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File Number: J 6/90 - 3.1.1
Application No.: 84 903 728.8
Publication No.: 0 159 342
Title of invention: Multiple chamber container

Classification: B65D 25/08, B65D 81/32

D E C I S I O N
of 22 October 1992

Applicant: Baxter International Inc.
Proprietor of the patent:
Opponent:

Headword: One-year period/BAXTER
EPC Article 122(2), third sentence
Keyword: "One-year period" - " Re-establishment of rights"

Catchwords

To make a valid request for re-establishment of rights within the year immediately following the expiry of the unobserved time limit, it is sufficient if the files contain a clearly documented statement of intent from which any third party may infer that the applicant is endeavouring to maintain the patent application.

Case Number : J 6/90 - 3.1.1

D E C I S I O N
of the Technical Board of Appeal 3.1.1
of 22 October 1992

Appellant : Baxter International Inc.
(a Delaware Corporation)
One Baxter Parkway
Deerfield
Illinois 60015 (US)

Representative : MacGregor, Gordon
ERIC POTTER & CLARKSON
14 Oxford Street
Nottingham, NG1 5BP (GB)

Decision under appeal : Decision of the Receiving Section of the
European Patent Office dated 24 August 1989
refusing the request for restitution into the
time limit for paying the renewal fee for the
third year.

Composition of the Board :

Chairman : O.P. Bossung
Members : J.C. Saisset
R.L.J. Schulte

Summary of Facts and Submissions

- I. The third year's renewal fee for European patent application No. 84 903 728.8 (arising from international application PCT/US 84/01504) was not paid by the due date. By a decision of the EPO's Receiving Section dated 24 August 1989 a request by the applicants' European representative for re-establishment of rights was rejected as inadmissible because the EPO had not received a statement of the grounds for re-establishment within the period of one year stipulated in Article 122(2), third sentence, EPC. The statement of grounds was not submitted until shortly after that, but within the period of two months specified in the first sentence of Article 122(2) EPC, which in the present case expired later.
- II. The applicants lodged an appeal against this decision on 12 October 1989, paying the appropriate fee, and submitted a statement of grounds for the appeal on 19 December 1989. Their representative and the Receiving Section were agreed on the facts, which have been reviewed by the Board of Appeal and are as follows:

30.9.86 Renewal fee due for third year.

12.11.86 Communication (EPO Form 2522) drawing attention to Article 86(2) EPC despatched to the European representative and received by him on 17.11.86.

30.3.87 Expiry of the time limit laid down in Article 86(2) EPC for paying the renewal fee plus an additional fee.

6.8.87 Despatch of a communication pursuant to Rule 69(1) EPC concerning the ensuing loss of rights under Article 86(2) EPC.

16.8.87 Removal of the cause of non-compliance and beginning of the two-month period specified in Article 122(2) EPC, assuming, in accordance with Rule 78(3) EPC, that the representative received the communication pursuant to Rule 69(1) EPC within ten days of posting.

21.9.87 Receipt of a letter dated 17 September 1987 from the representative, promising to pay the renewal fee, the additional fee and the fee for re-establishment of rights, and indicating that "a written application for re-establishment of rights" would follow.

28.9.87 Payment of the above-mentioned fees.

30.9.87 Expiry of the one-year period specified in Article 122(2), third sentence, EPC.

6.10.87 Receipt of a letter stating the grounds for re-establishment of rights.

16.10.87 Expiry of the two-month period specified in Article 122(2), first sentence, EPC, assuming that the cause of non-compliance was removed on 16 August 1987 (see above).

III. By a decision dated 24 August 1989, the formalities officer of the Examining Division of the European Patent Office rejected the application for re-establishment of rights as inadmissible for the sole reason that it had not been filed within the one-year period specified in the third sentence of Article 122(2) EPC. To be admissible in respect of this one-year period, an application for re-establishment of rights had to include a statement of grounds submitted within the year in question. Under

Article 99(1) in conjunction with Rules 55(c) and 56(1) EPC, a notice of opposition was inadmissible unless a statement of the grounds for opposition was presented before the opposition period had expired. By analogy, this also applied - with regard to the one-year period specified in Article 122(3), third sentence, EPC - to requests for re-establishment of rights.

- IV. The appellants lodged an appeal against this decision on 12 October 1989, paying the appropriate fee the following day. A statement of the grounds for appeal was submitted on 12 December 1989.

The appellants requested that the contested decision be set aside and their application for re-establishment of rights remitted to the department of first instance for further examination, i.e. in order to determine whether all due care had been taken as required by Article 122(1) EPC.

