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Registries

Chambres de recours
Greffes

Aktenzeichen

File Number

Numéro du dossier

J 14 194 - 311

In der Anlage erhalten Sie

eine Kopie des Berichtigungsbeschlusses

ein korrigiertes Vorblatt (Form 3030)

einen Leitsatz / Orientierungssatz (Form 3030)

Please find enclosed

a copy of the decision correcting errors

a corrected covering page (Form 3030)

a headnote / catchword (Form 3030)

Veuillez trouver en annexe

une copie de la décision rectifiant des erreurs

une page de garde (Form 3030) corrigée

un sommaire / une phrase vedette (Form 3030)

Anmeldung Nr. / Patent Nr.:

(soweit nicht aus der Anlage ersichtlich)

Application No. / Patent No.:

86303 0557

(if not apparent from enclosure)

Demande n° / Brevet n°:

(si le n° n'apparaît pas sur l'annexe)



Case Number: J 0014/94 - 3.1.1

D E C I S I O N
of 9 March 1995 correcting an error in the decision
of the Legal Board of Appeal 3.1.1
of 15 December 1994

Appellant: The Expanded Metal Company Ltd.
P.O. Box No. 14
Longhill Industrial Estate (North)
Hartlepool TS25 1PR (GB)

Representative: Skerrett, John Norton Haigh
H.N. & W.S. Skerrett
Charles House
148/9 Great Charles Street
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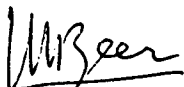
Decision under appeal: Decision of the Formalities Section of the EPO
dated 21 August 1991 rejecting the European patent
application No. 86 303 055.7.

Composition of the Board:

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

In application of Rule 89 EPC the expression "February 1990" has been exchanged by the expression "February 1991" on page 5, line 6.

The Registrar:



M. Beer

The Chairman:



R. Schulte

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen

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

Case Number: J 0014/94 - 3.1.1
Application Number: 86303055.7
Publication Number: 0199595
IPC: E04B 1/41, E04B 2/00

Language of the proceedings: EN

Title of invention:
Wall construction device

Applicant:
The Expanded Metal Company Ltd.

Opponent:
-

Headword:
Principle of good faith/THE EXPANDED METAL COMPANY

Relevant legal provisions:
EPC Art. 86(3)
EPC R. 67, 69(1)

Keyword:
"Loss of rights"
"Belated communication pursuant to Rule 69(1) EPC"
"Continuation of examination procedure after loss of rights"
"Principle of good faith"
"Venire contra factum proprium"

Decisions cited:
J 0003/87, OJ EPO 1989, 3; J 0001/89, OJ EPO 1992, 17.

Headnote:

I. If, during a long period of time, the EPO by its conduct leads the parties and the public to the legitimate belief that no loss of rights has taken place, the EPO cannot later refer to a loss of rights which occurred several years previously without offending against the prohibition of "venire contra factum proprium" and therefore contravening the principle of good faith.

II. In such circumstances, the late payment of a renewal fee may - by way of exception - be considered as having been made in time, if the EPO had not informed the applicant of the outstanding payment, had accepted later renewal fees without objection and had continued the examination proceedings for several years (here: until notification of the communication pursuant to Rule 51(6) EPC).



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

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Summary of Facts and Submissions

- I. The Appellant and Applicant filed European patent application No. 86 303 055.7 on 23 April 1986. The renewal fee for the third year fell due on 2 May 1988, but was not paid by that date. Contrary to its practice, the European Patent Office did not issue a notice drawing the Appellant's attention to the possibility offered by Article 86(2) EPC. Nor did the Appellant pay the renewal fee together with the additional fee within the six months of the due date provided for in the Article referred to above.

