

Veröffentlichung im Amtsblatt	Ja/Nein
Publication in the Official Journal	Yes/No
Publication au Journal Officiel	Oui/Non

Aktenzeichen / Case Number / N° du recours : J 32/86

Anmeldenummer / Filing No / N° de la demande : 83

Veröffentlichungs-Nr. / Publication No / N° de la publication : WO 84/

Bezeichnung der Erfindung: Internal combustion engine for diverse fuels
Title of invention:
Titre de l'invention :

Klassifikation / Classification / Classement : F02B 19/10

ENTSCHEIDUNG / DECISION

vom / of / du 16 February 1987

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Re-establishment

EPO/EPC/CBE Articles 113(1), 122, 133(2), Rules 85(a), 104(b)

Kennwort / Keyword / Mot clé : "Re-establishment" - "removal of cause of non-compliance" - "minor mistake"
"Appointment of professional representative"
"Good faith in procedural matters"

Leitsatz / Headnote / Sommaire

**Europäisches
Patentamt**
Beschwerdekammern

**European Patent
Office**
Boards of Appeal

**Office européen
des brevets**
Chambres de recours



Case Number : J 32/86

DECISION
of the Legal Board of Appeal
of 16 February 1987

Appellant :

Representative :

Decision under appeal : **Decision of the Receiving Section of the
European Patent Office dated 13 May 1986.**

Composition of the Board :

Chairman : P. Ford

Member : E. Persson

Member : O. Bossung

Summary of Facts and Submissions

- I. The appellant, having his residence in the USA and not being represented by a professional representative, filed on 21 January 1983 Euro-PCT application No. (PCT/US 83/) claiming priority from US application No. filed on 7 September 1982. The international search report was published on 15 March 1984.
- II. The time limits for the payment of the national fee, the search fee and the designation fee provided for in Articles 158(2), 157(2)(b) and 79(2) EPC respectively expired on 7 June 1984 in accordance with the provisions of Rule 104(b)(1) EPC in conjunction with Article 22(1) PCT. However, in accordance with Rule 85(a) EPC, these fees could have been validly paid up to 7 August 1984 subject to the payment of a surcharge.
- III. The time limit for requesting examination and paying the examination fee expired on 17 September 1984 (a Monday) in accordance with Articles 94(2) and 157(1) EPC. However, in accordance with Rule 85(b) EPC, these measures could have been validly taken up to 19 November 1984 (a Monday) subject to the payment of a surcharge.
- IV. The fees referred to under II. above, including the prescribed surcharges, were not paid until 20 August 1984 and, thus, after the expiration of the period of grace under Rule 85(a) EPC.
- V. On 26 October 1984 the Receiving Section
 - (a) notified the appellant in accordance with Rule 69(1) EPC that the application was deemed to be withdrawn as prescribed by Article 24(1)(iii) PCT because of the non-observance of the time limits referred to under II above;

(b) requested that the appellant comply with the provisions of Article 133(2) EPC by naming a representative;

(c) notified the appellant that the ordinary time limit for requesting examination under Articles 94(2) and 157(1) EPC referred to under III. above, that is 17 September 1984, had not been observed and reminded him of the period of grace of two months after that date provided for in Rule 85(b) EPC.

VI. In a letter dated 8 November 1984 and received on 12 November 1984 the appellant (personally) applied for *restitutio in integrum* in respect of the period of grace under Rule 85(a) EPC (cf. II and IV above). In support of this application he stated that he had inadvertently made an error in interpreting the final date for payment of the fees and surcharges in question as indicated in a communication from the Receiving Section of 9 July 1984. In this communication it was said that payment could still be validly made within a period of grace of "2 MONTHS after 07.06.84" which date he had misunderstood to be July 6th 1984 according to the American convention for digital dating. He furthermore asserted that he had made an effort in good faith to comply with the relevant provisions. The prescribed fee for re-establishment of rights (Article 122(3) EPC) was duly paid on 14 November 1984.

