

Publication in the Official Journal Yes / ~~No~~

File Number: J 37/89
Application No.: 84 904 177.7
Publication No.: 0 163 746

Official Text *

Title of invention:

Footnote:

*Pursuant to Art. 4(5)
of the Rules of Procedure
of the Boards of Appeal
(OJ EPO 1980, 171)

Classification:

D E C I S I O N
of 24 July 1991

Applicant: Matsushita Co.

Headword: Rejection of extension of time limit/MATSUSHITA

EPC Articles 96(3), 106(3), 121; Rule 84

Keyword: "Extension of time limit - Review of rejection of same"

Headnote

If a request for extension of a time limit filed in good time has been rejected under Rule 84, second sentence, EPC, and the applicant considers this unjust, the ensuing loss of rights can be only overcome by a request for further processing under Article 121 EPC. At the same time, he may request reimbursement of the fee for further processing. This secondary request will have to be decided on in connection with the final decision. Under Article 106(3) EPC, the decision on the secondary request can be appealed together with the final decision. The appeal may also be confined to contesting the decision on the secondary request.





Case Number : J 37/89

D E C I S I O N
of the Legal Board of Appeal
of 24 July 1991

Appellant : Matsushita Electric Industrial Co., Ltd., et al

Representative : Patentanwälte
Leinweber & Zimmermann
Rosental 7/II Aufg.
D - 8000 München 2

Decision under appeal : Decision of the Examining Division of the European Patent Office dated 25 July 1989 rejecting a request for extension of time limit pursuant to Rule 84 EPC.

Composition of the Board :

Chairman : O. Bossung
Members : M. Lewenton
C. Holtz

Summary of Facts and Submissions

- I. In a communication from the Examining Division under Article 96(2) EPC, the applicants' representative was given four months within which to file observations. The representative requested an initial two-month extension because the information received from Japan necessitated enquiries of the applicants' representatives there. The extension was granted, whereupon the representative requested a further two-month extension because the claims now needed to be amended to such an extent vis-à-vis those originally filed that the applicants' approval had to be obtained.
- II. In a decision dated 25 July 1989 on Form 2018.2-9.83, the Formalities Officer refused the second request. In the Form a reference was given to Guidelines E-VIII, 1.6; it was accompanied by a notice from the EPO dated 28 February 1989 (OJ EPO 1989, 180), point 3 of which stated that the criteria set out in the Guidelines would in future be strictly applied and that such requests would normally be refused. The decision also pointed out that a separate communication concerning the legal consequences would be issued and that further processing was possible under Article 121 EPC. A communication to that effect under Rule 69(1) EPC noting the loss of rights because of the deemed withdrawal under Article 96(3) EPC then followed.
- III. On 20 September 1989 the applicants' representative filed an appeal against the decision of 25 July 1989 refusing the second request for extension. A statement of grounds was attached and the fee for further processing of DEM 125 and appeal fee of DEM 680 were paid. He also filed observations in response to the earlier communication from the Examining Division and submitted amended application documents.

IV. In the meantime, the first instance has resumed processing the patent application under Article 121 EPC, i.e. retracted the loss of rights under Article 96(3) EPC. The object of the appeal has been further clarified between the appellants' representative and the Board of Appeal. The representative now requests a ruling that the first instance should have found in a decision under Rule 69(2) EPC that his request for an extension should not have been refused. He also requests reimbursement of the fee for further processing and the appeal fee.

Reasons for the Decision

1. The admissibility of the appeal depends on whether or not there is a decision that can be appealed under Article 106 EPC. This must be denied, since a rejection of a request to extend a time limit under Rule 84, second sentence, EPC does not terminate proceedings as regards the applicant (cf. Article 106(3) EPC) and because a decision under Rule 69(2) EPC, which as such would be open to appeal, has not been taken. The appeal must therefore be rejected as inadmissible under Article 106 in conjunction with Rule 65(1) EPC.
2. The inadmissibility of the appeal in the present case is in itself a reason for clarifying how a judicial review of a decision to refuse a request for a time-limit extension under Rule 84, second sentence, EPC can be carried out.

However, the inadmissibility of the appeal in the present case also demands that the Board of Appeal confine itself to clarifying this purely procedural question. The discretionary decision to be taken under Rule 84, second sentence, EPC will not therefore be commented on or examined, any more than will the formalities officer's

competence or the question of whether the request for an extension contained adequate grounds for a time-limit extension under Rule 84, second sentence, EPC or whether a reference to the Guidelines accompanied by a notice from the Official Journal can be regarded as sufficient reason for refusing a request.

3. The question that remains to be answered here therefore is how a judicial review of a discretionary decision under Rule 84, second sentence, EPC to refuse a request for a time-limit extension can be fitted into the system of time limits, loss of rights and remedies laid down in the EPC.

