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**Datasheet for the decision
of 28 November 2006**

Case Number: J 0008/04 - 3.1.01

Application Number: 96907598.5

Publication Number: -

IPC: A01N 25/34

Language of the proceedings: EN

Title of invention:
Method of pest control

Patentee:

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Opponent:

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Headword:

Notification to the right addressee/DEMITE

Relevant legal provisions:

EPC Art. 60(1)(3), 61, 122(5)

EPC R. 13, 78(2), 85a(1), 85(b), 104b(1)

PCT R. 92bis.1

Keyword:

"Notification of the Rules 85a(1) and 85b communication -
right addressee - yes"

"Suspension of proceedings - no"

"Re-establishment of rights - excluded"

Decisions cited:

J 0008/94, J 0007/96, J 0002/01, T 0247/98, G 0003/91,

G 0003/92, G 0005/92, G 0006/92

Catchword:

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Case Number: J 0008/04 - 3.1.01

D E C I S I O N
of the Technical Board of Appeal 3.1.01
of 28 November 2006

Appellant: Demite Limited
The Old Post Office
Woodborough
Pewsey
Wiltshire SN9 5PL (GB)

Representative: Gallafent, Richard John
GALLAFENT & CO.
27 Britton Street
London EC1M 5UD (GB)

Decision under appeal: Decision of the Receiving Section of the
European Patent Office of 8 May 2002.

Composition of the Board:

Chairman: M. Günzel
Members: G. Weiss
R. Moufang

Summary of Facts and Submissions

- I. The international application PCT/GB96/00672 (EP 96 907 598.5) was filed on 20 March 1996 on behalf of Demite Limited, claiming priority from a British application of 21 March 1995. With notification dated 19 September 1997, the International Bureau informed the EPO acting as elected Office of the recording of a change concerning the applicant, the new applicant being Protec Health Limited (Form PCT/IB/306).
- II. The 31-months time limit for entry into the regional phase expired on 21 October 1997 (Rule 104b(1) EPC applicable at this time). On 2 December 1997 communications pursuant to Rules 85a(1) and 85b EPC (as in force before 2 January 2002) were sent to Protec Health Limited. The required fees were not paid and the written request for examination was not filed. On 13 February 1998 a loss of rights communication under Rule 69(1) EPC was sent to Protec Health Limited based on the fact that the national basic fee and the designation fee(s) had not been paid and that the request for examination had not been filed within the time limits. The date of legal effect of the loss of rights i.e. that the application was deemed to be withdrawn on 22 October 1997, was published in the European Patent Bulletin 98/29 as well as in the European Patent Register.
- III. By fax letter of 21 September 1998, received on 22 September 1998 and confirmed by an identical letter of 23 September 1998, the representatives of the previous applicant Demite Limited explained that as a result of legal proceedings in the United Kingdom

introduced on behalf of Demite Limited against Protec Health Limited the present application was assigned to Demite Limited on 5 August 1998. They stated that Demite Limited sought by whatever means were appropriate to pursue the present application.

- IV. On 25 February 1999 the representatives of Demite Limited requested *restitutio in integrum* under Article 122 EPC submitting that the request for re-establishment be considered to have been made on 23 September 1998.
- V. By letter dated 27 August 1999 it was confirmed by the representative of Protec Health Limited that the communications pursuant to Rules 85a(1) and 85b EPC were received by Protec Health Limited. The Rule 69(1) EPC communication noting the loss of rights was also received by Protec Health Limited. At the request of the Receiving Section, the representative of Protec Health Limited submitted with a letter dated 11 October 2000 two copies of the communications pursuant to Rules 85a(1) and 85b EPC with date-stamps of receipt.
- VI. On 6 April 2001 the representatives of Demite Limited requested the EPO to send the Rules 85a(1) and 85b EPC communications to the rightful applicant i.e. Demite Limited since they were sent to (and received by) the wrong person. The request for *restitutio* was maintained.
- VII. On 15 August 2001 the representatives of Demite Limited requested that the application be revived according to Article 61 EPC. They stated that the applicant's letter of 23 September 1998 be considered as a request to continue the application since, according to the

sentence on page 3 of this letter, Demite sought to revive the application by "whatever means are appropriate". Furthermore, they stated that, since as a result of legal proceedings in the United Kingdom the present application was assigned to Demite Limited on 5 August 1998, the request of 23 September 1998 should be considered made in time according to Article 61 EPC.

