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Aktenzeichen / Case Number / N° du recours : J 22/86
Anmeldenummer / Filing No / N° de la demande : 81 305 646.2
Veröffentlichungs-Nr. / Publication No / N° de la publication : 53 903

Bezeichnung der Erfindung: Oral prothesis and method for producing same
Title of invention: [✓]
Titre de l'invention: ↙

Klassifikation / Classification / Classement : A 61 C 8/00

ENTSCHEIDUNG / DECISION

vom / of / du

7 February 1987

Anmelder / Applicant / Demandeur :

MEDICAL BIOLOGICAL SCIENCES

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

Disapproval/MEDICAL BIOLOGICAL

EPO / EPC / CBE

Arts. 97, 100, 108, 109, 113(2), 122, 123, 138 EPC;
Rules 51(4) and (5), 64, 65, 67, 86, 88 EPC

Kennwort / Keyword / Mot clé :

"Admissibility of appeal" - "absolute time
limit for grant and printing fees" - "no express disapproval of text"
- "application deemed to be withdrawn" - "no power to issue decision
refusing application" - "application for re-establishment allowed"

Leitsatz / Headnote / Sommaire

- I. In order to comply with Article 108 EPC, the written statement setting out grounds of appeal should set out fully the reasons why the appeal should be allowed and the decision under appeal should be set aside. Exceptionally, where the written statement does not contain such full reasons, the requirement for admissibility may be regarded as satisfied if it is immediately apparent upon reading the decision under appeal and the written statement that the decision should be set aside.

- II. If, following a communication under Rule 51(4) EPC, first sentence, the applicant does not expressly communicate his disapproval of the proposed text within the specified three month period, the provisions in the second sentence of Rule 51(4) EPC that the communication of the Examining Division shall be deemed not to have been made, and that examination shall be resumed cannot come into effect. Decision J 12/83 "Inadmissibility appeal/Chugai Seiyaku", paragraph 5, OJ EPO 1/1985, page 6, followed.

III. If, following a communication under Rule 51(4) EPC, first sentence, within the specified three month period the applicant does not communicate his disapproval of the proposed text and does not pay the fees for grant and printing and file translations of the claims as requested in such communication, the application shall be deemed to be withdrawn immediately upon expiry of such three month period. Consequently, following expiry of that period, the Examining Division has no power to issue a decision refusing the application pursuant to Article 97(1) EPC.



Case Number : J 22/86

D E C I S I O N
of the Legal Board of Appeal
of 7 February 1987

Appellant : MEDICAL BIOLOGICAL SCIENCES INC.
200 Central Park South
New York, New York 10019
USA

Representative : McCallum, William Potter
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Decision under appeal : Decision of the Head of the Formalities
Section of the European Patent Office
dated 10 February 1986 refusing European
Patent Application No. 81 305 646.2
pursuant to Article 97(1) EPC.

Composition of the Board :

Chairman : P. Ford
Member : G.D. Paterson
Member : O. Bossung

Summary of Facts and Submissions

- I. European patent application No. 81 305 646.2 was filed on 30 November 1981. After examination, the Examining Division sent an Advance Notice (Form 2004) of their intention to grant a European patent to the Applicant's representative on 19 December 1984. A proposed text for the application was sent with the Advance Notice. The Advance Notice stated that "If no objection is made within a period of two months or if approval is signified before the expiry of that period, the communication will be issued pursuant to Rule 51(4) and (5) EPC". The Applicant then requested amendments to the claims which were refused in a communication dated 8 May 1985, in which the Applicant was also asked to request grant of a patent with a text as enclosed with the Advance Notice. The Applicant duly gave his approval to such text in a letter dated 2 September 1985.
- II. On 26 September 1985 a Communication pursuant to Rule 51(4) and (5) EPC (Form 2005) was sent to the Applicant, which stated as conditions for the grant of the patent that if the Applicant approved the above text, he was "requested within three months to pay the fees for grant and printing, and to file a translation of the claims". During such three months period, such fees were not paid, a translation of the claims was not filed, and no communication of any sort took place between the Applicant and the Examining Division.
- III. On 10 February 1986, the Formalities Section of the Examining Division issued a Decision, by which the European application was refused "in pursuance of Article 97(1) combined with Article 97(2) and Article 113(2) of the EPC". The reasons for the Decision were stated as follows:

"The communication in accordance with Rule 51(4) of the EPC, dated 26.09.85, invited the applicant to declare his approval of the proposed text, to pay the fees for grant and printing and to file translations of the claims. As of this date, approval has not been declared, neither have the other requirements been met. The European Patent Application does not conform to the requirements of the EPC, on account of the lack of approval of the text provided."

