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Bezeichnung der Erfindung: Photosensitive member for Electrophotography

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : G 03 G 5/08

ENTSCHEIDUNG / DECISION

vom / of / du 25 March 1988

Anmelder / Applicant / Demandeur : Hitachi, Ltd.

Patentinhaber / Proprietor of the patent /

Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Re-establishment of rights/Hitachi

EPO / EPC / CBE Article 122, Rule 85a

Kennwort / Keyword / Mot clé Re-establishment of rights (denied) - Loss of rights already cured under Rule 85a EPC - Alternative remedies

Leitsatz / Headnote / Sommaire

- I. If the national fee, search fee and designation fees due in respect of a Euro-PCT application are not paid within the basic time limit (which expires 21 months after the priority date), Rule 85 a EPC and Article 122 EPC are potentially immediately available as alternative remedies against the permanent loss of rights.
- II. If the required fees and the surcharge are paid unconditionally within the period of grace provided by Rule 85 a EPC, the payment is immediately effective to cure the loss of rights and thereafter there are no lost rights which could be re-established under Article 122 EPC.
- III. Accordingly, an applicant who wishes to keep open his option to proceed under Article 122 EPC, should file an application under that Article before he makes payment under Rule 85 a EPC and/or notify the EPO at the time of payment that the payment under the Rule is a supplementary measure and that he would prefer re-establishment under Article 122 EPC.

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Chambres de recours



Case Number : J 12/87

D E C I S I O N
of the Legal Board of Appeal
of 25 March 1988

Appellant : Hitachi, Ltd.
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Chiyoda-Ku
Tokyo 100
Japan

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Decision under appeal : Decision of Receiving Section
of the European Patent Office
dated 10.09.86 rejecting request
for re-establishment of rights

Composition of the Board :

Chairman : P. Ford
Members : G.D. Paterson
E. Persson

Summary of Facts and Submissions

- I. An international application was filed in Japan on 14 December 1984, claiming priority from an earlier Japanese application which had been filed on 16 December 1983. The international application designated the EPO as well as various Contracting States. A copy of the international application was duly received by the EPO.

- II. A translation of the application into an official language of the EPO was not filed within 20 months of the priority date (ie by 16 August 1985); and the national fee, the search fee and the designation fees were not paid to the EPO within 21 months of the priority date (ie by 16 September 1985). In a first communication under Rule 69(1) EPC dated 14 October 1985 (Form 1208), the Appellant was informed that because the required translation had not been filed in due time, the European application was deemed to be withdrawn. In a second communication also dated 14 October 1985 (Form 1217), the Appellant was informed that the above-mentioned fees had not been paid in due time but could still be paid, together with a surcharge, within the period of grace of two months provided by Rule 85(a) EPC, and that if the fees with surcharge were not duly paid the application would be deemed withdrawn.

- III. On 18 November 1985, the national fee, the search fee and the designation fees were paid, together with the required surcharge under Rule 85(a) EPC.

By letter filed on 10 December 1985, the Appellant filed a translation of the application into English; he also filed applications under Article 122 EPC for re-establishment of his rights, inter alia in respect of

- (i) filing the translation;
- (ii) payment of the national, search and designation fees.

Separate fees were paid in respect of each application for re-establishment. A statement of grounds in support of and common to the applications for re-establishment was filed on 27 December 1985.

- IV. By a Decision dated 13 March 1986, the Appellant was informed that one of his requests for re-establishment dated 10 December 1985 was allowed, with the effect that the translation was deemed to have been received within the prescribed period, and that the notification of 14 October 1985 (Form 1208) was set aside.
- V. In a letter dated and filed on 18 March 1986, the Appellant stated that the failure to pay the above-mentioned fees by the due date of 16 September 1985 had been caused by the same reasons as had caused the failure to file the translation, and requested that the application for re-establishment in respect of such fees should therefore be allowed, with consequent refund of the surcharge under Rule 85(a). This request was supported by further submissions in a letter dated 22 May 1986.

A Decision dated 10 September 1986 was issued by the Receiving Section, in which it was held that the request for re-establishment into the basic time limit of Rule 104(b)(1) EPC for payment of the above-mentioned fees was rejected, because such fees had been validly paid within the period of grace of Rule 85(a) EPC.

- VI. The Appellant filed a notice of appeal and paid the appeal fee on 20 November 1986. He also filed a statement of grounds of appeal on 20 January 1987, in which he referred to and relied upon two earlier Decisions of the Legal Board

of Appeal - J 05/80 (OJ EPO 9/1981, page 343) and J 11/85 "Small amount lacking/Ikaplast" (OJ EPO 1/1986, page 1), to support the submission that Rule 85(a) EPC and Article 122 EPC provide alternative ways of avoiding loss of rights which are separately and equally available to an applicant. He also contended that, on expiry of the basic time limit, even if he did not immediately lose his rights in the European patent application, he did immediately lose the "right to pay official fees without the additional burden of a financial penalty", which is a "loss of any other right" for the purpose of Article 122(1) EPC. It was pointed out by the Appellant that if the Decision of the Receiving Section is correct, this would lead to the unsatisfactory consequence that a person who has inadvertently failed to take certain required steps in time, but is careful enough to notice the failure reasonably early, can only maintain his rights at that stage by payment of a surcharge; whereas another (less careful) person who has committed the same failure and only notices the failure comparatively late does not need to pay the surcharge in order to maintain his rights (provided re-establishment under Article 122 EPC is allowed).

