

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen
(D) [] No distribution

D E C I S I O N
of 8 October 2002

Case Number: J 0012/98 - 3.1.1

Application Number: 92203614.0

Publication Number: 0547652

IPC: F04D 29/12

Language of the proceedings: EN

Title of invention:
Water pump

Applicant/Patentee:
SKF Industrial Trading & Development Co, B.V.

Opponent:
-

Headword:
One year Article 122(2) time limit/SKF

Relevant legal provisions:
EPC Art. 96(2)(3), 122(2)
EPC R. 51(2), 69(1), 90

Keyword:
"Outside one year time limit of Article 122(2) EPC, third sentence (yes)"
"Time limit to be determined objectively in relation to omitted act, not subjectively depending on applicant's knowledge of omission"

Decisions cited:
J 0016/86, J xx/87, J 0034/92

Catchword:
-



Case Number: J 0012/98 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 8 October 2002

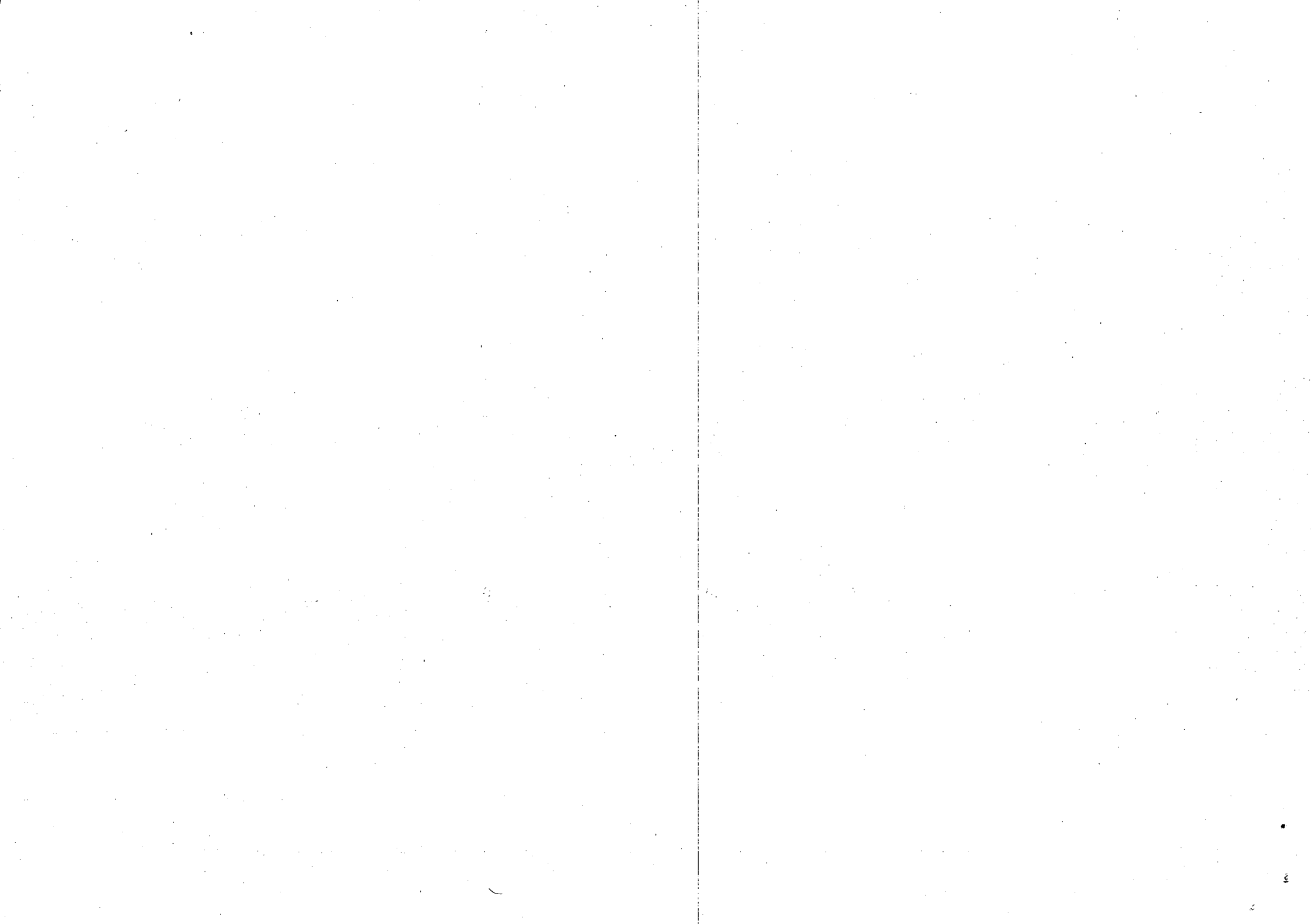
Appellant: SKF
Industrial Trading & Development Co, B.V.
Kelvinbaan 16
NL-3439 MT Nieuwegein (NL)

