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D E C I S I O N
of 19. November 2001

Case Number: J 0019/01 - 3.1.1

Application Number: 97...

Publication Number: -

IPC: ...

Language of the proceedings: EN

Title of invention:

...

Applicant:

N.N.

Opponent:

-

Headword:

Non-payment of fees; request for examination

Relevant legal provisions:

EPC Art. 122, 133

EPC R. 85a, 85b, 107

Keyword:

"Failure to pay the national basic fee and the designation fees and to file a written request for examination upon entry into the regional phase before the EPO."

Decisions cited:

G 0005/88, J 0012/82, J 0004/86, J 0008/94

Catchword:

-



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Patentamt**

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Boards of Appeal

Chambres de recours

Case Number: J 0019/01 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 19. November 2001

Appellant: N.N.

Representative: N.N.

Decision under appeal: Decision of the Examining Division of the European Patent Office posted 16 August 2000, concerning the deemed withdrawal of European patent application No. 97....

Composition of the Board:

Chairman: J.-C. Saisset
Members: R. T. Menapace
H. Preglau

Summary of Facts and Submissions

- I. European application No. 97 ... stems from international application PCT/NO ..., for which the 31-month period pursuant to Rule 107(1) EPC expired on 26 April 2000.
- II. About one year earlier, namely on 7 May 1999, EPO Form 1201 was sent to the Appellant. This standard letter contains a complete list of and detailed information on the steps which the Applicant is required to take for entry into the regional phase before the EPO including fees to be paid, appointment of a professional representative and request for examination, and the relevant time limits. The head note of this information letter indicated (in bold): "You are strongly advised to read it carefully. Failure to take the appropriate steps in due time could lead to the application being deemed withdrawn"; on top of point 5 it is stated: "... the following steps must be taken. (Note that non-completion or ineffective completion of the required steps will result in loss of rights or other disadvantage)". Furthermore, "... due to the complexity of the proceedings, applicants are strongly advised to appoint [a professional] representative" (point 3, in bold letters) and to use Form 1200 available free of charge from the EPO (point 4). As to the amounts of the fees (equivalents in the different currencies) reference is made to the Official Journal of the EPO. It is also explained under point 6 that a surcharge is due, if the national basic fee, the designation fees, or the search fee are only paid within the one month grace period pursuant to Rule 85a(1) EPC, or if the written request for examination is filed or the examination fee is paid

within the grace period of one month pursuant to Rule 85b EPC only.

- III. The Applicant did not react in any way until 27 April 2000, when she sent a telefax in which she asked "to charge the expenses for the German patent to the A. GmbH ... and the rest to myself".
- IV. On 6 June 2000 both the communications pursuant to Rules 85a and 85b EPC, based on nonpayment of the national basic fee, the examination fee and the designation fee(s) and on the omission to file a written request for examination, were sent to the Applicant; they were accompanied by a fee sheet indicating, in the different currencies, the amount of the fees in question and the percentage (50%) and the maximum total of the surcharge.
- V. In response, by telefax of 28 June 2000 the Applicant requested to waive the 50% "increase" of the examination and designation fee(s) which she should have been notified of; she had never heard about these fees and their due date.

The next day the examination fee (without a surcharge) was paid by the abovementioned A. GmbH.

By letter dated 6 July 2000 the Receiving Section informed the Applicant, that the Office had tried in vain to contact the Applicant by phone under her number obtained from A. GmbH, that it would like to give her advice on how to proceed in that the procedure of how to get a European Patent was apparently unknown to her, and that she should, without hesitation, contact the Receiving Section to this end.

In five telephone conversations between the Applicant and Formalities Officers on 6 and 7 July 2000 it was explained to the Applicant that the aforementioned communications were valid and correct; she was informed of all actions required from her for initiating the European phase and the relevant, unextendable time limit ending on 17 July 2000; she was also warned that in case of non-compliance the application would be deemed to be withdrawn.

- VI. As nothing happened until expiration of the time limit, the communication of the noting of loss of rights pursuant to Rule 69(1) EPC was sent to the Applicant on 16 August 2000. It was based on the finding that the written request for examination was not filed, the examination fee was paid without surcharge and the designation fees for (all) designated states as well as the national basic fee were not paid.

This communication triggered further telephone conversations and an exchange of letters and documents between the Applicant and the Receiving Section in which several Formalities Officers (including their head) tried to explain her the status of the application; also the need to appoint a professional representative was explained to her.

- VII. On 26 October 2000, which was the last day of the applicable time limit, a professional representative, on behalf of the Applicant, filed an application for a formal decision concerning the noting of loss of rights (Rule 69(2) EPC) and an unspecified request for restitutio in integrum under Article 122 EPC. The fee for re-establishment of rights and an amount of EUR 709,50 and 715,50 as "Surcharge under Rule 85" /

"Rule 85(b)" were paid on the same day.

