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D E C I S I O N
of 17 February 2004

Case Number: J 0024/03 - 3.1.1

Application Number: ...

Publication Number:

IPC:

Language of the proceedings: EN

Title of invention:
Image processing apparatus

Applicant:
N.N.

Opponent:
-

Headword:
Time limit definition/N.N.

Relevant legal provisions:
EPC Art. 122(1)
EPC R. 25(1)

Keyword:
"Re-establishment of rights - concept of time limit"

Decisions cited:
J 0003/83

Headnote:

I. A time limit within the meaning of Article 122(1) EPC involves a period of a legally indicated length fixed for carrying out a particular procedural act.

II. In procedural law, the fact that a conditional act can only be accomplished before a particular set of circumstances foreseen by a legal provision occurs (condition), is conceptually different from a set period of time imposed for doing an act (time limit) because in the first case the duration of the period in which the act should be completed is determined by the occurrence of the condition itself, whereas in the second case it is pre-determined from the outset.

III. Rule 25(1) EPC does not impose any time limit for filing a divisional application but rather sets a condition namely that the earlier European patent application is pending. Therefore, no time limit within the meaning of Article 122 EPC is imposed by this rule.

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: J 0024/03 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal
of 17 February 2004

Appellant: N.N.

Representative: N.N.

Decision under appeal: **Decision of the Receiving Section of the European Patent Office posted on 22 April 2003 refusing the request for re-establishment of rights for filing divisional application ....**

Composition of the Board:

Chairman: J. Saisset
Members: A. Pignatelli
M. J. Vogel

Summary of Facts and Submissions

I. On 2 July 2003, the appellant (applicant) lodged an appeal against the decision of the Receiving Section dispatched on 22 April 2003 concerning the refusal of his request for re-establishment of rights into the time limit for filing a divisional application and to have application No. ... treated as a divisional application of the earlier European patent application ... (parent application). The appellant paid the appeal fee and filed the statement of grounds of appeal on the same day.

II. The mention of the grant of the patent based on the parent application was published in European Patent Bulletin ... of 15 May 2002. On 11 July 2002, the appellant filed a divisional application according to amended Rule 25(1) EPC together with the request for re-establishment of the right to file the divisional application.

III. The Receiving Section held that the request for re-establishment of rights did not meet the requirements of Article 122 EPC because Rule 25 EPC did not provide a time limit for filing a divisional application within the meaning of Article 122 EPC. Furthermore, the Receiving Section was of the opinion that Article 122 EPC was not applicable because there were no proceedings pending before the European Patent Office at the time of the request for re-establishment of rights since the mention of the grant of the patent based on the parent application had been published and a divisional application had not been filed.

IV. The appellant requested that the decision under appeal be set aside and his right to file a divisional application be re-established or that the case be remitted to the department of first instance for further prosecution.

The appellant requested oral proceedings, as auxiliary request.

V. The appellant argued as follows:

According to amended Rule 25(1) EPC, the applicant may file a divisional application relating to any pending earlier European patent application.

The point in time at which the parent application is no longer pending is established by the European Patent Office with the communication informing the applicant of the publication date of the mention of the grant. Through this communication, the European Patent Office sets a time limit for filing a divisional application.

If the applicant missed this time limit it should be possible to grant re-establishment of rights if all other conditions provided for by Article 122 EPC are fulfilled. The time limit for filing a divisional application is not excluded by Article 122 EPC.

Article 122 EPC has to be applied to "applicant" and not to "proceedings". It is therefore not necessary that proceedings be pending to apply Article 122 EPC as long as an applicant has had a loss of right.

Reasons for the Decision

1. The appeal is admissible.

2. According to Article 122(1) EPC a request for re-establishment of rights is admissible only if the applicant was unable to observe a time limit vis-à-vis the European Patent Office.

In this case, the appellant argues that he missed the time limit for filing a divisional application provided for by Rule 25(1) EPC whereas the Receiving Section held that no time limit is provided for filing a divisional application by this rule and that therefore Article 122 EPC cannot be applied to the case.

The question is therefore, whether Rule 25(1) EPC imposes a time limit for filing a divisional application within the meaning of Article 122(1) EPC.

