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**Datasheet for the decision
of 12 December 2011**

Case Number: J 0022/10 - 3.1.01

Application Number: 06752688.9

Publication Number: 1906989

IPC: A61K 38/16

Language of the proceedings: EN

Title of invention:
Chaperonin 10-induced immunomodulation

Applicant:
CBIO Limited

Opponent:
-

Headword:
Extension Agreements

Relevant legal provisions:
EPC Art. 106
EPC R. 38(1), 39(1)

Relevant legal provisions (EPC 1973):
EPC Art. 78(2), 79(2)
EPC R. 85a(2), 107(1)(d)

Keyword:
"Notification refusing a request for late payment of extension fees not appealable"

Decisions cited:
J 0014/00, J 0019/00, J 0009/04, J 0002/05, J 0004/05

Catchword:
-



Case Number: J 0022/10 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 12 December 2011

Appellant: CBIO Limited
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Decision under appeal: Notification of the Receiving Section of the
European Patent Office of 21 August 2009

Composition of the Board:

Chairman: B. Günzel
Members: I. Beckedorf
L. Bühler

Summary of Facts and Submissions

- I. The appellant contested a notification of the Receiving Section dated 21 August 2009 refusing its request for late payment of the extension fees concerning the European patent application number 06 752 688.9 (European publication number 1906989).
- II. The EURO-PCT application with a priority date of 11 July 2005 was filed on 11 July 2006 under the international application number PCT/AU 2006/000980 and was published on 18 January 2007 under the international publication number WO 2007/006095. All (then) EPC Contracting States were designated in the international application.
- III. With letter dated 7 April 2008 the appellant designated all (then) five extension states (Albania, Bosnia and Herzegovina, Croatia, Former Yugoslav Republic of Macedonia, and Serbia) and asked for the debit of five extension fees and five late payment surcharges from the deposit account of the appellant's European professional representative. Those payments were done on 11 April 2008.
- IV. On 21 August 2009, the Receiving Section sent a reasoned notification refusing the appellant's request to consider the late payment of extension fees validly effected and ordered the fees paid to be refunded. It stated that the procedure for payment of the extension fee were not be governed by the EPC. All provisions relating to the implementation of the extension were established by national law in the relevant (extension) state, whereas the extension agreements merely

established the amount of the extension fee. The respective national laws of the extension states became obsolete with the entry into force of the EPC 2000 and the deletion of Rule 85a (2) EPC 1973.

- V. On 21 October 2009, the appellant filed an appeal against this notification and paid the appeal fee. As part of the notice of appeal, the appellant filed its statement of grounds of appeal submitting that the notification was a decision within the meaning of Article 106 EPC. Alternatively, it requested a review and the issue of an appealable decision.

As to the substance, the appellant argued that the extension agreements explicitly provided for late payment periods and were by no means affected by the entry into force of the EPC 2000. The extension agreements would still be applicable and the appellant's payments of the extension fees with late payment surcharges or further processing fees were accomplished within the relevant period of two months of the due date. Thus, the designation of the extension states was effective.

- VI. The appellant requested in essence that

the contested notification be set aside and that the late payment of the extension fees be accepted and the designation of the extension states be recognised.

- VII. The Receiving Section passed on the appeal to the Legal Board of Appeal.

VIII. With the communication dated 19 August 2011 the Legal Board of Appeal informed the appellant of its preliminary opinion that the contested denial of the Receiving Section to accept the late payment of the extension fee by the appellant was not open to an appeal and, consequently, that the Board was not competent to review the decision under appeal.

The appellant was invited to file a response to these remarks within two months but did not reply.

Reasons

1. The appeal is directed against the notification of the Receiving Section dated 21 August 2009 refusing the appellant's request to accept the late payment of the extension fee concerning the European patent application No. 06 752 688.9.
2. The appeal was filed, and the appeal fee was paid within two months of the date of the notification, alleged by the appellant to be appealable (Article 108 EPC).
3. As noted by the Legal Board of Appeal in its communication dated 19 August 2011, the appeal proceedings are essentially concerned with the question whether such a denial of the Receiving Section is open to an appeal and, therefore, whether the appeal is admissible.
 - 3.1 According to the exhaustive provisions of Article 106(1) EPC, only those decisions of the EPO may be contested

which are taken by the departments listed therein, i.e. by the Receiving Section, Examining Divisions, Opposition Divisions and the Legal Division, acting within the framework of their duties under the EPC.

