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D E C I S I O N
of 15 December 1994

Case Number: J 0022/92 - 3.1.1

Application Number: 89900103.6

Publication Number: WO 89/04371

IPC: C12P 21/00

Language of the proceedings: EN

Title of invention:

Plants genetically enhanced for disease resistance

Applicant:

Louisiana State University Agricultural and Mechanical College

Opponent:

-

Headword:

Re-establishment of rights

Relevant legal provisions:

EPC Art. 122

Keyword:

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Decisions cited:

T 0191/82, OJ EPO 1985, 189

Catchword:

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Case Number: J 0022/92 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 15 December 1994

Appellant: Louisiana State University
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Decision under appeal: Decision of the Receiving Section of the European Patent Office dated 6 February 1992 rejecting the requests for re-establishment of right filed by the Applicant.

Composition of the Board:

Chairman: R. L. J. Schulte
Members: J. P. B. Seitz
J. C. M. de Preter

Summary of Facts and Submissions

- I. International patent application No. PCT/US88/03908 was filed with the USPTO on 2 November 1988 claiming US priority of 2 November 1987.

A request for international preliminary examination was filed by letter dated 1 June 1989 received on 5 June 1989 by the USPTO.

The 19-month time limit set by Article 39(1)(a) PCT had expired on 2 June 1989.

On 9 June 1989 a communication was sent by the EPO to the US patent attorneys informing them of the procedural steps to be taken for entry into the regional phase before the EPO acting as the designated office.

- II. The 20-month period laid down in Article 22(1) PCT expired on 3 July 1989 and the 1-month period provided for in Rule 104b(1) EPC (then valid version) on 3 August 1989.

The communication pursuant to Rule 85a(1) EPC in respect of all fees was sent on 19 September 1989, directly to the Applicant, Louisiana State University.

On 22 January 1990, a communication pursuant to Rule 69(1) EPC was also addressed directly to the Applicant informing it that its European patent application was deemed to be withdrawn.

III. On 3 May 1990, EPO Form 1200 was filed for entry into the regional phase before the EPO as the designated office. All due fees were paid on the same date, and a representative appointed with the necessary authority to act before the EPO.

IV. On 18 July 1990, a consultation by telephone took place between the Receiving Section and the newly-appointed representative during which he was informed that the international application was deemed to be withdrawn but that he still had the opportunity to request re-establishment of rights under Article 122 EPC.

On 17 September 1990, the Applicant requested the EPO to decide that its request for international preliminary examination had been duly filed in time. Subsidiarily it lodged a request for restitutio in integrum and paid the corresponding fee. The EPO's attention was then drawn to the fact that a petition had recently been filed at the USPTO requesting that the date upon which the request for international preliminary examination had been submitted be changed from 5 June 1989 to 2 June 1989, so that if the said request was admitted the filing of 3 May 1990 before the EPO would necessarily be considered to have been made within the time limit laid down in Article 39(1)(a) PCT.

V. On 12 July 1991, the Receiving Section issued a communication which may be summarised as follows:

- The EPO is not competent to decide on the date of filing to be accorded to the request for international preliminary examination, since such a decision is reserved to the authority with which the relevant act has been accomplished;

- according to Article 48(2) PCT, in conjunction with Rule 82bis PCT, the EPO is competent to excuse the non-observance of the time limit provided for in Article 39(1)(a) PCT for the purpose of the proceedings before it and in accordance with the applicable law, i.e. the EPC;
- in the present case the provisions of Article 122 EPC constitute the legal remedy;
- however restitutio in integrum is only possible when the non-observance of the time limit has the direct consequence of causing the loss of a certain right; this is not the case where the failure to observe the time limit provided for in Article 39(1)(a) PCT does not entail any loss of rights, since the international application is still considered valid;
- restitutio would only be possible with regard to the two time limits provided for in Article 22(1) PCT in conjunction with Rule 104b EPC (former version) and the period of grace of Rule 85a(1) EPC;
- since the first of these two periods expired on 3 August 1989, restitutio would then only have been admissible into the second one which expired on 19 October 1990, provided that the omitted acts had been completed in due time.

VI. On 23 September 1991 the Applicant requested an extension of time of two months for reply to the communication of 12 July 1991 as no decision upon its petition had yet been taken by the USPTO.

VII. The decision under appeal dated 6 February 1992 based on the same statements rejected every request, the one for re-establishment as being inadmissible and considered that the application was deemed to be withdrawn with effect from 3 August 1989.

VIII. The Applicant lodged an appeal against that decision on 10 April 1992, and requested that it be cancelled in its entirety. The appeal fee was paid on the same day. The Statement of Grounds of Appeal was filed on 16 June 1992.

