which can only be amended by the Administrative Council and not by the Enlarged Board of Appeal. Therefore, the time limits not expressly mentioned in Article 122(5) EPC, including, in particular, the time limit under Rule 104b(1)(b) EPC, were impliedly excluded from the operation of Article 122(5) EPC. The Enlarged Board of Appeal was not entitled to decide that Euro-PCT applicants are excluded from re-establishment of rights but had to apply the EPC as it stands.

(c) Article 150(2) EPC states that in case of conflict between the provisions of the EPC and those of the PCT, the provisions of the PCT shall prevail. Article 150(2) EPC as a whole, taken in conjunction with Article 48(2) PCT, clearly indicated that an applicant for a Euro-PCT application was intended to enjoy separate, and different, rights regarding adherence to time limits as compared to an applicant for a European patent. Therefore, Article 122(5) EPC could

not be considered as applying to Euro-PCT applications.

(d) The time limits with which Article 78(2) and Article 79(2) EPC are concerned are connected with the completion of the filing requirements of a European patent application. On the other hand, the filing requirements for international applications are set out in Article 11 PCT. Once these requirements have been fulfilled, the international application is deemed to be a European application (Article 11(3) PCT). The time limits for paying the search fee (Article 157(2) EPC) and the national fee (Article 158(2) EPC) are long after the filing requirements had been completed on the deemed European application. Thus, these fees were not "a filing fee" because the patent application had already been filed. Therefore, there was no real analogy between the "national fee" and the filing fee provided for European applications.

(e) According to Article 48(2)(b) PCT, where national law does not allow delays to be excused in equivalent circumstances for a national application, a Contracting State may still excuse such a delay for International application. There was therefore a specific basis for a difference in treatment between international and national applications.

(f) Decision G 3/91 was contrary to consistent jurisprudence that re-establishment of rights is possible in the circumstances of failure

to meet the time limits of Article 157(2) and 158(2) EPC. Indeed, the decision was also contrary to the statements published by the EPO itself such as "Information for PCT Applicants" (OJ EPO 1991, 333).

(g) In most of the Contracting States where a national patent application, as an alternative to European patent application, can be designated in an International patent application, re-establishment of rights on grounds very similar or identical to Article 122 EPC is permitted to excuse delays in meeting the time limits for entry of the national phase. In view of this clear expression of opinion by the Contracting States whose laws have been harmonised with the EPC, the EPC should be interpreted by the EPO to allow delays in meeting the time limits for entry of the regional phase at the European Patent Office to be excused.

(h) The application of Decision G 3/91 to Euro-PCT applications would leave PCT-applicants at a disadvantage as they were therefore excluded from re-establishment for the claims fees which was not the case for European applicants. Both kinds of applicants should be treated equally, in accordance with general legal principles.

2. As concerns the second question:

The principle of the protection of the legitimate expectations of the users of the EPO should be applicable to the present case since, until Decision G 3/91, re-establishment of rights for Euro-PCT applications was granted by the EPO.

3. As concerns the third question:

The previous practice of the EPO should be applied at least to the cases entered before the date of publication of Decision G 3/91 in the Official Journal of the EPO. However, since a relatively long time span necessarily elapsed between this date and the time where the Official Journal was delivered to European attorneys and the latter were able to advise their clients correspondingly, a two-months grace period (period corresponding to the time limit of Article 122(2) EPC) taking effect at the date of publication of the Official Journal would be advisable in order to avoid expenses incurred for the preparation of requests for re-establishment which would become useless.

Reasons for the Decision

1. *First question*

1.1 Interpretation of Article 122 EPC

1.1.1 According to Articles 11(3) and 45(1) of the PCT and Articles 153 and 156 of the EPC, an International application designating or electing the European Patent Office has the effect in the Contracting States to the

EPC of a "national" (European) application as of the international filing date. The applicant has to pay a "national" fee (if any) not later than at the expiration of 20 months (Article 22(1) PCT) or, as the case may be, 30 months (Article 39(1)(a) PCT) from the priority date.

1.1.2 However, the "national" law or the "regional patent treaty" (Article 45(1) PCT) may fix a time limit which expires later (Article 22(3) or Article 39(1)(b) PCT). This is the case with the EPC which has fixed these time limits respectively at the expiry of 21 and 31 months from the priority date (Rule 104b(1) EPC) whereas, for the direct European patent application, the time limit for paying the filing fee and the search fee (and in the case provided for in Article 79(2) EPC the designation fees), is one month after the filing date (Article 78(2)).

1.1.3 The PCT provides that "any Contracting State (this meaning, in the present case, the European Patent Convention) shall ... excuse, for reasons admitted under its "national" (European) law, any delay in meeting any time limit" (Article 48(2)(a) PCT). For this reason, the provisions of Article 122 EPC which relate to the possibility of re-establishment of rights in case a time limit has not been respected should apply to the Euro-PCT applicants in so far as they also apply to the "direct" European applicants. Since the possibility of re-establishment of rights is excluded for direct European applicants in the case where the time limits provided for in Articles 78(2) and 79(2) EPC for paying the filing fee, the search fee and the designation fees have not been respected, this provision of the PCT does not oblige the EPC to give to the Euro-PCT applicant the possibility to be re-

established in the time limits for paying the **corresponding** Euro-PCT fees i.e. the national basic fee and the designation fees provided for in Rule 104b(1)(b) (i) and (ii) EPC.

