Internal distribution code:

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

Datasheet for the decision of 1 July 2019

Case Number: J 0001/19 - 3.1.01

Application Number: 16750078.4

Publication Number: 3256138

IPC: A61K31/724, A61K31/5415, A61K33/10, A61P19/02

Language of the proceedings: EN

Title of invention:
PHARMACEUTICAL COMPOSITIONS COMPRISING MELOXICAM

Applicant:
Axsome Therapeutics, Inc.

Headword:

Relevant legal provisions:
PCT Rule 49ter.2(b)(i), 49ter.2(b)(iii), 49ter.2(d)
EPC Art. 122(2) sentence 1
EPC R. 136(1) sentence 3

Keyword:

Request for restoration of the right of priority - prescribed fee not paid in due time - request deemed not to have been filed
Principle of the protection of legitimate expectations - misleading communication (no)
Principle of the protection of legitimate expectations - warning obligation (no)

Decisions cited:

G 0002/97, J 0003/87, J 0013/90, J 0002/94, J 0013/16, T 0014/89

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Juristische Beschwerdekammer

Legal Board of Appeal

Chambre de recours juridique

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: J 0001/19 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 1 July 2019

Appellant: (Applicant)	Axsome Therapeutics, Inc. 200 Broadway, 3rd Floor New York, New York 10038 (US)
Representative:	Green, Mark Charles Urquhart-Dykes & Lord LLP Euston House 24 Eversholt Street London NW1 1AD (GB)
Decision under appeal:	**Decision of the Receiving Section of the European Patent Office posted on 5 November 2018 ordering that the request for restoration of the right to priority of US 62/114,215 under Rule 49*ter*.2 PCT is deemed not to have been filed and that the application will continue with priority claim US 62/259,993.**

Composition of the Board:

Chairman	W. Sekretaruk
Members:	G. Decker
	A. Jimenez

Summary of Facts and Submissions

I. On 11 April 2016, the appellant filed international application PCT/US2016/026991, which claimed priority of previous applications US 62/114,215 of 10 February 2015 and US 62/259,993 of 25 November 2015.

II. As the earliest priority date was more than 12 months before the date of filing, the appellant filed a request for restoration of the right of priority under Rule 26*bis*.3 PCT. The USPTO, acting as the receiving Office, granted this request based on the criterion of unintentionality.

III. By EPO Form 1201 of 23 June 2017, the Receiving Section informed the appellant's United States representatives about the procedural steps required for entry into the European phase before the EPO. Point 8 of this form contains the relevant information on restoring priority right. It explicitly refers *inter alia* to the admissibility requirement of paying the requisite fee under Rule 49*ter*.2(b)(iii), (d) PCT.

IV. Following the appellant's request for entry into the European phase, the Receiving Section informed the appellant's professional representative by EPO Form 1227 of 31 August 2017 that the EPO, as designated Office, did not accept the criterion of unintentionality. It invited the appellant to file a request under Rule 49*ter*.2 PCT for restoration of the right of priority under the due care criterion. The appellant's attention was expressly drawn to the one-month time limit under Rule 49*ter*.2(b)(i) PCT for filing the request. The form did not contain an

explicit reference to the required payment of the restoration fee under Rule 49*ter*.2(b)(iii), (d) PCT.

V. On 2 October 2017, the appellant filed a corresponding request which contained a reasoned statement. It did not, however, pay the fee for restoration.

VI. On 17 April 2018, the Receiving Section issued a communication expressing its preliminary opinion that the request for restoration would be deemed not to have been filed because the appellant had not paid the restoration fee. At the same time, a communication noting the loss of rights for the priority claim was dispatched. The appellant did not respond.

VII. On 5 November 2018, the Receiving Section decided that the request for restoration of the right to priority of US 62/114,215 under Rule 49*ter*.2 PCT was deemed not to have been filed and that the application would continue with priority claim US 62/259,993.

The Receiving Section stated that under Rule 49*ter*.2(b)(iii) PCT a request for restoration under Rule 49*ter*.2(a) PCT had to be accompanied by the fee required under Rule 49*ter*.2(d) PCT. A request by an applicant under Rule 49*ter*.2(a) PCT, made to the EPO as the designated Office, is subject to the provisions of Article 122 EPC. Article 122(1) EPC stipulates that a request for re-establishment of rights is not deemed to have been filed until the prescribed fee has been paid. Since the appellant filed the request for restoration in due time but failed to pay the respective fee within the time limit under Rule 49*ter*.2(b)(i) PCT, the request was deemed not to have been filed.