- II. Nevertheless, the European Patent Office continued the examination procedure without informing the Appellant of any loss of rights. In 1989 and 1990, the Office accepted the renewal fees for the fourth and the fifth year. On 18 April 1990, a communication pursuant to Rule 51(4) EPC was issued followed by the Appellant's approval of the text notified. Finally, the Appellant paid the fees for grant and printing and filed the translations of the claims in accordance with the Office's communication pursuant to Rule 51(6) EPC dated 12 June 1990.

- III. On 15 January 1991 the professional representative asked the European Patent Office when the decision to grant could be expected. Following this inquiry the European Patent Office, on 18 February 1991, issued a communication pursuant to Rule 69(1) EPC stating that the application was deemed to be withdrawn due to non-payment of the renewal fee for the third year. The Appellant was also advised that the one year's time limit for filing a request for re-establishment under Article 122 EPC had already expired at that time.

IV. The Appellant then applied for a decision on the matter pursuant to Rule 69(2) EPC and paid the renewal fee for the third year plus the additional fee. In its decision of 21 August 1991, the European Patent Office stated that the failure to issue a notice under Rule 69(1) EPC informing the Appellant of its loss of rights at an early date could not have the effect of reversing a loss of rights which had already occurred. Accordingly, the application was deemed to be withdrawn as from 3 November 1988 and the refund of all fees paid by the Appellant after that date was ordered.

V. On 12 October 1991, the Appellant filed a notice of appeal against that decision having paid the appeal fee on 11 October 1991. A written Statement of Grounds of Appeal was received on 30 December 1991.

The Appellant requested that the decision under appeal be set aside and that the third renewal fee be deemed to have been paid in due time.

It argued essentially as follows:

- (a) The presumption of the first instance that loss of rights (deemed withdrawal) under Article 86(3) EPC occurs automatically by operation of law as soon as the last date for payment of a renewal fee has elapsed, was not based on a correct interpretation of that Article. In particular, taking its second sentence into account, it is clear that there must first be at least some decision of the EPO before the loss of rights can occur. It was therefore not correct to refer to a loss of rights "which has already occurred".

- (b) It follows from the case law of the Boards of Appeal, especially from the decision J .. /87 (OJ EPO 1988, 323), that the European Patent Office may exercise a discretion in appropriate circumstances to decide to "deem" that a fee, including a renewal fee, has been paid in due time even though it has not actually been so paid or when such payment cannot be proved from EPO records.

- (c) The failure to send any communication pursuant to Rule 69(1) EPC notifying the Applicant of the apparent loss of rights before expiry of the one year period of Article 122(2) EPC for applying for re-establishment of rights had resulted in the Appellant being statute barred and deprived of any opportunity to redress the situation under the provisions of that Article. The fact that the communication was sent well over two years later after the Appellant had already been informed of an intention to grant the patent constituted a serious procedural violation.

- (d) Accordingly, the European Patent Office should act to uphold the principle of good faith that governs relations between the Office and the users of the European patent system since in all the circumstances of the present case it would be fair and just to do so and would not cause any detriment to the public interest.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 1(1) and 64(b) EPC and is, therefore, admissible.
2. The decision of the first instance was substantially based on the grounds that the Office's failure to issue a notice pursuant to Rule 69(1) EPC at an early date could not have the effect of reversing a loss of rights which had already occurred (cf. point 4 of the decision)..
3. Pursuant to Rule 69(1) EPC the European Patent Office, if it notes that the loss of any rights results from the Convention, shall communicate this to the party concerned. If the party disagrees with the finding of the EPO it may apply for a decision on the matter by the EPO (Rule 69(2) EPC) or it may request further processing or re-establishment of rights, as the case may be.

Although, in the Board's view, an early transmission of the communication under Rule 69(1) EPC would clearly be desirable, there is no provision in the Convention imposing any obligation on the European Patent Office to issue such a communication within a certain period of time after a loss of rights has occurred or has been noted. Neither is there any provision according to which a loss of rights, which occurred by operation of law, may be reversed for the reason that the communication referred to above was issued late. Therefore, in the Board's view, the mere fact that a communication pursuant to Rule 69(1) EPC is issued late may not, as such, reverse a loss of rights.

