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D E C I S I O N
of 17 October 2000

Case Number: J 0006/98 - 3.1.1

Application Number: 94911676.8

Publication Number: WO 94/23572

IPC: A01N 1/02

Language of the proceedings: EN

Title of invention:
Cell Culturing method and medium

Applicant:
Human Cell Cultures, Inc.

Opponent:
-

Headword:
Re-establishment/HUMAN CELL CULTURES

Relevant legal provisions:
EPC Art. 111, 112, 122(2), (3), (5)
EPC R. 69(1), 78(2), 83(4), 85a, 85b, 104b

Keyword:
"Request for re-establishment - filed after expiry of the one year period of Article 122(2), 3rd sentence, EPC - late filed, irrespective of the ground-payment of renewal fee no such request"

Decisions cited:
G 0003/91, G 0005/93, G 0001/97, J 0006/90, J 0341/92,
J 0026/95, T 0966/95

Catchword:
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Boards of Appeal

Chambres de recours

Case Number: J 0006/98 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 17 October 2000

Appellant: Human Cell Cultures, Inc.
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Representative: Knott, Stephen Gilbert
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Decision under appeal: Decision of Receiving Section of the European Patent dated 19 August 1997 declaring European patent application No. 94 911 676.8 deemed withdrawn.

Composition of the Board:

Chairman: J.-.C. Saisset
Members: M. B. Günzel
V. Di Cerbo

Summary of Facts and Submissions

- I. The appeal is from the decision of the Receiving Section dated 19 August 1997 to refuse re-establishment into the time limits of Rules 85a and 85b EPC for the entry of international patent application No. PCT/US94/03101 into the regional phase before the EPO.
- II. The PCT application, filed on 21 March 1994 on behalf of the appellant, a US applicant, claimed 8 April 1993 as its earliest priority. A demand for international preliminary examination was filed on 8 November 1994.
- III. With a communication dated 29 November 1994 addressed to the appellant's US representative for the international phase of the PCT application the Receiving Section informed the US representative about the requirements and time limits for entry into the regional phase.

With communications dated 15 December 1995 pursuant to Rules 85a and b EPC the appellant was informed that the necessary acts required for entry into the regional phase had not been performed, that the fees had not been paid and that this could still be done within a period of one month from notification of these communications provided that, within the same period, a surcharge was paid; furthermore the appellant was informed that in case of failure to do so the application would be deemed to be withdrawn. No reply having been received from the appellant, communications noting a loss of rights under Rule 69(1) EPC were despatched to the appellant with letters dated 23 February 1996. All communications were returned to the EPO. On 8 March 1996 the third renewal fee was paid by a computer patent annuities firm.

- IV. On 15 May 1997 the now appointed European representative of the appellant requested re-establishment into the time limits for entry into the regional phase, filed form 1200, paid several fees and a fee for re-establishment and explained why the time limits for entry into the regional phase before the EPO had not been observed. He also pointed to the fact that the EPO had accepted or at least not refunded the third renewal fee, which reinforced the appellant's belief that the application had validly entered the regional phase before the EPO. That such was not the case was only discovered on 21 March 1997 when the European Patent Register was consulted to investigate the current status of the application in the context of entering licensing negotiations with a third party.
- V. The decision of the Receiving Section was based on the reason that according to decision G 3/91 (OJ EPO 1993,8) of the Enlarged Board of Appeal re-establishment into the time limits of Rules 104b, (now Rule 107) 85a and 85b EPC was not possible, to the extent that re-establishment into the corresponding time limits for European patent applications was excluded under Article 122(5) EPC.
- VI. On 17 October 1997 the appellant appealed against the decision of the Receiving Section.

The appeal was based on the ground that the finding of the Receiving Section that re-establishment of rights was not available for time-limits under Rules 104b and 85a and 85b EPC for Euro-PCT applications, to the extent that re-establishment was also excluded for the corresponding time limits for European applications, was erroneous. Decisions G 3/91 and G 5/93 were incorrect and had to be reconsidered for reasons set out in detail by the appellant.