VIII. On 18 December 2018, the appellant filed notice of appeal and paid the appeal fee. The statement setting out the grounds of appeal was filed on 9 January 2019. The appellant requested that the decision under appeal be set aside and that the right to priority of US 62/114,215 be restored. It did not file a request for oral proceedings.

IX. The appellant's submissions, where relevant to the present decision, may be summarised as follows:

The invitation in EPO Form 1227 referred to the PCT Rules but did not explicitly refer to the requirement to pay a fee for restoration, as would normally be required under the rules of the EPC. The filing of a request for restoration of priority derived from an international application was a very unusual occurrence in the day-to-day work of the appellant's representative. Thus, the latter was not immediately aware that there was a requirement for a fee, as this was not set out in the EPO's invitation. Hence, the fact that the fee required under Rule 49*ter*.2(d) PCT was not paid was due to an isolated human error by the appellant's professional representative working within a normally satisfactory and otherwise robust system.

The principle of good faith requires the EPO to warn appellants of an impending loss of rights if such a warning could be expected in good faith. This would be the case if the deficiency was readily identifiable by the EPO and if the appellant could still correct it within the time limit. Here, there would have been time for the formalities officer to have telephoned the representative to make him aware that the fee for restoration had accidentally been omitted from the

submission of 2 October 2017. This could have been done before the expiry of the relevant time limit.

X. In a communication pursuant to Article 113(1) EPC, the board informed the appellant of its provisional opinion on the merits of the case.

XI. In response to this communication, the appellant claimed that it could not understand why the reference to the payment of a fee that was included in Form 1201 could not also be included in Form 1227. The fact that there was no reference in Form 1227 meant that there was a contradiction between the two forms and made it possible for the reader to think that a fee might not be payable. Moreover, just as representatives before the EPO are expected to have knowledge of the relevant provisions of the EPO, it is justifiable to expect the EPO's formalities officers to have the same knowledge and to be aware that a fee which was due had not been paid. The deficiency was readily identifiable since, on checking the Form 1038 which accompanied the restoration request letter, a trained formalities officer would have seen that the fee had not been paid. Finally, this had to be contrasted with G 2/97, which related to the filing of an appeal. While in EPO communications relating to appeals it was very clearly set out that an appeal fee was payable, in Form 1227 the requirement for the payment of a fee to restore a priority right was not as clear.

Reasons for the Decision

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

2. *Request for restoration of the right of priority - Rule 49ter.2 PCT, Article 122, Rule 136 EP*C

2.1 The present international application was filed on 11 April 2016. Thus, the provisions of Rule 49*ter* PCT, introduced on 1 April 2007, apply in their version as in force until 30 June 2018. Any references in the present decision should thus be understood to refer to this version accordingly.

2.2 If an international application is filed more than 12 months from the filing date of the earlier application whose priority is claimed, the applicant may file a request for restoration of priority with the EPO as the designated Office under Rule 49*ter*.2 PCT. The EPO will grant such a request only if the failure to claim the right of priority within the priority period occurred in spite of due care having been taken, as required by the circumstances. The requirement of due care is applied by the EPO in accordance with its established practice under Article 122 EPC. The second criterion referred to in the PCT, namely whether the failure was unintentional, does not play a role in procedures before the EPO.

2.3 A request for restoration of the priority right will be granted only if the fee for restoration of the priority right levied by the EPO under Rule 49*ter*.2(b)(iii), (d) PCT, Rule 136(1) EPC is duly paid within the time limit under Rule 49*ter*.2(b)(i) PCT (see J 13/16, Reasons 3.2;

see also Article 2(1) No. 13 of the Rules relating to Fees, which explicitly refers to the fee for requesting restoration under Rule 49*ter*.2(d) PCT).

2.4 It is uncontested that the appellant filed a request for the restoration of the priority right in good time but did not pay the required fee under Rule 49*ter*.2(b)(iii), (d) PCT, Article 122(2), first sentence, Rule 136(1), third sentence, EPC within the one-month time limit under Rule 49*ter*.2(b)(i) PCT.

It follows from Rule 136(1), third sentence, EPC (and not from Article 122(1) EPC, as erroneously stated in the appealed decision) that the appellant's request for restoration is deemed not to have been filed.

2.5 In this context, the appellant essentially argued that, in accordance with the principle of good faith, the Receiving Section could and should have drawn its attention to the need to pay a fee for restoration. Furthermore, the Receiving Section could and should have warned it of the omitted payment.