4. However, in the circumstances of the present case, the European Patent Office not only failed to issue a communication pursuant to Rule 69(1) EPC at an early date, but rather took an active part in the continuation of the examination procedure for more than two years (from November 1988 to February 1990) after the critical date.

During this period the Office accepted all the fees paid by the Appellant (the renewal fees for the fourth and the fifth year as well as the fees for grant and printing). In the course of substantive examination, the Office issued several communications inviting the Appellant to perform procedural steps required in view of a later grant of the patent.

Hence, for more than two years after the critical date the European Patent Office indicated by its conduct that the application was still pending thereby implying that the time limit for paying the renewal fee for the third year was deemed to have been complied with.

5. The Appellant, not being aware of the failure to comply with the time limit referred to above, concluded from the Office's conduct that the patent application was still pending during the period of substantive examination in 1989 and 1990. Moreover, since the European Patent Office accepted the renewal fees for the **fourth** and the **fifth** year, the Appellant had every reason to believe that the time limit for the payment of the renewal fee for the **third** year had duly been complied with. Consequently, the Appellant, trusting that the application was still pending, invested time and effort in the examination procedure which, under the guidance of the European Patent Office, continued until the application was ready for grant.

6. Third parties informing themselves about the status of the patent application in question had no reason to believe that a loss of rights had occurred either. An inspection of the European Patent Register (Article 127, Rule 92) would not have revealed, still at the end of 1990, any entry of a deemed withdrawal of the application (cf. Rule 92(1)(n) EPC). An inspection of files (Article 128, Rule 94) would have confirmed that the examination procedure was duly continuing until the application was ready for grant.

7. Summarizing the above considerations, the following factors which were not sufficiently considered by the first instance appear to be relevant in the circumstances of the present case:
 - By the Office's conduct, the Appellant as well as third parties were led to believe that the application was still pending in 1989 and 1990.

 - Based on this assumption, the Appellant in good faith continued the examination procedure with the active cooperation of the European Patent Office for more than two years.

 - The Appellant could not have expected that, at the very end of the examination procedure, the Office should have revealed unexpectedly a loss of rights that had occurred at an early stage of the proceedings.

 - Third parties never had any ground to suppose that a loss of rights had occurred at any stage of the proceedings.

8. According to the case law of the Boards of Appeal, the principle of good faith governing relations between the EPO and the applicants require communications to be clear and unambiguous to the applicant. An applicant must not suffer a disadvantage as a result of having relied on a misleading communication (cf. J 3/87, OJ EPO 1989, 3; J 1/89, OJ EPO 1992, 17, points 6 and 7 of the Reasons).

In the present case, the EPO never issued a communication explicitly stating that there was no loss of rights. However, its conduct during a long period of time led the applicant and the public to the legitimate belief that no loss of rights had occurred. Such conduct in effect corresponded to a misleading communication of the EPO on which the applicant was entitled to rely. For the EPO to refer much later to a loss of rights which had occurred several years previously was clearly inconsistent with its previous behaviour and therefore offended against the generally recognized prohibition of "venire contra factum proprium" (Dig. 1, 7, 25 pr.) thereby contravening the principle of good faith governing relations between the EPO and the applicants.

9. In the circumstances referred to above, since the EPO had not informed the applicant of the outstanding payment but accepted later renewal fees without objection and continued the examination proceedings for several years, the late payment of a renewal fee may - by way of exception - be considered as having been made in time.

10. In consideration of the fact that the Appellant itself was responsible initially for the failure to pay the fee which led to the Office's misconception regarding the status of the application, a reimbursement of the appeal fee pursuant to Rule 67 EPC appears not to be equitable.

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 with the order to grant the patent on the basis of the approved text.

The Registrar:


M. Beer

The Chairman:


R. Schulte