In a decision notified to the US attorneys on 3 April 1992, the USPTO denied the request made by the Applicant to accord an earlier date of receipt for the request for the international preliminary examination, which therefore still retains the filing date of 5 June 1989, i.e. more than 19 months after priority.

IX. In its Statement of Grounds the Applicant submitted the following:

A) - Extension of time limit;

the Receiving Section rejected its request for extension of the time limit to answer the communication dated 12 July 1991, saying that the procedural situation was clear enough to allow further proceedings.

Such an extension should nevertheless have been allowed at least up to the date of the issue of the USPTO decision in respect of the filing date of the request for international preliminary examination, upon which depended the further time limit for entering the regional phase before the EPO acting as a designated office.

B) - Re-establishment of rights;

the decision under appeal wrongly asserts that the EPO could not in the present case excuse the non-observance of the time limit provided for in Article 39(1)(a) PCT since it does not entail any loss of rights, the entry in the regional/national phase being still possible within the period laid down in Article 22(1) PCT.

On the contrary, according to the Appellant the right to defer entry to the European national phase is a right within the meaning of Article 122(1) EPC "in fine".

Therefore, bearing in mind that the EPO considered the application withdrawn as from the 3 August 1989, the later filing by the Applicant on 3 May 1990 of EPO Form 1200 accompanied by all fees due for a valid entry into the regional phase, should necessarily have been considered as an application for re-establishment of rights since such an attitude constituted an unequivocal statement of intent to maintain the patent application.

It was then the duty of the EPO to draw the Applicant's attention to deficiencies in the request for re-establishment which were easy to correct within the period provided for in Article 122(2) EPC. Furthermore according to Article 9 EPC of Rules relating to fees the EPO should have overlooked the small amount lacking.

At least the request for re-establishment in respect of the period of grace laid down in Rule 85a(1) EPC should be considered admissible since, on the one hand, the said period having expired only on 19 October 1989, the application of 17 September 1990 had been filed within the time limit pursuant to Article 122(2) EPC, and, on the other hand, the application for re-establishment specifically requested that "any surcharge in respect of any fee are to be debited to our deposit account".

If at that time this instruction was considered by the EPO insufficient to effect the missing surcharge it was at least incumbent on it to inform the Applicant of the deficiency which could still be remedied in due time or within a period of time to be prescribed by the Office.

The principle of good faith requires the EPO to be unambiguous in its communications in order to avoid misleading Applicants. In the present case, the lack of response from the EPO after the filing of Form 1200 for commencing the regional phase was misleading in that it made the Applicant believe that the regional phase had been validly entered.

Neither the European representative nor the US attorney were informed that the EPO considered the application to have lapsed until a telephone conversation with the Senior Formalities Officer on 18 July 1990 during which the possibility of filing a request for re-establishment was raised.

For this very reason, the corresponding application was filed within the two month period following receipt of the information, i.e. on 17 September 1990.

As the communication dated 19 September 1989 warning the Applicant of an impending loss of right was seen by neither the European representative nor the US attorney before 7 September 1990, they both believed in good faith that the term for entering the European regional phase had been deferred to 2 May 1990 as a result of the filing of the request for international preliminary examination before 2 June 1989.

The Appellant pointed out that, although the communications pursuant to Rule 85a EPC and Rule 69(1) EPC were both issued directly to the Applicant, no communication had ever been sent out from the EPO in respect of the filing on 3 May 1990 of Form 1200 accompanied by all due fees, so that the representative had every reason to believe that the regional phase had been validly entered.

Such a misleading communication constitutes a substantial procedural violation of sufficient gravity to allow re-establishment of rights.

Furthermore the notice pursuant to Rule 69(1) EPC had never been received by the Applicant itself.

Therefore the removal of the cause of non-compliance took place on 7 September 1990, date of the receipt by the representative of a copy of the said notice.

In conclusion, the Appellant claimed to have at all times exercised all possible due care to maintain the application in force.

Reasons for the Decision

1. The appeal is admissible.
2. Concerning the request for extension of the time limit set in the office communication dated 12 July 1991.

This request was refused by the first instance for the reasons that on the one hand a long time had elapsed since the filing by the Applicant of a petition at the USPTO in order to obtain an earlier date for the request for international preliminary examination (i.e. on 2 June 1989), and on the other hand that, even if a final decision of the USPTO was still not available, the procedural situation before the EPO was clear enough to allow it to issue a decision in respect of the pending requests for "restitutio in integrum".

However the Board cannot share this opinion since the final admissibility of the request dated 3 May 1990 for entry into the regional phase before the EPO depended on the date of the filing of the request for international preliminary examination with the USPTO.

