

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

D E C I S I O N
of 5 July 2006

Case Number: J 0017/05 - 3.1.01

Application Number: 99968090.3

Publication Number: 1062440

IPC: F16J 1/00

Language of the proceedings: EN

Title of invention:
Mechanical shaft seal

Applicant:
Murphy, Glendon

Opponent:
-

Headword:
Re-establishment of rights

Relevant legal provisions:
EPC Art. 122, 113(1), 86(2), 86(3)
EPC R. 67, 68(2), 69(1)

Keyword:
"No communication prior to decision"
"Lack of reasons in a decision"
"Substantial procedural violation (yes)"

Decisions cited:
J 0007/82, J 0027/86

Catchword:
-



Case Number: J 0017/05 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 5 July 2006

Appellant: Murphy, Glendon
1927 Maple Avenue
Huntington WV 25703 (US)

Representative: Moore, Derek
Jensen & Son
366-368 Old Street
London EC1V 9LT (GB)

Decision under appeal: Decision of the Receiving Section of the
European Patent Office posted 22 April 2005
refusing the request for re-establishment of
rights.

Composition of the Board:

Chairman: B. Günzel
Members: D. Rogers
S. Hoffmann

Summary of Facts and Submissions

- I. The appeal is against the decision of the Receiving Section of 22 April 2005 which rejected the request of the appellant for re-establishment of the time limit for payment of the renewal fee for the fifth year (hereafter "the fifth renewal fee") for the European patent application 99. 968 090.3.
- II. Euro-PCT patent application 99.968 090.3 has an international filing date of 8 December 1999.
- III. In its communication dated 4 February 2004 the EPO informed the appellant that, although the fifth renewal fee had not been paid by the due date, it could still be validly paid within 6 months of the due date provided that the additional fee was also paid within this period (Article 86(2) EPC).
- IV. In a communication under Rule 69(1) EPC dated 12 August 2004, the EPO informed the appellant that the renewal fee and the additional fee had not been paid in due time, and that consequently, in accordance with Article 86(3) EPC, the application was deemed to be withdrawn.
- V. By a fax dated 8 December 2004 and received by the EPO on the same day, the appellant filed an application for re-establishment of rights (hereafter "*restitutio in integrum*") under Article 122 EPC and also paid all fees in question. The appellant attached various statements in support of his application for *restitutio in integrum* under Article 122 EPC.

- VI. On 15 December 2004, the Receiving Section sent a communication to the appellant stating that the communication of 12 August 2004 (see IV above) had become final, that proceedings were terminated and that 75% of the examination fee would be refunded.
- VII. On 22 April 2005, the Receiving Section issued a decision rejecting the application for *restitutio in integrum* on the ground that the request was not filed in due time. This decision made no reference to the content of the submissions made in the appellant's application for *restitutio in integrum* filed on 8 December 2004 (see V above).
- VIII. On 6 June 2005 the appellant filed a notice of appeal against the decision of the Receiving Section and paid the appeal fee. On 22 August 2005 the appellant filed documents in support of the appeal. The appellant requested that the decision under appeal be set aside and that his patent application be restored.

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 Receiving Section's decision of 22 April 2005 (see VII above) is in the form of a standard letter consisting of a number of paragraphs, the Receiving Section indicated which one applied by ticking it. This letter stated:

"DECISION TO REFUSE THE REQUEST FOR RESTITUTIO IN INTEGRUM (Rule 68(2) EPC)

The request for restitutio in integrum dated 08.12.2004 is ineffective and has been rejected for the following reason:

The request for restitutio in integrum was not filed in due time (Art. 122(2) EPC)".

3. The Receiving Section's letter of 22 April 2005 was the only communication that the Receiving Section sent to the appellant that addressed the appellant's request for *restitutio in integrum* set out in its letter of 8 December 2004.
4. Article 113(1) EPC provides that, "...decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments".

The practical consequence of this provision of the EPC is that in cases where a party has filed a request before the Receiving Section for *restitutio in integrum*, the Receiving Section will generally send the party a communication setting out the reasoned preliminary opinion of the Receiving Section on the *restitutio in integrum* application. The party will be invited to file comments on this communication prior to the issuing of an actual decision. Such communications serve to give a party an opportunity to reconsider its case or to argue against the preliminary opinion expressed by the EPO. At any rate, where a prior communication is necessary under Article 113(1) EPC to make sure that a later decision is only based on grounds or evidence on which the party concerned has

had an opportunity to comment, such a communication must be sent (see J 7/82 of 23 July 1982, OJ EPO 1982, 391, point 6 of the reasons).

5. In this particular case the appellant filed before the Receiving Section, under cover of its letter dated 8 December 2004, two "statements of truth" and a "declaration" in support of its application for *restitutio in integrum*. These documents set out a complex factual situation and seek to establish, amongst other things, the date of the removal of the cause of non-compliance with the time limit for paying the fifth renewal fee. Thus the factual and legal situation in this case is not straightforward. This means that it is far from immediately obvious to a party upon what grounds, evidence and arguments a decision of the Receiving Section could be expected to be based. Thus, the failure by the Receiving Section to issue a communication prior to the decision in this case constitutes a failure to conform to the requirements of Article 113(1) EPC, which amounts to a substantial procedural violation.

6. In accordance with Rule 68(2) EPC decisions of the European Patent Office which are open to appeal shall be reasoned. This does not necessarily mean that all the arguments submitted by a party should be dealt with in detail, it does however mean that the rights of the parties should be safeguarded, and the legality of the administrative decisions assured, by the due substantiation of decisions. Thus a decision in order to be reasoned needs to contain, in addition to the logical chain of facts and legal provisions on which the decision is based, a discussion of the crucial

points in dispute, in order to give the party concerned a fair idea of why its submissions were not considered convincing.

The Receiving Section's decision of 22 April 2005 is no more than a bald statement, unsupported by any discussion of the legal or factual basis for finding that the request for *restitutio in integrum* was not filed in due time.

Therefore, the decision under appeal is not in conformity with Rule 68(2) EPC, which amounts to a further substantial procedural violation.

7. Article 10 of the Rules of Procedure of the Boards of Appeal (OJ EPO 2003, 89) states that:

"A Board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise".

In this case no special reasons for not remitting the case are present and thus the Board comes to the conclusion that the decision under appeal must be set aside and makes use of its power under Article 111(1) EPC to remit the case to the Receiving Section for further prosecution of the request for *restitutio in integrum*.

Furthermore, the Board considers that in view of the substantial procedural violations (see points 5 and 6 above) it is equitable to reimburse the appeal fee, as provided for under Rule 67 EPC (see J 7/82 of 23 July

1982, OJ EPO 1982, 391, point 6 of the reasons; and
J 27/86 of 13 October 1987, point 6 of the reasons).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Receiving Section for further prosecution.
3. The appeal fee shall be reimbursed.

The Registrar:

The Chairman:

S. Fabiani

B. Günzel