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D E C I S I O N
of 23 September 1999

Case Number: J 0005/97 - 3.1.1

Application Number: 93909820.8

Publication Number: -

IPC: A61M 16/04

Language of the proceedings: EN

Title of invention:
Tracheotomy cannula

Applicant:
JEPPESEN, Finn

Opponent:
-

Headword:
-

Relevant legal provisions:

EPC Art. 94(2)(3), 121, 122(1)(5), 150(3)
EPC R. 69(1)(2), 83(1), (2), (4), 85(2), 85b, 104b(1)
PCT Art. 39(1)(a)

Keyword:

"No appointment of European representative for regional phase"
"Notification direct to applicant"
"Direct notification contributed to appellant's error (no)"
"Miscalculation of time limit for filing request for
examination"
"Application deemed withdrawn"

Decisions cited:
J 0014/94

Catchword:
-



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Case Number: J 0005/97 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 23 September 1999

Appellant: JEPPESEN, Finn
Kokildehojen 2A
8800 Viborg (DK)

Representative: Christiansen, Ejvind
c/o Hofman-Bang & Boutard, Lehmann & Ree A/S
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Decision under appeal: Decision of the Receiving Section of the European
Patent Office dated 11 January 1996 confirming
that European patent application No. 93 909 820.8
is deemed to be withdrawn pursuant to
Article 94(3) EPC.

Composition of the Board:

Chairman: J.-C. Saisset
Members: A. C. G. Lindqvist
M. K. S. AúZ Castro

Summary of Facts and Submissions

- I. The present appeal filed together with payment of the appeal fee on 11 March 1996 lies from the decision of the Receiving Section of 11 January 1996 in which it was decided in the matter of Euro-PCT application No. 93 909 820.8 filed on 11 May 1993 claiming a Danish priority of 11 May 1992 that the application for which a demand for International Preliminary examination had been filed on 8 November 1993 with the EPO as elected office was deemed to be withdrawn pursuant to Article 94(3) EPC as from 13 December 1994. In the decision it was further decided that the notification pursuant to Rule 69(1) EPC was maintained, that the requests for further processing (Article 121 EPC) and re-establishment of rights (Article 122 EPC) were refused, and that all fees paid to the European Patent Office after 13 December 1994, except for the fees for further processing and re-establishment of rights, should be refunded once the decision had become final.
- II. The decision under appeal that the application was deemed to be withdrawn was based on the finding that whereas the last possible date for validly paying the examination fee plus surcharge was 28 February 1995, the communication pursuant to Rule 85b EPC having been sent on 20 January 1995, the fee and surcharge (less an amount of 10%) were not paid until 2 March 1995.
- III. In his statement of grounds of appeal filed on 21 May 1996, a submission in response to a communication of the board giving a preliminary assessment of the case and at the oral proceedings of 23 September 1999 the appellant argued as follows:

- It is not disputed that the request for examination and the fee payment stipulated in Article 94(2) EPC were not made in due time. The factual background of the error is the following. The EPO sent communications pursuant to Rules 85a and 85b EPC to the appellant personally since he had not informed the EPO of an appointment of a representative for the relevant stage - the regional phase - of the proceedings. The appellant discussed the communication with the representative who had been employed for the international phase. The representative informed the applicant by fax of the latest date for payment, being 2 March 1995, which was a miscalculation. It is submitted that the private inventor/applicant received the communication from the EPO unexpectedly, without it having been sent to his representative, and that although there were indeed discussions between him, the appellant, and his representative in ample time before the imminent deadline the fact that the communication was not received by the representative through the "normal channels" contributed to the miscalculation. Although the representative was of course fully aware of the implications of Rule 85b EPC as such, he would in all likelihood not have made the miscalculation if the communication had been received directly and the deadlines had been double-checked and entered into his computer system as is done with all other communications from the EPO.

- It is admitted that the non-observed time limit is excluded from restoration of rights under Article 122 EPC. It is however submitted that other possibilities of saving the application may exist.

- (i) The principle of proportionality has been applied by the boards of appeal in a number of more recent decisions, presumably because the boards acknowledged that the consequences of minor errors or irregularities can be the extremely severe sanctions of loss of a patent application. Admittedly, these cases were concerned with situations where re-establishment under Article 122(5) EPC was not excluded. This was stressed in the decision under appeal, and is not disputed. According to the decision under appeal the principle of proportionality does not represent an independent means of redress introduced by the jurisprudence of the EPO. The appellant concurs with this statement but for different reasons, viz. because this means of redress has been there all the time. The Board's attention is drawn to T 869/90 from which the grounds are partly quoted: **"In accordance with general principles of law as applied in the context of administrative law, a procedural means used to achieve a given end (e.g. a sanction following a procedural non-compliance) should be no more than that which is appropriate and necessary to achieve that end; this is commonly referred to as the principle of proportionality. While the Board is not specifically applying this principle to the present case, nevertheless it would seem to be reasonable, in a case such as the present where there may be some doubt as to whether or not "all due care required by the circumstances" was exercised, to have this principle in mind"** (emphasis added).

