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D E C I S I O N
of 2 May 2002

Case Number: J 0018/01 - 3.1.1

Application Number: 00...

Publication Number: -

IPC: -

Language of the proceedings: EN

Title of invention:

...

Applicant:

...

Opponent:

-

Headword:

Late filed translation/...

Relevant legal provisions:

EPC Art. 14(2); 90(3); 122(1), (2)

EPC R. 6(1); 69(1), (2)

Keyword:

"Failure to file a translation within the time limit
prescribed by Rule 6(1) EPC"

"Pending application"

Decisions cited:

G 0005/88, G 0007/88, G 0008/88, J 0005/89

Catchword:

-



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Boards of Appeal

Chambres de recours

Case Number: J 0018/01 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 2 May 2002

Appellant: N.N.

Representative: N.N.

Decision under appeal: Decision of the Receiving Section of the European Patent Office dated 6 July 2001 declaring that European patent application No. 00 ... is deemed to be withdrawn.

Composition of the Board:

Chairman: J.-C. Saisset
Members: S. U. Hoffmann
G. E. Weiss

Summary of Facts and Submissions

- I. European patent application No. 00 ... claiming the priority of a Danish application of 24 August 1999 was filed with the EPO on 24 August 2000. The application documents were filed in the Danish language. The applicant was resident in Hobro/Denmark.
- II. On 7 November 2000 the applicant filed a first divisional application.
- III. On 13 November 2000 the EPO received an English translation of the application filed on 24 August 2000.
- IV. In a communication pursuant to Rule 69(1) EPC dated 8 December 2000 the applicant was informed that the application was deemed to be withdrawn because the translation of the (parent) application had not been filed in due time pursuant to Article 90(3) EPC.
- V. On 17 December 2000 the applicant filed a second divisional application.
- VI. During a telephone call on 8 February 2001, the applicant's representative learned that his letter dated 28 December 2000, in which a decision pursuant to Rule 69(2) EPC was requested could not be located in the EPO fax room in The Hague. On the same day a fax copy of this letter was sent to and received by the EPO. In this letter the applicant's representative stated: "Though having passed the official time limit for filing a translation, the application was still pending at this time, which was also confirmed by the EPO by a check in the computer files of the EPO. Thus, the translation has been filed while the application was still pending and more than a month before the receipt of the notification of the EPO. Furthermore, as

the patent application has not yet been published, no damage could occur for third parties, if the EPO would have accepted the translation as having been filed in due time and continued processing. Also, no substantial delay would have occurred for the processing of the application, if the EPO had accepted the translation as having been filed in due time."

- VII. In a communication under Article 113(1) EPC dated 25 April 2001 the applicant was informed that the EPO intended to issue a negative decision rejecting the request to consider the translation of the application as having been filed in due time.

- VIII. In a letter received on 19 May 2001 the applicant requested an appealable decision.

- IX. On 6 July 2001 the Receiving Section issued a decision pursuant to Rule 69(2) EPC stating that the request for setting aside the loss of rights communication pursuant Rule 69(1) EPC was rejected and that the application was deemed to be withdrawn with effect from 26 September 2000 on the basis of Article 90(3) EPC.

- XII. On 13 July 2001 the applicant lodged an appeal against the decision of the Receiving Section and paid the appeal fee on the same day. It was requested that the decision under appeal be set aside. The grounds for the appeal were attached.

The appellant admitted that the translation had not been filed in due time because its computer software system had not been correctly adapted with the result that the first divisional application had been filed before the notification of the loss of rights received on 11 December 2000 and the second one after it had been received. Furthermore it submitted that during several telephone calls on 20 October 2000, 14 December

2000, 15 March 2001 and 20 April 2001 the appellant's representative was informed that according to the EPO's computer system, both the parent application and the divisional applications were still pending. Had it been correctly informed in time that as of 25 September 2000 the appellant had no pending rights it could have stopped publication and filed the application anew without claiming priority, thus obtaining a new three month time limit for filing a translation which would have secured and re-established the appellant's rights. According to the EPO's Guidelines, the latest date for preventing the publication was 5 January 2001.