3.1 It may be assumed that a communication from the Examining Division under Article 96(2) EPC sets a time limit for filing observations. If, before expiry of that time limit, the applicant requests an extension, he is "answering" in a certain way (cf. also Article 123(2) EPC). It is therefore not clear in a case such as this whether loss of rights ensues also in such cases as a result of the legal fiction under Article 96(3) EPC. Requesting in good time a time-limit extension can also be regarded as a timely answer, even if it does not address the matter at issue. Applicants' answers do not have to contain relevant matter enabling the Examining Division to alter the view expressed in its communication for a loss of rights under Article 96(3) EPC to be avoided. If the answer given is insufficient with a view to the matter at hand, the situation arises that a decision may be taken in the matter on the basis of the file, because advantage was not taken of the right to be heard and to amend the documents. A final decision to this effect could consequently be taken, which could then be appealed together with the refusal to grant a time-limit extension (cf. Singer EPC, Article 120, point 14).

3.2 Clearly under these circumstances someone who had requested a time-limit extension in good time would be at a disadvantage vis-à-vis someone who had not answered at all and who, for a modest fee, could apply for further processing under Article 121 EPC. The mere fact of paying a sum of money can therefore have the indirect effect of extending the time limit which, including processing time, can easily amount to four months. The further time thus won cannot however then be extended under Rule 84, second sentence, EPC. That aside, further processing can nevertheless almost always satisfy the applicant's need for further time. In the rare instances that it cannot, the applicant can always appeal and have the decision to refuse the extension reviewed (see 3.1 above).

3.3 The first point to emerge from the foregoing is that applicants who request a time-limit extension in good time cannot be disadvantaged vis-à-vis those who do not answer at all. As in fact happens in EPO practice, cases in which a time-limit extension has been refused are therefore to be treated in the same way as where the communication from the Examining Division under Article 96(2) EPC either has not been answered or has been answered late. Article 96(3), Rule 69(1) and Article 121 EPC must be applied in the first instance, therefore, where a request for an extension has been refused.

3.4 This method of proceeding does not however give rise to a decision under Rule 69(2) EPC. The loss of rights under Article 96(3) EPC ensues as a result of failure to comply with a time limit as such. As in cases where re-establishment under Article 122 EPC is necessary, it is not disputed that the time limit itself was not met and that therefore a decision under Rule 69(2) EPC does not arise. The only point of contention is whether it was correct to refuse the request for extension. A route to judicial review

of a refusal to grant an extension cannot therefore be opened by way of appealing against a decision under Rule 69(2) EPC. Besides, the debate on whether it was right to refuse the extension could last for months and delay the examination procedure. If a time-limit extension is unjustly refused, the applicant will have a legitimate interest solely in securing an adequate time limit and obtaining a refund of the fee paid for further processing.

3.5 To sum up, this means the following: if a request for extension of a time limit filed in good time has been rejected under Rule 84, second sentence, EPC and the applicant considers this unjust, the ensuing loss of rights can be overcome only by first filing a request for further processing under Article 121 EPC. At the same time he may request reimbursement of the fee for further processing. This secondary request will have to be decided on in connection with the final decision. Under Article 106(3) EPC the decision on the secondary request may be appealed together with the final decision. The appeal may also be confined to contesting the decision on the secondary request.

4. A judicial review of the discretionary decision taken under Rule 84, second sentence, EPC therefore, may, come about as follows:

4.1 If the patent application is refused by a final decision, the applicant may have the question whether his earlier request for a time-limit extension was rightly or wrongly rejected examined in an appeal under Article 106(3) EPC. This is done by a Technical Board of Appeal, as is moreover appropriate since it is responsible for reviewing the entire first-instance procedure. There are links here between a rejection of a possible request for extension of a time limit under Rule 84, second sentence, a possible

infringement of the right to be heard under Article 113(1), a possible "procedural violation" within the meaning of Rule 67 and a possible need to remit the case under Article 111 EPC.

- 4.2 If the European patent is granted by a final decision, a secondary request that has been rejected may always be appealed.
- 4.3 If no decision is taken on the European patent application because the applicant does not prosecute it further, nevertheless, a separate decision may be taken on the secondary request. The question whether a fee, for example, a search fee or a surcharge, was reimbursable could also be decided on separately. The uncommon case, in which the main issue has been settled and only the question of a fee repayment remains, has been mentioned simply to examine the principle that the rejection of a request for a time-limit extension may be examined by the Examining Division itself in response to a request for further processing combined with a request for reimbursement of the fee for further processing.

In this case, the only interruption to the examination procedure is the unavoidable one connected with further processing under Article 121 EPC. In the final analysis, whatever the outcome of the examination procedure, the question of whether it was right to reject the request for a time-limit extension under Rule 84, second sentence, EPC may be submitted for judicial review by way of an appeal.

5. No decision can be taken in the present case regarding the appellants' request for reimbursement of the fee for further processing for the simple reason that the appeal is inadmissible. The appellants are at liberty to ask the first instance for reimbursement of this fee.

6. The request for reimbursement of the appeal fee must be refused. Rule 67 EPC stipulates as a precondition for reimbursement that the appeal be allowable, which is not the case here. It is clear from the wording and purpose of the provision that "allowable" is to be understood in the sense that the Board of Appeal, in substance at least, "follows" the relief sought by the appellants, in other words that it allows their requests. In the present case, none of the requests could be allowed since the appeal had to be rejected as inadmissible.

Order

For these reasons it is decided that:

1. The appeal is rejected as inadmissible.
2. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

M. Beer

O. Bossung

