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**Datasheet for the decision  
of 27 March 2019**

**Case Number:** J 0008/18 - 3.1.01

**Application Number:** 15802518.9

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**IPC:** C09K11/02, C09K11/88,  
C09K11/06, B82Y30/00,  
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**Language of the proceedings:** EN

**Title of invention:**  
CARRIER PARTICLE AND PREPARATION METHOD THEREFOR

**Applicant:**  
Joinstar Biomedical Technology Co., Ltd.

**Headword:**

**Relevant legal provisions:**

EPC Art. 121, 122  
EPC R. 6, 113  
PCT Art. 48(2)(a), R. 49ter  
GebO Art. 2(1) item 11

**Keyword:**

Appeal fee - entitlement to pay lower amount (yes)  
Further processing with respect to the time limit for  
requesting restoration of the right of priority -  
admissibility (no)  
Incorrect form of decision under appeal - name of responsible  
employee missing

**Decisions cited:**

J 0013/16, J 0016/17

**Catchword:**



**Juristische Beschwerdekammer**  
**Legal Board of Appeal**  
**Chambre de recours juridique**

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Case Number: J 0008/18 - 3.1.01

**D E C I S I O N**  
**of the Legal Board of Appeal 3.1.01**  
**of 27 March 2019**

**Appellant:** Jointstar Biomedical Technology Co., Ltd.  
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**Decision under appeal:** **Decision of the Receiving Section posted on 1  
February 2018 concerning European patent  
application No. 15802518.9.**

**Composition of the Board:**

**Chairman** W. Sekretaruk  
**Members:** R. Cramer  
C. Brandt

## **Summary of Facts and Submissions**

- I. The appeal lies against the decision of the Receiving Section posted on 1 February 2018 in which the request for further processing in respect of the missed time limit under Rule 49ter.2(b) (i) PCT was declared inadmissible, and the auxiliary request for re-establishment of rights into this time limit was declared inadmissible as well.
- II. International application PCT/CN2015/086144 was filed on 5 August 2015 with the State Intellectual Property Office of the People's Republic of China as receiving Office (RO). Priority was claimed of Chinese application 2014 10247053.3 filed on 5 June 2014. The application was thus filed after expiry of the priority period, but within the two-month period referred to in Rule 26bis.3(a) PCT.
- III. The RO granted the applicant's request under Rule 26bis.3(a) PCT and restored the right of priority under the "unintentional" criterion.
- IV. With EPO Form 1201, sent on 14 October 2016, the applicant was informed of the steps to be taken for entry into the European phase. In Nr. 8 of this form it was explained that a request for restoration under Rule 49ter.2 PCT would need to be filed with the EPO as designated Office if the RO had granted a request for restoration based on the unintentionality criterion. The applicable time limit, the need to provide reasons for the request, and the need to pay the requisite fee were mentioned.
- V. Following the filing of EPO Form 1200 (Entry into the European phase) on 6 December 2016 the applicant was

invited to file a request for restoration of the right of priority under Rule 49ter.2 PCT (EPO Form 1227). The form does not explicitly state what requirements such request must fulfil, neither with respect to the contents, nor with respect to the due fee.

- VI. The applicant filed a request for restoration of the right of priority under Rule 49ter.2 PCT on 6 February 2017, but omitted to pay the fee for restoration (Article 2(1), item 13, RFees).
- VII. The applicant was contacted by a Formalities Officer on 21 February 2017, and confirmed that the fee had not been paid.
- VIII. On 5 April 2017 the applicant filed a request for further processing in respect of the time limit of Rule 49ter.2(b)(i) PCT, as well as a reasoned request for re-establishment of rights into the same time limit, and argued that this time limit was not excluded in Article 121(4), Article 122(4), Rule 135(2) or Rule 136(3) EPC.
- IX. The applicant's arguments were rejected in the decision under appeal.
- X. The applicant filed a notice of appeal on 3 April 2018. On the same day an appeal fee of € 1880 was paid. On 4 April the appeal fee was paid once more in the amount of € 2255. On the last day of the time limit under Article 108, first sentence, EPC (11 April 2018) a declaration under Rule 6(6) EPC was filed stating that the appellant was a small or medium-sized enterprise (SME) within the meaning of Rule 6(4) and (5) EPC. In its statement of grounds of appeal the appellant maintained its position that the time limit for

requesting restoration under Rule 49ter.2 PCT is not excluded from further processing in Article 121(4) or Rule 135(2) EPC, corresponding arguments applying to its request for re-establishment of rights under Article 122(1) EPC.

XI. Oral proceedings were held on 27 March 2019. The appellant requested that the decision under appeal be set aside, that the request for further processing and/or the request for re-establishment of rights into the time limit of Rule 49ter.2(b)(i) PCT be found admissible, and to remit the case to the Receiving Section to decide on the request for restoration of the right of priority under Rule 49ter.2(a) PCT. The appellant essentially reiterated its earlier arguments, and furthermore argued that it is not obvious for applicants that the EPO charges a fee for a request for restoration under Rule 49ter.2 PCT as this is neither mentioned in EPO Form 1227, nor appears in the list of fees to be paid upon European phase entry when using the EPO's online fee payment service.

