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**D E C I S I O N**  
**of 13 March 2002**

**Case Number:** J 0008/00 - 3.1.1

**Application Number:** 98201403.7

**Publication Number:** 0870699

**IPC:** B65D 83/54

**Language of the proceedings:** EN

**Title of invention:**

Aerosol valves

**Applicant:**

MINNESOTA MINING AND MANUFACTURING COMPANY

**Opponent:**

-

**Headword:**

Failure to pay designation fees/MINNESOTA MINING

**Relevant legal provisions:**

EPC Art. 76(2)

**Keyword:**

"Application of an Enlarged Board's decision to cases pending at the time of the decision"

**Decisions cited:**

G 0004/98, G 0005/88, G 0009/93, J 0022/95, J 0019/96

**Catchword:**

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Boards of Appeal

Chambres de recours

Case Number: J 0008/00 - 3.1.1

**D E C I S I O N**  
**of the Legal Board of Appeal 3.1.1**  
**of 13 March 2002**

**Appellant:** MINNESOTA MINING AND MANUFACTURING COMPANY  
3M Center  
Saint Paul  
Minnesota 55144-1000 (US)

**Representative:** Bowman, Paul Alan  
LLOYD WISE, TREGEAR & CO.  
Commonwealth House  
1-19 New Oxford Street  
London WC1A 1LW (GB)

**Decision under appeal:** Decision of the Receiving Section dated  
28 September 1999.

**Composition of the Board:**

**Chairman:** J. Saisset  
**Members:** P. Mühlens  
C. Rennie-Smith

## Summary of Facts and Submissions

- I. The appeal lies against a decision of the Receiving Section dated 28 September 1999 that the contracting states Austria, Denmark, Spain, Finland, Great Britain, Greece, Luxemburg, Monaco and Portugal have not been validly designated in European application No. 98 201 403.7 . This divisional application was filed on 1 May 1998. The parent application No. 96 908 690. 1 was derived from the international application No. PCT/US96/03087. In the international application, all EPC contracting states were designated. No designation fees in respect of the states mentioned above had been paid by the deadline of 10 December 1997.
- II. In a letter dated 13 August 1998, the appellant's representative requested that all designations of the international application should be maintained in the divisional application. It submitted that in the parent application, originating from the international application, all the contracting states were designated. Thus, the requirement of Article 76(2) EPC had been met even though on entry in the European phase designation fees were only paid in respect of certain states.
- III. In the impugned decision, the Receiving Section decided that the states in question had not been validly designated in the divisional application. When the divisional application was filed, all the designations in respect of which no fees had been paid were deemed to be withdrawn pursuant to Article 91(4)EPC and thus could not be resurrected by the divisional application. Reference was made to decisions J 22/95 (OJ EPO 1998,

569) and J 19/96 (unpublished in OJ EPO) as well as to opinion G 4/98 (OJ EPO 2001,131) of the Enlarged Board.

- IV. On 3 December 1999, the applicant lodged an appeal against the decision of the Receiving Section and paid the appeal fee.
- V. In the grounds of appeal, the appellant submitted that Article 76(2) EPC has to be applied literally and not, as stated in the impugned decision, in the sense that the designations in the parent application must be *valid* for the respective states. Case law of the Boards of Appeal contrary to this argument is not applicable for Euro - PCT applications. In addition, as the application was filed before the publication of J 22/95, J 19/96 and G 4/98, that case law could not be applied retrospectively.
- VI. In a communication dated 18 September 2001, the Board observed that the basic question underlying this appeal was answered by the opinion G 4/98; and that the Board did not see any "retrospective" application of "new" case law.
- VII. In its response to the communication, the appellant submitted that it no longer disputed that the "non-literal" application of Article 76(2) EPC was also applicable to Euro-PCT-applications. However it expressed the view that the issue of the "retrospective" application of new case law had to be clarified. At the time when the appellant chose not to pay the designation fees on the parent application, there was no appeal board decision to the effect that it would then lose its rights. It referred to decisions G 5/88 (OJ EPO 1991,137), G 5/93 (OJ EPO 1994,447) and

G 9/93 (OJ EPO 1994, 891). All of them, although related to new case law, were not applied retrospectively. Furthermore, allowing its request would not violate any legitimate expectation of third parties because third parties inspecting the file or the register after 1 May 1998 would have seen that the applicant was explicitly claiming rights in all contracting states of the EPC.