Furthermore, owing to incorrect and incomplete telephone information from the EPO, in combination with internal mail delays within the EPO, the appellant had been deprived of the opportunity of filing a request for re-establishment of rights within the two-month time limit laid down in Article 122(2) EPC which had ended (allegedly) on 11 February 2001. The representative's office usually managed all of the appellant's cases via a computer administration system which generated time limits in respect of articles and rules as laid down *inter alia* in the European Patent Convention if the application was treated in accordance with Chapter II of the PCT, which did not apply to the application under consideration. Due to a human error the application was not handled by a manual system backing up the computerised system. The application was therefore forwarded to the translation services too late for a translation to be done in time.

Additionally, the appellant claimed the problem stemmed mainly from the fact that it was working in a language other than one of the three official languages of the EPO. This disadvantage was not sufficiently compensated for by a fee reduction of 20%.

Furthermore, the time limit prescribed in Rule 6(1) EPC was rather unimportant by comparison with the subject-matter and scope of the case. The fact that the translation was filed only slightly late did not impede the preparations for publication.

Finally, in view of the recently ratified TRIPS agreement ("measures and procedures to enforce intellectual property rights do not themselves become barriers to legitimate trade"), it seemed to be a very harsh punishment if the overrunning of a time limit for filing a translation would cause the loss of the applicant's rights.

XIII. The appellant requested that the decision under Rule 69(2) EPC dated 6 July 2001 be set aside and the application reinstated for further examination at the EPO.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rules 1(1) and 64 EPC and is therefore admissible.
2. The appellant's request to the Receiving Section for a decision pursuant to Rule 69(2) EPC was filed within two months of notification of the EPO's communication concerning the loss of rights pursuant to Rule 69(1) EPC. Therefore, the Board has to decide whether or not a loss of rights has taken place.
3. Under Article 90(3) EPC the application is deemed to be withdrawn if, in the case provided for in Article 14(2) EPC, the translation of the application into the language of the proceedings has not been filed in due time.

The European patent application in suit was filed on 24 August 2000 claiming priority from an earlier application dated 24 August 1999. The application documents were filed in the Danish language. The applicant was resident in Hobro/Denmark.

In accordance with Rule 6(1)EPC, the translation referred to in Article 14(2) EPC must be filed within three months after the filing of the European patent application, but not later than thirteen months after the date of priority claimed. In the present case, thirteen months after the priority date was the applicable period.

The last day for filing the translation of the application, accordingly, was Monday 25 September 2000 (Rules 6(1), 85(1)EPC). However, the translation was only received by the EPO on 13 November 2000. The appellant therefore failed to observe the time limit provided for in Article 14(2) in conjunction with Rule 6(1)EPC and the application was deemed to be withdrawn with effect from 26 September 2000 pursuant to Article 90(3)EPC.

- 4.1 Re-establishment of rights under Article 122 EPC may be sought in cases where the applicant was unable to observe a time limit vis-à-vis the EPO in spite of all due care required by the circumstances having been taken, but as stated in the notice of appeal such a request was not filed within the two-month time limit under Article 122(2) EPC.

This time limit started to run (after the removal of the cause of non-compliance) at the latest on the date of filing of the first divisional application, namely 7 November 2000 and ended on 7 January 2001. According to the appellant's submissions, this application was filed as a precautionary measure because it was aware

that the time limit prescribed in Rule 6(1) EPC had not been observed. Consequently, the cause of non-compliance mentioned in Article 122(2) EPC had been removed at the latest on 7 November 2000. The appellant's assertion that the time-limit under Article 122(2) started to run only on 11 December 2000 after notification of the Rule 69(1) EPC communication does not change the crucial and decisive legal fact that it failed to observe the time limit under Article 122(2) EPC.

- 4.2 The appellant admitted these facts but did not accept the legal consequences prescribed by Article 90(3) in conjunction with Article 14(2) and Rule 6(1) EPC.

Article 90(3) EPC allows the Board no discretion to disregard the appellant's failure to observe the prescribed time limit - on the grounds of special circumstances involving problems with languages, computer software or postal delays - without a valid request for *restitutio in integrum*. The TRIPS agreement does not empower the Board to declare a time limit prescribed in the European Patent Convention as null and void.

5. The Board examined the appellant's arguments and the facts of the case to determine whether the principle of the protection of legitimate expectations applies to the present case and whether, therefore, the appellant is to be treated as if it had filed the required translation in due time.