VII. Together with the same letter, the appellant filed a request for examination (cf. III. above). The surcharge for late filing of this request - but not the (ordinary) examination fee - was paid on 14 November 1984, that is within the period of grace under Rule 85(b) EPC.

VIII. In the same letter of 8 November 1984 the appellant stated that he was planning to communicate the appointment of a professional representative as soon as possible and to file an authorization. He further asked for a list of English-speaking representatives recognized by the EPO. Such a list was sent to the appellant by the Receiving Section on 23 November 1984.

IX. On 20 December 1984 a European patent attorney practising in London telexed to the Receiving Section informing it that he had been appointed as the appellant's professional representative. Furthermore, he asked to be informed of the status of the application in question and to be advised what action he must take to ensure the orderly processing of the application. The telex was confirmed by a letter of 28 December 1984 received on 31 December 1984.

X. In response to his questions, on 2 January 1985 the Receiving Section telexed to the representative giving him a detailed account of the status of the application. As to the non-observance of the period of grace under Rule 85(a) EPC it was stated that "on 12.11.84 the applicant filed a request for restitutio and paid the restitutio fee both in due time". As far as the request for examination was concerned it was stated in the telex that this request "was filed in due time". It was at the same time noted that the examination fee "as such" seemed to have been overlooked by the appellant (cf. VII. above) and it was concluded that "the filing of a further request for restitutio in integrum seems therefore also to be necessary" in respect of the period of grace under Rule 85(b) EPC.

XI. The (ordinary) examination fee was paid on 4 February 1985. In a letter dated 12 February 1985 and received on 13 February 1985 the appellant's representative, who had filed an authorization on 7 January 1985, applied for

restitutio in integrum in respect of the period of grace under Rule 85(b) EPC. In support of this application, it was pointed out that this was the appellant's first patent application under either the EPC or the PCT and that the appellant was clearly bewildered by the complexity of the procedure involved in the application, the variety of fees to be paid and the various deadlines for paying these fees. This situation had been aggravated by English not being the appellant's mother tongue. However, he had all along tried to comply with the EPC and the rules thereunder and had exercised his best endeavours, in the circumstances, to respond appropriately to the official communications he had received. The fee for re-establishment in this case was paid on 13 February 1985.

XII. In a communication dated 11 April 1985, the Receiving Section pointed out that three documents did not bear the signature of a professional representative as required under Article 133(2) EPC and invited the appellant's representative to return enclosed photocopies of these documents signed in due form within two months. Among the enclosed documents were the application for *restitutio in integrum* in respect of the period of grace under Rule 85(a) EPC filed by the appellant on 12 November 1984 (cf. VI. above) and his request for examination filed at the same time (cf. VII. above). The representative complied with this invitation on 17 April 1985.

XIII. On 13 May 1986 the Receiving Section issued a decision according to which the applications for *restitutio in integrum* in respect of the periods laid down in Rule 85(a) and in Rule 85(b) EPC were refused.

XIV. (a) In the reasons for the decision, as far as the application for *restitutio in integrum* in respect of the period of grace under Rule 85(a) EPC is concerned,

the Receiving Section assumed that the cause of non-compliance with the relevant time limit was removed on 5 November 1984 which was the date the appellant actually received the notification of 26 October 1984 referred to under V.(a) above. Thus, the period of two months under Article 122(2) first sentence EPC had expired on 7 January 1985 (a Monday). The Receiving Section accepted that the fee for re-establishment of rights prescribed by Article 122(3) EPC was duly paid but held that a valid application for *restitutio in integrum* had not been filed in good time. The application filed by the appellant on 12 November 1984 was in the view of the Receiving Section invalid, since he had then not acted through a professional representative as required by Article 133(2) EPC. The Receiving Section concluded that the copy of the appellant's own application for *restitutio in integrum* subsequently signed by the appellant's representative was to be considered to be the proper application. However, this had been received only on 17 April 1985 (cf. XII. above) which date fell outside the time limit prescribed by Article 122(2) first sentence EPC. In these circumstances the Receiving Section found it not necessary to consider the substantial question whether the appellant had exercised the due care required by Article 122(1) EPC.

