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File Number: J 0004/93 - 3.1.1
Application No.: 90 914 566.6
Publication No.: WO 91/03727
Title of invention: Method for analyzing agent gas

Classification: G01N 21/35

DECISION
of 24 May 1993

Applicant: Nellcor Incorporated

Headword: Re-establishment/NELLCOR

EPC Art. 122(5), 112(1)(a)

Keyword: "Scope of Article 122(5) EPC" - "Referral to the Enlarged Board of Appeal"



Case Number : J 0004/93 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal
of 24 May 1993

Appellant : Nellcor Incorporated
25495 Whitesell Street
Hayward
CA 94545 (US)

Representative : Wilson, N.M.
Withers & Rogers
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Decision under appeal : Decision of the Receiving Section of the
European Patent Office dated 22 October 1992
rejecting the request for re-establishment of
rights pursuant to Article 122(5) EPC.

Composition of the Board :

Chairman : R. Schulte
Members : B. Schachenmann
G. Davies

Summary of Facts and Submissions

- I. International application WO 91/03727 was filed under the PCT, claiming the priority of a previous US application and designating several Contracting States of the EPC for which the Applicant/Appellant wished to obtain a European patent. This application, therefore, is deemed to be a European patent application (Article 150(3) EPC). It has the European application number 90 914 566.6.
- II. Prior to the expiration of the 19th month from the priority date, the European professional representatives of the Appellant were instructed to request international preliminary examination and to elect **inter alia** the European Patent Office. The European Patent Office, which was the international preliminary examination authority under the PCT, never received such a request. The "national fee" referred to in Article 158(2) EPC was paid neither within the time limit of 21 months laid down in Rule 104b EPC nor within the period of grace pursuant to Rule 85a EPC. The EPO, therefore, informed the Appellant on 18 September 1991 that the European patent application was deemed to be withdrawn.
- III. On 27 February 1992, the European representatives on behalf of the Appellant filed a request for re-establishment of rights based on Article 122 EPC and completed the omitted acts.
- IV. By a communication of 25 June 1992, the Receiving Section informed the Appellant of the decision J 16/90 of the Legal Board of Appeal, which had been published shortly before that date. By this decision the question whether Article 122 EPC (re-establishment of rights) applied to the time limits for the payment of the "national fee" pursuant to Article 158(2) EPC was referred to the

Enlarged Board of Appeal. The Receiving Section in its communication stated that it would return to the request for re-establishment as soon as the Enlarged Board of Appeal had given its ruling. On 22 October 1992, the Receiving Section refused the request for re-establishment based on the decision G 3/91 dated 7 September 1992 of the Enlarged Board of Appeal, without having given the Appellant an opportunity to comment on these new issues. As to the due care requirement, the Receiving Section merely stated: " N.B. Even if the request would be allowable, the due care required by the circumstances (Art. 122(1) EPC) has not been shown."

V. An appeal was filed against this decision "in its entirety" on 17 December 1992. The statement setting out the grounds of appeal substantially contained the following arguments and requests:

- (a) The communication pursuant to Rule 85a EPC, and the notification pursuant to Rule 69(1) EPC of the Receiving Section, were formally incorrect. The notification pursuant to Rule 69(1) EPC, therefore, should be deemed not to have been made and the communication pursuant to Rule 85a EPC should be repeated.
- (b) Article 122 EPC is clear. The interpretation of the provisions of this Article in the decision G 3/91, excluding its application to the time limits pursuant to Article 157(2)(b) and Article 158(2) EPC was incorrect and, in fact, constituted a revision of the Convention in the sense of Article 172 EPC. The decision G 3/91, therefore, should be reconsidered by the Enlarged Board of Appeal with regard to the time limits for entry into the regional phase at the EPO.

- (c) The decision G 3/91 of the Enlarged Board of Appeal constituted a substantial procedural violation in contravention of Article 113(1) EPC and contrary to the principles of good faith governing the relations between the EPO and the Applicants, since the parties whose proceedings before the EPO had been suspended, pending the handing down of the said decision, had not been given an opportunity to present their comments.
- (d) The Appellant submitted two questions regarding the issues referred to in paragraphs (b) and (c) above, with the request that these be referred to the Enlarged Board of Appeal. Should Article 122 EPC be considered applicable in the present circumstances, the Appellant requested that the case be remitted to the first instance for consideration on the merits.

Reasons for the Decision

1. The appeal, which is admissible, lies from a decision of the Receiving Section of the EPO refusing a request for re-establishment of rights under Article 122 EPC in respect of the 21 months' time limit for payment of the "national fee" defined in Article 158(2) EPC and Rule 104b(1)(b) EPC.
2. The Receiving Section of the EPO in its decision only dealt with the question whether, considering the exclusions under Article 122(5) EPC, the provisions of Article 122(1) to (4) EPC were applicable in the present circumstances. This question was answered in the negative by the first instance based on decision G 3/91 of the Enlarged Board of Appeal (OJ EPO 1993, 8). This question would not arise again in the present appeal proceedings,

if the appeal could be decided on other grounds. It is appropriate, therefore, for the Legal Board of Appeal to first examine whether there are any other grounds for allowing or dismissing the appeal.