- VIII. The Receiving Section issued an appealable decision on 8 May 2002. The request to issue the communications pursuant to Rules 85a(1) and 85b EPC to Demite Limited, the request for re-establishment of rights and the request to prosecute the application according to Article 61 EPC were rejected. It was considered that the communications pursuant to Rules 85a(1) and 85b EPC as well as the notification of loss of rights were correctly issued and received by the recorded applicant, that *restitutio in integrum* was excluded in the unobserved time limits and that the conditions of Article 61 EPC were not met.
- IX. Against this decision the present appeal was lodged on 10 July 2002. The appeal fee was paid the same day. The statement setting out the grounds of appeal was filed on 18 September 2002. Essentially the same arguments as submitted before the Receiving Section were put forward. The appeal was remitted to the Legal Board of Appeal at the end of March 2004.
- X. On 11 September 2006 the Board summoned the appellant to oral proceedings and set out its preliminary view on the merits of the appeal.

- XI. On 28 November 2006 oral proceedings took place before the Board. The representative of the appellant had informed the Board that he would not be attending the oral proceedings.
- XII. The appellant requested in writing cancellation of the decision of 8 May 2002 which rejected three requests: a request to issue communications pursuant to Rules 85a(1) and 85b(1) EPC to Demite Limited, a request for re-establishment of rights in respect of the unobserved time limits and a request for the application to be prosecuted in accordance with Article 61 EPC. The appellant indicated in the statement setting out the grounds of appeal that the request for re-establishment had been "vacated".
- XIII. At the end of the oral proceedings, the decision of the Board was announced.

Reasons for the Decision

1. The appeal satisfies the conditions of Articles 106 to 108 and Rule 64 EPC and is therefore admissible.

2. Concerning the request that communications pursuant to Rules 85a(1) and 85b EPC be reissued to the appellant:

During the international phase of the PCT application, the International Bureau recorded on 19 September 1997, at the applicant's request, changes in the particulars relating to the person, name and address of the applicant (Rule 92bis.1 PCT). These changes were notified to the EPO. Thus, Protec Health Limited was

recorded by the International Bureau as the applicant as of 19 September 1997, i.e. before expiry of the 31-month time limit (21 October 1997). Following non-payment of the fees due and non-filing of a request for examination, communications pursuant to Rules 85a(1) and 85b EPC were issued on 2 December 1997 to Protec Health Limited who was the (registered) applicant.

From the statement of grounds it appears that the appellant no longer contests but on the contrary acknowledges that these communications were received by Protec Health Limited. Under these conditions it is not necessary to examine further the question of the delivery of these communications, since under Rule 78(2) EPC only "in the event of any dispute" does the EPO have to establish that the communications reached their destination or the dates on which they were delivered to the addressee (see for example T 247/98 of 17 June 1999).

Therefore, from the copies of the communications submitted by the letter of the representative of Protec Health Limited of 11 October 2000 and taking account of the absence of a dispute concerning their notification, the Board judges that the Rules 85a(1) and 85b EPC communications were received by Protec Health Limited. The Rule 69(1) EPC notification of loss of rights was also issued to and received by the registered applicant.

Moreover, the Rules 85a(1) and 85b EPC communications were also delivered to the right addressee. According to Article 60(3) EPC, the (registered) applicant is deemed to be entitled to exercise the right to the

European patent in proceedings before the EPO. Article 60(3) EPC determines who has the procedural right to the patent, in contrast to Article 60(1) EPC which determines who has the right to the patent as a matter of substantive law. This distinction between the procedural right and the substantive right to the patent is deliberate and allows the EPO not to be concerned with questions of entitlement under substantive law (see, for example, J 2/01, OJ EPO 2005, 88, point 2.6 of the reasons). The applicant is regarded as the entitled party by virtue of a presumption, without this entitlement being examined by the EPO and which may be rebutted in accordance with the provisions of Article 61 EPC and Rule 13 EPC. Jurisdiction over entitlement is left entirely to the national authorities. Thus, procedural acts have to be performed by the EPO in relation to the registered applicant and it is irrelevant therefore as to whether the registered applicant is entitled to the subject-matter of the application as to substance.