3.2 The Legal Board of Appeal found in a number of cases that decisions taken by the EPO when carrying out its obligations under the co-operation agreements with certain states extending the protection conferred by European patents (Extension Agreements) were not based on the EPC itself but solely based on the Co-operation Agreements between the European Patent Organisation (EPO) on the one hand and the extension states on the other hand; it, therefore, rejected the respective appeals as inadmissible (J 14/00, OJ EPO 2002, 432; J 19/00 of 10 May 2001; J 9/04 of 1 March 2005; J 2/05 of 1 March 2005; J 4/05 of 2 February 2006).

3.3 Starting from this, the following aspect is relevant in deciding the current case:

3.3.1 It follows already from the very nature of the Extension Agreements relevant in these appeal proceedings (Albania, OJ EPO 1995, 803 and 1996, 82; Bosnia and Herzegovina, OJ EPO 2004, 619; Croatia, OJ EPO 2004, 117; Former Yugoslav Republic of Macedonia, OJ EPO 1997, 345 and 538; Serbia and Montenegro, OJ EPO 2004, 583, 2007, 406 and 2010, 10) that any decisions based on such international treaties do not fall within the scope of the EPC and, as a result of this, are not subject to the jurisdiction of the Boards of Appeal.

3.3.2 The procedure for payment of the extension fees is determined by the Extension Agreements alone. Although

there are certain parallels between the formal procedures of extension of protection under the Extension Agreements on the one hand and the designation of a contracting state under the EPC on the other hand (Articles 78(2) and 79(2) EPC 1973, Rules 38(1) and 39(1) EPC), the Extension Agreements form a legal system of their own that is distinct from the legal system created by the EPC.

References within the Extension Agreements to the EPC, in particular to the so-called period of grace under Rule 85a(2) EPC 1973 (in combination with Article 79(2) EPC 1979, Rule 107(1)(d) EPC 1973 and the EPO Rules relating to Fees), do not override this fundamental distinction.

Consequently, the legal nature of any decision taken on the legal basis of the Extension Agreements remains within that legal system and does not extend to the legal system of the EPC.

- 3.3.3 The Extension Agreements make it absolutely clear that references to provisions of the EPC are exhaustive and, thus, that there can be no corresponding application of other provisions, including those of Articles 106 et seq. EPC concerning the appeals procedure.

Neither is there anything in the structure or legal nature of the Extension Agreements to support the appealability of the contested decision within the legal framework of the EPC. As bilateral agreements, the Extension Agreements essentially deal - exhaustively and strictly separated from the EPC - with matters pertaining to the integration of extended

European applications and protective rights into the respective national law and their relationship to national applications and rights based on the law on industrial property of the extension states.

Nor do the Extension Agreements provide for a transfer of jurisdiction on the EPO and its Boards of Appeal. Such a transfer could only have been established by an explicit and clear provision to this effect in the Extension Agreements. Particularly with regard to the principle of sovereignty of the extension states, there is no room for acknowledging an implicit transfer of jurisdiction from the respective national law and the national courts to the EPC and the Boards of Appeal.

- 3.4 The Legal Board of Appeal is not competent to decide a case that is solely governed by a "foreign" legal system.

4. All this has been brought to the appellant's attention by way of the communication of the Board dated 19 August 2011 to which the appellant chose not to reply. Having reviewed the facts and legal issues involved in this appeal case, the Board maintains the opinion already expressed in said communication and reiterated above.

5. Since the contested notification of the Receiving Section dated 21 August 2009 refusing its request for late payment of the extension fee concerning the European patent application Nr. 06 752 688.9 is not open to an appeal according to Article 106 EPC the appeal has to be rejected as inadmissible.

Order

For these reasons it is decided that:

The appeal is rejected as inadmissible.

The Registrar

The Chairwoman

C. Eickhoff

B. Günzel