- IV. On 29 March 1986 the Applicant filed a Notice of Appeal, which (in addition to setting out information as required by Rule 64 EPC) contained the following statement:

"It is requested that the application be restored to enable further processing to be carried out with the object of securing the grant of a patent."

The appeal fee was duly paid.

No further statement was filed within the four month period provided by Article 108 EPC.

- V. In a letter dated 22 August 1986, the Appellant's representative submitted:

(i) that the statement quoted in paragraph IV above constituted the Statement of Grounds of Appeal and quite clearly constituted the grounds relevant to the appeal;

(ii) that in view of the established procedure in the EPO, whereby failure to respond to the communication under Rule 51(4) EPC afforded an automatic extension of time, the Appellant elected to delay filing claims and fees;

- (iii) that in reliance upon paragraph 13.2.2 of the European Patents Handbook, they were still awaiting a new communication under Rule 51(4) EPC establishing new time limits for payment of the grant and printing fees and filing translations of the claims;
- (iv) that such Handbook stated at paragraph 13.2.2 that if such fees were paid and translations filed within 2 months of notification of refusal, the appeal will be granted without the need for grounds of appeal;
- (v) that in the light of the above, the appeal procedure in the present circumstances was clearly intended to be essentially formal in nature.

VI. On 6 September 1986 the Appellant paid the fees for grant and printing and filed translations of the claims.

VII. On 17 October 1986 the Appellant filed an application for *restitutio in integrum* under Article 122 EPC in respect of the failure to observe the time limit for complying with the formal requirements of Rule 51(4) EPC.

Reasons for the Decision

Admissibility of the appeal

1. The first question to be decided is whether or not the appeal is admissible, having regard to the requirements of Article 108 EPC. It is to be noted that Article 108 EPC is mandatory in its requirement that "a written statement setting out the grounds of appeal must be filed" within four months after notification of the decision from which appeal lies, and that Rule 65(1) EPC is mandatory in its requirement that "the Board of Appeal shall reject (the appeal) as inadmissible", if it does not comply *inter alia*

with Article 108 EPC within the relevant time limit laid down in that Article. Furthermore, Article 109 EPC does not allow rectification of a decision by a department whose decision is contested unless the appeal is considered by that department to be admissible (i.e. inter alia to satisfy the requirements of Article 108 EPC); and Article 110(1) EPC requires that an appeal is admissible before the Board of Appeal can examine whether it is allowable.

Thus no appeal can be allowed unless it satisfies inter alia all the requirements for admissibility set out in Article 108 EPC; in particular, no appeal can in any circumstance be allowed unless a Statement of Grounds of Appeal has been filed within the specified four months time limit. (Such a Statement can, of course, be incorporated in the document which constitutes the Notice of Appeal).

It follows that insofar as any publication suggests that an appeal could be allowed, either under Article 109 EPC or under Articles 110 and 111 EPC, without the need for filing a Statement of Grounds of Appeal in accordance with Article 108 EPC, it must be wrong.

2. The requirement of Article 108 EPC for "a written statement setting out the grounds of appeal" is clearly in addition to the requirement for a "notice of appeal". The requirements for a notice of appeal are set out in Rule 64 EPC, and are essentially formal in nature. In contrast, the requirement for a written Statement "setting out the grounds of appeal" is clearly not merely formal, but involves a presentation of the Appellant's case. That this was intended by the Convention is also supported by the fact that an extra two months is allowed for the filing of the Statement.

The requirement of Article 108 EPC is for a statement which sets out the substance of the Appellant's case; that is, the reasons why the appeal should be allowed and the decision under appeal should be set aside. As recommended in the officially published "Guidance for Appellants and their Representatives" (OJ EPO 6/1981, 176 and 8/1984, 376, at Section 1.3), a well-drafted Statement of Grounds of Appeal should contain reasoning that is full but concise. And, in general, it is obvious that the less reasoning that a Statement contains, the greater will be the risk that the appeal will be rejected as inadmissible for non-compliance with Article 108 EPC.

