

Europäisches  
Patentamt

European Patent  
Office

Office européen  
des brevets

Juristische  
Beschwerdekammer

Legal Board  
of Appeal

Chambre de  
recours juridique



Case No. J 03/80

DECISION

of 31 January 1980

80,92

Appellant:

Chubb Electronics Limited  
42-50 Hersham Road  
Walton-on-Thames  
Surrey KT12 1RY  
England

Representative:

Graham F. Coles  
14-22 Tottenham Street  
London W1P 0AA  
England

Decision under  
appeal:

Decision of the Receiving Section  
of the European Patent Office  
dated 21.12.1979 rejecting an  
application for restitutio in  
integrum of European Patent  
Application No. 79301754.2.

Composition of the Board:

- Dr R. Singer                      Chairman
- P. Ford                              Member
- L. Gotti Porcinari              Member

Facts and Submissions of the Appellant

- I. On 28 August 1979, the appellant filed a European patent application at the United Kingdom Patent Office, London, claiming priority from an application for a United States patent made on 28 August 1978. Nine Contracting States were designated in accordance with Article 79 EPC, as States in which protection for the invention was desired.
- II. On 3 September 1979, the United Kingdom Patent Office issued a "secrecy direction" under section 22 of the United Kingdom Patents Act 1977, one effect of which was that the application could not be forwarded to the European Patent Office unless and until the United Kingdom Ministry of Defence gave notice to the United Kingdom Patent Office that the "secrecy direction" could be revoked.
- III. With the full co-operation of the appellant's representative, the process of inspection of the application by the United Kingdom Ministry of Defence was accelerated, a copy of the specification and drawings being delivered by hand to the Ministry on 21 September 1979.
- IV. The "secrecy direction" was subsequently revoked and the notice informing the appellant that this had been done was issued on 29 October 1979. By letter dated 30 October 1979, the United Kingdom Patent Office informed the Receiving Section of the European Patent Office that the application "would now be forwarded" to the Receiving Section "in the normal way". This letter was received by the European Patent Office on 2 November 1979. The application itself arrived there on 5 November 1979.
- V. Article 77(1) EPC obliges the central industrial property office of a Contracting State to forward to the European Patent Office, in the shortest possible time any European patent applications which have been filed with that office.

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In accordance with Article 77(3) EPC, European patent applications which require "further examination as to their liability to secrecy" shall be forwarded in such manner as to reach the European Patent Office, where priority has been claimed, within fourteen months after the date of priority. As the period of fourteen months had expired on 29 October 1979, the Receiving Section issued a notice in accordance with Rule 69(1) EPC on 16 November 1979, that, pursuant to Article 77(5) EPC, the application was deemed to be withdrawn. This notice was received by the appellant's representative on 19 November 1979.

- VI. The appellant applied, by letter dated 22 November 1979, for restitution of rights pursuant to Article 122 EPC.
- VII. The Receiving Section of the European Patent Office issued a decision dated 21 December 1979, rejecting the application for restitution of rights on the single ground that Article 122 EPC provides only for restoration of rights where there has been failure to observe a time limit which it is for the applicant to observe, whereas the time limit not observed in the present case was one which it was for the United Kingdom Patent Office to observe.
- VIII. In this appeal, the appellant requests reversal of the decision and restitutio in integrum of the patent application or such other relief as to set aside deemed withdrawal of the patent application and to enable the patent application to proceed. The appellant also requests reimbursement of the appeal fee.
- IX. The notice of appeal and grounds of appeal, dated 18 January 1980, were received on 21 January 1980 and the appeal fee was duly paid.
- X. The appellant contends on the appeal:
  - i) that it took all due care to ensure that the time limits could be complied with
  - ii) that it could not fulfil or cause the United Kingdom or its Patent Office to fulfil its obligations under Article 77 EPC

- iii) that the delay in receipt of the application by the Receiving Section of the European Patent Office was not foreseeable by the appellant
- iv) that it would have been possible for the application to have been forwarded earlier than it was and so reach the European Patent Office in time
- v) that the failure of the United Kingdom to fulfil its treaty obligations under Article 77 EPC was not a consequence of any failure on the part of the appellant or its representative
- vi) that the delay was of the order of a few days only
- vii) that, in all the circumstances, the case deserves special consideration.