- 2.1 The Appellant submitted that, due to formal irregularities, the notification pursuant to Rule 69(1) EPC should be deemed not to have been made and that the communication pursuant to Rule 85a EPC should be repeated. However, neither of these communications constitutes a decision subject to appeal within the meaning of Article 106 EPC (T 222/85, OJ 1988, 128). In order to challenge the notification pursuant to Rule 69(1) EPC, the Appellant would have had to apply for an appealable decision (after, if necessary, having obtained re-establishment of rights with regard to the time limit in Rule 69(2) EPC). The request for re-establishment of rights, however, was clearly directed to the "time limit for entry into the European regional phase" and the Appellant did not, in order to complete the omitted act, apply for a decision under Rule 69(2) EPC.

Therefore, in the absence of an appealable decision with regard to the notification pursuant to Rule 69(1) EPC, the appeal cannot be allowed on the ground of the alleged formal irregularities.

Were there to have been any formal irregularity in the transmission of certain communications or notifications by the EPO, this could be considered in the course of an examination of the request for re-establishment of rights on its merits. Such examination, however, will only be possible if, in the present circumstances, the provisions of Article 122(1) to (4) EPC are applicable.

2.2 Leaving aside the question of applicability of Article 122 EPC, it is also not possible to decide the appeal on the basis that the Appellant has failed to take all the due care required by the circumstances. With regard to this question, the first instance confined itself to the statement that "the due care required by the circumstances has not been shown", without giving any reason for this finding. Its decision, therefore, is at variance with the provisions of Rule 68(2) EPC. Neither the Appellant nor the Legal Board of Appeal is able to examine the reasons which led the first instance to the above finding, with the effect that, should the Legal Board of Appeal now decide on this issue, the Appellant would have been deprived of the opportunity of having his case considered by two instances.

Therefore, if in the circumstances of the case the provisions of Article 122(1) to (4) EPC are considered applicable, the Legal Board of Appeal should remit the case to the first instance with the order to issue a reasoned decision on the due care requirement, complying with the provisions of Rule 68(2) EPC. If, on the other hand, Article 122 EPC should not be applicable, obviously the appeal will have to be dismissed.

2.3 From these considerations it follows that the present appeal cannot be decided without an answer to the question whether in the present circumstances the provisions of Article 122(1) to (4) EPC are applicable or not to the case.

3. In the statement setting out the grounds of appeal, the Appellant argued that Article 122 EPC was complete in itself and did not, according to its wording and context, exclude the time limits of Article 157(2)(b) EPC and Article 158(2) EPC from re-establishment of rights.

The decision G 3/91 of the Enlarged Board of Appeal was contrary to the consistent findings of the Boards of Appeal in a long line of cases and in fact constituted a revision of the EPC that the Enlarged Board of Appeal, according to Article 172 EPC, was not entitled to make. This decision, therefore, should not be followed.

The Legal Board of Appeal, at the present stage of the proceedings, does not consider it appropriate to comment on this point of law. Following the Appellant's request, it decides, in view of the similar pending Euro-PCT cases (J 15/90, J 8/91), to refer this question to the Enlarged Board of Appeal. The referral will allow the Enlarged Board of Appeal to consider other legal aspects regarding the interpretation of Article 122(5) EPC. It will e.g. be necessary to consider the fact that Article 122(5) EPC provides an exception to the general rule of Article 122(1) to (4) EPC and, applying general principles of interpretation, cannot just be extended to cover situations to which it does not specifically apply.

Attention will also have to be paid to the fact that, when applying Article 122(5) EPC to Rule 104b EPC, there is a danger that Euro-PCT-applicants will be put at a disadvantage compared with Euro-applicants. Euro-applicants, according to Article 122(5) EPC in combination with Article 78(2) and 79(2) EPC, would be excluded from re-establishment of rights only in respect of the time limits for the payment of the filing fee, the search fee and the designation fees, but not in respect of the claims fee of Rule 31 EPC. In contrast, the "national fee" of Rule 104b(1)(b) EPC for Euro-PCT-applications comprises the national basic fee, the designation fees and, where applicable, the claims fee of Rule 31 EPC. From this it follows, that a Euro-applicant could have his rights re-established in respect of the

time limit for the payment of the claims fee, whereas a Euro-PCT-applicant would be excluded from this possibility. Furthermore, such a exclusion would not appear to be in compliance with Article 48(2)(a) PCT.

In this context, the further question arises whether re-establishment of rights in respect of the time limit for the payment of the "national fee" referred to in Rule 104b(1)(b) EPC could be granted on the ground that part of this composite fee, namely the claims fee, is not excluded from re-establishment.

The referral will also enable the Appellant to present his comments as a party to the proceedings before the Enlarged Board of Appeal (Article 112(2) EPC), thereby obviating his second objection based on Article 113(1) EPC.

Hence, the first question to be referred to the Enlarged Board of Appeal is whether, in the light of Article 172 EPC, the EPO and the Boards of Appeal are competent to exclude, by way of interpretation of Article 122(5) EPC, the time limit provided for in Rule 104b(1)(b) EPC from re-establishment of rights.