The question whether a particular statement alleged to be a Statement of Grounds of Appeal in a particular case meets the minimum requirement of Article 108 EPC can only be decided in the context of that particular case; and the context of a particular case will normally include the contents of the decision under appeal. In a wholly exceptional case such as the present, it may be immediately apparent to the Board of Appeal upon reading the decision under appeal and the Statement of Grounds of Appeal that such decision cannot properly be supported, even though the grounds contained in such statement can fairly be described as minimal. This is the situation in the present case, for the reasons set out below. Therefore, this Board has decided that the statement which was filed in the present case satisfies the final sentence of Article 108 EPC. Consequently the appeal is admissible.

Allowability of the appeal

3. Article 97(2) EPC is concerned with the situation when "the Examining Division is of the opinion that the application and the invention to which it relates meets the requirements" of the EPC. This was the situation in the present

case. In accordance with the usual practice, an "Advance Notice" (Form 2004) was duly sent. Subsequently, as set out in paragraph II above and also in accordance with the usual practice, a "Communication pursuant to Rule 51(4) and (5) EPC" (Form 2005) was sent. This Communication was in accordance with the first sentence of Rule 51(4) EPC, this being the Rule in the Implementing Regulations which sets out the procedure to be followed in connection with the provisions of Article 97(2) EPC.

4. The second sentence of Rule 51(4) EPC states as follows:

"If the Applicant has communicated his disapproval of the patent being granted on the basis of this text within that period (i.e. the three months period for paying the fees for grant and printing and for filing a translation of the claims which is prescribed by the first sentences of Rule 51(4) EPC), the communication of the Examining Division shall be deemed not to have been made, and the examination shall be resumed".

The question arises as to what is meant by "communication of disapproval of the patent being granted on the basis of this text", in this context. The answer to this question is clearly related to the provision in Article 113(2) EPC, which states: "The European Patent Office shall consider and decide upon the European patent application of the European patent only in the text submitted to it, or agreed, by the Applicant for or proprietor of the patent".

In the Board's view, "disapproval" of a text pursuant to Rule 51(4) EPC, second sentence, must be distinguished from a proposal to amend the text of the application. Amendment of the text of an application (in the sense of a proposed change of wording from what has previously been submitted or agreed by the Appellant) can only take place in

accordance with the provisions of Article 123 EPC and Rules 86 to 88 EPC. After the sending of a communication pursuant to Rule 51(4) and (5) EPC, a proposal by the Applicant to amend the text could only be considered under the provisions of Rule 86(3) or Rule 88 EPC. In contrast, the opportunity provided to an Applicant by Rule 51(4) EPC to "disapprove" of the text in which the Examining Division intends to grant the patent is clearly intended to provide the Applicant with a final chance to check that the provisions of Article 113(2) EPC are satisfied; i.e. that the text proposed by the Examining Division conforms exactly with the text which the Applicant has submitted, or to which the Applicant agrees. If there is a disconformity in this respect, pursuant to Rule 51(4) EPC, second sentence, the Applicant must tell the Examining Division that he disapproves of the text which the latter has proposed, and why he disapproves. Examination must then be resumed, in order to check whether or not the text proposed by the Examining Division conforms with the text which has been "submitted to it, or agreed, by the Applicant".

This interpretation is fully consistent with the view taken by M. van Empel in his book "The Granting of European Patents" (A.W. Sijthoff-Leyden, 1975). At page 213, under the heading "Grant of the European Patent", it is stated in paragraph 457:

"If, on the contrary, the Examining Division is of the opinion that the application and the invention as such meet the requirements of the Convention, the first thing it has to do is to make absolutely sure that the text in which it intends to grant the patent is approved by the applicant (Article 97(2)(a)). It should be recalled that the EPO may break off its dialogue with the applicant in a negative sense - by refusing the application - but never in a positive sense, by imposing a text on the applicant. To

this effect the envisaged text shall be transmitted to the applicant, who then disposes of three months for stating his disapproval, if any (Rule 51(4)). If he does so, the examination shall be resumed. If not, he must pay within the same period the fees for grant and printing and file a translation of the claims in the two EPO languages other than the language of the proceedings (Article 97(2)(b) and (5) and Rule 51(4))".

With reference to the drawing up of Rule 51(4), a footnote states:

"When drawing up this provision, the Working Party concerned agreed "that the applicant should state his grounds for disapproving the intended form of the grant of the patent" (see doc. BR/177/72, no. 58)".