3. To answer this question it is first necessary to examine the legal character of a time limit in the meaning of Article 122(1)EPC.

Article 122 EPC is a procedural provision and its wording is to be understood as an expert in procedural law would understand it.

As already established in decision J 3/83 a time limit involves a period of time having a certain duration. Furthermore, according to the principles of procedural law generally recognised in the Contracting States, this period of a legally indicated length is fixed for carrying out a particular procedural act. (Cf. e.g. for

Austrian law Fasching, Lehrbuch des österreichischen Zivilprozeßrechts , 1990, III. Rdnr. 547; for English law CPR 2.8, 2.9; for French law Couchez, Procédure civile, 1998, paragraph nr. 348; for German law Baumbach, Lauterbach, Zivilprozeßordnung, 53. Aufl., Übersicht zu § 214 Rdnr. 9.; for Italian law Verde-Di Nanni, Codice di procedura civile annotato con la giurisprudenza, Art. 152; for Spanish law Nosete, Dominguez, Sendra, Catena, Derecho procesal, 1989, paragraph nr. 181; for Swiss law Vogel, Grundriss des Zivilprozessrechts und des internationalen Zivilprozessrechts der Schweiz, 6. Auflage, 9. Kapitel Rdnr. 88.)

It follows that Article 122 EPC is only applicable if Rule 25(1) EPC imposes a time limit i.e. if this Rule provides a period of a fixed length for accomplishing a procedural act.

4. Pursuant to Rule 25(1) EPC, the applicant may file a divisional application relating to any pending earlier European patent application.

If the earlier European patent application is no longer pending, whatever the reason for that may be, a divisional application cannot be filed.

The definition of a pending application was given in the Notice from the European Patent Office dated 9 January 2002 concerning amendment of Rules 25(1), 29(2) and 51 EPC (OJ EPO 2002, 112). According to that definition, an application is pending up to (but not including) the date that the European Patent Bulletin mentions the grant of the European patent, or until the

date that the application is refused, withdrawn or deemed withdrawn; if notice of appeal is filed against the decision to refuse, a divisional application may still be filed while appeal proceedings are under way.

The consequence is that, in order to fulfil the provisions of Rule 25(1) EPC, the divisional application should have been filed before the publication of the mention of the grant because after that point in time the necessary condition for filing a divisional application, i.e. that the earlier application is still pending, is not fulfilled.

In procedural law, the fact that a conditional act can only be accomplished before a particular set of circumstances foreseen by a legal provision occurs (condition), is conceptually different from a set period of time imposed for doing an act (time limit) because in the first case the duration of the period in which the act should be completed is determined by the occurrence of the condition itself, whereas in the second case it is pre-determined from the outset.

The result of this analysis of Rule 25(1) EPC is that Rule 25(1) EPC does not impose any time limit for filing a divisional application but rather sets a condition namely that the earlier European patent application is pending. Therefore, no time limit within the meaning of Article 122 EPC is imposed by this rule.

5. The appellant interprets the fact that the day of publication was communicated to him as an implicit imposition of a time limit for filing the divisional application.

The communication from the European Patent Office that the grant of the European Patent will be mentioned in the European Patent Bulletin on a specific date serves merely to inform the applicant about a step which the European Patent Office is obliged to take during the proceedings.

The date that the grant is mentioned is the day on which the European Patent Office takes this procedural step.

The mention of the grant in the European Patent Bulletin is a procedural act within the competence of the European Patent Office.

Neither the communication of the date of the publication of the mention in the European Patent Bulletin, nor the mention of the grant are periods of fixed length for doing particular procedural acts (time limits).

Therefore, neither the communication that the grant of the patent will be mentioned on a particular date nor the day on which the mention is published can be considered to be time limits within the meaning of Article 122 EPC.

6. Article 122 EPC is not applicable to the filing of a divisional application because, as the first instance correctly stated, no time limit is foreseen by the EPC for filing a divisional application.

For this reason, the request for re-establishment of rights is not admissible.

7. Since the request for re-establishment is not admissible the Board does not need to examine whether it is allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

S. Fabiani J. Saisset