If a warning could have been expected but was not issued, the Receiving Section must send another communication drawing the appellant's attention to the above requirement and the omitted payment as well as setting a new time limit (see e.g. T 14/89, Headnote 2; J 13/90, OJ EPO 1994, 456, Headnote 4).

2.6 *Principle of the protection of legitimate expectations*

The principle of the protection of legitimate expectations (also referred to as the principle of good faith) is a general principle generally recognised in the EPC contracting states (see G 2/97, OJ EPO 1999,

123, Reasons 1). It can be understood as an embodiment of the right to fair procedure and a fair hearing under Article 6 ECHR and has to be taken into account by the EPO under Article 125 EPC. The protection of the legitimate expectations of users of the European patent system has two main principles (see Case Law of the Boards of Appeal, 8th edition 2016, section III.A).

2.6.1 Firstly, it stipulates that the user must not be at a disadvantage as a result of having relied on erroneous information or a misleading communication received from the EPO. Communications, including official forms, must be clear and unambiguous, i.e. drafted in such a way as to rule out misunderstandings on the part of a reasonable addressee (see J 3/87, Headnotes 1 and 2).

However, the principle of the protection of legitimate expectations does not require comprehensive legal advice to be included in such forms. In other words, forms do not need to include explanations of the law. Rather, parties to proceedings before the EPO - and their representatives - are expected to have knowledge of the relevant provisions of the EPC, even if such provisions are intricate (see Case Law of the Boards of Appeal, 8th edition 2016, section III.A.1.2.1, and further references cited there).

2.6.2 Secondly, the principle of the protection of legitimate expectations also requires the EPO to warn the applicant of any loss of rights if such a warning could be expected in good faith. Following G 2/97, OJ EPO 1999, 123, Reasons 4.1, two requirements must be met:

- the deficiency must be readily identifiable by the EPO within the framework of the normal handling of

the case at the relevant stage of the proceedings, and

- the user must be in a position to correct the deficiency within the time limit.

However, in G 2/97, Reasons 4.2, the Enlarged Board of Appeal pointed out that it is incumbent on both the EPO and users of the European patent system who are party to proceedings before it to act in good faith. Users of the European patent system have the responsibility to take all necessary steps to avoid a loss of rights. Therefore, there is no justification for the suggestion that the principle of good faith imposes on a board an obligation to warn a party of deficiencies in the area of the party's own responsibility. The appellant's responsibility for fulfilling the conditions of an admissible appeal cannot be passed on to the board of appeal. Users of the European patent system cannot legitimately expect that a board of appeal will issue warnings that relate to the failure to meet such responsibilities. To take the principle of good faith that far would imply, in practice, that the boards of appeal would have to systematically assume the responsibilities of the parties to proceedings before them. There is no legal justification in the EPC or in general principles of law for this proposition.

The Enlarged Board of Appeal set out the above principles in the context of proceedings before the boards of appeal. They must, however, apply in the same way to proceedings of the department of first instance of the EPO.

2.7 *Obligation to provide clear and unambiguous communications*

2.7.1 The appellant and its representative were expected to be familiar with all of the prerequisites for filing a valid request for restoration of the right of priority under Rule 49*ter*.2 PCT. This is true regardless of any possible reference in an EPO communication to the requirement to pay the fee under Rule 49*ter*.2(b)(iii), (d) PCT. In determining whether the EPO complied with its obligation to provide clear and unambiguous communications, it is irrelevant that express references to certain statutory requirements may be missing.

2.7.2 Furthermore, in point 8 of EPO Form 1201 the Receiving Section had in fact explicitly drawn the appellant's attention to the fact that a fee for the restoration request was payable under Rule 49*ter*.2(b)(iii), (d) PCT. Hence, the appellant (via its United States representatives) did have positive knowledge of the requirement to pay a restoration fee.

2.7.3 Finally, the board does not consider the communication using EPO Form 1227 to be misleading. On this form, the appellant was invited "*to file a request for restoration of the right of priority under Rule 49ter.2 PCT*". The reference made to the relevant PCT Rule also covers the provisions under Rule 49*ter*.2(b)(iii), (d) PCT, which include the possible requirement to pay a restoration fee. This is also why the board is unable to establish the contradiction between EPO Forms 1201 and 1227 alleged by the appellant. The mere fact that the latter form explicitly referred only to the one-month time limit under Rule 49*ter*.2(b)(i) PCT did not

imply that there were no other statutory requirements for the restoration request.

