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**D E C I S I O N**  
**of 6 October 2004**

**Case Number:** J 0001/03 - 3.1.1

**Application Number:** 00967695.8

**Publication Number:**

**IPC:**

**Language of the proceedings:** EN

**Title of invention:**

Test article, method and kit for performing serum or plasma sialic acid assays

**Patentee:**

Therapicon Srl

**Opponent:**

-

**Headword:**

Re-establishment of rights

**Relevant legal provisions:**

EPC Art. 122(1), (5)  
PCT R. 48(2)(a), 4.9(b)(ii)

**Keyword:**

"All due care required by the circumstances" (no)

**Decisions cited:**

G 0003/91

**Catchword:**

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Case Number: J 0001/03 - 3.1.1

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.1  
of 6 October 2004

**Appellant:** Therapicon SrL  
via Malachia Marchesi de Taddei 21  
I-21046 Milano (IT)

**Representative:** Bayliss, Geoffrey C.  
Boult Wade Tennant,  
Verulam Gardens  
70 Gray's Inn Road  
London WC1X 8BT (GB)

**Decision under appeal:** Decision of the Receiving Section dated  
9 August 2002 for re-establishment of rights  
into the time limit of Rule 4.9(b)(ii) PCT.

**Composition of the Board:**

**Chairman:** J.-C. Saisset  
**Members:** P. Mühlens  
H. Preglau

## Summary of Facts and Submissions

I. International application PCT/EP00/09106 was filed with the EPO as Receiving Office on 14 September 2000 claiming priority from an Italian patent application filed on 1 October 1999. The applicant marked in Box No. V (Designation of states) of form PCT/RO/101 all check-boxes for national offices without exception, but none of the check-boxes for Regional Patents (among these "EP" for a European Patent). After search by the EPO, completed on 19 February 2001, the application was published with the designations mentioned above on 12 April 2001. On the applicant's demand under Chapter II PCT, the EPO completed the International preliminary examination report on 5 November 2001.

By letter dated 21 November 2001, the applicant's representative requested entry in the regional phase before the EPO and requested simultaneously re-establishment of rights under Article 122 EPC with respect to the designation of "EP" in the International application. It also paid all relevant fees. There is no time limit for the designation of states or regional offices in the PCT, but it appears from the appellant's submissions that the request for re-establishment of rights is meant to concern the time limit under Rule 4.9(b)(ii) PCT. According to Rule 4.9 PCT, an applicant can make by a so-called Precautionary Designation Statement also all other designations which would be permitted under the PCT, these additional designations being subject to confirmation before the expiration of 15 months from the priority date. In default of such confirmation, these designations are deemed to be withdrawn.

II. To motivate its request for re-establishment of rights, the appellant submitted that the record copy containing the designations has been received on 24 November 2000, whereas the time limit under Rule 4.9(b)(ii) PCT expired on 1 January 2001. The representative of the appellant had overlooked the necessity to confirm the precautionary designations due to its absence from work during the Christmas period and the fact that the centralised reminder system in its office had, at this time, not yet been set up.

III. The appealed decision held that it is not allowed to grant re-establishment of rights where the time limit under Rule 4.9(b)(ii) PCT was not observed. The provision under the EPC which closest corresponds to the time limit under Rule 4.9(b)(ii) PCT in the procedure before the EPO is the time limit to confirm the designations of EPO member states by paying the designation fees in accordance with Article 79(2) EPC. However, this time limit is excluded from the re-establishment of rights, Article 122(5) EPC. Article 48(2) PCT being intended to ensure an equal but not a better treatment of PCT-applicants compared to direct national/regional applicants, Article 122(5) EPC excludes the re-establishment of rights in the present case as well.

Furthermore, even if Article 122(1) were applicable, the request would not succeed on its merits as it has not been shown that the representative of the applicant was unable to observe the time limit in spite of all due care required by the circumstances having been taken. It did neither submit which measures had been

- taken to ensure the observation of time limits, nor did it submit that it had properly instructed the patent attorney who looked after its work while it was absent.
- IV. With the grounds of appeal, the appellant submits that Article 122 EPC is clearly applicable in PCT-procedures and that Articles 122(5) and 79(1) EPC cannot be applied to the present case, as Article 79(1) EPC is concerned with payment of designation fees and not with designations. However, even though not all intended designations had been crossed in the appropriate boxes of the form, all designation fees had been paid in time. Thus, it was clear for the Receiving Office (the EPO) that it was the applicants intention to designate "EP" as well.
- V. After a preliminary examination of the case, the Board made the following remarks in a communication dated 7 July 2004: Although it was at present not convinced that Article 122(1) EPC - *restitutio in integrum* - was not applicable in the preset case, there were no reasons for re-establishment on the merits of the case as the appellant had not submitted any reasons which go beyond what could be called a "normal" mistake or failure.
- VI. In its response dated 22 September 2004, the representative of the appellant submitted a sworn statement by Michael George Douglas Baverstock, the former representative of the appellant. In this statement, Mr Baverstock gives a detailed description of the procedures followed by him and his secretary when filing the application concerned. These procedures were designed in such a way that mistakes like the

present one normally could not occur. Because it was his firm belief that mistakes were not possible, he overlooked in the present case that the Precautionary designations still had to be confirmed. Thus, the failure was due to extraordinary circumstances.

