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D E C I S I O N
of 19 June 1995

Case Number: J 0022/94 - 3.1.1

Application Number: ...

Publication Number: -

IPC: B02B 1/00

Language of the proceedings: EN

Title of invention:
Reduction of phytale in oats

Applicant: N.N.

Opponent:

-

Headword:
Reduction of phytale/S.

Relevant legal provisions:

EPC Art. 14, 122, 133

EPC R. 6, 81

Keyword:

"Re-establishment of rights - no"

"Two months time limit - cause of non-compliance"

"Address for correspondence"

"Appointment of representative - no retrospective effect"

"Principle of good faith - no warning for any deficiency"

Decisions cited:

G 0005/88; J 0041/92

Catchword:

I. An appointment of a representative has no retrospective effect on notifications made before.

II. A party may only expect a warning in respect of a deficiency if there was a specific indication for the EPO that there could be a misunderstanding in respect of the requirements to be fulfilled.



Case Number: J 0022/94 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 19 June 1995

Appellant 01: N.N.

Appellant 02: N.N.

Representative: N.N.

Decision under appeal: Decision of the Receiving Section of the European Patent Office dated 30 June 1994 refusing a request for re-establishment of rights concerning European patent application No. ... pursuant to Article 122 EPC.

Composition of the Board:

Chairman: R. Schulte
Members: R. E. Teschemacher
G. Davies

Summary of Facts and Submissions

- I. European patent application ... was filed on 7 May 1993 in the name of Ms. S. and Ms. L.. The request for grant (form 1001) indicated Mr. B. as representative in box 15/16 as well as the address for correspondence in box 9. On 28 June 1993, an English translation of the original Swedish application documents was filed by Ms. S., the applicant named first in the request for grant. In reply to an enquiry, the Receiving Section sent on 5 August 1993 an information to Ms. S. on fees to be paid and advising the applicants to appoint a professional representative if they were not familiar with the EPC. On the same date, a letter was sent to Mr. B., informing him that he could not act as a representative and that communications would be sent to the applicants directly.
- II. On 7 September 1993, Ms. S. was informed pursuant to Article 90 (3) EPC that the application was deemed to be withdrawn since the translation of the application had not been filed within 13 months from the priority date. In the communication, the assumption was expressed that the priority date indicated in the request form (8 May 1993) was subject to a clerical error and that the correct date should have been 8 May 1992. Furthermore, the applicants were informed of the possibility to request a decision pursuant to Rule 69 (2) EPC if they considered that the finding of the EPO was inaccurate. By letter of 26 October 1993, received on 28 October 1993, a professional representative was appointed who filed the priority document for the previous Swedish application of 11 May 1992. The priority declaration in the request for grant (box 25) was rectified accordingly ex officio. At the same time, the representative requested re-establishment of rights since Mr. A., the

applicants' adviser in patent matters had been suffering from a severe heart disease in the relevant period and had been prevented from informing the applicants of the requirement to file a translation.

- III. In a communication from the Receiving Section of 28 January 1994, the applicants were informed that it had not been shown that all due care required by the circumstances had been applied and that the request for re-establishment was deemed not to have been filed according to Article 122 (3) EPC because the necessary fee had not been paid.
- IV. In response, the applicants paid the fee on 24 February 1994, and requested the EPO to consider Mr. A. as having been appointed as their representative with effect from the filing date until the date when the new representative was appointed (28 October 1993).
- V. By decision of the Receiving Section of 30 June 1994 the request for re-establishment was refused and the application stated to be deemed to be withdrawn. The reason given was that the request was deemed not to have been filed since the necessary fee had not been paid in due time. Even if the fee had been paid in due time the request could not have been allowed since the applicants had not applied all due care. Mr. A. had neither been an employee of the applicants nor a professional representative. Therefore, he could not be a party to the proceedings and the responsibility of filing the translation remained with the applicants.
- VI. An appeal was filed on 29 August 1994 and the necessary fee was paid at the same time. A Statement of Grounds was filed on 12 October 1994. The appellants submitted that their employer had directed them to Mr. A., a representative of the Department of Innovation

Technology, for help in patent matters. Because of the close relationship between the employer, the appellants and Mr. A. "the general principles of representation should be applicable". Furthermore, it was argued that the EPO should have addressed procedural communications to Mr. B. since he had been indicated as the address for correspondence in the request form. Ms. S. had regarded the notifications sent to her to be only copies of the correspondence between the EPO and Mr. B. and had not paid too much attention to them.

VII. In respect of the fee for re-establishment, it was argued that the request for *restitutio in integrum* in the letter of 26 October 1993 had been filed only as a precautionary measure and that the fee had not been necessary for the request for a decision under Rule 69 (2) EPC which had been referred to in the communication of 7 September 1993. The fee had been paid after the communication of 28 January 1994 mentioning that the fee was lacking.