As a result, from the perspective of a reasonable addressee, the lack of an explicit reference to the provisions under Rule 49*ter*.2(b)(iii), (d) PCT did not mean that the requirement to pay a restoration fee was not applicable.

2.8 *Obligation to warn the appellant of the omitted payment*

2.8.1 It was the appellant's own responsibility to fulfil the conditions of a valid restoration request. This responsibility could not be passed on to the EPO department responsible for processing the request (i.e. the Receiving Section). Thus, there was in principle no legitimate expectation on the part of the appellant that the EPO would issue a warning about deficiencies in meeting such responsibilities (here: the payment of the restoration fee). Hence, it is irrelevant that the formalities officers should be expected - as claimed by the appellant - to be aware that an outstanding fee had not been paid.

2.8.2 Furthermore, the board is unable to detect a readily identifiable deficiency in the documents filed by the appellant which would have made it one of those rare cases where such a warning was necessary.

(a) In the case relating to decision G 2/97, the notice of appeal was filed so early that the appellant could have reacted to a potential warning and have paid the fee in time. But there was no indication - either in the notice of appeal or in any other document filed in relation to the appeal - that would imply that the appellant could, without such

notification, inadvertently miss the time limit for payment of the appeal fee. In these circumstances, the Enlarged Board of Appeal held that the principle of good faith did not impose any obligation on the boards of appeal to notify the appellant that an appeal fee was missing.

(b) In the board's opinion, this case is comparable to G 2/97. The appellant had already filed its request for restoration on 2 October 2017, well before the expiry of the relevant time limit under Rule 49*ter*.2(b)(i) PCT on 10 October 2017. However, there was no indication in the request letter (such as a reference to the - missing - payment of the restoration fee) that it would inadvertently miss the time limit to pay the restoration fee. Rather, it was entirely possible that it would still pay the fee within the time limit.

(c) Contrary to the appellant's view, the principles set out in G 2/97 are applicable here. In terms of the obligation of the EPO to issue a possible warning, there is no difference between filing an appeal and filing a request for restoration of the priority right.

(d) In this context, the appellant alleged that there was indeed a difference since the references to the requisite fee in the EPO communications relating to appeals and restoration requests did not have the same level of clarity. This is, however, irrelevant, for the reasons set out in point 2.7.1 above.

(e) Moreover, it should be noted that many payments are made in a way which is not apparent from the letter

containing the request. Therefore, the EPO can often only establish whether a specific fee has been paid after the expiry of a time limit when it has access to full data on all payments made during the relevant period (see J 2/94, Reasons 5). Consequently, the mere fact that the appellant's request was not accompanied by a cheque or a debit order did not require the immediate reaction of the Receiving Section.

(f) The appellant's additional argument that, on checking the Form 1038 which accompanied the restoration request letter, a trained formalities officer would have seen that the fee had not been paid is therefore also not persuasive. Even if the formalities officer had spotted the omission, they would not have been obliged to warn the appellant, for the above reasons.

2.9 To summarise, the principle of the protection of legitimate expectations did not oblige the Receiving Section to draw the appellant's attention to the required payment of the fee for restoration and/or to alert it to the omitted payment.

3. *Request for re-establishment of rights - Article 48(2)(a) PCT, Article 122, Rule 136 EPC*

3.1 The appellant did not file an explicit request for re-establishment into the one-month time limit for paying the restoration fee under Article 48(2)(a) PCT in conjunction with Article 122, Rule 136 EPC. That being said, in the statement of grounds of appeal the appellant submitted that the non-payment of the restoration fee was the result of an isolated human error by its professional representative working within

a normally satisfactory and otherwise robust system. This line of argument is apparently directed at the due care criterion under Article 122(1), first sentence, EPC.

3.2 In its communication under Article 113(1) EPC, the board noted that the above submission might be considered to be an implicit request for re-establishment into the time limit for paying the restoration fee. At the same time, the board drew the appellant's attention to the fact that under Rule 136(4) EPC the department responsible for deciding on this request was the Receiving Section and not the board. The board also noted that such a request would be inadmissible for various reasons.

In its reply to the board's communication, the appellant did not comment on this.

3.3 In view of the above, the board concludes that the appellant did not file an implicit request to that effect.

4. *Summary*

As the principle of the protection of legitimate expectations does not support the appellant's case, the finding of the Receiving Section in the decision under appeal is justified.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

C. Eickhoff W. Sekretaruk

Decision electronically authenticated