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**D E C I S I O N**  
**of 3 July 2006**

**Case Number:** J 0010/05 - 3.1.01

**Application Number:** 01107921.7

**Publication Number:** 1143602

**IPC:** H02M 1/12

**Language of the proceedings:** EN

**Title of invention:**

Active filter for reduction of common mode current

**Applicant:**

INTERNATIONAL RECTIFIER CORPORATION

**Opponent:**

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**Headword:**

-

**Relevant legal provisions:**

EPC Art. 79(2), 122(5)

EPC R. 85a(1)

**Keyword:**

"Restitutio in integrum (no)"

"Designation fees not paid in due time"

"Time limits"

"Grace period"

**Decisions cited:**

G 0003/91, J 0011/86, J 0025/01, J 0014/02

**Catchword:**

Article 122(5) EPC excludes both the time limit for the payment of designation fees under Article 79(2) EPC and the corresponding grace period under Rule 85a(1) EPC from the application of restitutio in integrum



Case Number: J 0010/05 - 3.1.01

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.01  
of 3 July 2006

**Appellant:** INTERNATIONAL RECTIFIER CORPORATION  
233 Kansas Street  
El Segundo, CA 90245 (US)

**Representative:** Feldkamp, Rainer  
Patentanwälte  
Wallach, Koch, Dr. Haibach, Feldkamp  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 17 January 2005  
refusing the request for re-establishment of  
rights pursuant to Article 122 EPC.

**Composition of the Board:**

**Chairman:** M. Günzel  
**Members:** D. Rogers  
E. Lachacinski

## **Summary of Facts and Submissions**

- I. The appeal is against the decision of the Examining Division of 17 January 2005 which rejected the request of the appellant for re-establishment of the time limit for the payment of the designation fees and late payment surcharge for the European patent application 01 107 921.7.
  
- II. In communications dated 1 and 9 December 2003, the Receiving Section informed the appellant that on 26 November 2003 the European Patent Bulletin mentioned the publication of the European search report for the application. These communications drew the attention of the appellant to the fact that the designation fee(s) had to be paid within 6 months of 26 November 2003, in accordance with Article 79(2) EPC.
  
- III. On 2 July 2004 the Examining Division issued a communication pursuant to Rule 85a(1) EPC. This communication noted that the designation fee had not been paid within the time limit specified. The communication informed the appellant that he could still validly pay the designation fee within a period of grace of 1 month after notification of the communication, provided that the surcharge under Rule 85a(1) EPC was paid at the same time.
  
- IV. The appellant did not pay the designation fee and surcharge. The Examining Division sent a communication dated 21 September 2004 to the appellant. This communication gave the appellant notice of loss of rights pursuant to Rule 69(1) EPC due to the non-

payment of designation fee and surcharge pursuant to Article 79(2) and Rule 85a EPC.

- V. In a letter dated 19 November 2004 and received by the EPO on 22 November 2004 the appellant applied for *restitutio in integrum* in order to re-establish his rights following a failure to pay the designation fee and surcharge.
- VI. On 17 January 2005 a decision of the Examining Division refused the appellant's request for *restitutio in integrum*. The Examining Division reasoned that:
- "Article 122(5) EPC excludes re-establishment of rights where the time limit provided for in Article 79(2) EPC is not observed. Moreover, Article 122(5) EPC excludes re-establishment of right also where the period of grace pursuant to Rule 85a EPC, extending the normal period for the request for examination, is not observed (see Decision of the Legal Board of Appeal J 11/86).
- Your request for re-establishment of rights of 19.11.2004, received on 22.11.2004 is therefore refused, because it is inadmissible for the aforementioned reasons"
- VII. On 17 March 2005 the appellant filed a notice of appeal against the decision of the Examining Division and paid the appeal fee. On 27 May 2005 the appellant filed its grounds of appeal. The appellant requested that the decision under appeal be set aside and that its rights be re-established.

VIII. The appellant argued that the Examining Division had based its finding that the time limit in Article 79(2) EPC was excluded from *restitutio in integrum* by Article 122(5) EPC at least in part upon a decision of the Legal Board of Appeal J 11/86 which contained this finding. The appellant argued:

"...any such decision was made before the amendment of the Article 79(2) entered in force on July 1, 1997. It is therefore questionable whether this Decision J 11/86 is applicable to the present application which was filed after the amendment of Article 79(2)".

The appellant further pointed out that under the pre 1 July 1997 version of Article 79(2) EPC the European search report was only published after all the designation fees had been paid, whereas the post 1 July 1997 version of Article 79(2) EPC provides that these fees are to be paid within 6 months of the publication of this report. Thus the appellant argued that its administrative employee assumed that:

"...all application fees including the designation fees already had been deducted at the time of the withdrawal of the automatic debit order...".