1.1.4 However, Article 48(2)(a) PCT does apply in the case of the time limits for paying the claims fees provided for in Rule 104b(1)(b) (iii) EPC because the direct European applicant is not excluded by Article 122(5) EPC from re-establishment in the time limit to pay the corresponding fees provided for in Rule 31 EPC. Therefore, a Euro-PCT applicant may be re-established in the time limit to pay the claims fees under the provisions of Article 122 EPC in conjunction with Article 48(2)(a) PCT.

1.1.5 Even if the EPC is thus not obliged to offer to the Euro-PCT applicant the possibility to be re-established in the time limits for paying the national fee (except for the claims fees), it could still offer this possibility to the Euro-PCT applicants for other reasons (Article 48(2)(b) PCT). The Appellants have submitted that the EPC had done so because the express mention in Article 122(5) of certain time limits implied the exclusion of all other time limits which are not expressly mentioned, and consequently of the time limits for paying the "national fee" provided for in Rule 104(1) EPC.

1.1.6 In this respect, the referring Board of Appeal has also submitted that the "national fee" mentioned in Article 158(2) EPC was a composite single fee, which, as indicated in Rule 104b(1)(b) EPC, was comprised of a national basic fee, designation fees and, where applicable, claims fees. The referring Board pointed out that this composite single fee could not be equated

with the sum of the partial fees which it comprises. The time limit to pay this composite single fee could therefore be considered as an independent time limit for which re-establishment of rights was not excluded under Article 122(5) EPC.

1.1.7 These submissions presuppose that the time limit for paying the "national fee" is different in its legal nature from the time limits for paying the European filing, designation and claims fees.

In the opinion of the Enlarged Board of Appeal, the time limits for Euro-PCT applicants and those for direct European applicants do not differ in their legal nature because of their equivalent function. This function makes both time limits in essence identical. The fact that they differ in their respective duration does not affect their equivalent legal nature.

The distinction made in Rule 104b(1)(b) EPC between the different parts of the "national" fee does not establish a difference between the time limit for paying the European fees and the time limit for paying the "national" fee but, on the contrary, confirms the quasi-identity of these time limits.

Thus, the legal consequences of non-payment within the given time limit of the filing fee (Article 90(3) EPC), the designation fees (Article 91(4) EPC) and the claims fees (Rule 31(2) EPC) by the direct European applicant are the same as the legal consequences defined in Rule 104(c) EPC for the non-payment within the given time limit of the corresponding parts of the "national" fee. The European patent application is deemed to be withdrawn unless the filing fee or the national basic fee and at least one designation fee have been paid in

due time. In case of non-payment of a designation fee, the designation is deemed to be withdrawn. On the other hand, where a claim fee has not been paid, the corresponding claim is deemed to be abandoned. This shows clearly that this "national" fee is not a composite single fee but an aggregate of independent fees respectively identical to the filing fee, the designation fees and the claims fees for the European application, as indicated in Rule 104b(1)(b) (ii) EPC for the designation fees.

1.1.8 Therefore, the mention of Articles 78(2) and 79(2) EPC in Article 122(5) EPC is not limited to direct European applications but also refers to Euro-PCT applications which under Article 11(3) PCT have the effect of a national (European) application as of the international filing date and are according to Article 150 EPC submitted to the provisions of the EPC in so far as these provisions do not conflict with those of the PCT.

1.1.9 It follows from the above considerations and from the reasons already given in Decision G 3/91, that the provisions of Article 122(5) EPC apply to the time limits provided for in Rule 104b(1)(b) (i) and (ii) EPC in conjunction with Articles 157(2)(b) and 158(2) EPC.

2. *Second and third questions*

2.1 According to the "Information for PCT applicants (as at 1 June 1991) concerning time limits and procedural steps before the EPO as designated Office under the PCT (Articles 150, 153, Rule 104(b) EPC)" (OJ EPO,1991, 328), points B-II 6 and 7 (page 333) "if a loss of rights occurs, (due to the non payment of the national basic fee, of the designation fees, of the search fee

or of the claims fees) the applicant can have them re-established pursuant to Article 122 EPC".

2.2 The European Patent Office was therefore bound, by its own interpretation, to admit the possibility for the Euro-PCT applicants to be re-established in the time limits for paying the above mentioned fees.

2.3 The Euro-PCT applicants were thus entitled to expect that the European Patent Office should apply its own interpretation up to the date at which Decision G 3/91 of the Enlarged Board of Appeal, which has established that the said interpretation and the corresponding practice was not the proper interpretation of the relevant provisions of the EPC, was made available to the public.

Order

For these reasons, it is decided that the questions of law which were referred to the Enlarged Board of Appeal are answered as follows:

The provisions of Article 122(5) EPC apply to the time limits provided for in Rule 104b(1)(b) (i) and (ii) EPC in conjunction with Articles 157(2)(b) and 158(2) EPC. This notwithstanding, Euro-PCT applicants may be re-established in the time limit for paying the national fee provided for in Rule 104b EPC in all cases where re-establishment of rights was applied for before Decision G 3/91 was made available to the public.

The Registrar: The Chairman:

J. Rückerl P. Gori