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File No.: J 0007/93 - 3.1.1
Application No.: 90 903 571.9
Publication No.: WO 90/08604
Classification: B08B 7/00
Title of invention: Apparatus and method for cleaning contact lenses

D E C I S I O N
of 23 August 1993

Applicant: Beckrich Corporation
Proprietor of the patent:
Opponent:

Headword: Contact lenses/BECKRICH

EPC: R. 104(b); **PCT:** Art. 39; information for PCT applicants, OJ
1992, 245

Keyword: "Communications pursuant to Rule 69(1) and Rule 85(a) EPC by the
EPO regarding itself as designated Office" - "Following
information of the EPO of its election, failure to inform the
applicants to ignore the premature communications"

Headnote
Catchwords



Europäisches
Patentamt

European
Patent Office

Office européen
des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number: J 0007/93 - 3.1.1

DECISION
of the Legal Board of Appeal 3.1.1
of 23 August 1993

Appellant: Beckrich Corporation
2515 Birchview Lane
Minnetonka
Minnesota 55343 (US)

Representative: Allard, Susan Joyce
Boult, Wade & Tennant
27 Furnival Street
London EC4A 1PQ (GB)

Decision under appeal: Decision of the Receiving Section of the European Patent Office dated 22 October 1992 refusing request for re-establishment of rights pursuant to Article 122 EPC.

Composition of the Board:

Chairman: R. Schulte
Members: B. Schachenmann
S.C. Perryman

Summary of Facts and Submissions

- I. International application PCT/US 90/00516, having the priority date of 2 February 1989, was filed at the US Patent and Trademark Office which, in the present case, acted as the receiving Office. The Applicant/ Appellant requested, within the 19 month time limit of Article 39 PCT, international preliminary examination under PCT Chapter II. The request contained - *inter alia* - the election of several designated Contracting States of the EPC for which the Appellant wished to obtain a "regional patent". The EPO, therefore, became an elected Office for the present application within the meaning of Article 2(xiv) PCT.

- II. The International Bureau did not notify the EPO of its election within the 21 month time limit under Rule 104(b)(1) EPC. After the end of the 21 month period, the EPO - being unaware of its election - issued a communication pursuant to Rule 85(a) EPC asking the Applicant/Appellant to pay the national fee, the search fee and the designation fees. This communication, however, was premature since, according to Rule 104(b)(1) EPC and Article 39 PCT, the extended time limit of 31 months under PCT Chapter II was applicable to the present case.

- III. The Appellant's US professional representatives, due to an error in their offices, failed to pay the fees referred to above within the 31 month time limit applicable to the present case according to Rule 104(b)(1) EPC and Article 39 PCT. This term ended on 2 September 1991. The error was discovered in May 1992 and a request for re-establishment of rights was filed within the two month time limit of Article 122 EPC.

- IV. The EPO, in the meantime, had issued a notification pursuant to Rule 69(1) EPC according to which the application was deemed to be withdrawn. This notification, dated 8 April 1992, again referred to the supposed failure to observe the 21 month time limit pursuant to Rule 104(b)(1) EPC and Article 22(1) PCT since the EPO, at that time, was still unaware of its election under PCT Chapter II. It was not until 21 July 1992 that the EPO received the notification of election pursuant to Rule 61.2 PCT from the International Bureau.
- V. On 22 October 1992 the Receiving Section refused the request for re-establishment on the ground that, following the Enlarged Board of Appeal's decision G 03/91, the re-establishment of rights in respect of the time limits for paying the fees pursuant to Rule 104(b)(1)(b) and (c) EPC was excluded under Article 122(5) EPC.

Reasons for the Decision

1. The appeal, which is admissible, lies from the decision of the Receiving Section dated 22 October 1992 refusing the Appellant's request for re-establishment of rights under Article 122 EPC. The Receiving Section, in its decision, tacitly started from the assumption that the Appellant had failed to observe "the time limits for the payment of the national fee, designation fees and search fee". However, it does not follow from the decision which time limit, in the view of the first instance, was exactly concerned. The Legal Board of Appeal, therefore, has to consider first whether the EPC and/or the PCT provide for any time limit that was not observed by the Appellant.