- (b) As far as the application for *restitutio in integrum* in respect of the period of grace under Rule 85(b) EPC is concerned, the Receiving Section stated in its decision that the irremediable loss of rights under Rule 85(a) EPC precluded re-establishment in respect of the period of grace under Rule 85(b) EPC and that, therefore, this application also had to be refused.

- XV. By letter dated 20 June 1986, the appellant's representative filed an appeal against the decision of the Receiving Section. The appeal fee was duly paid and a statement of grounds was communicated in a letter dated 18 September 1986 received on 22 September 1986.
- XVI. To summarize the main grounds of appeal, the appellant's representative submitted that the combined effect of the action taken by the appellant himself and the representative was that, by 7 January 1985, the appellant was represented by a professional representative and acted through him in respect of the proceedings established by the EPC that apply to the present patent application, including the application for *restitutio in integrum* in respect of the time limit under Rule 85(a) EPC, and thus met the requirements of Article 133(2) EPC in respect of all those proceedings. Referring, in particular, to the telex by the Receiving Section of 2 January 1985 and its invitation of 11 April 1985 to sign certain documents, including the application for *restitutio in integrum* previously filed by the appellant himself, the representative further contended that he had been given the impression that the Receiving Section, at these stages of the proceedings, shared the view that the patent application was being orderly processed. Otherwise, the Receiving Section should have given the appellant an opportunity to correct the deficiency in the application for *restitutio in integrum* in accordance with Article 91(2) EPC. The representative, who asked for an oral hearing, finally remarked that it was unfortunate that the appealed decision had been taken without the appellant or his representative being given an opportunity to comment on the grounds of that decision, as would have been expected in accordance with Article 113(1) EPC. In these circumstances reimbursement of the appeal fee was requested.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. As stated in the reasons for the decision under appeal, *restitutio in integrum* is, in accordance with the case law established by the Legal Board of Appeal (cf. J 06/79, OJ EPO 7/1980, p. 225), possible in EURO-PCT-applications in respect of the periods of grace under Rules 85(a) and 85(b) EPC.
3. The cause of non-compliance with the time limit under Rule 85(a) EPC is, *prima facie*, to be considered to have been removed on 5 November 1984 which was the date the appellant actually received the communication under Rule 69(1) EPC directed to that time limit (cf. J 07/82, OJ EPO 10/1982, p. 391). Consequently, the two-month time limit under Article 122(2) first sentence EPC for filing an application for *restitutio in integrum* expired, *prima facie*, on 7 January 1985 (a Monday).
4. By that latter date the appellant, who had personally filed an application for *restitutio in integrum* on 12 November 1984 and shortly afterwards paid the prescribed fee, was represented by a professional representative as required under Article 133(2) EPC.
5. Although, in a situation of this kind, the mere appointment of a professional representative to meet the requirement of Article 133(2) EPC does not automatically have the legal effect of validating acts previously performed by an applicant himself, it follows from the principles of good faith which govern the relations between the EPO and applicants for European patents over procedural matters (cf. J 10/84, OJ EPO 3/85, p. 71) that, irrespective of the

fact that Article 91(2) EPC does not apply as suggested by the appellant's representative, the EPO is obliged to give the representative a fair chance to remedy any deficiency of this kind that might have occurred before his appointment but still can be lawfully remedied by him.

6. In the present case, it is to be noted that the appellant's representative in a telex of 20 December 1984, i.e. well ahead of the critical date of 7 January 1985, asked the Receiving Section for advice what action he must take to ensure the orderly processing of the application. The information given by the Receiving Section in response to this in its telex of 2 January 1985 (cf. X. above) was in the Board's view clearly misleading as far as the status of the application for *restitutio in integrum* in respect of the time limit under Rule 85(a) EPC is concerned. Its effect was to distract the representative's attention from the necessity of remedying the deficiency in the appellant's previously filed own application. If, as appropriate, the representative's attention had been drawn to this problem, it may be assumed that he would have been able to take proper action for remedying the deficiency in question within the relevant time limit by signing a copy of the appellant's own application or by filing a new application for *restitutio in integrum*.
7. The issuing by the Receiving Section of the communication of 11 April 1985 (cf. XII. above) inviting the appellant's representative to sign *inter alia* a copy of the application for *restitutio in integrum* previously filed by the appellant himself was obviously also aimed at confirming the impression given to the representative that the application as such had been accepted as made in due time. Otherwise, the invitation to sign this document would appear to have been quite meaningless and only adding to the confusion. It is in these circumstances quite