Representative: Hammond, Andrew
Ström & Gulliksson IP AB
Sjöporten 4
S-417 64 Göteborg (SE)

Decision under appeal: Decision of the Examining Division of 19 February 1998 refusing request for re-establishment of rights within the time limit of Article 86(2) EPC filed on 9 August 1997 in respect of European patent application No. 92 203 614.0.

Composition of the Board:

Chairman: J.-C. Saisset
Members: V. Di Cerbo
S. C. Perryman



Summary of Facts of Submissions

- I. European Patent application No. 92 203 614.0 was filed on 24 November 1992.
- II. By letter dated 31 January 1995 the Examining Division issued a communication pursuant to Article 96(2) and Rule 51(2) EPC to the representative of the applicant informing him that the examination of the application revealed that it did not meet the requirements of the European Patent Convention. The applicant was invited to file observations and to rectify the deficiencies of the application indicated in the communication within a period of 4 months. He was also warned that failure to comply with such invitation in due time would result in the application being deemed to be withdrawn pursuant to Article 96(3) EPC.
- III. On 12 July 1995 a communication pursuant to Rule 69(1) EPC (noting of loss of rights) was issued to the applicant's representative informing him that, since the above quoted invitation was not complied with, the application was deemed to be withdrawn under Article 96(3) EPC.
- IV. The renewal fee for the fifth year, which was paid on 28 October 1996, was refunded on 8 November 1996.
- V. By letter dated 4 August 1997 and received by the EPO on 9 August 1997 the new appointed representative of the applicant requested re-establishment of rights pursuant to Article 122 EPC. In particular he maintained that, due to a misunderstanding that had occurred between the applicant's officer and the former representative, the latter was induced to believe that the application in suit was to be withdrawn. Therefore he closed the pertinent files and took no further

action in the matter. Accordingly he neither reacted to the communications quoted under II and III above nor notified them to the applicant. Because of this mistaken behaviour the applicant neither knew nor could have known that the patent application had lapsed until the receipt of a letter sent by his representative dated 30 August 1996 informing him of the actual situation.

- VI. By communication pursuant to Article 113 EPC dated 23 September 1997 the Examining Division informed the applicant's new representative that the application for re-establishment of rights was inadmissible pursuant to Article 122(2) EPC, third sentence.
- VII. By letter dated 23 November 1997 (sent per fax one day later) the appellant's representative filed his comments on the above quoted communication.
- VIII. In its decision dated 19 February 1998 the Examining Division refused the request for re-establishment of rights and declared that the European Patent application was deemed to be withdrawn. The Examining Division ruled that the request for re-establishment of rights was inadmissible since it had been filed after the one-year time limit provided for in Article 122(2) EPC, third sentence, expired. Indeed said time limit ran irrespective of whether or not the party concerned was aware of it. The decision also gave further reasons why the application for reinstatement would be neither admissible nor allowable.
- IX. On 7 April 1998 a notice of appeal against the above quoted decision was filed. On the same date the appeal fee was paid.

X. On 25 June 1998 the statement of grounds of appeal was filed. The appellant requested that the decision under appeal be set aside and that the Board consider the petition for re-establishment of rights as filed in due time, thus allowing the further examination of the facts and evidence offered. An auxiliary request for oral proceedings under Article 116(1) EPC was also filed.

XI. In a communication annexed to the summons to oral proceedings and sent to the appellant on 21 June 2002 the Board of Appeal put forward its provisional and non binding observations. The attention of the appellant was drawn, in particular, to the established case-law of the Boards of Appeal concerning the interpretation of Article 122(2) EPC.

XII. The appellant's arguments on meeting the one year time limit can be summarized as follows:

Said time limit could not be considered as elapsed at the date of the application since, due to a misunderstanding having occurred between the applicant's officer and the former applicant's representative, the applicant only became aware that the application in suit was deemed withdrawn when he received a letter dated 30 August 1996 from the latter informing of the actual situation of the patent application. In particular:

- The decision of the Examining Division, based on the assumption that the time limit referred to in Article 122(2) EPC, third sentence, runs irrespective of whether or not the party concerned was aware of it and that, as a consequence of the above, the removal of the cause of non-compliance was not relevant to the lapsing of said time limit, could not be shared. The time limit under

consideration should run only from the date on which the applicant knew or should have known of the lapsing of the application. Indeed Article 122 EPC was concerned with the factual situation of the removal of the cause of non-compliance, and that factual situation was not overridden by any presumption that it had been removed irrespective of the situation.