Thus in a particular case an Applicant may communicate his disapproval of the text proposed by the Examining Division, and suggest a change of wording in such text. When resuming examination and dealing with this request, the Examining Division may have to undertake two distinct enquiries:

(i) Is the Applicant correct in suggesting that the text which has been proposed by the Examining Division differs from what has been "submitted to it, or agreed, by the Applicant"? If yes, then a further communication under Rule 51(4) EPC would be sent, accompanied by a revised text. But if the Applicant is not correct in that suggestion:

(ii) should the proposed change of wording be considered as an application to amend under Article 123 and Rules 86 to 88 EPC, and if so is the application to amend allowable under such provisions?

5. The above interpretation of Article 97 and Rule 51(4) EPC is also consistent with the preparatory documents for the EPC. Thus the Minutes of the 9th Meeting of Working Party I held from 12 to 22 October 1971 in Luxembourg contain the following discussion in relation to Article 97 EPC:

"As a result of an observation by the United Kingdom delegation, the Working Party agreed that paragraph 2 should be amended to the effect that in the event of the applicant not agreeing with the text in which the Examining Division intended to grant the European patent, the period of one month for the payment of the fees for grant and printing should be suspended to allow him to submit observations and any amendments to the text he might propose. If the period had not been suspended, the interpretation could not have been excluded that, in accordance with paragraph 2, the European patent application had been deemed to be withdrawn at the end of one month, even if the applicant had submitted his observations and amendments in the meantime. It also had to be ensured that Article 97 complied with the principle set out in Article 144 that the European Patent Office might decide upon the application only in the text submitted or agreed by the applicant."

The Article 144 referred to subsequently became Article 113 EPC.

6. It follows from what has just been set out that a communication of "disapproval" by an Applicant pursuant to Rule 51(4) EPC, second sentence, must be an express communication of disapproval. This is in any event clear from the use of the word "communicate", which in this context requires an active step of communication by the applicant to the Examining Division. Silence and inactivity

do not constitute communication. In this respect, this Board follows the Decision of the Legal Board of Appeal in J 12/83, "Inadmissible appeal/Chugai Seiyaku" paragraph 5 (OJ EPO 1/1985, page 6).

It also follows from what is set out above that in the absence of communicated "disapproval" as just interpreted, there is no basis in the EPC either for deeming the Communication under Rule 51(4) EPC not to have been made, or for sending a further communication under Rule 51(4) EPC.

7. In the present case, as set out in paragraph II above, no communication of his approval of the text was made by the Applicant to the Examining Division within the three months period provided by the Communication pursuant to Rule 51(4) and (5) EPC dated 26 September 1985. Thus the provision in the second sentence of Rule 51(4) EPC was not brought into effect.
8. Article 97(3) EPC provides that "If the fees for grant and printing are not paid in due time, the application shall be deemed to be withdrawn". In the present case, again as set out in paragraph II above, such fees were not paid within the prescribed three months period. They were therefore "not paid in due time". It follows inevitably, in accordance with the EPC, that (subject to any application under Article 122 EPC) the application must be "deemed to be withdrawn". (This provision in Article 97(3) EPC is directly comparable to the provision in Article 90(3) EPC in respect of the filing and search fees, for example, and under Article 90(3) EPC the practice has always been that failure to pay the filing and search fees in due time results in the application being deemed to be withdrawn).

Similarly, Article 97(5) EPC provides that "If the translation has not been filed in due time the application shall be deemed to be withdrawn." Translations were not filed within the prescribed three month period. For this reason also, the application must therefore be "deemed to be withdrawn" (again subject to Article 122 EPC).

9. It also follows from what has been set out in paragraphs 4 to 6 above that the Examining Division had no power to issue its Decision dated 10 February 1986 by which "the application was refused" pursuant to Article 97(1) EPC. As soon as the three months period provided by the Communication dated 26 September 1985 expired, i.e. on 6 January 1986, the application automatically became "deemed to be withdrawn" by operation of law in accordance with Article 97(3) EPC (subject to any application for re-establishment of rights under Article 122 EPC as to which, see paragraph 14 below). Thus at the date of the Decision of the Formalities Section of the Examining Division, this application no longer existed as a proceeding before the EPO with respect to which any decision could be made. In particular, as the application no longer existed, the Examining Division had no power to "refuse" it in pursuance of Article 97(1) EPC.

