

Aktenzeichen: J 07/82
Case Number:
N° du recours :

82,391

ENTSCHEIDUNG / DECISION
vom / of / du 23 July 1982

Anmelder: CATALDO, T. R.
Applicant:
Demandeur :

Stichwort: cause of non-compliance / Cataldo
Headword:
Référence :

EPÜ/EPC/CBE Articles 113(1), 114(1), 122; Rule 67
PCT Article 22(1)

"re-establishment of rights" - "cause of non-compliance with the time limit" - "decision based on ground on which party had no opportunity to present his comments" - "substantial procedural violation" - "reimbursement of appeal fee"

Leitsatz / Headnote / Sommaire

- I. The provisions of Rule 78(2) EPC, last sentence, which deem postal notifications to have been made when despatch has taken place, do not apply in a case in which the receipt of a notification under Rule 69(1) PEC is relevant to the question when the cause of non-compliance with a time limit has been removed, for the purposes of Article 122 EPC. In such a case, the significant date is the date of actual receipt by the applicant.
- II. If a decision does not take into account arguments submitted by a party and is based on a ground on which the party had no opportunity to present his comments, this is a substantial procedural violation.
- III. Reimbursement of the appeal fee may be ordered pursuant to Rule 67 EPC, even though reimbursement has not been applied for, if the conditions laid down in that rule are fulfilled.

Europäisches
Patentamt

Juristische
Beschwerdekammer

European Patent
Office

Legal Board
of Appeal

Office européen
des brevets

Chambre de
recours juridique



Case No. J 07/82

DECISION
of 23 July 1982

Appellant:

CATALDO, T. R.
5169 Princess Anne Road
La Canada
California 91011
USA

Representative:

Bowman, Paul Alan
Lloyd Wise, Tregear & Co.,
Norman House,
105-109 Strand,
GB London WC2R OAE

Decision under appeal:

Decision of the Receiving Section
of the European Patent Office dated
29 December 1981 that an application
for re-establishment of rights in
European patent application
No. 79901231.5 pursuant to Article 122
was inadmissible.

Composition of the Board:

R. Singer, Chairman
P. Ford, Member
L. Gotti Porcinari, Member

SUMMARY OF FACTS AND SUBMISSIONS

- I. On 6 September 1979, the appellant filed International Application No. 79901231.5 under the Patent Cooperation Treaty in the United States of America, claiming priority from an application for a US national patent filed on 6 September 1978 and designating eight contracting States of the European Patent Convention as States for which a European patent was desired.
- II. The national fee, the search fee and the designation fees were not paid within the periods prescribed by Article 22 (1) 3 PCT and Rule 104 b (1) EPC, which expired on 6 June 1980.
- III. By a communication dated 5 August 1980, the Receiving Section of the EPO informed the appellant, pursuant to Rule 69 (1) EPC, that the application was deemed to have been withdrawn on account of failure to pay those fees within one month after expiry of the time limit laid down in Article 22 (1) PCT.
- IV. The appellant did not ask for a decision under Rule 69 (2) EPC but, on 9 June 1981, the appellant's European professional representative applied under Article 122 EPC for re-establishment of the appellant's rights, after paying the amount of the unpaid fees and the fee for re-establishment of rights on 5 June 1981. The time limit for the application for re-establishment of rights in accordance with Article 122 (2) EPC, third sentence, would ordinarily have expired on 6 June 1981, but was extended by virtue of Rule 85 (1) EPC to the next business day, 9 June 1981.
- V. The appellant's Statement of Case in support of the application for re-establishment of rights alleged that he had been unable to observe the time limit for payment of the national fee, the search fee and the designation fees because he had been unable to obtain the necessary financial resources. He had subsequently been lent the money by the firm of U.S. attorneys who were

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seeking to help him to finance the development and marketing of his invention by offering shares in his company to the public. For present purposes it is not necessary to summarize the appellant's other submissions or the contents of the declarations filed in support of the application for re-establishment of rights.

VI. By the decision under appeal, given by the Receiving Section of the EPO on 29 December 1981, it was held that the application for re-establishment of rights was inadmissible.

The application for re-establishment of rights was held to be inadmissible on the ground that it should have been filed at the latest on 6 October 1980, since, in the opinion of the Receiving Section, the period of two months from the removal of the cause of non-compliance with the time limit prescribed by Article 122 (2) EPC, first sentence, had to be calculated from the date of the communication given pursuant to Rule 69 (1) EPC.

VII. On 4 March 1982, the appellant's representative filed a Notice of Appeal against the decision of the Receiving Section, submitting that the decision was wrong in law and contrary to the provisions of the EPC and that the cause of non-compliance with the time-limit prescribed by Article 122 (2) EPC was the appellant's lack of funds, which cause had not been removed until June 1981. Accordingly, the appellant submitted that the application for re-establishment of rights was admissible and should be considered on its merits. The appeal fee was duly paid.

VIII. On 19 April 1982, the appellant's representative filed Grounds of Appeal, accompanied by copies of the declarations previously submitted in support of the application for re-establishment of rights. In the Grounds of Appeal, the appellant repeated that the cause of non-compliance with the time-limit for payment of fees had been lack of funds and not, as had been apparently

assumed by the Receiving Section, ignorance of the time-limit. It was submitted that the appellant had been extremely diligent in seeking to obtain adequate finance and that for reasons beyond his control he had been unable to make the application for re-establishment of rights until June 1981.

REASONS FOR THE DECISION

1. The appeal complies with Articles 106-108 and Rule 64 EPC and is therefore admissible.
2. According to the appellant's submission, the cause of non-compliance with the time limit referred to in Article 122 (2) EPC, first sentence, was his lack of funds. The Receiving Section decided that the requirement of Article 122 (2) EPC, first sentence, had not been fulfilled, without any reference to the appellant's submission.
3. It is impossible to decide what is the cause of non-compliance with a time limit without considering the facts of each case. In many cases it may well be the fact that a time limit is not complied with through ignorance of it, or inadvertence, so that receipt of a notification under Rule 69 (1) EPC can be regarded as removal of the cause of non-compliance but, in the present case, this was not so.
4. It should be observed that in a case in which receipt of a notification under Rule 69 (1) EPC is relevant, for the purpose of Article 122 (2) EPC, it is the fact of actual receipt by the applicant which is significant, not, as was considered in this case, the fact of despatch of the notification by the EPO.

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5. It follows that the decision under appeal must be set aside and that the case must be remitted to the Receiving Section for a decision on its merits.

6. As the decision under appeal did not take into account any of the arguments submitted by the appellant and was based on a ground on which the appellant had had no opportunity to present his comments (cf. Article 113(1) EPC), it is clearly equitable to order reimbursement of the appeal fee, pursuant to Rule 67 EPC. Even though the appellant has not made application therefor, the Legal Board of Appeal can order reimbursement, as it is not restricted by the relief sought: cf. Article 114 (1) EPC.

For these reasons,

it is decided that:

1. The decision of the Receiving Section of the European Patent Office dated 29 December 1981 that an application for re-establishment of rights in European patent application No. 79901231.5 was inadmissible is set aside and the case is remitted to the Receiving Section to be considered on its merits.

2. Reimbursement of the appeal fee is ordered.