VIII. The appellants requested that the decision under appeal be set aside and that their rights be re-established.

Reasons for the Decision

1. The appeal is admissible.
2. Since the application was filed in the Swedish language, a translation thereof had to be filed within three months after filing, but no later than thirteen months after the priority date pursuant to Article 14 (2), first sentence, EPC, in connection with Rule 6 (1), first sentence, EPC.

2.1 In the present case, the indication 8 May 1993 in the declaration of priority was corrected by the Receiving Section *ex officio*, i.e. without a request or the agreement of the applicants. The corrected date is 11 May 1992 and corresponds to the date certified by the Swedish Patent Office as the date of filing on the priority document.

2.2 In reply to a communication from the Board, the appellants insisted on this priority and declared that they did not wish to abandon it. Thereby they agreed with the correction made by the Receiving Section. Therefore, the time limit of thirteen months applies with the consequence that the translation was not filed in due time. Hence, the Receiving Section was correct in stating that the application was deemed to be withdrawn pursuant to Article 90 (3) EPC.

3. The request for *restitutio in integrum* is not admissible.

3.1 The request had to be filed within two months from the removal of the cause of non-compliance with the time limit (Article 122 (2), first sentence, EPC).

3.1.1 The appellants submit that they failed to file the translation in due time because they did not know that such a requirement existed. They were informed of it at the latest by the notification of 7 September 1993 which prompted them to appoint a representative and to file a request for *restitutio in integrum* with their representative's letter dated 26 October 1993, received on 28 October 1993. The fact that the translation already had been filed on 28 June 1993 may give rise to the assumption that the cause of non-compliance was removed before receipt of the notification of 7 September 1993. There is, however, no need to clarify

this point since the request was not filed validly in due time, even if the cause of non-compliance was not removed until receipt of the notification.

- 3.1.2 The request was not deemed to be filed until the fee for re-establishment of rights had been paid, i.e. not until 24 February 1994, four months after the appellant's initial response to the communication of 7 September 1993. This means that the request was deemed to be filed after the end of the prescribed time limit of two months (Article 122 (2), first sentence, (3), second sentence, EPC).
4. The appellants submit that the EPO should have sent any correspondence to Mr. B, the person indicated as the address for correspondence in the request for grant, apparently implying that the Office contributed to the missing of the time limit. The Board is not in a position to draw from this submission any conclusions in favour of the appellants. The person indicated as address for correspondence was also indicated as representative in the request form. Not being an authorised representative, however, he was not entitled to act for the applicants (Articles 133, 134 EPC) and could not be validly appointed. Hence, Rule 81 (1) EPC did not apply and any notification had to be sent to the applicants themselves. Mr. B's address was not an address of the applicants themselves and could, therefore, not be used as their address for correspondence. The notes to the request for grant state expressly that the EPO accepts as address for correspondence only the applicant's own address. The later appointment of Mr. A. had no effect on the previous notifications. First, Mr. A was not entitled to act as an authorised representative (Article 134 (1) EPC). As an employee, he could act under Article 133 (3) EPC only for his employer but not for other employees of

the same employer. Second, the appointment of a representative cannot have any retrospective effect on notifications made before. Rule 81 (1) EPC only applies if a representative is actually appointed before a notification is posted since a notification has to be made on the basis of the facts on file at the time of posting. For these reasons, it was correct to send any communication to the address of the applicant first named in the request for grant (Rule 100, first sentence, EPC). Apart from these considerations, the requirement to file the translation was not dependent on the receipt of any preceding information from the EPO.

5. The appellants could not expect to be informed of the requirement to pay the fee for re-establishment. Whereas the EPO may be obliged, on the basis of the principle of good faith governing the procedure before the EPO (G 5/88, OJ EPO 1991, 337), to give such an information on a specific query, a party may not expect a warning in respect of any deficiency occurring in the course of the proceedings (J 41/92, OJ EPO 1995, 93). In the present case it was the appellants' responsibility to comply with the formal requirements for a request for *restitutio in integrum*. Their representative referred expressly to Article 122 EPC in his letter of 26 October 1993. There was no specific indication for the EPO that there could be a misunderstanding in respect of the requirements to be fulfilled which might have required a reaction and clarification from the EPO.

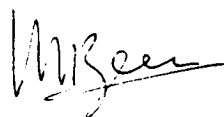
6. Since the request *for restitutio in integrum* is not admissible, there is no need to examine the question whether the appellants applied all due care in respect of the time limit not observed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:



M. Beer

The Chairman:



R. Schulte

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