Therefore, even if it were acknowledged that the decision of the UK Court had retroactive effect in the sense that the assignment of the application to Protec Health Limited was to be regarded as void *ab initio*, the issuance of the communications to Protec Health Limited would still have been the correct procedural act to be performed by the EPO, at least in a situation such as the present one, where the recording of the change of applicant had not been challenged by the original applicant.

Moreover, it is to be noted that the assignment to Protec was only qualified as voidable by the Court and that reassignment to the appellant was apparently deemed necessary by the Court.

In the Board's judgment, therefore, the communications were rightly issued to Protec Health Limited.

The Board therefore sees no legal basis for reissuing these communications. They were issued to the correct addressee i.e. the registered applicant. Thus, since the fees due had not been paid and a request for examination had not been filed, the application was deemed to be withdrawn on 22 October 1997. The date of legal effect of the loss of rights was correctly published in European Patent Bulletin 98/29 as well as in the European Patent Register.

3. Concerning the request that the application be prosecuted in accordance with Article 61 EPC:

In the event of a dispute over the right to a European patent, the relevant EPC provision (Rule 13 EPC) provides for the suspension of the grant proceedings, if a third party provides proof to the European Patent Office that he has opened proceedings against the applicant for the purpose of seeking a judgment that he is entitled to the grant of the European patent. This presupposes that the proceedings are still pending at the time when the person claiming to be the lawful applicant commences proceedings before a national court of a Contracting State, claiming his entitlement to grant and at the time the application for suspension is made (see, for example, J 7/96, OJ EPO 1999, 443

points 2.1, 2.4 and 3 of the reasons). In its decision G 3/92 (OJ EPO 1994, 607), the Enlarged Board of Appeal makes it clear that the alternative chosen by the appellant i.e. the prosecution of the application as his own application in place of the applicant requires a pending application (see point 5.2 of the reasons). In the present case, at the time "the third party" (here: the appellant) notified the EPO of a national court judgment in the fax letter dated 21 September 1998, the proceedings were no longer pending. In fact, the application was deemed withdrawn with effect from 22 October 1997. For this reason alone, the conditions for a suspension of the proceedings are not met. It need therefore not be decided whether the proceedings opened in the present case qualify as national entitlement proceedings within the meaning of Article 61 EPC and the rules on jurisdiction laid down in the Protocol on Recognition at all.

4. Concerning the requests for re-establishment in the non-observance of the time limits:

Although it seems that the appellant has not followed up these requests, the Board wishes to emphasize that the requests would not in any case have been successful. As decided by the Enlarged Board of Appeal re-establishment is excluded as a result of the parity established between the Euro-PCT application and the purely European application for the time limits under Rule 104b(1)(b)(i), (ii) and (c) EPC (applicable at this time) in conjunction with Article 157(2)(b) and 158(2) EPC for the payment of the filing, designation and search fees (see G 3/91, OJ EPO 1993, 8). Also the non-observance of the time limit for requesting

examination under Article 150(2), fourth sentence EPC cannot be remedied by *restitutio* (see G 5/92 and G 6/92, OJ EPO 1994, 22 and 25). *A fortiori* the grace periods in Rules 85a(1) and 85b EPC which are closely linked to the time limits laid down in Rule 104b(1)(b)(i), (ii) and (c) EPC (applicable at this time) in conjunction with Article 157(2)(b) and 158(2) EPC and Article 150 (2) EPC are accordingly excluded from re-establishment under Article 122 (5) EPC (see G 3/91 OJ EPO 1993, 8 for the grace period under Rule 85a EPC and J 8/94, OJ EPO 1997, 17 for the grace period under Rule 85b EPC). Thus, there would be no legal basis for allowing any request for re-establishment of rights.

5. For the reasons given above, the appeal cannot be allowed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

B. Günzel