Moreover, since the EPO had absolutely no right to interfere in the proceedings before the US patent office in respect with the taking of the said decision, the Applicant's request for an extension of the time limit set by the office constituted in fact an interlocutory plea, which prevented the Receiving Section from issuing a decision prior to the final decision by the US patent office on the petition to accord an earlier date of receipt for the request for international preliminary examination.

To decide the contrary could result in a disadvantage to the Applicant if its request for re-establishment before the designated office were to be rejected by a final decision, and if, after it had lost its right to enter the regional phase, it were to appear by virtue of a later final decision of the USPTO that a request for preliminary examination had indeed been filed within the time limit laid down in Article 39(1)(a) PCT and that the Applicant was entitled to keep the benefit of a deferred entry into the regional phase.

However this is not the situation in the present case since, firstly, the Applicant appealed against the decision of the Receiving Section and, secondly, the US patent office refused on 3 April 1992 to rectify the filing date of the request for international preliminary examination, so that the substantial procedural violation consisting of the refusal of the request of extension of the time limit until the interlocutory decision of the USPTO was to hand, did not entail any loss of right for the Applicant.

3. *Concerning the requests for re-establishment*

The first instance considered these requests in respect of all the time limits provided for under either Article

39(1)(a) PCT and Article 22 PCT, or Rule 85a EPC and rejected them all as inadmissible since, on the one hand, no right had been lost, and, on the other hand the omitted act had not been completed and the due fees had not been paid within the time limit set out in Article 122(2) EPC.

- 3.1 However, the provisions of restitutio in integrum do not apply to the time limits referred to in Article 122(5) EPC. In particular, in its decision G 3/91 (OJ EPO 1993, 8), the Enlarged Board of Appeal held that contrary to earlier case law, European PCT Applicants were like European Applicants no longer entitled to have their rights re-established if they failed to observe the time limits for payments of national fees, designation fee or search fees.

The Enlarged Board considered the former case law of the Boards of Appeal, according to which European patent Applicants who had not paid appropriate fees in due time had been re-established in their rights (cf. J 5/80 OJ EPO 1981, 343 and J 12/87 OJ EPO 1989, 366).

It then stated that both European PCT Applicants and European Applicants are to be treated equally and therefore decided that the time limits provided for in Article 78(2) and 79(2) EPC and those provided for in Rule 104b(1)(b) and (c) EPC in conjunction with Article 157(2)b and 158(2) EPC were excluded from restitutio in integrum.

Additionally the Enlarged Board, although the question had not been referred to, discussed the possibility of restitutio in integrum as regards the period of grace pursuant to Rule 85a EPC, stating that this period of grace was closely linked to the normal periods laid down

in Article 78(2), 79(2) and Rule 104b(1)(b) and (c) EPC and was consequently also excluded from re-establishment under the provisions of Article 122(5) EPC.

Another referral by decision J 4/93 related to the application of the new case law to proceedings which were still pending when decision G 3/91 came to the attention of European patent Applicants or their professional representatives, as in the present case.

Thus at that stage of the procedure it was necessary to wait for the decision of the Enlarged Board upon the said question.

In its decision G 5/93 dated 18 January 1994, (OJ EPO 1994, 447) the Enlarged Board upheld its case law, stating that the provisions of Article 122(5) EPC apply to the time limits provided for in Rule 104b(1)(b)(i) and (ii) EPC in conjunction with Article 157(2)(b) and 158(2) EPC; it considered notwithstanding that European PCT Applicants may be re-established in the time limit for paying the national fee provided for in Rule 104b EPC in all cases where re-establishment of rights was applied for before decision G 3/91 was made available to the public.

"Mutatis mutandis" the same solution applies in a case such as the present one where a European PCT Applicant applied for re-establishment into the period of grace according to Rule 85a EPC before decision G 3/91 was published (OJ EPO 1993, 8).

- 3.2 When the Applicant requested restitutio on 17 September 1990 more than one year had lapsed since the 2 June 1989 deadline for filing a request for international preliminary examination with the USPTO allowing the

deferred entry into the regional phase provided for in Article 39(1)(a) PCT, so that the request in respect of this time limit must be considered inadmissible.

Therefore, there is no need for the Board to consider the first instance's arguments relating to the absence of a loss of rights.

This request is also inadmissible as regards the time limit for entry into the regional phase as set out in Article 22(1) PCT in conjunction with Rule 104b(1) EPC (former version), since it expired on 3 August 1989, i.e. more than one year before filing of the request for restitutio.

- 3.3 In view of the period of grace provided by Rule 85a(1) EPC (then valid version), a communication was sent on 19 September 1989 directly to the Applicant so that the 1-year period pursuant to Article 122(1) EPC had not elapsed at the date of the filing of the request for re-establishment dated 17 September 1990.

The first instance however refused to consider such request as admissible since all the omitted acts (i.e. payments of surcharges provided for in Rule 85a(1) EPC) had not been completed in time.