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

According to the case law, communications addressed to applicants must therefore be clear and unambiguous. An applicant must not suffer a disadvantage as a result of having relied on a misleading communication.

6. The appellant's arguments are based on allegedly incorrect and incomplete information given by EPO formalities officers during telephone inquiries. Contrary, to the appellant's view, the Board holds that the information that the parent application and divisional applications "were still pending" was neither incorrect nor ambiguous. In procedural terms the wording "pending application" is correct as long as the case has not been finally decided. This principle applies to a procedure affected by an occurrence which causes the application to be deemed withdrawn. As long as the applicant has the formal right to request a decision under Rule 69(2) EPC or to file an appeal against such a decision and the Board has not finally decided on this issue, the application under consideration is still pending irrespective of the validity of the application on which the Board still has to decide. If an appeal is to have suspensive effect in accordance with Article 106(1), second sentence EPC, the application must still be pending up to the final decision of the Board of appeal. This is also in line with the notice from the EPO dated 28 August 1990 ordering the publication of European applications whose deemed withdrawal has not yet become definitive ie which are regarded as still pending (OJ EPO 1990, 455). The expression "pending application" gives no hint as to whether such applications are still valid or not. Therefore, the information given by the formalities officers was correct and unambiguous, even if a communication or decision under Rule 69 EPC had previously been issued by the Receiving Section.

7. Apparently the appellant interpreted the telephone

information from the EPO formalities officers concerning "pending parent and divisional applications" as if the applications were valid. It stated that, relying upon the correctness of the information given by the formalities officers up to 20 April 2001, it had omitted to file a request for *restitutio in integrum* with regard to the time limit in Rule 6(1) EPC. Furthermore, as a result it had not withdrawn the parent application before the publication date so as to retain the option of filing a new application giving a new three month time limit under Rule 6(1) EPC, which would have avoided the total loss of the application, even though the priority date had been surrendered.

As regards the parent application, it is not plausible, on the basis of the said information, for the appellant to claim that it believed the parent application was valid. The appellant knew that the translation had not been filed in due time and admitted in its written submissions that this was why two divisional applications had been filed as a precautionary procedural measure. Finally, the appellant received a Rule 69(1) EPC communication dated 8 December 2000 on 11 December 2000, and on 28 December 2000 it requested a decision under Rule 69(2) EPC on the grounds that "though having passed the official time limit for filing a translation the application was still pending at this time, which was also confirmed by the EPO by a check in the computer files of the EPO".

The EPO confirmation concerning "still pending applications" did not include a statement that these applications were valid. It placed responsibility on the appellant to produce appropriate facts and evidence from his own resources to refute the loss of rights and it would be a contortion to accept that the EPO confirmation concerning "still pending applications" could be submitted as such a fact. The applicant had to

be aware that a final decision under Rule 69(2) EPC ordered that the application was deemed to be withdrawn with effect from 26 September 2000, with the result that the application **then** had to be regarded as no longer pending from this date.

8. It is to be noted that the present case differs in an essential point from J 05/89 (not published in OJ EPO) albeit there also was a failure to file a translation within the time limit prescribed by Rule 6(1) EPC. In that case the EPO had issued a communication raising objections to a request for re-establishment but explicitly accepting an alternative request which, however, was later refused. In the present case the EPO had not issued a communication that it would accept the applicant's request or would grant relief under Rule 69 EPC which could justify the application of the principle of the protection of legitimate expectations.
9. The appellant asserted that its application for a Rule 69(2) EPC decision dated 28 December 2000 was sent by fax and that the original was forwarded at the same time but that the letter went astray in the EPO, thus it had only been able to file a copy after the time limit for submission of a request for *restitutio in integrum* had expired. Apart from the fact that the appellant has not proved that the letter went astray in the EPO, the Board does not acknowledge that the EPO was obliged to decide on this Rule 69(2) EPC request within the time limit prescribed in Article 122(2) EPC. The appellant could not assume that a decision under Rule 69(2) EPC would necessarily be notified before the expiry of the time limit pursuant to Article 122(2) EPC. Following a notification of loss of rights by the EPO, it was incumbent on an applicant to undertake all necessary measures to protect its procedural position vis-à-vis the EPO.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

J.-C. Saisset