- Also the statement in the decision under appeal, according to which the time limit referred to in Article 122(2) EPC, third sentence, was a preclusive period had to be challenged, since, as ruled by J xx/87 (OJ EPO 1988, 323), a lack of capacity to act on the part of the applicant or his representative interrupted pursuant to Rule 90 EPC all proceedings before the EPO, including the one year time limit under Article 122(2) EPC. The above quoted decision confirmed that the one-year period did not run irrespective of whether or not the party concerned was aware that the time limit had not been observed.

XIII. Further submissions were made by the appellant in relation to the additional reasons given in the decision under appeal for finding the application for re-establishment of rights inadmissible and in any case not allowable.

XIV. At the oral proceedings (on 8 October 2002) no-one appeared on behalf of the appellant. The Board having ascertained that the appellant had been duly summoned pursuant to Rule 71(2) EPC, it continued the proceedings without him and decided on the appeal.

Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rule 64 EPC. It is therefore admissible.
2. The facts which are relevant for the decision of the appeal in suit are undisputed.

The communication pursuant to Article 96(2) and Rule 51(2) EPC, informing the applicant's representative that the application did not meet the requirements of the European Patent Convention and inviting him to file observations and to rectify the deficiencies of the application within a period of four months, was issued with letter dated 31 January 1995.

The noting of loss of rights (because the above quoted invitation was not complied with) was issued to the applicant's representative on 12 July 1995.

The request for re-establishment of rights was filed on 9 August 1997, ie, as stated in the decision under appeal, after the one year time limit provided for in Article 122(2) EPC, third sentence, had elapsed.

3. In the Board's view the appeal cannot be granted.
 - 3.1 The critical issue for discussion is the interpretation of Article 122(2) EPC, third sentence. According to said provision an application for re-establishment of rights shall be admissible only within the year immediately following the expiry of the unobserved time limit, while the first and second sentence of Article 122(2) EPC refer to the need to file the application and complete the omitted act within two months from the removal of the cause of non-compliance

to be admissible. A point decisive for the appeal is whether these are separate requirements calculated in respect of different events.

According to the established case law of the Boards of Appeal (see for example J 16/86; J 34/92) these are separate requirements, and the one-year period is calculated in relation to the expiry of the unobserved time-limit, irrespective of the applicant's state of knowledge. This one-year time limit serves to provide legal certainty. If this period has elapsed, any third party who made a file inspection more than one year after the expiry of the unobserved time limit and found that no application for re-establishment had been made, could confidently assume that a patent which had been rendered invalid by the non-observance of a time limit would not be revived.

The appellant's chief argument on appeal appears to be that the words "within one year of the unobserved time limit" of sentence three of Article 122(2) EPC should be read as if it was stated "within one year of the applicant having knowledge of the unobserved time limit". As already pointed out by the Board in its provisional opinion annexed to the summons, this interpretation would appear to make the starting point for calculating the two month period referred to in sentences one and two of Article 122(2) EPC the same as the starting point for calculating the one year limit of sentence three of Article 122(2) EPC. This interpretation would thus deprive sentence three of Article 122(2) EPC of any function, as of necessity something done within two months of a particular date is done within one year of that date. Such an interpretation would be contrary to the normal rules of interpretation.

The appellant's argument thus appears to conflict with the actual wording used in Article 122(2) EPC, and with the interpretation put on it in the established case law.

3.2 With reference to the appellant's submissions regarding the application of Rule 90 EPC the Board has already pointed out (in its communication sent on 21 June 2002) that said provision relates (only) to exceptional circumstances, namely death or incapacity, causing an interruption of proceedings. In these exceptional circumstances it has been held that time would stop running for the purpose of calculating the one year period referred to in sentence three of Article 122(2) EPC. But here the appellant did not argue that the circumstances in this case were such as to require an interruption of proceedings pursuant to Rule 90 EPC, and where Rule 90 EPC does not apply, the third sentence of Article 122(2) EPC must be applied as stands.

4. Given that the appeal must fail because the application for re-establishment was inadmissible because filed outside the one year time limit of Article 122(2) EPC, third sentence, the other reasons given in the decision under appeal for finding the application inadmissible and not allowable, do not need consideration.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:



S. Fabiani

The Chairman:



J. C. Saisset