So what the board deciding T 869/90 did in reality was to apply a **general principle of**

administrative law to the factual circumstances, or at least to have said principle in mind when the Board attempted to strike a fair balance. In T 869/90 a term was transgressed with one day. In T 111/92 the transgression was two days because of a mistake in calculating the 10 day period, i.e. exactly the same mistake as made in the present case. From a strictly logical point of view it is difficult to accept a legal fiction according to which the applicability of a general administrative principle as such is pertinent with regard to terms which are not excluded from restoration under Article 122, but not pertinent with regard to such terms as are excluded.

- (ii) The applicant's legitimate expectation must also be considered. It is not alleged that the EPO committed any procedural violation in the communication with the representative and the appellant or that the representative was not aware that communications would be sent to the applicant in due course. What is challenged is the set-up of the procedures. It should be appreciated that while the form used (1201) is indeed very useful, it is not a form a representative would normally send to the applicant, at least not to a private inventor. In the present case the representative first received an unconditional order not to enter the regional phase. In such cases it was at least in 1995 not standard practice to inform the EPO that the "PCT-representative" had been appointed also as EP-representative, nor to register a fictitious deadline for possible change of mind. Only if the applicant wanted to postpone the filing decision beyond the 31 months would the

representative at that time confirm the appointment as an EP-representative. In analogy with T 111/92 the representative was unexpectedly brought into time pressure which led to the calculation error, a situation which would in all likelihood not have arisen if the EPO had mailed communication (forms 1217 and 1218) to the representative rather than to the applicant, or mailed the forms to both.

Finally it is submitted that third parties would, upon inspection of file, not have any ground to suppose that a loss of rights had occurred. In this respect reference is made to decision J 14/94, OJ EPO 1995, 824.

- IV. The appellant requested that the decision under appeal be set aside and that the patent application be allowed to proceed.

Reasons for the Decision

1. The appeal complies with the requirements of the provisions mentioned in Rule 65 EPC and is therefore admissible.
2. In the case of an international application as referred to in Article 150(3) EPC the applicant shall within a period of 31 months where Article 39(1)(a) PCT applies, file, pursuant to Rule 104b(1)(d) EPC (in force until 29 February 2000, now Rule 107), the request for examination in accordance with Article 94 EPC if the time limit specified in Article 94(2) EPC which is 6 months from the date of the mention of the publication of the international search report. Where a demand for international preliminary examination has been effected

prior to the expiration of the 19th month from the priority date the time limit for filing the request for examination is prolonged to 31 months after the priority date pursuant to Article 39(1)(a)(b) PCT and Rule 104b(1)(d) EPC.

The priority date of the application under consideration being 11 May 1992 and the demand for international preliminary examination having been filed on 8 November 1993, i.e. less than 19 months after the priority date, the requirement of Article 39 PCT is fulfilled with the consequence that the time limit of 31 months after the priority date applies here pursuant to Rule 104b(1)(d) EPC.

This time limit expired on 12 December 1994 pursuant to Rules 83(1), (2), (4) and 85(2) EPC, the 11 December being a Sunday.

The time limit having expired without the appellant having filed the request for examination the receiving section sent a communication pursuant to Rule 85b EPC on 20 January 1995 that no request for examination had been filed and no examination fee paid in due time and that the deficiency could be rectified within one month of notification of the communication provided a surcharge of 50% of the examination fee was paid. Since no professional representative for the regional phase had been appointed the communication was directly sent to the appellant. Pursuant to Rules 78(3), 83(1), (2), (4) EPC the time limit of one month expired on 28 February 1995. The filing of the request for examination on 2 March 1995 was thus late with the consequence as correctly decided by the Receiving Section that pursuant to Article 94(3) EPC the application is deemed to be withdrawn as from 13 December 1994.

3. The appellant does not contest that the fees required for entering into the regional phase before the EPO were not paid in time. However, he submits that the fact that the communication pursuant to Rule 85b EPC was sent to the applicant directly, without having been sent to his representative, contributed to the miscalculation leading to the late payment. The appellant does not either contest that the EPO had not been informed of the appointment of a European professional representative to act for him in the regional phase.

