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File Number: J 15/90

Application No.: 87 309 472.6

Publication No.:

Title of invention:

Classification:

D E C I S I O N
of 4 September 1992

Applicant: Duriron Company, Inc.

Headword: Re-establishment/DURIRON

EPC Art. 122(5)

Keyword: "Extent of applicability of Art. 122(5) EPC; supplementary referral to J 16/90 - Fabritius G 3/91"



Case Number : J 15/90

D E C I S I O N
of the Technical Board of Appeal
of 4 September 1992

Appellant : Duriron Company

Representative : Baron & Warren
18 South End
Kensington
London W8 5BU (GB)

Decision under appeal : Decision of the Receiving Section of the European
Patent Office dated 14 September 1989, rejecting
the request for re-establishment of rights
pursuant to Article 122(5) EPC.

Composition of the Board :

Chairman : O. Bossung
Members : S. Perryman
J-C. De Preter

Summary of Facts and Submissions

In Decision J 16/90, Fabritius, the Legal Board of Appeal put to the Enlarged Board of Appeal questions of law on applying Article 122 EPC to certain failures to meet time limits (Enlarged Board of Appeal case number: G 3/91). These relate respectively^m to European patent applications (hereinafter Euro-case), on the one hand, and to international applications on entry into the so-called PCT regional phase at the EPO (hereinafter: Euro-PCT case), on the other hand. For details reference is made to Decision J 16/90. The questions there put are as follows:

1. As regards re-establishment of rights in the case of time limits for payments which have to be made at the beginning of the procedure before the EPO:
 - (a) Is Article 122 EPC applicable to the time limits of Article 78, paragraph 2 and of Article 79, paragraph 3, EPC for European applications?
 - (b) Is Article 122 EPC applicable to the time limit for payment of the "national fee" referred to in Article 158, paragraph 2, sentence 2, EPC in the case of international applications?

2. As regards re-establishment of rights in respect of the time limit for making the request for examination:
 - (a) Is Article 122 EPC applicable to the time limit of Article 94, paragraph 2, EPC in the case of European applications?

(b) Is Article 122 EPC applicable to the time limit mentioned in Article 150, paragraph 2, sentence 4, EPC in the case of international applications?

II. The above questions of law relate to four types of case, namely the Euro-case and the Euro-PCT case respectively relating to payments at the beginning of the procedure, that is the so-called "entry fees", (Questions 1a and 1b) and the corresponding cases for the request for examination (Questions 2a and 2b). The referral to the Enlarged Board of Appeal in Decision J 16/90 concerns a Euro-case/entry fees thus on a narrow view it concerns only Question 1a.

III. Cases of each kind are pending before the Legal Board of Appeal, and above all before the Receiving Section. Insofar as re-establishment is not considered to be excluded by Article 122 according to present jurisprudence, re-establishment is granted provided the conditions of Article 122(1), (2) and (3) EPC are fulfilled. This necessarily results in the Legal Board of Appeal receiving mainly Euro-cases. Euro-PCT cases are only pending before the Legal Board of Appeal if the Receiving Section as first instance rejected the application for re-establishment for some reason other than solely the question of applicability of Article 122.

IV. The following is a list of the cases pending, starting with the already referred case J 16/90, with characterisation of the type of case:

J 16/90, Fabritius: Euro-case/entry fees

J 15/90, Duriron: Euro-case/request for examination

J 08/91, Houpt: Euro-case/request for examination

J 09/92, Decknology: Euro-PCT-case/request for examination

J 20/92, Klehr: Euro-PCT-case/entry fees

Reasons for the Decision

1. The Legal Board of Appeal has resolved, in the cases of Appeals J 15/90, J 8/91, J 9/92 and J 20/92, to refer to the Enlarged Board of Appeal the same questions of law as in case J 16/90 and to do so with the same reasoning. In addition a further question of law is referred relating to the PCT-cases.
 - 1.1 In the present case J 15/90 and the other mentioned cases J 8/91, J 9/92 and J 20/92, the respective decision to refer is made separately. There is no consolidation of appeal proceedings within the meaning of Article 9 of the Rules of Procedure of the Boards of Appeal (OJ EPO 1983, 7). The decisions are, apart from the language of the proceedings, in substance identical. Thus each decision to refer also contains exposition relating to the other cases. In this manner the appellants obtain an overview over the whole situation.
2. In view of the interrelation of the questions of law, renewed referral of the same questions of law does not, it is true, appear absolutely necessary. The existing referral in G 3/91 is based on Article 112(1)(a) EPC. While being occasioned by proceedings J 16/90 (compare Article 112(1)(a) EPC: "bei - during - en cours"), the questions of law are however - because they are of

fundamental importance - general questions of law which go beyond the specific case J 16/90. The questions are also interrelated because they concern an application of the general principle of equality before the law.

