

Internal distribution code:

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

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 14 March 1996

Case Number: J 0025/94 - 3.1.1

Application Number: 90303958.4

Publication Number: 0397326

IPC: C08K 5/12

Language of the proceedings: EN

Title of invention:
Plasticised polymer compositions

Applicant:
BP Chemicals Limited et al

Opponent:
-

Headword:
Restitutio/BP CHEMICALS

Relevant legal provisions:
EPC Art. 94, 122(5)
EPC R. 85a, 85b

Keyword:
"Restitutio in respect of period of grace of R. 85b EPC - (no)"

Decisions cited:
G 0003/91, G 0005/92, G 0006/92, J 0008/94

Headnote:
-



Case Number: J 0025/94 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 14 March 1996

Appellant:

- BP Chemicals Limited
Belgrave House
76 Buckingham Palace Road
London, SW 1W OSU (GB)
- Sistemi Terapeutici S.p.A.
26020 Palazzo Pignano
Cremona (IT)

Representative:

Dr W. Luderschmidt
Fuchs, Luderschmidt, Mehler, Weiss
Patentanwälte
Abraham-Lincoln-Strasse 7
D-65189 Wiesbaden (DE)

Decision under appeal:

Decision of the Receiving Section of the European
Patent Office dated 26 April 1994 refusing a
request for restitutio in integrum with respect to
European patent application No. 90 303 958.4.

Composition of the Board:

Chairman: J.-C. Saisset
Members: B. Schachenmann
S. Perryman

Summary of Facts and Submissions

- I. The appellants are the two applicants for European patent application No. 90 303 958.4. In connection with this application the examination fee was not paid within the period laid down in Article 94(2) EPC.
- II. On 19 June 1991 the European Patent Office issued a communication pursuant to Rule 85b EPC pointing out the failure to observe the time limit referred to above and informing the applicants that the examination fee could still be paid within a period of grace of one month provided that within this period a surcharge was paid.
- III. On 16 August 1991 a notification pursuant to Rule 69(1) EPC was transmitted to the applicants informing them that their application was deemed to be withdrawn since the examination fee plus surcharge was not paid within the period of grace either.
- IV. On 13 March 1992 a new representative filed a request for re-establishment in respect of failure to meet the period of grace pursuant to Rule 85b EPC and, as a precaution, also in respect of the normal period pursuant to Article 94(2) EPC. At the same time the omitted act was completed.

The appellants' arguments in support of this request may be summarized as follows:

- (i) After receipt of the search report the first of the two applicants was no longer interested in the application. The two applicants therefore agreed that the second applicant should be responsible for the further prosecution of the case even if the first applicant remained the

addressee for the mail from the European Patent Office. Due to this situation the representative of the second applicant, who in fact was the person responsible for deciding on the filing of a request for restitutio, was not informed of the notification pursuant to Rule 69(1) until 17 January 1992. The cause for non-compliance with the time limit was therefore not removed until 17 January 1992 with the effect that the request for restitutio had been filed in time.

- (ii) The non-compliance with the time limit pursuant to Rule 85b EPC was due to a mistake on the part of a secretary in the offices of the second applicant. Though experienced in the field of patent administration and properly instructed, she cancelled the term for paying the examination fee plus surcharge from the internal register without having executed the payment.

- (iii) With regard to the question of whether re-establishment of rights was possible despite Article 122(5) EPC apparently prohibiting reinstatement into the time limits concerned, the appellants referred to the decisions J 6/79 (OJ EPO 1980, 225) and J 32/86 of 16 February 1987 (unpublished in the OJ EPO). According to these decisions re-establishment was available as a remedy for EURO/PCT applications in respect of the time limit for requesting examination including the period of grace pursuant to Rule 85b EPC. However, the same principles should apply to all European patent applications. Since this issue was referred to the Enlarged Board of Appeal (J 16/90, OJ EPO

1992, 260), the forthcoming decision of the Enlarged Board of Appeal should in any case be taken into consideration in this context.

- V. After some correspondence with the appellants the Receiving Section decided on 26 April 1994 to refuse the request for re-establishment.

The form decision (EPA form 1145a (11.93)) contained substantially the following reasons: according to the recent Enlarged Board of Appeal's decisions G 3/91, G 5/92 and G 6/92 the prohibition of re-establishment for the time limits in question now extends also to EURO/PCT applications. This revises previous case law, according to which the re-establishment of rights in respect of these time limits was possible in the case of EURO/PCT applications.

