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**Datasheet for the decision
of 17 December 2010**

Case Number: T 1935/08 - 3.3.07

Application Number: 05734974.8

Publication Number: 1778181

IPC: A61K 8/92

Language of the proceedings: EN

Title of invention:
Cosmetic mixture for hair

Applicant:
SOULIMANI, Atika

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 122
EPC R. 136(1)

Relevant legal provisions (EPC 1973):
-

Keyword:
"Re-instatement into period for paying renewal fee (no)"

Decisions cited:
-

Catchword:
-



Case Number: T 1935/08 - 3.3.07

D E C I S I O N
of the Technical Board of Appeal 3.3.07
of 17 December 2010

Appellant: SOULIMANI, Atika
I-98070 Acquedolci (IT)

Representative: Scarfone, Maria Adelaide
Studio Rubino S.A.S.
Via Lucrezia della Valle, 84
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 9 April 2008
refusing European patent application
No. 05734974.8 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: S. Perryman
Members: F. Rousseau
D. Semino

Summary of Facts and Submissions

- I. European patent application 05 734 974.8 of the applicants (hereinafter "requester") was refused by the Examining Division, the written decision being posted on 9 April 2008.
- II. The 4th year renewal fee had been normally due on 30 April 2008, but could be paid with an additional fee up to 30 October 2008. A communication of 4 June 2008 from the EPO to the professional representative of the requester drew attention to this possibility.
- III. An appeal on behalf of the requester was received by the EPO on 11 June 2008, and the respective appeal fee was received by the EPO on the 10 June 2008. Grounds of appeal were received by the EPO on 11 August 2008.
- IV. A notification of loss of rights was sent by the EPO on 12 November 2008 noting that the application was deemed withdrawn for failure to pay the renewal fee for the 4th year, and drawing attention to Article 122 EPC.
- V. On 4 December 2008, the representative telephoned the Registry of the Boards of Appeal to obtain information. In a letter of 5 December 2008 the representative explained that they had waited with paying the renewal fee until the client had indicated his wishes regarding an appeal. With the presentation of the appeal they thought that all the procedure had been suspended, also the renewal fee, and they "did not have no reason in order not to pay the renewal fee". They further indicated the importance of the application to their

client. On the same date they paid the 4th yearly renewal fee plus surcharge.

VI. By a communication dated 15 December 2008 the registrar on instructions from the board sent a communication giving the following information *inter alia*:

- Where a time limit for paying a fee had been missed, it was not enough to pay the fee late. Rather the EPC laid down a specific procedure that governed such a case, and the Boards of Appeal had no power to depart from this procedure.
- The procedure was to file an application for *restitutio in integrum* under Article 122 EPC which if granted would mean that the late payment could be accepted. The request had to comply with Rule 136 EPC, in particular the prescribed fee had to be paid and the request had to be made within two months of removal of the cause of non-compliance with the time limit.
- From what was stated in their letter it appeared that the cause of non-compliance was an erroneous belief that the annual renewal fee need not be paid due to the suspensive effect of the appeal. The view of the law accepted during the last thirty years was that the suspensive effect under Article 106(1) EPC applied to the effects of the decision under appeal only. Thus while the present appeal was pending, the decision of the examination division to refuse the application did not take legal effect, and the application was deemed still pending with the consequence that

annual renewal fees remained payable as for all pending applications.

- VII. On 9 January 2009 an application for re-establishment of rights into the period for paying the 4th yearly renewal fee was filed on behalf of the requester. The explanation given for the failure to pay this fee in time was essentially the same as in their letter of 5 December 2008 (see point V. above).
- VIII. In response to an enquiry by the board, the professional representative with letter dated 12 March 2009 indicated that no oral proceedings were wanted on the request for re-establishment.

Reasons for the Decision

1. The request for re-establishment in this case was filed within two months of receipt of the notification of loss of rights noting that the application was deemed withdrawn for failure to pay the 4th year renewal fee, and so the admissibility requirement of Rule 136(1) EPC can be regarded as met.
2. However the reason for the failure to pay the 4th yearly renewal fee in time, was a mistake as to law, namely that the suspensive effect of an appeal also suspended the obligation to pay annual renewal fees. As the requester's professional representative had been informed it is established case law of the Boards of Appeal, that the suspensive effect of an appeal does not extend to the payment of annual renewal fees. These thus still have to be paid. A mistake as to the

applicable law cannot be considered as having occurred despite all due care having been used, and the request for re-establishment must be refused. This means that any annual renewal fees paid subsequent, to 30 October 2008 and not already repaid, are to be repaid.

Order

For these reasons it is decided that:

The request for re-establishment of rights is refused.

The Registrar:

The Chairman:

S. Fabiani

S. Perryman