understandable that the representative was very surprised when, having promptly complied with the said invitation, he learned from the decision under appeal that the signed copy was considered to be the only proper application for *restitutio in integrum* but ineffective on the ground that it had been filed outside the time limit under Article 122(2) first sentence EPC. Furthermore, it was, as submitted by the representative, contrary to the provisions of Article 113(1) EPC to base the contested decision on these grounds without giving the representative an opportunity to comment on them beforehand.

8. It is quite obvious that, due to the series of procedural violations by the Receiving Section in the course of the proceedings of this case, the decision under appeal has to be set aside. In the circumstances, the Board takes the view that the cause of non-compliance with the time limit under Rule 85(a) EPC was not removed until the appellant's representative received the communication by the Receiving Section of 11 April 1985 inviting him to sign a copy of the application for *restitutio in integrum* previously filed by the appellant himself, which was the first time the representative was made aware of the deficiency in that application. Since the representative complied with this invitation already on 17 April 1985, it is apparent that the two-month time limit under Article 122(2) first sentence EPC has been observed. Consequently, the application for *restitutio in integrum* in respect of Rule 85(a) EPC must be considered on its merits.
9. Since the Receiving Section considered the application for *restitutio in integrum* in respect of Rule 85(a) EPC as filed out of time, it found it not necessary to consider whether the substantial requirements under Article 122(1) EPC were fulfilled in this case. The question therefore arises whether the case should not be remitted to the

Receiving Section for further prosecution on this point. Taking into account that the relevant facts are very clear and the case as a whole appears to be quite simple from a legal point of view, the Board, however, considers that it should avail itself of the possibility under Article 111(1) EPC to exercise the power within the competence of the Receiving Section to decide on the substance of the matter on this point.

10. As appears from paragraph VI. above the appellant asserts that the reason why the fees in question were not paid until 20 August 1984 and, thus, outside the period of grace under Rule 85(a) EPC, which expired on 7 August 1984, was that he inadvertently misinterpreted a communication from the Receiving Section saying that the fees could still be validly paid within a period of grace of "2 MONTHS after 07.06.84". There would seem to be no reason not to believe that this assertion is true. Taking further into account that the appellant was used to the American convention of indicating the month before the day and at that point of time was prosecuting his first Euro-PCT application without any assistance, the minor and understandable mistake made by him in this respect does not prevent the Board from taking the view that he exercised all due care required by the circumstances in trying to comply with the relevant provisions of the EPC.
11. It follows that the appellant should have his rights re-established in respect of the time limit under Rule 85(a) EPC.
12. The application for *restitutio in integrum* in respect of the time limit under Rule 85(b) EPC has been refused by the Receiving Section as a mere consequence of the refusal to grant *restitutio in integrum* in respect of the time limit under Rule 85(a) EPC. The appellant's representative has

not commented at all on this point in his statement of grounds of appeal. In these circumstances the case must be remitted to the Receiving Section for further prosecution.

13. In the circumstances of the case, the Board does not consider it necessary to appoint oral proceedings before deciding in the appellant's favour.
14. In view of the substantial procedural violations that have occurred in the course of the proceedings before the Receiving Section, reimbursement of the appeal fee is equitable and shall therefore be ordered as also requested.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The appellant is restored in his rights as far as the payment of the national fee, the search fee and the designation fee within the time limit under Rule 85(a) EPC is concerned.
3. The application for restitutio in integrum in respect of the time limit under Rule 85(b) EPC is remitted to the Receiving Section for further prosecution.
4. Reimbursement of the appeal fee is ordered.

The Registrar



The Chairman