- VIII. On 23 April 2001 the Receiving Section issued the decision under appeal in which the communication pursuant to Rule 69(1) EPC was maintained and it was held that the request for re-establishment of rights was not admissible and that the European patent application was deemed to be withdrawn due to nonpayment of the national basic fee, the designation fee and the not filing of the written request for examination. As to the reimbursement of fees it was stated under point 6 of the reasons for the decision, that "any invalidly paid fees for this patent application will be refunded".
- IX. The notice of appeal was filed and the fee for appeal was paid on 25 June 2001. The Appellant requests that the decision be cancelled entirely and that the Board of Appeal should re-establish rights.
- X. In the statement setting out the grounds of appeal, which was filed on 21 August 2001, the chronology of the events as set out in the impugned decision was confirmed. It was submitted, however, that the Appellant was advised by the Norwegian Commission for Patents that she did not need to seek professional representation, and therefore she assumed that the process must be straightforward, and that the EPO would assist her and inform her of what she needed to do. As the Appellant was unfamiliar with EPO procedures, a great deal of confusion was caused, resulting in the applicant being unaware of the amounts of fees to be paid and when they needed paying, despite her repeated attempts to find out. She did everything requested, except for attending to matters relating to money, in

which she understood A. GmbH would act on her behalf. The Appellant, who did not need a professional representative, feels that the systems and procedures of the EPO should have been more accessible to individual applicants such as herself. The information the Appellant required (such as exact amounts of fees to be paid) was available to the EPO, but was not provided to her until it was too late. The fact that the Appellant made so many attempts to obtain information about what needed to be done and the amounts of fees due shows that she made every effort to obtain a European patent. She feels that the system is unproductive, as she was allowed to apply without professional representation, but was not provided with sufficient information to obtain a patent until it was too late and important dates had already been missed.

Reasons for the Decision

1. The appeal is admissible.
2. As in the reasons for the decision set out below the Board concurs with the reasons given in the decision under appeal and rejects the Appellant's arguments as wrong in law, it was neither necessary under Article 113(1) EPC nor appropriate to issue a communication for comment by the Appellant before the decision was taken.
3. The decision under appeal correctly established, that the time limits for filing a written request for examination and for payment of the examination and designation fee(s) and of the national basic fee have not been observed in respect of the European patent

application in question. This fact has not been contested by the Appellant.

4. The decision under appeal is also correct, insofar as it found the request for re-establishment to be inadmissible. Article 122(5) EPC and the relevant jurisprudence, in particular that of the Enlarged Board of Appeal cited in the impugned decision, leave no doubt as to the exclusion of re-establishment of rights in the case of non-observance of the aforementioned time limits. This is also true for the period of grace pursuant to Rule 85a or 85b EPC (see eg. decisions J 12/82 and J 8/94).
5. As a consequence, the cause of non-compliance and the question of whether the Applicant, in spite of all due care required by the circumstances having been taken, was unable to observe the relevant limits, is of no relevance. Nor is there any other legal remedy provided for in the EPC against such a loss of rights.
6. The Office did not act or behave in any way which would have been incompatible with good faith, ie the protection of legitimate expectations of the parties to the proceedings (see decisions G 5/88, G 7/88 and G 8/88, OJ 1991, 137). In particular, there was neither a wrong or misleading information or advice, not even allegedly, given by the Office in respect of the time limits and the fees in question; nor did the Office fail to specifically warn the Applicant where it could recognize that otherwise the Applicant would not perform acts required by the EPC in time and, as a consequence suffer a loss of rights: In a first phase, up to the expiration of the basic time limits on 26 April 2000 the Office, which had sent a detailed and

comprehensive information letter (EPO Form 1201) to the Applicant, had no reason to assume that the Applicant would not comply with what is prescribed by the EPC and had been explained in said information letter. In a second phase, up to the expiration of the period of grace pursuant to Rule 85a and 85b EPC on 17 July 2000, there were several contacts both by phone and in writing, between the Appellant herself and the Receiving Section, which fully informed her about the outstanding steps including also the need to pay the surcharge within the aforementioned period of grace. If this constituted a special treatment of the Appellant, then it was in her favour and it was clearly more than what can reasonably be expected from the Office in view of the great number and the variety of users of the European Patent system. The same is true for the third phase, ie after the time limit in question had expired unobserved, when the Receiving Section continued to try to explain the status of the application to the Applicant in several telephone conversations and letters, and eventually the Head of the Receiving Section discussed the case with the Appellant's nominated representative. This information and help given cannot, of course, be invoked against the decision under appeal, more especially as it was not causal for the irreparable loss of rights which had occurred before due to the Appellant's unwillingness to comply with the information and explanations given to her by the Office.

7. The question of whether the Appellant was legally obliged to appoint a professional representative pursuant to Article 133(2) EPC is not relevant in the present case where the deemed withdrawal is the legal consequence of the fact that certain acts required

under the EPC have not been performed at all within the prescribed time limit. Whether an individual applicant actually needs a professional representative in order to cope with the technical and procedural complexities of his European patent application and to obtain the optimal protection, is a completely different question, which by its very nature cannot be answered by the legislator or the Office, which, for good reasons strongly recommends to appoint such representative upon entry of international application into the European phase (see EPO form 1201 which was sent to the appellant on 7 May 1999). It is the applicant who alone can assess and decide, whether and to what extent he needs professional advice and representation. Thus, irrespective of any obligation under Article 133(2) EPC, this matter must be left to the applicant's assessment and responsibility and the Appellant's complaint that, whilst being allowed to apply without professional representation, she was not provided with sufficient information to obtain a patent until it was too late and important dates had already been missed, is unfounded, both in law and fact.

8. As the decision on the appeal finally settles the case, those fees which have been paid without legal basis as a consequence of the deemed withdrawal, which took legal effect on 27 April 2000 (ie upon expiry of the period referred to in Rule 107 EPC and not upon expiry of the period of grace provided by Rules 85a and 85b EPC - see decisions J 4/86, OJ 1988,119 and G 4/98, OJ 2001,131), have to be re-imbursed as specified in the order below.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. All fees paid after 26 April 2000, except the fee for re-establishment of rights and the appeal fee, shall be reimbursed.

The Registrar:

The Chairman:

S. Fabiani

J.-C. Saisset