- VI. On 16 June 1994 the appellants filed an appeal against the decision referred to above and paid the appeal fee. In their statement of grounds the appellants referred to "the decision of 27 September 1993 of the Enlarged Board of Appeal" and denied its applicability to the present case. In particular, they argued that this decision did not help clarify the issue of when the cause of non-compliance with the time limits in question was removed. Consequently the appellants maintained their request for re-establishment of rights.

- VII. On 10 March 1995 the Legal Board of Appeal issued a communication pursuant to Article 4(2) RPBA informing the appellants that, considering in particular the decisions G 5/92 and G 3/91 of the Enlarged Board of Appeal, the Board had serious doubts whether re-establishment of rights was possible for the time limits referred to above.

Reasons for the Decision

1. The appeal is admissible.
2. The present appeal is directed against the finding of the first instance that restitutio in integrum was not possible in respect of the time limit for filing the request for examination and/or the corresponding period of grace. The appellants are of the opinion that "the decision of 27 September 1993 of the Enlarged Board of Appeal" (i.e. decision G 5/92) cited by the first instance was not applicable to their case since it did not help clarify the issue of when the cause of non-compliance with the time limits in question was removed (Article 122(2) EPC).

However, the first instance did not cite the decision referred to above in view of the requirements laid down in Article 122(2) EPC, but rather in support of its finding that re-establishment of rights was excluded under Article 122(5) EPC for the time limit pursuant to Article 94(2) EPC. Indeed, the decisions G 5/92 and G 6/92 of the Enlarged Board of Appeal (OJ EPO 1994, 22 and 26) clearly state that the time limit under Article 94(2) EPC is excluded from restitutio in integrum by the provisions of Article 122(5) EPC.

3. On the other hand, it is true that neither of the decisions G 3/91, G 5/92 and G 6/92 cited by the first instance explicitly deals with the issue of whether restitutio in integrum is also excluded for the period of grace pursuant to **Rule 85b EPC** in its amended version which entered into force on 1 April 1989. In particular, decision G 3/91 (OJ EPO 1993, 8) only deals with the period of grace pursuant to **Rule 85a EPC** which, according to point 2 of the reasons of that decision, is

closely linked to the corresponding normal periods and is accordingly excluded, as they are, from re-establishment under Article 122(5) PCT.

However, as concerns the period of grace pursuant to Rule 85b EPC the Legal Board of Appeal, in its recent decision J 8/94 of 7 December 1995 (to be published in the OJ EPO), held after considering the point in detail that the conclusions drawn in decision G 3/91 for Rule 85a EPC equally apply to the period of grace pursuant to Rule 85b EPC, the latter being linked to the corresponding normal period exactly in the same way as Rule 85a EPC (see point 7 of decision J 8/94). Thus, the Board held that the period of grace pursuant to Rule 85b EPC was excluded from re-establishment under Article 122(5) EPC as the normal period pursuant to Article 94(2) EPC (see point 9 of decision J 8/94).

It has to be pointed out in this context that the parties to the present proceedings were informed in advance of the essential reasoning on which the decision J 8/94 was based. They therefore had sufficient opportunity to present their comments in accordance with Article 113(1) EPC.

4. The appellants' request for restitutio in integrum refers to the time limit pursuant to Article 94(2) EPC and/or the period of grace pursuant to Rule 85b EPC which, according to the decision J 8/94, are excluded under Article 122(5) EPC from re-establishment of rights. For the same reasons as set out in the reasoning of that decision, the present Board holds that in this case too restitutio in integrum is not possible into the time limits referred to above.


In view of this finding it is not necessary for the Board to further consider whether the 2 month time limit pursuant to Article 122(2) EPC, first sentence, had been observed or whether the requirement of all due care was complied with.

Order

For these reasons it is decided that:

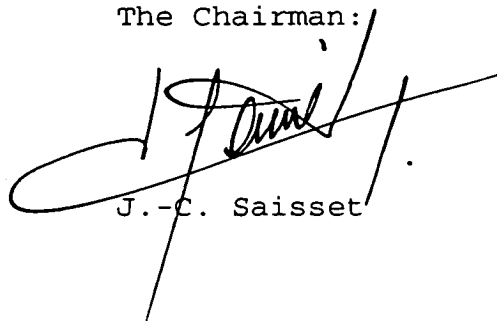
The appeal is dismissed.

The Registrar:



M. Beer

The Chairman:



J.-C. Saisset