Furthermore, having regard in particular to what is set out in paragraphs 6 and 7 above, the conclusion set out in the final sentence of the paragraph headed "Reasons for the Decision", in the Decision dated 10 February 1986, set out in paragraph III above, is wrong.

10. The Board notes that the "Guidelines for Examination in the European Patent Office" at C.VI., paragraphs 15.4.2, 15.4.3 and 15.4.4 are inconsistent with the interpretation of Article 97(3) and Rule 51(4) EPC which is set out above. These paragraphs are as follows:

"15.4.2 If the applicant communicates his express approval of the text proposed in the communication under Rule 51, paragraph 4, but fails to pay the fees for grant or printing in due time or to file the translations of the claims in due time (see VI, 15.2), then the European application is deemed to be withdrawn.

15.4.3 Following the three-month period prescribed by Rule 51, paragraph 4, the application will be refused pursuant to Article 97, paragraph 1, in conjunction with articles 97, paragraph 2, and 113, paragraph 2, if express approval of the text proposed has not been communicated and none of the above-mentioned formal requirements has been met before issue of the decision.

15.4.4 If the above-mentioned requirements are met only in part or belatedly, but before a decision to refuse is issued (see VI, 15.4.3), then there is no tacit approval on the part of the applicant, and a further communication pursuant to Rule 51, paragraph 4, will be issued. If any outstanding requirement identified in the further communication is not complied with within the period laid down therein, the application will be refused."

11. Article 15(2) of the Rules of Procedure of the Boards of Appeal states that "If, in its decision, a Board gives a different interpretation of the Convention to that provided for in the Guidelines, it shall state the grounds for its action if it considers that this decision will be more readily understood in the light of such grounds". The grounds on which this Board has interpreted the Convention are set out above, but in order to make this Decision more

readily understood, the reasons why this Board does not agree with the interpretation of the Guidelines as reflected in the above-identified paragraphs will now be set out.

As to paragraph 15.4.2: in the Board's view, as set out specifically in paragraph 8 above, if an applicant fails either to pay the fees for grant and printing or to file translations of the claims in due time (i.e. within the three month period provided by Rule 51(4) EPC), then the application is "deemed to be withdrawn", pursuant to Article 97(3) or (5) EPC, whether or not "the applicant has communicated his express approval of the text proposed in the communication under Rule 51, paragraph 4".

As to paragraph 15.4.3:

- (i) In a case where, during the three month period provided by Rule 51(4) EPC there is silence from the applicant (no express approval, no compliance with the formal requirements of paying the grant and printing fees and filing translations of the claims), in the Board's view this cannot be construed as equivalent to communication of the applicant's disapproval of the text, such as to bring the final sentence of Rule 51(4) EPC into effect ("... the communication of the Examining Division shall be deemed not to have been made, and the examination shall be resumed"). As stated in paragraph 6 above, disapproval for the purpose of Rule 51(4) EPC must be expressed.
- (ii) Even if, contrary to the above, silence by the applicant was properly to be construed as equivalent to communication of his disapproval for the purpose of Rule 51(4) EPC, with the result that as a legal

fiction, the communication under Rule 51(4) EPC was deemed not to have been made, it would follow logically from such legal fiction that because the communication under Rule 51(4) EPC must be considered as not having been sent, there is then nothing in the file which has requested the applicant's approval or disapproval. The application and the invention to which it relates still meet the requirements of the Convention, and there is thus still no basis for refusing the application pursuant to "Article 97(1) EPC, in conjunction with Article 97(2) EPC and Article 113(2) EPC".

As to paragraph 15.4.4:

- (i) For the reason set out in (i) in relation to paragraph 15.4.3, silence during the three month period does not bring the final sentence of Rule 51(4) EPC into effect, and there is no basis for issuing a further communication pursuant to Rule 51(4) EPC. Silence in response to the communication under Rule 51(4) EPC can only result in the application being deemed to be withdrawn immediately at the end of the three month period, and this cannot be altered by the formal requirements being met belatedly.
- (ii) Similarly, partial compliance with the formal requirements of Rule 51(4) EPC during the three month period does not bring the final sentence of Rule 51(4) EPC into effect. Partial non-compliance with such formal requirements will bring either Article 97(3) or Article 97(5) EPC into operation, so that the application will be deemed to be withdrawn.