## **Reasons for the Decision**

### Admissibility of the appeal

1.1 The appeal fee was paid twice within the two month period of Article 108 EPC, once the reduced amount of € 1880 on 3 April 2018 and once the regular amount of € 2255 on 4 April 2018. The amount of € 2255 was subsequently (on 17 April 2018) refunded to the appellant.

1.2 According to Article 1(4) of the Decision of the Administrative Council of 13 December 2017 amending

Articles 2 and 14 of the Rules relating to Fees (OJ EPO 2018, A4) the fee for appeal for an appeal filed by a natural person or an entity referred to in Rule 6(4) and (5) EPC shall be € 1880. The fee for an appeal filed by another entity shall be € 2255. These amounts shall be applicable for appeals filed on or after 1 April 2018 (Article 3(4) of the Decision). The present appeal has been filed on 3 April 2018.

- 1.3 An entity within the meaning of Rule 6(4) and (5) EPC is a small or medium-sized enterprise (SME) as defined by the European Commission Recommendation 2003/361/EC mentioned in Rule 6(5) EPC, or a non-profit organisation, university or public research organisation.
- 1.4 The Decision of the Administrative Council does not refer to Rule 6(3) EPC, that provides for a reduction in the filing fee and the examination fee for persons referred to in Article 14(4) EPC.
- 1.5 Thus, whereas the reduction in the filing fee and the examination fee is only available for natural persons and the above-mentioned entities if they have their residence or principal place of business in a Contracting State having a language other than English, German or French as an official language, and nationals of such state who are resident abroad, the applicable amount of the appeal fee is not dependent on the restrictions in Article 14(4) EPC, and also not on the language in which the notice of appeal is filed.
- 1.6 As a consequence, the fact that the appellant is an enterprise that has its principal place of business in China does not mean that it cannot benefit from the lower appeal fee.

1.7 The next question is whether the appellant can be qualified as a small or medium sized enterprise (SME) within the meaning of the European Commission Recommendation.

1.8 The appellant has filed no evidence to this effect, but merely a statement that the appellant is an SME within the meaning of the European Commission Recommendation. The Decision of the Administrative Council does however not refer to Rule 6(6) EPC, wherein such declaration is mentioned, either. The Board is aware of the Notice from the EPO dated 18 December 2017 concerning the reduced fee for appeal (OJ EPO 2018, A5), that appears to suggest that it is enough to benefit from the reduced fee for appeal if the appellant simply declares that it is an entity covered by Rule 6(4) EPC, provided that the declaration is filed at the latest by the time of payment of the reduced fee (Point 4 of the Notice). In the present case the declaration was filed eight days later. While the Board is in no way bound by Notices from the EPO concerning the application or interpretation of legal provisions, it is of the opinion that at least based on the principle of legitimate expectations the appellant could rely on the information given by the EPO and furthermore assume that its appeal would either be deemed filed or admissible following the refund of the regular appeal fee before the file was transferred to the boards of appeal.

2. Violation of Rule 113(1) EPC

The Board has furthermore noted that the appealed decision does not state the name of the responsible employee. As the exception in Rule 113(2) EPC does not



apply, the decision does not meet the requirements of Rule 113(1) EPC. In decision J 16/17 it was held that a violation of Rule 113(1) EPC amounts to a substantial procedural violation. As the appellant did not base its appeal on this deficiency, and a remittal would only cause unnecessary delays, the Board has decided to exercise the discretion conveyed by Article 11 RPBA to decide on the merits of the case.

3. The appeal

- 3.1 With communication of 14 December 2016 the appellant was informed that the RO decision under Rule 26*bis*.3 PCT to restore the right of priority based on the criterion of unintentionality had no effect before the EPO (Rule 49*ter*.1(b) PCT). It was therefore necessary to file a request for restoration of the right of priority with the EPO as designated Office under Rule 49*ter*.2 PCT. The request was to be filed within one month from expiry of the 31-month time limit pursuant to Rule 159(1) EPC. This time limit expired on 5 January 2017. Therefore the request had to be filed by 5 February 2017 (extended to 6 February 2017 as 5 February was a Sunday).
- 3.2 A reasoned written request for restoration of the right of priority was filed on 6 February 2017, in which the appellant argued that the failure to file the international application within the priority period occurred in spite of due care required by the circumstances having been taken (Rule 49*ter*.2(a)(i) PCT).
- 3.3 Rule 49*ter*.2(d) PCT allows the designated Office to levy a fee for the request for restoration, that is to be paid at the same time as the filing of the request

(Rule 49ter.2(b)(iii) PCT). Such fee is indeed levied by the EPO as designated Office (Article 2(1), item 13, RFees that expressly mentions restoration under Rule 49ter.2 PCT). The fee was however not paid by the appellant when filing the request for restoration.