- VII. In response to a communication by the Board pointing out that the one year period after expiry of the missed time limit of Article 122(2) 3rd sentence EPC, within which the request for re-establishment had to be filed, seemed to have been missed by the appellant, the appellant submitted that this time limit had indeed been complied with because the appellant had, by paying within this period the renewal fee due for the third year on 8 March 1996, unequivocally indicated his wish to proceed further with the patent application. Moreover, having regard to the appellant's right to two instances it would be inappropriate for the current Board of Appeal to consider this question because this point was not raised in the decision under appeal.
- VIII. Oral proceedings before the Board were held on 17 October 2000, in which the appellant did not appear, as he had announced to the Board.
- IX. The appellant requested in writing that the decision under appeal be set aside and that the appellant have his rights re-established. As an auxiliary request the appellant requested that the decision under appeal be set aside and the case be remitted to the Receiving Section for further consideration.

Reasons for the Decision

1. The request for re-establishment, filed on 15 May 1997, was filed later than one year after expiry of the longest running time limit within which the regional phase before the EPO could still be validly entered.

The 31 months period for entry into the regional phase under Rule 104b EPC had expired on 8 November 1995. The communications under Rules 85a and 85b EPC were

despatched on 15 December 1995 to the US appellant. Even if these communications were returned to the EPO, pursuant to Rule 78(2), 2nd sentence EPC, applicable at that time, notification of these communications was nevertheless deemed to have been made on 15 December 1995. According to Rule 83(4) EPC the time limit for entry into the regional phase under Rules 85a and 85b EPC therefore expired on 15 January 1996.

Thus, on 17 May 1997 the one year period for an application for re-establishment to be admissible under Article 122(2), 3rd sentence EPC, had long since expired.

2. The argument put forward by the appellant that the fact that the EPO did not refund the third renewal fee paid on 8 March 1996 led him to assume that its application was still pending and that the request for re-establishment should be regarded for this reason as having been filed in time, is not legally relevant in the context of having missed the one year period provided for in Article 122(2), third sentence, EPC.

According to established jurisprudence of the Legal Board of Appeal the one year period under said Article within which the request for re-establishment must be filed is absolute in the sense that in the interests of legal certainty an applicant should not be allowed to revive an application by a request filed after the expiry of that time limit, irrespective of the grounds which may have caused the non-observance of the one year period, see e.g. decisions J 34/92 dated 23 August 1994, unpublished, J 6/90, OJ 1993, 714, J 16/86 dated 1 January 1986, unpublished. This even applies where an inappropriate handling of an application by the EPO has occurred, J 34/92, point 4.1 of the Reasons. The principle, expressed in decided cases of the Boards of Appeal according to which the EPO has to give the

applicant sufficient additional time to perform a missed act where the non-observance of the time limit is due to a lack of due care by the EPO, does not apply to the one year time limit of Article 122(2) EPC, because this time limit has the legal function of a statutory exclusion (see decision J 34/92, point 4.1, point 3.2 et seq, see also J 6/90, point 2.3).

It therefore need not be further discussed whether or not the appellant's submissions of facts in this respect are corroborated by the circumstances and whether or not the EPO acted correctly in not refunding the third renewal fee immediately upon receipt.

3. The payment of the third renewal fee on 8 March 1996 cannot be regarded as constituting a request for re-establishment.
- 3.1 In some cases concerning a loss of right for failure to observe a time limit, in the absence of an explicit request for re-establishment having been filed in time the boards have examined the question as to whether another procedural act or action taken by the appellant in time could be interpreted as constituting a request for re-establishment.

In the case underlying decision J 6/90 the applicant had filed a letter within the one year period of Article 122(2), third sentence, EPC, in which he had announced that he would file within a short time a request for re-establishment and perform the necessary acts required by Article 122 EPC in this context. Said letter was interpreted by the Legal Board to constitute a request for restitutio already. In decision J 34/92 the Legal Board examined (point 3. of the Reasons) whether the fact that a translation of the claims had

been filed could be regarded as being an unequivocal expression of applicant's wish to restore the application. This was denied because at the time of filing the translations the application was still pending.