4. The Board does not agree that the direct communication with applicant/inventor has contributed to the miscalculation. As a courtesy service not required by the EPC the Receiving Section in a communication of 19 January 1994, well in advance of the expiration of the time limits, provided the necessary information for the procedural steps to be taken when entering the regional phase before the EPO. In that communication the appellant was informed via his representative in the international phase, that any future notification would be sent exclusively to the applicant, unless he communicated an appointment of a European representative to the EPO in due time. Therefore, the appellant could not have been surprised when receiving the communication pursuant to Rule 85b EPC. The error appears to be a pure mistake of calculation which occurred without connection with the circumstances alleged by the appellant.

5. With regard to the possibility of re-establishment of rights pursuant to Article 122 EPC the appellant invokes the principle of proportionality according to which there should be a balance between the error that a party has committed and the importance for him of the effects of an ensuing decision by the authorities. According to Article 122(5) EPC the provision of re-

establishment of rights is not applicable to the time limit for filing the request for examination, what is expressly admitted by the appellant. The case law referred to by the appellant concerns, however, cases in which re-establishment of rights was not excluded. The deciding boards referred to the principle of proportionality in the context of the requirement of "all due care", a legal concept which has to be specified taking into account the particular circumstances of a given case. The principle does not represent, the impugned decision correctly says, an independent means of redress introduced in the jurisprudence of the EPO. As follows from the above, such a principle can serve as a background to the reasoning in cases where a margin for weighing the importance of the factual circumstances exists. The deemed withdrawal of the present application is however a loss of rights which follows, without any decision by the EPO, according to Article 94(3) EPC and which, pursuant to Article 122(5) EPC, cannot be re-established. In the Board's assessment no scope therefore exists in the case under appeal for considerations within the framework of the principle of proportionality. Contrary to the appellant's allegations there is no logical discrepancy between the possibility of applying the principle of proportionality when assessing due care and the exclusion of the applicability of this principle with regard to Article 122(5) EPC, because the principle can only be applicable where the remedy as such, i.e. re-establishment of rights is possible and not excluded as is the case here.

6. The appellant also submits that the principle of protection of legitimate expectations governing the procedure between the EPO and the applicants should be taken into account. A prerequisite for the use of the principle to redress a situation is that the conduct of

the EPO has in some way caused the party to be misled. According to the established jurisprudence of the boards of appeal the principle requires, for example, that communications addressed to the parties of the proceedings must be clear and unambiguous. In particular, parties must not suffer a disadvantage as a result of having relied on misleading information. As already mentioned (see point 4, supra) the appellant was informed in a communication that any future notifications would be sent to him directly unless a European representative was appointed. A situation where the appellant was caused to be misled by information from the EPO did consequently not arise.

Whether or not it was standard practice in 1995 to inform the EPO that the "PCT-representative" has been appointed also as EP-representative is of no importance to the case. What matters is that the PCT-representative was informed by the EPO well in advance of the expiration of any time limit under point 8 of the communication of 19 January 1994 that future notifications on procedural matters would exclusively be addressed to the applicant respectively his European representative, if the appointment of the latter had been communicated in due time. Besides, the appellant himself confirms that in the case of entry into the regional phase before the EPO after 31 months the representative would confirm the appointment as an EP-representative. Since this time limit applies here the argument of the appellant is pointless.

7. Finally, the board cannot agree with the appellant that third persons inspecting the file would not become aware of the loss of rights due to missing the prescribed time limits. This is already clear from the date of the payment of the fees and the pertinent communications. This question does, however, not play a

role here. The case under consideration is only concerned with the problem that a loss of rights in fact occurred and that in the specific case re-establishment is excluded. Decision J 14/94 referred to by the appellant is not pertinent here. It concerns a case where the EPO during a long period of time led the parties and the public to the legitimate belief that no loss of rights had taken place by continuing the examination procedure after the loss. Since the receiving section has informed the appellant about the loss of rights in due time, the considerations of the cited decision do not apply.

Order

For these reasons it is decided that:

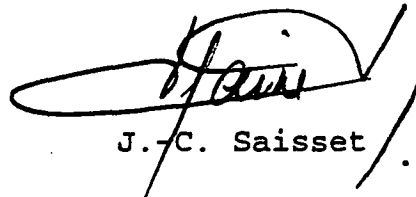
The appeal is dismissed.

The Registrar:



M. Beer

The Chairman:



J.-C. Saisset