2. As pointed out in the summary of facts and submissions, the communication pursuant to Rule 85(a) EPC and the notification pursuant to Rule 69(1) EPC both were issued with reference to the 21 month period under Rule 104(b)(1) EPC, although, in the present circumstances, the 31 month period was applicable instead of the 21 month period. This proceeding is in line with the constant practice of the EPO according to which the communications referred to above are issued after the 21 period has expired if, by this time, the EPO has not been notified of its election under Article 31(7) and Rule 61.2 PCT. This practice is outlined in an "Information for PCT applicants ...", published in the Official Journal 1992, 245. According to this practice the EPO, once informed of its election, should tell the applicant "to ignore" the previous communications, because the period for taking the steps for entry into the regional phase is increased under Rule 104(b) EPC to 31 months. The communication pursuant to Rule 85(a) EPC and the notification pursuant to Rule 69(1) EPC, in these circumstances, are considered to be legally non-existent because they cannot be based on any provision contained in the EPC or in the PCT. The Legal Board of Appeal has no reason, in the present circumstances, to object to this practice of the EPO.
3. However, it immediately follows from this practice that a party which, in these circumstances, ignores the communication pursuant to Rule 85(a) EPC and the notification pursuant to Rule 69(1) EPC and which does not react to them must not suffer any loss of right. The reason for which a party refrains from reacting to these communications is not relevant since the communications referred to above, being legally non-existent, can not have any legal effect to the party's detriment.

4. In the circumstances of the present case, the communication pursuant to Rule 85(a) EPC dated 30 November 1990 and the notification pursuant to Rule 69(1) EPC dated 8 April 1992, both referring to the 21 month period of Article 22 PCT and Rule 104(b)(1) EPC, are legally non-existent, since the election of the EPO was effected prior to the expiration of the 19th month from the priority date (Article 39 PCT) and the time limit of Rule 104(b)(1) EPC, therefore, was extended to 31 months. Consequently, the notification pursuant to Rule 69(1) EPC dated 8 April 1992 has no legal effect.

5. The Appellant failed to pay the national (basic) fee, designation fees and search fee within the 31 month time limit of Rule 104(b)(1) EPC and Article 39 PCT. According to the provisions of Rule 85(a) EPC these fees may still be paid together with a surcharge within a period of grace of one month of notification of a communication pointing out the failure to observe the time limit. Until now no such communication with regard to the 31 month time limit has validly been issued by the EPO. Since, in the meantime, the Appellant has paid these fees together with its request for re-establishment of rights and thereby has met the requirements pursuant to Rule 104(b)(1) EPC, it is no longer necessary for the EPO to issue a Rule 85(a) communication with regard to the 31 month time limit.

6. On 21 July 1992 the EPO was notified by the International Bureau of its election under Article 31(7) and Rule 61.2 PCT. In contrast to its constant practice referred to under point 2 of this decision, the EPO did not tell the Appellant to ignore its previous communications issued in connection with the 21 month time limit. Such information would have enabled the Appellant to recognise that its request for re-

establishment was unnecessary. Instead, the EPO continued the proceedings of re-establishment of rights and finally refused *restitutio* without taking into account the fact that these proceedings were unnecessary from the very beginning. All this amounts to a substantial procedural violation within the meaning of Rule 67 EPC. Therefore, it is equitable to order reimbursement of the appeal fee, even though the Appellant has not applied for this (cf. Decision J 7/82, OJ 1982, 391).

7. .Since the Appellant, with the payment of the fees provided for in Rule 104(b)(1) EPC plus the surcharge of Rule 85(a) EPC, had no longer any legal ground to request re-establishment of rights, the fee for re-establishment was wrongly accepted by the EPO and, therefore, must be refunded to the Appellant (cf. Decision J 1/80, OJ 1980, 289).

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 of the application.

3. Reimbursement of the appeal fee is ordered.
4. Refund of the fee for re-establishment of rights is ordered.

The Registrar:



M. Beer

The Chairman:



R. Schulte

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