12. The practice as set out in paragraphs 15.4.3 and 15.4.4 of the Guidelines, in which, in the absence of an express approval, non-compliance with any of the formal requirements results in refusal of the application under Article 97(1) EPC rather than the application being deemed to be withdrawn, leads to a situation in which the applicant can obtain an extension of time in which to pay the fees for grant and printing and to file translations of the claims, with consequent delay in the grant. If the applicant complies with such formal requirements before a decision to refuse is issued, as envisaged in paragraph 15.4.4, the patent is eventually granted after issuance of a further communication under Rule 51(4) EPC (even though, in the case where all such formal requirements have been complied with, there is no purpose in such further communication).

If the applicant complies with such formal requirements after a decision to refuse has been issued and at the same time as he files an appeal, in accordance with the normal practice interlocutory revision takes place under Article 109 EPC. However, the practice in paragraphs 15.4.3 and 15.4.4 is based upon non-compliance with the formal requirements (in the absence of express approval) being considered as equivalent to disapproval of the text such as to bring the last sentence of Rule 51(4) EPC into effect. As discussed previously, this has the consequence that the communication under Rule 51(4) EPC is deemed not to have been made. Consequently, as pointed out by the present Appellant (see paragraph V(iii) above), there is no time limit in respect of the formal requirements with which the applicant has to comply. Thus on the basis of the practice as set out in the Guidelines, there appears to be virtually no limit derivable from the EPC to the extension of time which an applicant can obtain. For example, if (as in the present case) the applicant fails to comply with the formal

requirements either within the three month time limit, or before issuance of a decision to refuse under Article 97(1) EPC, or before filing an appeal from such decision, but eventually complies with such formal requirements at some time just before a decision in the appeal is issued, the present practice would lead such an appellant to expect the appeal to be allowed on an essentially formal basis equivalent to an interlocutory revision. This is in fact what the present Appellant expected - see paragraph V(v) above.

In the opinion of this Board, the possibility of such an extension of time for complying with the formal requirements of Rule 51(4) EPC is not envisaged by the Convention. Furthermore, such an extension of time could be to the advantage of the applicant and to the disadvantage of interested third parties who are waiting to know whether or not a patent will be granted which may restrict their activities. For this reason also the Board considers that the Convention should be interpreted as set out in paragraphs 4 to 9 above, and not as set out in the Guidelines.

It is recognized that the Board's interpretation of the Convention allows an applicant an absolute maximum of three months, following the communication under Rule 51(4) EPC, in which to comply with the formal requirements (in the absence of an express disapproval of the text as discussed in paragraphs 4 to 6 above) with the sanction of deemed withdrawal of the application in the event of non-compliance; and that the interpretation of the Convention as reflected in the Guidelines is intended to alleviate this relatively short period of time for compliance with the formal requirements. However, in the Board's view the practice of sending an "advance notice" of a communication

under Rule 51(4) EPC, as discussed in paragraph 15.4.1 of Part C, Chapter VI of the Guidelines, provides a means of alleviating the obligation of the applicant to comply with the formal requirements in such a relatively short period of time, which means is also consistent with the requirements of the Convention.

13. For the reasons set out above, in the judgement of this Board the Decision of the Formalities Section of the Examining Division dated 10 February 1986 must be set aside, and the appeal is allowed.

Reimbursement of the appeal fee

14. Consequently, the Board must consider whether the appeal fee should be reimbursed under Rule 67 EPC. In the present case, in the Board's view the procedure in accordance with which the Decision dated 10 February 1986 was issued when the patent application to which it related was deemed to have been withdrawn was incorrect. A substantial procedural violation has therefore occurred. Furthermore, in all the circumstances of this case the Board considers that reimbursement of the appeal fee is equitable.

Application for re-establishment of rights

15. In paragraphs 8 and 9 above the possibility of an application for re-establishment of rights was mentioned, in connection with the failure of the Appellant either to pay the fees for grant and printing, or to file translations of the claims, within the required three month period. In fact, as stated in paragraph VII above, such an application under Article 122 EPC was filed on 17 October 1986.

Article 122(4) EPC states that "The department competent to decide on the omitted act shall decide upon the application". In relation to the failure to pay such fees and file such translations, the Examining Division is in the first instance competent to decide upon such omitted act. However, Article 111(1) EPC states that "the Board of Appeal shall decide on the appeal. The Board of Appeal may ... exercise any power within the competence of the department which was responsible for the decision appealed...". In the circumstances of this case, the Board has decided, pursuant to Article 111(1), to exercise the power of the Examining Division to decide upon the application for *restitutio* under Article 122 EPC.