VIII. Oral proceedings were held on 13 March 2002.

IX. In the oral proceedings, the representative of the appellant again expressed its view that the case law created by G 4/98 should not be applied "retrospectively" to the present case. At the time of filing the divisional application, the general understanding of the users of the European patent system was that for the application of Article 76(2) EPC it was sufficient that a state was designated in the parent application, irrespective of whether the designation fee for that state had been paid. Thus, G 4/98 has created a completely new legal situation.

X. The appellant requested that the decision under appeal be set aside and that all designations of the international application PCT/US 96/03087 be maintained in the divisional application 98 201 403.7.

### **Reasons for the Decision**

1. The appeal is admissible.
2. The basic question underlying this case is whether Article 76(2) EPC must be applied "literally", in the

sense that it is sufficient that the states were designated in the parent application for the designations to be valid. This point of law has been decided by the Enlarged Board in case G 4/98. The Enlarged Board clearly states in its opinion that "if the designation fees are not paid in due time", the designations will "not have any effect with respect to acts to be performed after that date, such as the filing of a divisional application" (point 4 of the opinion). As the appellant no longer contests (other than on the grounds of "retrospective effect" - see point 3 below) that the opinion G 4/98 applies to the present case, the Board sees no need to do more than direct attention to point 4 of the Enlarged Board's decision.

3. The remaining question to be decided by the Board is whether G 4/98 should not be applied to the present case because of a possible "retrospective effect". It seems clear that the appellant is not using that expression in its usual sense, to mean that legal rights or obligations are changed with a back-dated effect, but to mean that cases pending at the date of the decision in G 4/98 should be exempted from its application.

- 3.1 The Enlarged Board has decided on a number of occasions that the principle of good faith has to be applied to case law which creates a new situation for users of the EPO because their legitimate expectations must be protected. This principle was applied in case G 5/88, where the Enlarged Board overruled an agreement made by the President of the EPO with the German Patent Office concerning the treatment of documents intended to be filed at the EPO. Decision G 5/93 was concerned with

the re-establishment of certain time limits in PCT-applications. The decision of the Enlarged Board was contrary to the "Information for PCT-Applicants", a guideline issued by the EPO in which (contrary to the Enlarged Board's decision) it was said that re-establishment was allowed. The principle was also applied in decision G 9/93 which held that a proprietor cannot oppose his own patent, overturning the ruling in G 1/84 (OJ EPO 1985, 299).

3.2 All of the three decisions in which the Enlarged Board ordered that new case law should not apply retrospectively have in common changes to prior law and practice on which users of the European patent system had relied: an existing agreement between the EPO and a national office, a guideline published by the EPO itself, or, in G 9/93, a previous decision of the Enlarged Board itself which had explicitly allowed so-called "self-oppositions". Those three Enlarged Board decisions, which all had that special feature, cannot form the basis of a general rule that new case law must never be applied retrospectively (in the sense used by the appellant).

3.3 In the present case, not only did the Enlarged Board make no order as to the non-application of its decision in G 4/98 to pending cases, but also there was no change in prior law and practice on which users had relied. On the contrary, the Enlarged Board, by providing a definitive interpretation of Article 76(2) EPC, provided users not with a change in the law they had previously relied on but with an interpretation of the law they could rely in place of the previous uncertainty on which they could not rely. Therefore, the protection of legitimate expectations and the

principle of good faith as raised by the appellant are not in question. The interpretation of Article 76(2) EPC supplied in G 4/98 applies to the present case and serves to decide it.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

J. Saisset