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is admissible.
2. In the case of an international application such as the present, various combinations of provisions of the PCT and Rule 104(b)(1) EPC, require that particular fees, namely the national fee, the search fee and the designation fees, are all paid to the EPO within what can be called a "basic time limit", which expires 21 months after the priority date.

If (as in the present case) the fees are not paid within that time limit, loss of the European patent application may result. However, as is apparent from the history of the case as set out above, Rule 85a EPC and Article 122 EPC provide potentially two ways by which the permanent loss of rights in the European patent application may be avoided if the fees are not paid within the basic time limit.

As to the applicability of Rule 85(a) EPC, in the Board's view it follows from Decision J 05/80 (OJ EPO 9/1981, page 343) that in the case of a Euro-PCT application such as the present, this Rule is applicable to the time limit for the payment of each of the fees which was due.

3. In the Decision dated 10 September 1986 which is under appeal, it was held that after expiry of the basic time limit, "The legal consequence (of deemed withdrawal of the application due to non-payment of the fees) becomes effective only after expiry of the period of grace provided for in Rule 85(a) EPC", and that "if the applicant can save the loss of rights by means of the legal remedy provided by Rule 85(a) EPC, then under the EPC the right is not immediately lost on expiry of the basic time limit...". It was therefore held that loss of rights in the application was not a direct consequence of non-compliance with the basic time limit, as is required if Article 122(1) EPC is to be applicable, and that to allow re-establishment under Article 122 EPC in this case "would amount to a circumvention of Rule 85(a) EPC".

If this reasoning is correct, then it would follow that the two potential ways of avoiding permanent loss of rights upon expiry of the basic time limit are only available sequentially. During the two months period of grace immediately following expiry of the basic time limit Rule 85(a) EPC is applicable, but not Article 122 EPC. After expiry of that two months period, Article 122 EPC would become available.

However, in the Board's view, a failure to observe the basic time limit for the payment of the relevant fees results in the automatic and immediate deemed withdrawal of the application or designation by operation of law. In other words, contrary to the finding in the Decision dated 10 September 1986, loss of rights in the application is a direct consequence of non-compliance with the basic time limit. Article 122 EPC is therefore potentially available to re-establish such loss of rights.

The Board notes that Form 1217, which was sent to the Appellant in the present case (see paragraph 11 above), is not fully consistent with this finding of the Board, insofar as it does not state that because the relevant fees have not been paid in due time the application is deemed to be withdrawn (in contrast with Form 1208, which does so state).

Rule 85(a) EPC is also available as a parallel remedy in order to avoid a permanent loss of rights. This Rule provides a grace period of two months during which the loss of rights which has already occurred may be cured by the payment of the required surcharge in combination with the basic fees (in this connection Decision J 04/86 dated 4 March 1987 - to be published in OJ EPO 4/1988, page 119 - which is concerned with Rule 85(b) EPC, is relevant).

Thus in the present case Rule 85(a) and Article 122 EPC were both available to the Appellant as alternative remedies for the avoidance of permanent loss of rights, at the time when the basic time limit expired.

4. In the present case, however, as set out in paragraph II and III above, the basic time limit expired on 16 September 1985. The Appellant paid the relevant fees and surcharge

pursuant to Rule 85(a) EPC on 18 November 1985, (the final day of the two months period of grace), and the EPO was not notified at that time that the Appellant intended to file an application under Article 122 EPC and that he preferred the latter remedy. Three weeks later, by letter dated 10 December 1985, the Appellant filed the application under Article 122 EPC. In this letter reference was made to the fact that the relevant fees and surcharge had been paid on 18 November 1985.

The further question therefore arises whether or not in these circumstances the application under Article 122 EPC can be considered as admissible.

Rule 85(a) EPC provides that the relevant fees "may still be validly paid" within the period of grace of two months after expiry of the time limit, together with the surcharge. In the Board's view, the natural meaning of this Rule is that if the required fees together with the surcharge are paid within the period of grace, such payment is immediately effective (upon completion of the required payment) so as to "cure" the loss of rights (the deemed withdrawal of the application and designation) which occurred upon expiry of the basic time limit. If the payment is not immediately effective to cure the loss of rights, it is difficult to derive, either from the wording of Rule 85 EPC or otherwise, any other point in time when the payment would be effective to cure the loss of rights. It is in the interest of legal certainty as to the status of an application that the loss of rights should be considered as cured or restored immediately upon payment of the required fees. By this interpretation the rights of third parties are protected.

It follows that in the present case the loss of rights which occurred upon expiry of the basic time limit on 16 September 1985 was cured on 18 November 1985 when

payment of the required fees plus surcharge was completed. Thus from 18 November 1985 onwards there were no longer any lost rights which could be re-established as a result of the subsequently filed application under Article 122 EPC, which application cannot therefore be admitted for consideration.

In the present case, if the Appellant had filed an application under Article 122 EPC before he paid the required fees plus surcharge, and/or if he had notified the EPO at the time of payment of the fees, that the fees were being paid as a supplementary measure to the preferred choice of Article 122 EPC as the means for avoiding any permanent loss of rights, it may be that the lost rights could have been re-established under Article 122 EPC rather than by Rule 85(a) EPC.

However, having regard to the fact that the fees and surcharge were paid under Rule 85(a) EPC without any such notification to the EPO, as stated above re-establishment under Article 122 EPC is not possible in this case.

For these reasons, it is decided that:

The appeal is dismissed.

The Registrar:

J. Rückerl

The Chairman:

P. Ford

