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Anmeldenummer / Filing No / N^o de la demande : 85 304 874.2
Veröffentlichungs-Nr. / Publication No / N^o de la publication :

Bezeichnung der Erfindung: Process for reducing the nitrate content
Title of invention: in water
Titre de l'invention :

Klassifikation / Classification / Classement : not classified

ENTSCHEIDUNG / DECISION

vom / of / du 6 August 1986

Anmelder / Applicant / Demandeur : SOLT, George Stefan and
KLAPWIJK, Abraham

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Filing, search, designation fees/non
correctable deficiencies/reminder from
EPO/restitutio in integrum
EPÜ / EPC / CBE Articles 78(2), 79(2), 90, 91, 122(5) and
Rule 85(a) EPC

Leitsatz / Headnote / Sommaire

A European patent application for which no filing, search and designation fees were paid in due time shall be deemed to be withdrawn (Art. 90(3), 91(4) EPC). The non-payment of these fees is not a correctable deficiency under Art. 91(2) EPC, which the EPO has to give the applicant an opportunity to correct. Thus, the appellants cannot derive any right from the non-issuance of a reminder by the EPO and restitutio in integrum is excluded by Art. 122(5) EPC whether or not such reminder has been sent.

Europäisches
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Beschwerdekammern

European Patent
Office

Boards of Appeal

Office européen
des brevets

Chambres de recours



Case Number : J 11 / 86

D E C I S I O N
of the Legal Board of Appeal
of 6 August 1986

Appellant : SOLT, George Stefan
Hollington Wood,
Emberton, Olney,
GB-Buckinghamshire MK46 5JH

KLAPWIJK, Abraham
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Representative : Shipley, Warrwick Grenville Michael
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Decision under appeal : Decision of the Receiving Section of the
European Patent Office dated 12 February 1986
rejecting an application for re-establishment
of rights in respect of European patent
application No. 85 304 874.2

Composition of the Board :

Chairman : P. Ford
Member : C. Payraudeau
Member : R. Schulte

Summary of Facts and Submissions

- I. On 9 July 1985, the appellants filed European patent application No. 85 304 874.2 claiming priority from a British national patent application filed on 10 July 1984.
- II. On 5 November 1985, a Formalities Officer of the Receiving Section of the EPO issued a notification pursuant to Articles 90(3) and 91(4) EPC informing the appellants that the European patent application was deemed to be withdrawn because no filing fee, no search fee and no designation fee had been paid with the time limits pursuant to Articles 78(2), 79(2) and Rule 85(a) EPC.
- III. On 18 November 1985, the appellants applied under Article 122 for re-establishment of their rights after having paid the amount of the unpaid fees (however without the surcharges provided for in Rule 85(a) EPC) and the fee for re-establishment of rights on 13 November 1985.
- IV. In their statement of case in support of the application for re-establishment of rights and in their further correspondence with the Receiving Section of the EPO, the appellants alleged that they had not been given an opportunity to correct the non-payment of the fees in accordance with Articles 90 and 91 EPC and had not received any communication according to Rule 41 EPC.

The appellants contended that whilst Article 78 EPC (which relates to the normal period for payment of the fees) is excluded from Article 122 EPC, the requirements of Article 90 and 91 EPC were not so excluded. The EPO was under the obligation by virtue of Article 91(2) EPC to give the applicant an opportunity to correct the deficiencies which may be corrected and the non-payment of these fees was, in their opinion, such a deficiency. Since the

appellants had not paid the fees because they had not received any such notification, they were entitled to restore the European patent application under Article 122 EPC. For this reason, the appellants had not paid the extension fee payable under Rule 85(a) EPC since this did not apply in this instance.