3.4 With letter of 5 April 2017 the appellant requested further processing pursuant to Article 121 EPC and paid the corresponding fees. As an auxiliary request the appellant requested re-establishment of rights under Article 122(1) EPC into the time limit for paying the fee for restoration. In the appealed decision of 1 February 2018 both requests were rejected as inadmissible.

3.5 In the statement of grounds of appeal the appellant firstly argued that the conclusion by the Receiving Section that the request for restoration under Rule 49ter.2 PCT was deemed not to have been made because the fee for restoration was not paid, citing Rule 136(1) EPC, was incorrect.

3.6 With respect to this argument the Board notes that the PCT does not define the legal consequences if the fee Rule 49ter.2(d) PCT has not been paid within the time limit mentioned in Rule 49ter.2(b)(i) PCT. That means it is left to the practice of the designated Offices what those consequences are. It has so far been the practice of the EPO that a request which is subject to the payment of a fee is deemed not to have been filed if the fee has not been paid within the relevant time limit (cf. Referral pursuant to Article 112(1)(b) EPC by the President of the EPO, case G 1/18). The Board can therefore find no fault in the reasoning of the decision under appeal other than that Rule 136(1) EPC is not directly applicable. Rather, the last sentence

of Rule 136(1) EPC can be considered to apply *mutatis mutandis*. The Board can also not see how the appellant could have been adversely affected by this finding.

- 3.7 It is undisputed that the fee for restoration mentioned in Rule 49*ter*.2(b)(iii) and (d) PCT was not paid within the applicable time limit mentioned in Rule 49*ter*.2(b)(i) PCT. The PCT itself does not provide for any relief in the event this time limit is missed. Whether any relief is available therefore depends on the national law of the designated Office. Article 48(2)(a) PCT states that "Any Contracting State shall, as far as that State is concerned, excuse, for reasons admitted under its national law, any delay in meeting any time limit". It is generally accepted that the term "Contracting State" within the meaning of Article 48(2) PCT covers the EPO, and that the term "national law" covers the EPC (cf. Article 2(x) PCT).
- 3.8 Furthermore, the time limit in Rule 49*ter*.2(b)(i) PCT is a time limit within the meaning of Article 48(2)(a) PCT (Rule 82*bis*.1(i) PCT). Thus the EPO would be obliged to provide relief in the event the time limit was missed if it would have had to provide relief in the same situation under the EPC.
- 3.9 The appellant argues that further processing under Article 121 EPC should be available for missing the time limit in Rule 49*ter*.2(b)(i) PCT. The Board agrees that the appellant indeed failed to observe a time limit *vis-à-vis* the EPO within the meaning of Article 121(1) EPC, as the request for restoration under Rule 49*ter*.2 PCT was to be filed with the EPO as designated Office. The Board further agrees that further processing could in principle be an available relief when a time limit to be observed *vis-à-vis* a designated

Office is not met (Rule 82*bis*.2 PCT). However, relevant in the wording of Article 48(2)(a) PCT is the proviso "for reasons admitted under its national law", meaning that further processing is not available if it is not available for not meeting a corresponding time limit under the EPC. Article 121(4) EPC expressly rules out further processing *inter alia* in respect of the time limit for requesting re-establishment of rights. A request for restoration of rights as specified in Rule 49*ter*.2 PCT is equivalent to, and identical in legal nature, to a request for re-establishment of rights under the EPC (J 13/16, Reasons Nr 4.8).

- 3.10 The appellant argued that a request for restoration under Rule 49*ter*.2 PCT is not a separate request for restoration because a request under Rule 26*bis*.3 PCT had already been filed, but rather an opportunity to file additional arguments and evidence. That this is not the case already follows from the fact that the filing of a request for restoration under Rule 49*ter*.2 PCT is not dependent on whether a request under Rule 26*bis*.3 PCT was filed before the receiving Office. Therefore, a request for restoration under Rule 49*ter*.2 PCT is a separate and independent request (cf. J 13/16, Reasons Nr. 3.2, last paragraph, and 3.3).
- 3.11 Thus, the EPO is neither obliged under Article 48(2)(a) PCT to provide further processing if the time limit for requesting restoration of rights under Rule 49*ter*.2 PCT has not been met, nor entitled to grant further processing under Article 121(4) EPC. Therefore such request is inadmissible.
- 3.12 The same considerations apply to the appellant's auxiliary request for re-establishment of rights, as was already held in decision J 13/16.

4. Legitimate expectations

The appellant's final argument that it was not obvious that a fee was due for a request for restoration under Rule 49ter.2 PCT cannot convince the Board either. Apart from the fact that parties to proceedings before the EPO are expected to know the relevant legal provisions, it should also be known that the EPO charges fees for further processing and re-establishment of rights, and it would therefore be unlikely that the EPO did not charge a fee for the request for restoration under Rule 49ter.2 PCT. It would therefore have been incumbent on the appellant to check whether the EPO had made use of its right to charge a fee under Rule 49ter.2(d) PCT.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:



C. Eickhoff

W. Sekretaruk

Decision electronically authenticated