- 3.3.1 The Board cannot share this opinion since in the case in suit the omitted act had in fact been duly completed with the filed application for re-establishment where it is specifically requested that for the purpose of restitutio:

"any further fee which is due for payment of any surcharge in respect of any other fee including the fees paid on 1 May 1990 (i.e. the national fee, search fee,

designation fees, examination fee and the excess claims fees) are to be debited to our deposit account".

It was then incumbent on the EPO to debit the due surcharges from the deposit account of the representative. This could be performed immediately on 17 September 1990 within the 2-month time limit calculated from the removal of the cause of non-compliance.

- 3.3.2 According to the established case law of the Boards of Appeal, the removal of the cause of non-compliance occurs on the date on which the person responsible for the application is made aware of the impending loss of rights.

In the absence of circumstances to the contrary a communication under Rule 69(1) EPC or a notification under Rule 85a(1) EPC to the representative appointed by the person entitled to the patent application removes the cause of non-compliance.

Notwithstanding the fact that such communications were sent by the EPO directly to the Applicant respectively on 19 September 1989 (under Rule 85a(1) EPC) and on 22 January 1990 (under Rule 69(1) EPC) the removal of the cause of non-compliance took place on 18 July 1990, i.e. when the telephone conversation between the newly-appointed professional representative and the EPO took place.

As regards the Applicant itself, it had empowered US attorneys to prosecute the patent application and remained unaware of the procedures before the various patent offices. It had therefore assumed that documents received were copies of those already sent to its

attorneys and was entitled to think in all good faith that they had already dealt with the first communication.

On the other hand, the Appellant still alleges that it never received the second communication pursuant to Rule 69(1) EPC, and nothing in the file allows the EPO to establish that the letter dated 22 January 1990 ever reached its destination.

Certainly in the present case the notification dated 22 January 1990 has been correctly made under provisions of Rule 78(2) EPC, the Applicant having neither residence nor principal place of business within the territory of one of the Contracting States.

However it has to be borne in mind that whether or not the cause of non-compliance has been removed is a matter of fact and therefore must be established beyond any reasonable doubt.

This is not the case where the notification is only deemed to have been made when despatch has taken place even when the receipt of the letter cannot be proved.

On the other hand, the representative of the Appellant, Mr Eyles, became aware of a possible procedural irregularity on 18 July 1990 during a telephone call with the Receiving Section. Since Mr Eyles is the Appellant's representative in the proceedings before the EPO, the Board is satisfied that it is proper to consider the date on which the responsible representative first became aware of the missed time limit to be the date on which the removal of the cause of non-compliance with the time limit occurred (see T 191/82, OJ EPO 1985, 189 = EPOR 1986, 88). Moreover, the minutes of this telephone call show that the

attention of the representative was drawn to the possibility of re-establishment pursuant to Article 122 EPC. Furthermore, it was pointed out to the representative that the two-month time limit pursuant to Article 122(2) EPC started from "today", i.e. 18 July 1990. Taking these facts into account, it is the view of the Board that the request for re-establishment with regard to the time limit provided for in Rule 85a EPC was filed in due time and is therefore admissible.

3.4 Article 122 EPC provides for an Applicant, who, in spite of all due care required by the circumstances having been taken, was unable to observe a time limit vis-à-vis the EPO, thereby losing a right or other redress, to have its rights re-established.

3.4.1 The time limit the Applicant failed to comply with, and which also is the only one it may be reinstated in, is actually the period of grace set in Rule 85a(1) EPC, so that the due care to be appreciated in the case in suit is only the one related to said period of grace.

In the present case, the communication pursuant to Rule 85a(1) EPC was sent directly to the US Applicant, the Louisiana State University, on 19 September 1989.

The Applicant who had appointed the US attorneys for the purpose of the PCT application was entitled to believe that a copy of said communication had been sent to the US attorneys as well, enabling the latter to act in order to maintain the application.

3.4.2 The Board on the other hand wishes to emphasise that the due care to be considered in the present case is in fact not that which is expected from a professional representative but that which is expected from an Applicant unaware of the proceedings, and who generally

assumes that documents received from one of the various patent offices are copies of those already sent to the appointed attorneys or representatives.

Therefore, bearing in mind the principle of proportionality, the loss of the patent application as a result of what may be considered at most a minor procedural irregularity would appear an extremely severe result. Furthermore, although still having slight doubts whether all due care had been taken, in the special circumstances of this case the Board applies the basic principle of law "in dubio pro reo" in favour of the Applicant and therefore allows re-establishment.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The Appellant is re-established in the time limit provided for in Rule 85a(1) EPC.

The Registrar:

The Chairman:

M. Beer

R. Schulte