V. By the decision under appeal, given by the Receiving Section of the EPO on 12 February 1986, the application for re-establishment of rights was rejected on the ground that Article 122(5) EPC excluded *restitutio in integrum* where the time limits provided for in Article 78(2) and 79(2) EPC are not observed. This was also applicable to the period of grace laid down in Rule 85(a) EPC and the applicants could derive no claim in respect of the omission of the notification usually sent by the EPO drawing attention to the fact that the fees have not been paid in time, but may still be paid with a surcharge, because this notification was only a voluntary service of the EPO.

VI. In their grounds of appeal and in their answer to a communication from the Rapporteur of the Legal Board of appeal, the appellants essentially repeated their submission that the EPO was under the obligation pursuant to Article 91(2) EPC to notify the applicant of the non-payment of the filing, search and designation fees which, according to them, was a correctable deficiency and that, in the absence of such notification, the appellants were entitled to restore the European patent application by virtue of Article 122 EPC since the provisions of Articles 90 and 91 EPC were not excluded from the scope of Article 122.

The appellants explained also that the reason why they had not paid the fees was a clerical error due to the introduction in their office of a computerised office management system.

Reasons for the decision

1. The appeal complies with Article 106-108 and Rule 64 EPC and is therefore admissible.
2. Article 122(5) EPC expressly excludes *restitutio in integrum* for the non-payment of the filing, search and designation fees within the time limits set up in Articles 78(2) and 79(2) EPC. This express exclusion formulated with regard to the non-payment of these fees within the normal time limit also applies in the event of their not being paid within the period of grace provided for in Rule 85(a) EPC, for the obvious reason that to concede that *restitutio in integrum* applies to the non-observance of this above-mentioned period would allow the unequivocal prohibition contained in Article 122(5) to be evaded (J 12/82 OJ EPO 1983, p.221, J 18/82 OJ EPO 1983, p.441).
3. The appellants have not contested this interpretation of the European Patent Convention but have contended that the EPO was under the obligation pursuant to Articles 90(1)(b) and 91(e) EPC to examine whether the filing, search and designation fees had been paid in due time and if not, to give the applicant an opportunity to correct this deficiency by virtue of Article 91(2) EPC. In the absence of a notification from EPO to this effect, the appellants were entitled to restore their application under Article 122 EPC.
4. However, the Board cannot accept the argumentation presented by the appellant, for the following reasons:

The non-payment of the filing, search and designation fees cannot be considered as a deficiency correctable under Article 91(2) EPC since it is clearly stipulated in Articles 90(3) and 91(4) EPC that in case of non-payment of

these fees in due time the European patent application and/or the designation(s) shall be deemed to be withdrawn.

The EPO can only establish that these fees have not been paid in due time and that, consequently, the application is deemed to be withdrawn.

It is true that in order to alleviate the severity of Articles 78(2), 79(2), 90(3) and 91(4) EPC, the Administrative Council added on 30 November 1979 Rule 85(a) which permits late payment of these fees with a surcharge within a two-month period of grace after expiry of the one month period of Articles 78(2) and 79(2) EPC. It is also true that a reminder would be useful for the applicant but it is only a voluntary service of the EPO and the appellants cannot derive any right from its omission. Any other interpretation of Rule 85(a) EPC would be in direct contravention of the above-mentioned dispositions of Articles 78(2), 79(2), 90(3) and 91(4) EPC and also by implication, with those of Article 122(5) (see point 1 above).

5. Accordingly, since it has been established that the appellants have not paid the filing, search and designation fees within the period provided for in Articles 78(2) and 79(2) and in Rule 85(a) EPC the above-mentioned European patent application has been rightly deemed to be withdrawn by the Receiving Section of the EPO by virtue of Articles 90(3) and 91(4) EPC. Moreover, the present application for re-establishment of rights is inconsistent with the provisions of Article 122(5) EPC and has to be rejected.

O R D E R

For these reasons,

it is ordered that

the appeal against the decision of the Receiving Section of the European Patent Office dated 12 February 1986 is dismissed.

The Registrar

The Chairman

B A Norman

P Ford