4. As follows from points III and IV of the Summary of Facts and Submissions, the Appellant's request for re-establishment was filed before the decision G 3/91 had been taken and even before the respective questions were referred to the Enlarged Board of Appeal (J 16/90, OJ 6/1992).

At the time the request for re-establishment was filed, it was perfectly clear from the jurisprudence of the Boards of Appeal (J 05/80, OJ 1981, 343; J 12/87, OJ 1989, 366) and from the publications of the EPO

(Information for PCT applicants, OJ EPO 1991, 333), that the provisions of Article 122(1) to (4) EPC were applicable to the time limits for payment of the "national fee" pursuant to Rule 104b(1)(b) EPC. The Appellant, therefore, when filing his request for re-establishment, could rely upon a constant legal practice of the EPO and of the Boards of Appeal according to which the provisions of Article 122(1) to (4) EPC were held to be applicable to the time limits referred to in Rule 104b(1)(b) EPC.

Should the Enlarged Board of Appeal confirm the findings of its decision G 3/91 as to the exclusion of the time limits under Rule 104b(1)(b) and (c) EPC from re-establishment of rights, the question of the (retroactive) effect of this decision on pending requests will arise. This point of law may become important not only in the present but also in several other Euro-PCT cases to be decided by the Legal Board of Appeal in which re-establishment of rights was requested before the decision G 3/91 had been made or published.

One of the general principles of law recognized within the jurisprudence of the Boards of Appeal is the principle of protection of the legitimate expectations of the users of the EPO (cf. decision of the Enlarged Board of Appeal G 5,7,8/88, OJ EPO 1991, 137, point 3.2 et seq.). In the light of this principle, the question of the extent to which decision G 3/91 has retroactive effect may be more precisely put as follows:

Is the former, constant practice of the EPO regarding the applicability of Article 122 EPC to the time limit under Rule 104b(1)(b) EPC a sufficient basis for the legitimate expectation of a party to have its request for re-establishment of rights examined according to the former

practice, if the request was filed before the party was duly informed of the decision G 3/91?

5. Should the answer to this question be in the affirmative, the further question arises, from which date can the users of the EPO be assumed to have been duly informed by the EPO of the decision G 3/91. It would correspond with the general principle of equality before the law recognized by the Enlarged Board of Appeal (G 1/86, OJ 1987, 447) to define such date, which then could be applied uniformly to all similar cases.

There are several alternative dates to be considered:

- the date of publication of the decision J 16/90 (i.e. the referral to the Enlarged Board of Appeal) in OJ 6/1992 (printed date of said issue: 12 June 1992),
- the date of the decision G 3/91 (7 September 1992),
- the date of publication of the headnote of the decision G 3/91 in OJ 11/1992 (printed date of said issue: 5 November 1992),
- the date of publication of the decision G 3/91 in OJ 1-2/93 (printed date of said issue: 12 February 1993).

Since the users of the EPO only had the opportunity to become aware of the full extent of the new jurisprudence after the decision G 3/91 had been published in OJ 1-2/93, the date of publication of this issue of the Official Journal appears to be the most appropriate for the purpose referred to above.

In order to avoid any misunderstanding, it is pointed out that the protection of legitimate expectations could only refer to the expectation of the users to have their request for re-establishment of rights examined on the basis of the jurisprudence established at the date of filing the request, which would not include any expectation of a successful outcome to such examination.

6. As set out in point 2, an answer to the questions referred to in points 3, 4 and/or 5 is required to decide the present case. These questions refer to points of law which are important not only for deciding the present case but also with a view to the other Euro-PCT cases pending before the Enlarged Board of Appeal (J 15/90, J 8/91). Therefore, these questions are referred to the Enlarged Board of Appeal pursuant to Article 112(1)(a) EPC.

On the other hand, the Legal Board rejects the Appellant's request to refer to the Enlarged Board of Appeal the question whether it is "allowable for the Enlarged Board of Appeal to make a decision without reading and considering comments made by the parties concerned". Since the Appellant, as a result of the present referral, will have the opportunity to present his comments as a party to the proceedings before the Enlarged Board of Appeal, no answer to this question is required in the circumstances of the present case.

Order

For these reasons, it is decided that:

The following points of law are referred to the Enlarged Board of Appeal:

1. Is the EPO and are the Boards of Appeal, in the light of Article 172 EPC, competent to exclude, by way of interpretation of Article 122(5) EPC, the time limit provided for in Rule 104b(1)(b) EPC from re-establishment of rights?

2. If the answer is yes (and the decision G 3/91 is confirmed with regard to the time limit provided for in Rule 104b(1)(b) EPC):
Is the former, constant practice of the EPO regarding the applicability of Article 122 EPC to the time limit referred to in Rule 104b(1)(b) EPC a sufficient basis for the legitimate expectations of a party to have its request for re-establishment examined according to this former practice, if the request was filed before the party was duly informed of the decision G 3/91?

3. If the answer to question 2 is yes:
From which date can the users of the EPO be assumed to have been duly informed of decision G 3/91?

The Registrar:

The Chairman:

J. Ruckerl

R. Schulte