VII. (i.) Oral proceedings were held on 6 October 2004.

(ii.) In the oral proceedings, the representative of the appellant emphasised that the appellant had paid the designation fees for all possible designations but not crossed the regional offices and that thus there was a discrepancy. Although the onus was on the applicant to make things correct, PCT-authorities also had a duty to take care of applicant's interests.

As the discrepancy between designations and designation fees was evident, it should have warned the applicant explicitly. The form PCT/ II B/ 301, i.e. the "Notification of Receipt of Record Copy" under PCT Rule 24.2 (a), was however "passive" as it does not prompt anything. Moreover, it is a well-known fact it is difficult to discover a mistake if one is convinced that everything is correct.

VIII. The appellant requested that the decision under appeal be set aside and that restitution be granted into the time limit under Rule 4.9 (b) (ii) PCT.

## Reasons for the Decision

1. The appeal is admissible.
  
2. According to Article 122(1) EPC, the applicant for or proprietor of a European Patent who, in spite of all due care required by the circumstances having been taken, was unable to observe a time limit, shall have his rights re-established. This provision is also applicable to applications filed under the PCT, as, under Article 48(2)(a) PCT, any party to the PCT shall excuse, for reasons admitted under its own law, any delay in meeting any time limit.
  
3. (a) According to Article 122(5) EPC re-establishment may not be granted in certain cases, among these the payment of the designation fees under Article 79(2) EPC. Article 48(2)(a) PCT being designed to ensure an equal but not a better treatment to PCT-applicants, decision G 3/91(OJ1993,8) extends the application of Article 122(5) EPC to identical time limits under the PCT. Following this line of argumentation, the appealed decision holds that re-establishment is excluded in the present case as well, the provision in the EPC which closet corresponds to the time limit under Rule 4.9 PCT being the time limit under Article 79(2) EPC.  
  
(b) Although this argumentation seems to be reasonable, and at first view in line with the principles underlying decision G 3/91, the Board is reluctant to apply Article 122(5) EPC to the present case. Actually, there is no time limit in the EPC which corresponds to the time limit under Article 4.9(b)(ii) PCT. Thus, there is no identical time limit under the

PCT within the meaning of decision G 3/91 but only a comparable one. Consequently, application of Article 122(5) EPC to the present case would result in a further parallel application of the law to the detriment of the appellant. Bearing this consequence in mind, the Board has examined whether re-establishment could be granted on the merits of the present case. As the answer is no, the Board has come to the conclusion that this point of law (applicability or non-applicability of Article 122(5) EPC) is of no relevance for the ruling in this case. Thus, the Board has insofar refrained from a final decision.

4. The Board cannot establish that the "all-due-care-requirement" of Article 122(1) EPC has been met. The designation of receiving offices-states or regional offices- is a crucial part in the PCT-procedure and of paramount importance. It can be assumed that all practitioners are aware of that. It can be also assumed that they know that it is difficult and in many cases even impossible to correct wrong or missing designations. There is, *inter alia*, an established case law of the Boards of appeal that such corrections, if any, can only be made before the application has been published. The respective PCT-forms such as PCT/RO/101 may be complicated, but experienced practitioners and their offices will be perfectly familiar with them. Thus, it is as easy to deal correctly with those forms. Knowing the utmost importance of correct designation, the forms have to be dealt with and checked afterwards carefully. Consequently, the benchmark for what "all due care" means in those cases, is very high.



5. If nonetheless an error occurs when dealing with the designation forms, the PCT-procedure offers an emergency brake: In the "Notification of Receipt of Record Copy", the International Bureau notifies the content of the international application as received, Then, the applicant has a further opportunity to check whether his application is correct. Mistakes, if any, can be easily discovered and corrected at this stage. Bearing in mind that such correction is extremely difficult at a later stage in the proceedings, practitioners have to make this check very carefully.
  
6. (a) In the present case, the mistake made by the appellant and/or his office was two-fold: First, the box "EP" had not been ticked, and then, after receipt of the notification, it was not discovered that "EP" was missing in the list notified by the International Bureau. In contrast, all relevant fees for all possible designations have been paid.  
  
(b) Although the onus to avoid errors is on the applicant, there is also an obligation towards the applicant to react, if, for example, a mistake or failure is discovered in the application. In the Board's view, this obligation is perfectly fulfilled by sending out the notification under Rule 24.2(a) PCT. Actually, this notification does not contain a special indication pointing at a certain mistake, as the representative of the appellant had wished for, but it enables the applicant to find mistakes himself. Moreover, the respective form (PCT/IB/301) is not as "passive" and "silent" as the representative of the appellant submits. In its headline, the form is denominated "Important Notification", and it is clearly

stated that the International Bureau has received the record copy of the international application "as detailed below". After the detailed list, the form contains the warning that the applicant should carefully check the data appearing in the notification, to compare them with those in the application and to inform the International Bureau immediately of any discrepancy.

(c) After all, even though it may not be easy to find a mistake if one is sure that there is none, the Board held that the omission of "EP" in the list of designations as well as the subsequent missing of confirmation of the precautionary designation was caused by a "normal" error and not unavoidable "in spite of all due care". Thus, the requirements of Article 122(1) EPC are not met.

## **Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

J. Saisset