IX. At the oral proceedings on 3 July 2006 the appellant advanced the argument that its letter of 12 December 2003, which stated:

"In response to Communication pursuant to Article 96(1), Rule 51(1)EPC and reference to Article 79(2) EPC of December 9, 2003 the

applicant desires to proceed further with the application on the base of the documents as originally filed".

should be considered as a response to the Receiving Section's letter of 9 December 2003 and that it should be considered to implicitly instruct the EPO to deduct the designation fees mentioned in the "NOTE" at the bottom of this letter from the appellant's account.

- X. In support of the above position the appellant argued at the oral proceedings that although it had cancelled the automatic debit of fees from its account by a letter dated 13 March 2003, the EPO had deducted further search fees from the appellant's account in response to the appellant's letter of 18 August 2003 which stated:

"In response to the communication dated July 17, 2003...

...

It is requested to deduct three further search fees from our account with the European Patent Office, account Nr. 28 000 269".

Thus, as the EPO had interpreted the appellant's letter of 18 August 2003 as an instruction to deduct search fees, so it should have interpreted the appellant's letter of 12 December 2003 as an implicit instruction to deduct designation fees.

- XI. At the end of the oral proceedings, the decision of the Board was announced.

## Reasons for the Decision

1. The appeal satisfies the requirements of Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. The appellant has argued (see IX and X above) that its letter of 12 December 2003 should have been read by the EPO as a response to the Receiving Section's letter of 9 December 2003 and as an implicit instruction to the EPO to deduct the designation fees.

The appellant's letter of 12 December 2003 makes no reference whatsoever to any fees. As a general rule, in order to discharge its duty as a responsible public administration, the EPO cannot, in the absence of express instructions, simply deduct fees from a client's account. The appellant supported its argument of an implicit instruction to deduct fees by reference to its letter of 18 August 2003, following which the EPO deducted search fees. This 18 August 2003 letter, however, gives clear and explicit instructions to deduct fees (see X above). Thus a reference to a letter which gave an explicit instruction to pay some fees provides no support for the argument that a letter that makes no reference to fees is implicitly giving instructions to pay the fees.

3. The Board therefore concludes that the appellant's letter of 12 December 2003 cannot be read as an instruction to the EPO to deduct the designation fees.
4. Article 122(5) EPC expressly excludes from *restitutio in integrum* the non-observance of certain time limits.

The time-limit for the payment of designation fees under Article 79(2) EPC is such an expressly excluded time limit. The amendment to Article 79(2) EPC which entered into force on 1 July 1997 did not alter this express exclusion.

5. The question therefore arises as to whether the Board may, by following the appellant's arguments in VIII above, go against the express wording of Article 122(5) EPC and find that the time limits set out in Article 79(2) EPC are not excluded from the application of *restitutio in integrum*.

Under the pre 1 July 1997 version of Article 79(2) EPC, no publication of the search report took place without the prior payment of the designation fees. The post 1 July 1997 version provides that designation fees are to be paid within 6 months of the date on which the European Patent Bulletin mentions the publication of the European search report. The effect of the current version of Article 79(2) EPC is thus to give more time to an applicant to pay designation fees. Thus, although the amendment of Article 79(2) EPC has changed the time limit, the nature of this time limit (that it sets a period within which the designation fee must be paid, and that non-payment has consequences) has remained the same. Thus, the amendment to Article 79(2) EPC has not fundamentally changed the nature of the time limit. Thus the Board finds that there is no basis for disregarding the express wording of Article 122(5) EPC.

There is a constant and well established case law of the Boards of Appeal to the effect that both the pre- and post- 1 July 1997 versions of Article 79(2) EPC are



excluded by the unchanged Article 122(5) EPC from the application of *restitutio in integrum* (see J 11/86 of 4 August 1986, reasons point 1; G 3/91, OJ 1993 008, reasons point 1.7, last sentence; J 14/02 of 30 December 2002, reasons point 3; J 25/01 of 13 February 2003, reasons point 5). (All "J" decisions have not been published in the Office Journal).

6. The question also arises as to whether the period of grace for the payment of fees in Rule 85a EPC, which refers to the payment of designation fees under Article 79(2) EPC, is also excluded by Article 122(5) EPC. Rule 85a EPC has the effect of mitigating the serious consequences of failure to observe certain time limits excluded from re-establishment under Article 122(5) EPC. This it does by offering applicants for European patents who have not observed these time limits a last opportunity to rectify their omission within a period of grace, subject to the payment of a surcharge. The period of grace in Rule 85a EPC is therefore closely linked to the time limit laid down in Article 79(2) EPC and is accordingly excluded, as is Article 79(2) EPC, from re-establishment under Article 122(5) EPC (see G 3/91, OJ 1993, 008, reasons point 2).

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

B. Günzel