16. As regards the failure to pay the fees for grant and printing and to file translations within the three month time limit, clearly the established practice of the EPO, as set out *inter alia* in the Guidelines, envisages the possibility that such formal requirements of Rule 51(4) EPC are not complied with during the three month period, without immediate loss of rights. Thus in the present case it is clear that the Appellant was led into non-compliance with such formal requirements by the established practice. In such circumstances, in the view of the Board, the Appellant could not have been aware of the necessity for complying with such formal requirements during the three month period in order to avoid the application being deemed to be withdrawn, until receipt of this Decision. Thus for the purpose of Article 122(2) EPC notification of this Decision constitutes removal of the cause of non-compliance with the three month time limit.

In the Board's view, the application for re-establishment of rights which was in fact filed before notification of this Decision, must be regarded as having been filed within two months from the removal of the cause of non-compliance

with the time limit. The omitted acts, namely the formal requirements of Rule 51(4) EPC were also completed in due time. Furthermore, the application for re-establishment of rights was filed within the year immediately following the expiry of the unobserved time limit. Thus that application is admissible.

17. The submissions, facts and evidence filed on behalf of the Appellant in this case make it clear that the Appellant was at the relevant time fully aware of the existence of the time limit laid down by Rule 51(4) EPC, but as just previously mentioned, was led into non-compliance with the time limit by the established practice of the EPO. In this circumstance, for the purpose of Article 122(1) EPC the Board is satisfied that in spite of all due care required by the circumstances having been taken, the Appellant was unable to observe the time limit provided by Rule 51(4) EPC. It follows that in the judgement of the Board, the application should be allowed. The rights of the Appellant in respect of his patent application are thus restored.

Subsidiary observations on present practice

18. The present practice of the EPO may have led to the grant of some European patents on applications which, in accordance with the EPC as interpreted in this Decision, should have been regarded as deemed to be withdrawn, and therefore not susceptible of grant in the absence of an application for re-establishment of rights filed within the time limits of Article 122(2) EPC. It could therefore be thought that there was a defect in the grant of such patents.

In such cases, the loss of rights may have been caused by following the present practice or the need for an application for re-establishment of rights in due time may have been obscured by the present practice. In either event, re-establishment of rights which were lost by following the official published practice of the EPO could scarcely be refused, unless the application for re-establishment was barred by expiry of the time limits.

Any such cases are not relevant to the present case, in which an application for re-establishment under Article 122 EPC was made in due time. However, the fact that an application made in due time under Article 122 EPC would have led legitimately to the grant of such patents emphasizes that any defect in the granting procedure was essentially of a formal character, and such as should properly be regarded as cured by the act of grant. This view is supported by the limited scope of Articles 100 and 138 EPC as regards the grounds for challenge to granted European patents.

Order

For these reasons, it is decided that:

1. The appeal is allowed.
2. The Decision of the Formalities Section of the Examining Division dated 10 February 1986 is set aside.
3. European patent application No. 81 305 646.2 is deemed to have been withdrawn following the failure to comply with the formal requirements of Rule 51(4) EPC within the specified time limit.

4. The application for re-establishment of rights under Article 122 EPC is allowed, and therefore the rights of the Appellant in European patent application No. 81 305 646.2 are re-established.

5. The appeal fee shall be reimbursed.

The Registrar

J. P. G.

The Chairman

Peter Lind

MP
TS

Europäisches
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European Patent
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Boards of Appeal

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Case Number : J 22/86

Correction Order of 18 February 1987
to the D E C I S I O N
of the Legal Board of Appeal
of 7 February 1987

Appellant : MEDICAL BIOLOGICAL SCIENCES INC.
200 Central Park South
New York, New York 10019
USA

Representative : McCallum, William Potter
Cruikshank & Fairweather
19 Royal Exchange Square
Glasgow G1 3AE

Composition of the Board :

Chairman : P. Ford
Member : G.D. Paterson
Member : O. Bossung

In accordance with Rule 89 EPC, the Decision is amended as follows:

Page 6, line 24, delete "of", insert "or".

Page 10, line 12, delete "approval", insert "disapproval".

The Registrar:



The Chairman:

