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Datasheet for the decision of 7 May 2018

Case Number: J 0010/17 - 3.1.01

Application Number: 13845204.0

Publication Number: 2907062

IPC: C12Q1/68, G06F19/22

Language of the proceedings: EN

Title of invention:
SYSTEMS AND METHODS FOR TUMOR CLONALITY ANALYSIS

Applicant:
Five3 Genomics, LLC

Headword:
Restoration of the right of priority/FIVE3 GENOMICS

Relevant legal provisions:
PCT R. 26bis.3, R. 49ter.1, R. 49ter.2

Keyword:
Restoration of the right of priority under the PCT (no)
Legitimate expectations (no)

Decisions cited:
G 0005/88, G 0002/97, J 0003/87, J 0001/89, J 0027/92

Catchword:
Restoration of the right of priority under Rule 49ter.2 PCT

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Case Number: J 0010/17 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 7 May 2018

Appellant: (Applicant)	Five3 Genomics, LLC 101 Cooper Street Santa Cruz, California 95060 (US)
Representative:	Pallini Gervasi, Diego et al. Notarbartolo & Gervasi GmbH Bavariaring 21 80336 Munich (DE)
Decision under appeal:	**Decision of the Receiving Section of the European Patent Office posted on 3 February 2017 concerning restoration of the right of priority in the matter of European patent application No. 13 845 204.0**

Composition of the Board:

Chairwoman	C. Vallet
Members:	M. Blasi
	G. Weiss

Summary of Facts and Submissions

I. The present appeal lies against the decision of the Receiving Section rejecting the request to reverse the finding that European patent application No. 13 845 204.0 does not enjoy a right of priority with respect to the claimed priority.

II. The application had been filed as an international application under the PCT on 7 November 2013, with the USPTO as receiving Office. Priority from an earlier US application of 9 October 2012 was claimed.

III. As the international application was not filed within the priority period, the applicant submitted a request for restoration of the right of priority with the receiving Office. The receiving Office decided to restore the right of priority based on the finding that the failure to file the international application within the priority period had been "unintentional". This information, however, did not reach the EPO until a later stage.

IV. Following a demand under Chapter II of the PCT, an international preliminary examination was carried out.

V. After entry of the application into the European phase, the Receiving Section issued a communication on 4 June 2015, entitled "*Invitation to file a request for restoration of the right of priority under Rule 49ter.2 PCT - Invitation to file observations under Rule 49ter. 1 d) PCT*" (EPO Form 1227 11.14). Two boxes were crossed on the form, providing the following information:

"*The applicant is informed that in respect of the European patent application referred to above, a request for restoration of the right of priority pursuant to Rule 49ter.2 PCT is necessary for the following reasons:*

No request for restoration of the right of priority has been filed pursuant to Rule 26bis.3 PCT during the international phase".

At the top of the form, the following text was added "*Time limit ends 09.06.2015*".

VI. By letter received on 10 June 2015 the applicant's representative stated that "*the request for restoration of the priority right was already filed in the international phase ... and duly granted by the Receiving Office*". Enclosed with this letter was a copy of the receiving Office's decision dated 2 April 2014 granting the request for restoration of the right of priority based on the "unintentional" criterion and documentary evidence describing the events upon filing the international application. The EPO was asked to confirm "*that the priority right is duly in force*".

VII. In a notification of loss of rights under Rule 112(1) EPC of 30 June 2015 the Receiving Section informed the applicant that the filing date did not lie within the twelve-month priority period and that the application did therefore not enjoy a right of priority with respect to the oldest priority claimed in the application. The reason cited was that the "*decision by the receiving Office to restore the right of priority based on the criterion of unintentionality has no effect in proceedings before the EPO*

(R. 49ter.1(b) PCT) and no valid request under Rule 49ter.2 PCT has been filed".

In an accompanying letter, the Receiving Section took the view that, even though the incorrect box had been crossed in the letter dated 4 June 2015, the intention of reminding the applicant had been expressed. It was pointed out that the reminder letter had also stated that the decision of the receiving Office to restore the right of priority based on the criterion of unintentionality has no effect in proceedings before the EPO. The item had not been crossed but the professional representative should have been aware of this position of the EPO.

VIII. In response to the notification of loss of rights, the applicant requested that a decision be issued. After an exchange of letters, the impugned decision was taken by the Receiving Section against which the applicant (appellant) filed its appeal.

IX. In the statement setting out the grounds of appeal, the appellant referred to the incorrect information given in the communication dated 4 June 2015 and argued that the principle of legitimate expectations should apply in the present circumstances. The appellant requested that the decision under appeal be set aside and asked "*to receive a new, corrected invitation for filing a request for restoration of the right of priority including a new time limit*". As an auxiliary measure, oral proceedings were requested.

X. The board issued a summons to oral proceedings together with an accompanying communication in accordance with Article 15(1) RPBA in which it set out its preliminary opinion and addressed some of the issues to be

discussed. A copy of pages 99 and 100 of the EPO publication "How to get a European patent - Euro-PCT, Guide for applicants Part 2", 7th edition 2014, was enclosed.

XI. In response the appellant's representative filed a copy of an email of 10 June 2015 from the US patent attorney and submitted that this was when he was informed for the first time that the applicant had successfully restored the right of priority in the international phase.

XII. The board held oral proceedings on 7 May 2018 in the course of which the appellant confirmed that it relied solely on the line of argument presented at the oral proceedings and that the lines of argument previously submitted in writing were not to be further pursued.

XIII. The appellant's arguments, as far as they are relevant to this decision, may be summarised as follows:

After entry of the application into the European phase, the appellant's European representative noted that the period of priority for the present application had not been observed. He was aware that a request for restoration of the priority right had to be filed with the EPO within the one-month time limit under Rule 49*ter*.2(b)(i) PCT for the priority right to be validly claimed. The US patent attorney had, however, neither provided any instructions concerning the priority in this particular case nor given any indication of a request for restoration of the priority right filed during the international phase pursuant to Rule 26*bis*.3 PCT. The general instruction in such cases was that, when no request for restoration of the right of priority was filed in the international phase, the

European representative should consider that the applicant had no interest in filing such a request in the European phase. After receiving EPO Form 1227 on 4 June 2015 indicating that no request for restoration of the right of priority had been filed during the international phase, the form was forwarded to the US patent attorney without further information as it was assumed that the applicant was not interested in the priority, in accordance with the established general instruction. No reaction from the US patent attorney was expected and no action from the representative himself was necessary. When the reply of the US patent attorney was received by email dated 10 June 2015, the indicated deadline had already expired. Had EPO Form 1227 not contained the erroneous information, the representative would have sought explicit instruction on whether a request for restoration of the right of priority should be filed with the EPO. With the error, however, the information in the form confirmed the representative's assumption that the general instruction applied.

Neither proof of the established general instruction mentioned above nor of the correspondence with the US patent attorney after receipt of EPO Form 1227 could be provided. The appellant's European representative assumed that the forwarding must, however, have taken place at the latest on 5 June 2015. That the US patent attorney replied only after the deadline indicated on EPO Form 1227 may have been caused by the US patent attorney's assumption that the EPO would recheck the request filed under Rule 26*bis*.3 PCT of its own motion.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 99 EPC and is therefore admissible.

2. *Requirement to file a request for restoration of the right of priority pursuant to Rule 49ter.2 PCT*

2.1 The present international application was filed on 7 November 2013. Thus, the provisions of Rule 49*ter* PCT, introduced as of 1 April 2007, apply in their version as in force until 30 June 2015. Any references in the present decision should be understood to refer to this version accordingly. Moreover, Rule 49*ter* PCT applies in conjunction with the provisions of Rule 76.5 PCT because the EPO acts as elected Office.

2.2 In the present case, in order for the application to proceed with a valid priority claim in the proceedings before the EPO, the filing of a request pursuant to Rule 49*ter*.2 PCT was required.

2.3 Rule 49*ter*.1(b) PCT provides that where the receiving Office has restored a right of priority under Rule 26*bis*.3 PCT based on a finding by it that the failure to file the international application within the priority period was unintentional, that restoration shall, subject to further conditions, be effective in any designated state whose applicable national law provides for restoration of the right of priority based on that criterion or on a criterion which, from the viewpoint of applicants, is more favorable than that criterion (emphasis added by the board).

2.4 In the present case, the receiving Office had restored the right of priority under the criterion of "unintentionality" following the appellant's request under Rule 26*bis*.3 PCT. However, the EPO neither applies this criterion nor a more favourable one. It applies the "due care" criterion (cf. Notice from the EPO of 7 November 2007 concerning the withdrawal of reservations under the PCT, OJ EPO 2007, 692, point 6). Accordingly, the restoration of the right of priority granted by the receiving Office following the appellant's request under Rule 26*bis*.3 PCT has no effect in the proceedings before the EPO pursuant to Rule 49*ter*.1(b) PCT.

2.5 Furthermore, Rule 49*ter*.1(f) PCT provides that where the receiving Office has refused a request for restoration of the right of priority, any designated Office may consider that request to be a request for restoration submitted to that designated Office under Rule 49*ter*.2(a) PCT within the time limit under that rule. Accordingly, under this provision, no new request for restoration would be necessary after entry into the national phase. Instead, the request submitted in the international phase would automatically be considered by the designated Office. This is not the situation in the present case as admitted by the appellant's representative.

2.6 Thus, in order for the application to proceed with a valid priority claim, the filing of a request pursuant to Rule 49*ter*.2 PCT was required. This was also no longer questioned by the appellant's representative at the oral proceedings before the board. Uncontestedly, no such request had been filed by the appellant's representative in the present case.

3. *Protection of legitimate expectations*

3.1 The appellant's representative argued that the fact that no request under Rule 49*ter*.2 PCT had been filed was due to erroneous information contained in the EPO's communication dated 4 June 2015 and that, therefore, the principle of legitimate expectations should apply in the present circumstances.

3.2 It is well established that the principle of protection of legitimate expectations applies in the proceedings before the EPO (e.g. Enlarged Board of Appeal decisions G 5/88, OJ EPO 1991, 137, point 3.2 of the Reasons, G 2/97, OJ EPO 1989, 123, point 1 of the Reasons). This principle also applies to courtesy services provided by the EPO such as the sending of reminders. It is established case law that where such a service has been rendered, an applicant is entitled to rely upon its content, to the effect that, if erroneous information misled the applicant into an action to the detriment of the proper processing of the application, he may not suffer any disadvantage therefrom (see e.g. J 1/89, OJ EPO 1982, 17, point 5 of the Reasons; J 27/92, OJ EPO 1995, 288, point 3.1 of the Reasons).

3.3 However, it is also an established principle that parties to proceedings before the EPO - and their professional representatives - are expected to know the relevant legal provisions, even when such provisions are intricate. Thus, for an applicant or its representative, respectively, to be able to rely on misleading information, it must be established that the communication from the EPO was the direct cause of action and that, on an objective basis, it was reasonable for the applicant or its representative to have been misled by the information; this depends on

the circumstances of each case (see J 3/87, OJ EPO 1989, 3, point 7 of the Reasons; J 27/92, *supra*, point 3.2 of the Reasons).

3.4 The information contained in the communication of 4 June 2015 (EPO Form 1227) that "*no request for restoration of the right of priority has been filed pursuant to Rule 26bis.3 PCT during the international phase*" indeed did not reflect the actual circumstances because such a request had in fact been filed before the receiving Office. A wrong box had been crossed due to unknown reasons.

3.5 According to the submissions of the appellant's representative at the oral proceedings, he had been well aware of the requirement that, because the application had been filed with the USPTO as receiving Office outside the priority period, a request under Rule 49*ter*.2 PCT needed to be filed with the EPO if the application was to proceed with a valid priority claim in the European phase.

3.6 Thus, the fact that EPO Form 1227 contained incorrect information had in itself no consequence for the European representative's understanding and construction of the legal requirements. The function of the EPO communication of 4 June 2015, namely reminding the appellant's representative of the need to file such a request, was achieved or redundant, respectively. As the appellant's representative was perfectly aware of the need to file a request for restoration under Rule 49*ter*.2 PCT, it can hardly be said that the appellant was prevented from duly filing such a request.

3.7 That, in fact, the time limit for filing the request under Rule 49*ter*.2 PCT did not expire on 9 June 2015, as indicated on EPO Form 1227, did not have to be addressed in more detail by the board. The calculation of the aggregate time limit under Rule 49*ter*.2(b)(i) PCT effectively lead to 11 June 2015 as last date, because the expiry of the 31-month time limit, representing the event for the start of the one-month time limit, had been extended to Monday, 11 May 2015 (see Rule 80.2 and Rule 80.5 PCT; same result if calculated based on Rule 131(2),(4) and Rule 134(1) EPC). However, this inaccuracy had never been raised by the appellant's representative.

3.8 Rather, the appellant's representative argued that what misled him in the EPO's communication was the erroneous information that no request for restoration of the right of priority under Rule 26*bis*.3 PCT had been filed in the international phase. Due to the general instruction that, in cases where no request for restoration of the right of priority was filed in the international phase, he should consider that the applicant had no interest in filing such a request in the European phase, he did not see the need to file a request under Rule 49*ter*.2 PCT with the EPO. He considered that the applicant's intention was that the application would then proceed without a valid priority claim in the proceedings before the EPO.

3.9 Assuming that such general instruction existed, the board would have had to consider whether the principle of protection of legitimate expectations should apply to the benefit of the appellant in the sense that the erroneous information contained in the EPO's communication dated 4 June 2015 was suitable to provide

a causal link for the omission of the filing of a request under Rule 49*ter*.2 PCT.

3.10 This question does not have to be further addressed since the appellant's representative has not provided the board with any evidence concerning the existence and content of the alleged general instruction to the effect that in all cases in which no request for restoration of the right of priority under Rule 26*bis*.3 PCT had been filed in the international phase, the European representative should consider that, under all circumstances, the appellant had no interest in filing a request under Rule 49*ter*.2 PCT in the European phase.

3.11 The appellant's letter received by the EPO on 10 June 2015 in which the appellant referred to the circumstance that "*the request for restoration of the priority right was already filed in the international phase*" neither supports nor contradicts the existence of such a general instruction.

3.12 The email of 10 June 2015 received by the European representative from the US representative informing him that a request under Rule 26*bis*.3 PCT had in fact been successfully filed also contains no hint in this respect.

3.13 A copy of the forwarding of the EPO communication dated 4 June 2015 by the European representative, which allegedly had taken place by 5 June 2015 and which seems to have triggered the email of 10 June 2015, could, according to the submissions of the representative at the oral proceedings, not be provided. The board was also not provided with other

evidence supporting the allegations in relation to the general instruction.

3.14 In view of this, the board cannot establish the presence of a causal link between the erroneous information in the EPO communication dated 4 June 2015 and the omission to file a request for restoration of the right of priority under Rule 49*ter*.2 PCT. Indeed the mistaken information in the EPO communication dated 4 June 2015 that no request for restoration of the right of priority had been filed in the international phase had no bearing on the conduct of the European representative as to whether a request should have been filed in the European phase in the absence of proof of the alleged instruction.

3.15 Hence, in the absence of an established link between the erroneous information and the loss of the priority right, the principle of legitimate expectations cannot apply.

4. As no admissible request for restoration of the right of priority under Rule 49*ter*.2 PCT was filed and the principle of legitimate expectations does not support the appellant's case, the finding of the Receiving Section in the decision under appeal that the present application does not enjoy a right of priority is justified.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairwoman:

C. Eickhoff C. Vallet

Decision electronically authenticated