In the present case the payment of the renewal fee on 8 March 1996 cannot be regarded as an unequivocal indication of the wish of the appellant to proceed further with the application, from which a third party, on inspecting the files, would have been bound to conclude that a desire existed for re-establishment of rights and for maintenance of the application, as has been required in said decisions, J 6/90, point 2.4 of the Reasons, J 34/92, point 3. of the Reasons. It is widely known that renewal fees are often not paid by the representative or the applicant himself but by specialised firms, as was also done in the present case. It is not unusual in these and other circumstances that a renewal fee is - e.g. as a result of a lack of timely communication between the persons concerned - still paid after the applicant decided to let the application lapse. In the present case third persons would have noticed upon file inspection that the US representative of the appellant was informed with the letter of the Receiving Section dated 29 November 1994 about the requirements and time limits to be met for entry into the regional phase. No reaction to this from the appellant's side being on file, no European representative having been appointed and all later communications addressed to the US applicant itself having been returned to the EPO, a third person would have reasonably concluded that the appellant had no interest in proceeding with the PCT application in Europe and that the third renewal fee was erroneously still paid by the computer annuities firm at a point in time when the appellant had already decided to let the application lapse.

3.2 Moreover, according to Article 122(3), second sentence, EPC a request for re-establishment shall not be deemed to be filed until after the fee for re-establishment of rights has been paid. As has been set out in decision J 26/95, OJ EPO, 668, point 5.2 of the Reasons, the legal fiction provided for in said article is an automatic and mandatory consequence of the omission to pay the fee for re-establishment and there is no room for the exercise of discretion by the Board. In the present case the fee for re-establishment was only paid on 15 May 1997, i.e. after expiry of the one year period under Article 122(2), third sentence, EPC. By contrast, in the case underlying decision J 6/90, the fee for re-establishment was also paid within the one year period after expiry of the non-observed time limit, so that it was accordingly possible for the Board to establish that the letter expressing the applicant's wish to apply for re-establishment constituted a valid request to that effect.

As a consequence, no valid request for re-establishment was filed by the appellant within the one-year period provided for in Article 122 EPC.

Thus, as a result the Receiving Section has rightly refused the request for re-establishment into the time limit of Rules 85a and 85b EPC and has correctly stated the application to be deemed withdrawn as from 9 November 1995.

4. As regards the appellant's request in the appeal proceedings for remittal to the first instance should the Board consider deciding the case on the basis of the legal evaluation set out above, the Board exercises its discretion under Article 111 EPC in the sense that it decides itself in the matter:

Contrary to what has been submitted by the appellant, the EPC does not guarantee the parties an absolute right to two instances in the sense that parties are entitled to have every aspect of fact or of law on which a board of appeal bases its decision examined previously by the first instance. As can be derived from the wording of Article 111(1) EPC and as has recently again been confirmed by the Enlarged Board of Appeal in its decision G 1/97, OJ EPO 2000, 322, point 2a) of the Reasons, said article confers a discretion on the boards either to exercise any power within the competence of the department which was responsible for the decision under appeal or to remit the case, depending on the circumstances of the case. According to the Enlarged Board of Appeal, as a matter of principle, the power of the board of appeal not to remit the case but to "correct" the first instance decision even exists where fundamental deficiencies are apparent in the proceedings at first instance, or where a board considers revoking a patent in response to an appeal by an opponent. Thus, the fact that a board of appeal sees other reasons of fact or law as being the relevant issues for deciding the case under consideration than the ones on which the first instance based its decision is not in itself a reason for remitting the case, because otherwise the discretionary power attributed to the boards of appeal under Article 111(1) EPC would be meaningless (see also decision T 966/95 dated 24 March 1999, point 2.2 of the Reasons). This must apply in particular where the outcome of the case before the board of appeal is, for the reasons considered by the board, the same as before the first instance. In the present case the Board's view that the request for re-establishment has been filed out of time is based solely on a legal assessment of the facts as they appear from the application file. No new facts submitted for the first time in the appeal

proceedings having to be considered nor any further investigation of facts having to be made, the Board has exercised its discretion under Article 111(1) EPC as indicated.

5. The appeal having to be dismissed because the appellant's request for re-establishment was filed after expiry of the one year period under Article 122 EPC, the question as to whether re-establishment into the time limits for the entry of PCT applications into the regional phase before the EPO is excluded insofar as the corresponding time limits for direct European patent applications are excluded from re-establishment under Article 122(5) EPC, is not decisive for the outcome of the present appeal within the meaning of Article 112 EPC.

Order


For these reasons it is decided that:

The appeal is dismissed

The Registrar:


M. Beer

The Chairman:


J.-C. Saisset