XI. The appellant further contends that Article 122 EPC is applicable, because:

- i) on its proper interpretation, Article 77(3) EPC does not attribute responsibility for forwarding applications to any specific party
- ii) applicants have overall responsibility for observance of the time limit of Article 77(3) EPC, since they can influence (and, in the present case, did influence) the course of the process of "further examination" as to secrecy
- iii) the grant of restitution would not affect third parties or be in conflict with other provisions of the European Patent Convention
- iv) alternatively or additionally, where time limits have not been observed but the applicants are not at fault, it is within the spirit of Article 122 EPC to permit restoration of rights. In particular, Article 122(5) EPC does not exclude cases of failure to observe Article 77 EPC

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rules 1(1) and 64 EPC and is therefore admissible.
2. While it is clear that the appellant and its representative were in no way responsible for what has happened and did all they could to see that it did not happen, it is, however, not possible to interpret the provisions of either Article 77 EPC or Article 122 EPC in the manner contended for or in any other way that would entitle the appellant to succeed on this appeal.
3. The appellant does not contest the proposition of the Receiving Section that Article 122(1) EPC refers to a time limit for the observation of which vis-à-vis the European Patent Office the applicant for or proprietor of a European patent is responsible. That proposition is plainly correct.
4. The appellant asserts that Article 77(3) EPC, in contrast to Article 77(1) and (2) EPC, does not attribute responsibility for forwarding applications to any specific party and that the applicant has overall responsibility for observance of the relevant time limits. This assertion cannot be accepted. The obligation to forward European patent applications filed nationally to the European Patent Office rests, and rests alone, upon the relevant central industrial property office, in accordance with Article 77(1) EPC, to which the provisions of Article 77(3) EPC are merely supplementary. The central industrial property office is in no sense the agent of the applicant, so far as concerns the forwarding of the application. It follows that the appellant cannot bring itself within the language of Article 122(1) by any argument that it had responsibility for forwarding the application.
5. It is clear from the provisions of Article 77(5) EPC, taken together with Articles 135(1)(a) and 136(2) EPC, that an applicant who suffers the misfortune suffered by the present appellant should not be entitled to claim

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restitution of rights under Article 122 EPC. On the contrary, Article 77(5) EPC expressly provides for refund of the filing, search and designation fees and Articles 135 (1) (a) and 136(2) EPC provide facilities for conversion to national patent applications on request filed within three months after notification has been made that the European patent application is deemed to be withdrawn. It follows that there is no scope for an argument that the spirit of Article 122 EPC should be invoked: specific alternatives to restoration of rights are provided.

6. It is, of course, true, as Mathély has pointed out ("Le droit européen des brevets d'invention" Librairie du Journal des Notaires et des Avocats, Paris 1978, p. 244), that the sanction of Article 77(5) EPC is grave, because it is imposed on the applicant for a default for which he is not responsible, but neither Mathély nor any other author whose writings are known to the Legal Board of Appeal, suggests that Article 122 EPC is applicable to relieve the applicant in such circumstances as those of the present case. Van Empel ("The Granting of European Patents" Sijthoff, Leyden 1975, para. 382) observes that once the time limit referred to in Article 77(5) has expired without the European application reaching the European Patent Office, the applicant's "only hope" for obtaining a patent resides in the possibility of conversion of the European application into national ones.
7. Van Empel also rightly points out that the loss of the European application represents a loss to the applicant. In the present case, the extra expenses incidental to conversion are likely to be considerable as no fewer than nine national applications would have to be made to secure the applicant's lost position. However, any complaint or claim for compensation against a national authority is a matter for national law exclusively. Some of the appellant's submissions in this appeal may be relevant to such a complaint or claim but are not relevant to the matters with which this Board has to deal.

8. In the circumstances, the Decision of the Receiving Section was correct in all respects and must be affirmed.
9. The appellant's claim for reimbursement of the appeal fee cannot be allowed in accordance with Rule 67 EPC, as the appeal fails.

For these reasons,

it is decided that:

The appeal against the Decision of the Receiving Section of the European Patent Office dated 21 December 1979 and the claim for reimbursement of the appeal fee are rejected.