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**D E C I S I O N
of 9 June 1994**

Case Number: J 0004/93 - 3.1.1

Application Number: 90914566.6

Publication Number: WO 91/03727

IPC: G01N 21/35

Language of the proceedings: EN

Title of invention:
Method for analyzing agent gas

Applicant:
Nellcor Incorporated

Opponent:

-

Headword:
Re-establishment/NELLCOR II

Relevant legal norms:
EPC Art. 122(5)

Keyword:
"Scope of Article 122(5) EPC"

Decisions cited:

-

Headnote/Catchword:



Europäisches
Patentamt

European
Patent Office

Office européen
des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number: J 0004/93 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 9 June 1994

Appellant: Nelcor Incorporated
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Representative: Wilson, N.M.
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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 No. PCT/US 90/05046 (publication No. WO 91/03727) was filed under the PCT and is deemed, pursuant to Article 150(3) EPC, to be a European patent application. It has the European application number 90 914 566.6.

- II. The European Patent Office, which was the international preliminary examination authority under the PCT for the present application, did not receive a demand for international preliminary examination. The "national fee" referred to in Article 158(2) EPC, which was therefore due within the time limit of 21 months laid down in Rule 104b(1)(b) EPC, was paid neither within this period 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 The EPO, therefore, informed the Appellant on 18 September 1991 that the European patent application was deemed to be withdrawn.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. The European representatives on behalf of the Appellant filed a request for re-establishment of rights pursuant to Article 122 EPC on 27 February 1992 and completed the omitted acts.

- IV. By its decision of 22 October 1992 the Receiving Section refused the request for re-establishment. In the reasons, reference was made to decision G 3/91 dated 7 September 1992 of the Enlarged Board of Appeal (OJ EPO 1993, 8), according to which Article 122(5) EPC excluded the possibility for Euro-PCT applicants to have their rights re-established with respect to the time limits laid down in Rule 104b(1)(b) EPC.

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 the decision of the Receiving Section 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 Rule 104b(1)(b) 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.

VI. On 24 May 1993 the Legal Board of Appeal, in accordance with the Appellant's request, decided to refer three legal questions to the Enlarged Board of Appeal (cf. decision J 4/93 of 24 May 1993, questions published in OJ EPO 1993, 705). These questions were:

- "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?"

- VII. The Enlarged Board of Appeal, in its decision G 5/93 of 18 January 1994 (headnote published in OJ EPO 5/1994), answered question 1 by confirming 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 Articles 157(2)(b) and 158(2) EPC.

With regard to questions 2 and 3 it decided that Euro-PCT applicants may have their rights re-established with respect to 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.

Reasons for the Decision

1. The admissible appeal lies from the decision dated 22 October 1992 of the Receiving Section refusing the Appellant's request for re-establishment of rights under Article 122 EPC in respect of the 21 months' time limit for payment of the national fee provided for in Rule 104b(1)(b) EPC.
2. In the meantime, the Enlarged Board of Appeal has issued the decision G 5/93 (cf. point VII. above). It is binding on the Legal Board of Appeal in respect of the present appeal (cf. Article 112(3) EPC).

The decision G 5/93 makes it clear that the provisions of Article 122(5) EPC apply to the time limits provided for in Rule 104b(1)(b)(i) and (ii) EPC thereby excluding

the possibility for Euro-PCT applicants to have their rights re-established with respect to the time limits for paying the national basic fee and the designation fees.

This notwithstanding, Euro-PCT applicants may have their rights re-established with respect to the time limits referred to above in all cases where the application for re-establishment of rights was filed before decision G 3/91 was made available to the public (cf. G 5/93, Order, last sentence).

3. The main issue to be considered in the present case is therefore whether the Appellant applied for re-establishment of rights before decision G 3/91 of 7 September 1992 was made available to the public. The Appellant's application for re-establishment of rights was filed on 27 February 1992, i.e. before the Enlarged Board of Appeal arrived at its decision G 3/91. Thus, since the Appellant had applied for re-establishment already before G 3/91 was decided, it may have its rights re-established with respect to the time limit for paying the national fee provided for in Rule 104b EPC, provided that the requirements pursuant to Article 122(1) to (3) EPC are complied with.
4. The decision under appeal did not consider the question whether, in the circumstances of the present case, the requirements pursuant to Article 122(1) to (3) EPC were complied with. The Receiving Section confined itself to stating that "the due care required by the circumstances has not been shown", without giving any reason for this finding. Neither the Appellant nor the Legal Board of Appeal is therefore able to examine the reasons which led the first instance to the above finding, with the effect that, should this Board now decide on these

issues, the Appellant would have been deprived of the opportunity of having its case considered by two instances.

5. The Board accordingly exercises its power under Article 111(1) EPC to remit the case to the first instance for consideration of the merits of the Appellant's request for re-establishment of rights filed on 27 February 1992.

6. The Appellant's additional request that, due to formal irregularities, the notification pursuant to Rule 69(1) EPC be deemed not to have been made and the communication pursuant to Rule 85a EPC be repeated, was already considered by this Board in the decision J 4/93 dated 24 May 1993. The Board found that neither of these communications constituted a decision subject to appeal within the meaning of Article 106 EPC (T 222/85, OJ EPO 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 Appellant's request that the communication pursuant to Rule 85a EPC be repeated is rejected. 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 the examination of the merits of the request for re-establishment of rights.

7. The referral enabled the Appellant to present its comments as a party to the proceedings before the Enlarged Board of Appeal (Article 112(2) EPC). The Appellant's further objection based on Article 113(1) EPC is, therefore, without foundation.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:



M. Beer

The Chairman:



R. Schulte