Reasons for the Decision

1. The appeal is admissible.
- 2.1 Article 122(2), third sentence, EPC stipulates a period of one year in the following terms: "The application shall only be admissible within the year immediately following the expiry of the unobserved time limit." The meaning is the same in all three official languages. The two preceding sentences and the following paragraph 3 are also concerned with "the application" and the requirements it has to fulfil with regard to time (the two-month period) and formal considerations. From this, one might be tempted to infer that all the acts required in any way as conditions of re-establishment had to be completed

cumulatively within the first of the two periods (two months and one year) to expire. The impression therefore arises that the following requirements have to be met in their entirety within the first of the two periods to expire:

- (a) filing of a written application (paragraph 2, first sentence),
- (b) completion of the omitted act (paragraph 2, second sentence),
- (c) submission of a statement of the grounds on which the application is based, setting out the facts on which it relies (paragraph 3, first sentence),
- (d) establishing the credibility ("glaubhaft machen" - in German text only) of the facts (paragraph 3, first sentence),
- (e) payment of the fee for re-establishment (paragraph 3, second sentence).

2.2 These requirements have to be cumulatively fulfilled before rights can be re-established. This imperative is in itself a sufficient reason for enumerating all these requirements in Article 122(2) and (3) EPC. At the same time, the law can scarcely be taken to mean that all the above-mentioned requirements have to be met within each of the two periods. If this were the meaning of Article 122 EPC, the situation would frequently arise, especially in connection with renewal fees, that the two-month period would be curtailed, as it were, by the prior expiry of the one-year period. In the case of renewal fee payments, the one-year period begins on the date when payment falls due, and under Article 122(2), fourth sentence, EPC, it is

reduced to six months, calculated from the last date for payment, i.e. the date on which the additional fee falls due. As in the present case, the communication pursuant to Rule 69(1) EPC concerning loss of rights is often issued so late that the two-month period expires after the end of the one-year period. This in itself suffices to show that the one-year period cannot have the legal function of a time limit for the fulfilment of the individual requirements listed above (point 3.1). Insofar as these requirements are subject to a time limit, they have to be met within the two-month period.

2.3 Within the overall conditions for re-establishment of rights laid down by Article 122 EPC, the one-year period has the legal function of an exclusion. This is indicated, inter alia, by the fact that there are two limitations in point of time, namely the two-month and the one-year periods. Each of these limitations has its own specific function.

2.4 The one-year period serves to provide legal certainty. A year after the expiry of the unobserved time-limit, it should be clear to all parties that re-establishment of rights is no longer possible. If the one-year period has elapsed, then any party can confidently assume that a patent application or patent which has been rendered invalid by the non-observance of a time limit will not be revived. He can rest secure in the knowledge that the protective right has been removed and can no longer be infringed. However, if a third party notes on inspecting the file that an application for re-establishment has been made within the one-year time limit, then he has adequate notice. The Board therefore takes the view that observation of the one-year period does not presuppose fulfilment of the substantive requirements for re-establishment of rights. These requirements are assignable

to the two-month period and in the present case were fulfilled within it. The purpose of the one-year period under Article 122(2), 3rd sentence, EPC being to ensure legal certainty, this provision is fully complied with if a third party, on inspecting the files, is bound to conclude that a desire exists for re-establishment of rights in respect of failure to observe the time limit. This requirement is sufficiently fulfilled if the applicant or patent proprietor has unequivocally indicated his wish to proceed further with the patent application or to maintain the patent.

- 2.5 In the present case, this was so. Taken in context, the representative's letter of 17 September 1987 has to be regarded as constituting a categorical request for re-establishment of rights in respect of failure to observe the time limit for paying the renewal fee plus additional fee. The wording of the letter does require ~~a certain effort of~~ interpretation, since the representative said that a written request for re-establishment of rights would follow shortly. However, that in itself has to be seen as an application for re-establishment. This follows from the fact that the representative paid the fee for re-establishment a few days later, within the period of one year. As a rule, fees in respect of applications are only paid when such an application has been filed. In the present case, the Board deems the request for re-establishment of rights to be valid with regard to the one-year period following expiry of the unobserved time limit. The contested decision is therefore to be set aside and the case remitted for resumption of proceedings.

Order

For these reasons, it is decided that:

The contested decision is set aside and the case remitted to the department of first instance.

The Registrar:

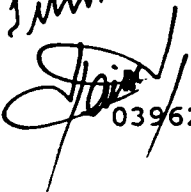


M. Beer

The Chairman:



O. Bossung

Subm 6.11.92

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