- 2.1 The Legal Board of Appeal, nevertheless, prefers to follow the example of Decision T 184/91. There a further case (G 11/91) was referred to the Enlarged Board of Appeal putting the same question as had already been put in a previous referral (G 3/89) to the Enlarged Board of Appeal. In this way all the appellants are also formally given the status of parties in the sense of Article 112(2) EPC.

Admittedly this does not apply to the applicants in those cases which are pending before the Receiving Section. Further the status of parties within the meaning of Article 112(2) EPC can only be accorded to PCT-applicants in those cases which primarily turn on other questions than re-establishment. As is known, re-establishment was hitherto considered as permitted in PCT cases.

- 2.2 Finally the Legal Board of Appeal wishes to make it possible for the Enlarged Board of Appeal to give a comprehensive answer to all the questions of law, in view of the pending and stayed cases before the Legal Board of Appeal and above all before the Receiving Section. All questions await a decision of equal authority. As it is conceivable that there will be a departure from the hitherto applicable jurisprudence, such change should not also take place in stages.

3. The Legal Board of Appeal also considers that a decision of the Enlarged Board of Appeal is required within the meaning of Article 112(1)(a) EPC in the cases mentioned below.

- 3.1 In the newly referred cases the appeal is - with the exception of case J 20/92, Klehr - admissible. In case J 20/92 it would first be necessary to have re-establishment for the time limit for filing the grounds of appeal, before the substantive question of re-establishment can be considered in the suit. Thus twofold re-establishment would be necessary to allow the appeal, firstly for the time limit for filing the grounds of appeal and secondly for the time limit for payment of the entry fees on entry of the regional phase at the EPO. If it should result from the decision of the Enlarged Board that the latter is precluded by Article 122(5), then there would hardly be any point in the appellant making efforts to obtain re-establishment into the time limit for filing the grounds of appeal.
- 3.2 In the newly referred case J 9/92, it is only secondarily a question of whether for a Euro-PCT-case there exists re-establishment on failure to meet the time limit for the request for examination (more precisely: the period of grace of Rule 85(b) EPC). Prior to that question comes the question of whether the communication pursuant to Rule 85(b) had been effectively delivered. However this question is only of decisive importance, if it is certain that re-establishment is precluded. Euro-PCT cases which depend only on re-establishment, are not pending before the Legal Board of Appeal, because the first instance on principle applies Article 122 to these.
4. By the referral of the new cases the Enlarged Board of Appeal now has before it all types of cases corresponding to the referred questions of law 1a, 1b, 2a and 2b, namely:

Question of law 1a: J 16/90-Fabritius
Question of law 1b: J 20/92-Klehr
Question of law 2a: J 15/90-Duriron
and J 08/91-Houpt
Question of law 2b: J 09/92-Decknology

5. In the opinion of the Legal Board of Appeal answers by the Enlarged Board of Appeal to the questions of law referred as a whole, will dispose of all the referrals.

6. Now PCT cases too have been referred to the Enlarged Board of Appeal. The possibility cannot be excluded that - contrary to the hitherto applicable jurisprudence as continually applied in practice - the enlarged Board of Appeal will declare that re-establishment is precluded. In this case the transition might cause a problem. The additional question of law relates to this.

Order

For these reasons, it is decided that:

1. In appeals J 15/90, J 8/91, J 9/92 and J 20/92 the same questions are referred to the Enlarged Board of Appeal with the same reasoning as in case J 16/90 (G 3/91).

2. In addition the following question is referred to the Enlarged Board of Appeal:

If the answer to the questions of law 1b or 2b is negative, that is re-establishment is precluded in the relevant PCT cases, is the decision of the Enlarged Board of Appeal then also immediately applicable to all pending cases?

The Registrar:

The Chairman:

M. Beer

O. Bossung