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Decision of Technical Board of Appeal 3.3.4 dated 9 October 1998

T 227/97 - 3.3.4

(Language of the proceedings)

Composition of the board:

Chairman: U. M. Kinkeldey

Members: L. Galligani

S. C. Perryman

Applicant: Lindahl, Gunnar

Headword: Protein Rib/LINDAHL

Article: 122, 111, 150(2) EPC

Rule: 28(1)(c), 28(2), 28(2)(a) EPC

Article: 48(2)(a) PCT

Rule: 13^{bis} PCT

Keyword: "Request for re-establishment of rights - admissible (yes) - loss of rights"- "Remittal"

Headnote

The provisions of Article 122 EPC are applicable to the time limit set by Rule 28(2)(a) EPC and that set by PCT Rule 13^{bis}.4.

Summary of facts and submissions

I. An international application was filed by the appellant on Monday 21 March 1994 (International publication No. WO 94/21685, International publication date 29 September 1994) with priority of 19 March 1993, proceeding in the European Patent Office (EPO) as European Patent application No. 94 911 348.4.

II. On receiving on 23 January 1995 the international preliminary examination report, issued on 18 January 1995 by the European Patent Office as International Preliminary Search Authority, stating inter alia that claims 9 to 14 were unclear because the deposit numbers were missing, the appellant realised that the intended information about the DSM (Deutsche Sammlung von Mikroorganismen und Zellkulturen GmbH) accession numbers of the micro-organisms referred to in the specification had not been provided to the International Bureau within the sixteen month time limit from the priority date prescribed by Rule 13^{bis}.4 PCT, both in the version then in force and the present version.

III. By letters dated 30 January and 8 February 1995 to the EPO, received respectively on 2 and 11 February 1995, the appellant filed at the EPO, Munich, deposit receipts, respectively corrected deposit receipts, relating to deposits DSM 9039, 9040 and 9041.

IV. On 22 March 1995 the appellant entered the regional phase before the European Patent Office, paying the necessary fees. At the same time he filed new pages 2 and 18 and amended claims 9 to 14 containing the DSM accession numbers, and a request for re-establishment according to Article 122 EPC into the time limit for filing the accession numbers, accompanied by a statement of grounds and facts. The corresponding fee was paid.

V. The appellant wrote to the International Bureau by letter dated 3 April 1995, together with the copies of the deposit receipts showing the accession numbers.

VI. By letter dated 5 May 1995 the International Bureau wrote to the EPO stating that it wished to bring to the attention of the designated Office, for its consideration as far as the regional phase is concerned, information provided by the applicant to the International Bureau concerning the deposit of microorganisms referred to in the application, namely the letter of 3 April 1995, and the copies of the deposit certificates. The International Bureau further stated, inter alia, that the numbers were not furnished within the applicable time limit under Rule 13^{bis}.4 PCT and drew the attention to the fact that nothing in the PCT prevented any designated Office from considering that the indications of the numbers were furnished in time.

VII. In an official communication dated 1 July 1996, the examining division expressed the opinion that a request for restitutio in integrum could not remedy a substantive defect and that thus the request for re-establishment of rights could not be granted. The communication further specified that this was in no way a prejudice to the question of whether the application fulfilled the requirement of Rule 28(1)(b) EPC and whether and to what extent the application met the requirement of Article 83 EPC. The appellant was thus given a time limit of two months for stating whether the request was withdrawn or whether they wished to receive an appealable decision on it. In reply thereto, the appellant asked the examining division to issue an appealable decision.

VIII. By an interlocutory decision pursuant to Article 106(3) EPC dated 25 September 1996, the examining division rejected the appellant's request for re-establishment of rights on the grounds that:

- The Enlarged Board of Appeal in its decision G 2/93 (OJ EPO 1995, 275, in particular paragraphs 12 and 13 of the reasons) made it clear that the indication of the file number (accession number) in the application was **substantive** because under the EPC, it was instrumental in enabling a person skilled in the art to carry out the invention. Rule 28(2)(a) EPC provided a reasonable time limit which guaranteed that the culture deposit was made available to the public at the same time as the corresponding European patent application was published. The Enlarged Board

concluded that the "information concerning the file number of a culture deposit according to Rule 28(1) (c) EPC may not be submitted after expiry of the time limit set out in Rule 28(2)(a) EPC".

- Consequently, if this time limit had not been complied with, so that the required information on the deposit could not be included in the published application, the invention could not be regarded as disclosed under Rule 28(1) EPC in connection with Article 83 EPC. An insufficient disclosure, by its very nature, could not be made good later, either by way of correction or by re-establishment of rights pursuant to Article 122 EPC.

- It was true but immaterial, that the time limit provided for in Rule 28(2)(a) EPC was not expressly mentioned in Article 122(5) EPC as exempted from restitutio in integrum. Rule 28 EPC was younger than said provision of the EPC (which, for systematic reasons, mentioned only Articles of the Convention as such) and subordinated to the Articles of the Convention (Article 164(2) EPC). It could not, even in combination with restitutio in integrum, be used for satisfying the requirement of an enabling disclosure after the decisive point in time - just in the same way as this was, as a matter of principle, excluded under Article 123(2) EPC, which provision was not mentioned in Article 122(5) EPC either. Such deficiency was essentially irreparable.

- It followed from this that the criterion of due care required by the circumstances under Article 122(1) EPC needed no consideration.

A separate appeal against this decision was allowed by the examining division.

IX. The appellant filed an appeal arguing inter alia that the time limit of Rule 28(2) EPC was open to restitutio in integrum and requesting that the decision under appeal be set aside and that restitutio in integrum be allowed.

Reasons for the decision

1. *Interrelation between PCT and EPC*

1.1 The time limit missed by the appellant was that of Rule 13^{bis}.4 PCT which at the relevant time read:

"If any of the indications referred to in Rule 13^{bis}.3(a) is not included in a reference to a deposited micro-organism in the international application as filed but is furnished by the applicant to the International Bureau within 16 months after the priority date, the indication shall be considered by any designated Office to have been furnished in time unless its national law requires the indication to be furnished at an earlier time in the case of a national application and the International Bureau has been notified of such requirement pursuant to Rule 13^{bis}.7(a)(ii)..."

The indications referred to in Rule 13^{bis}.3(a) PCT include the accession number given to the deposit by the depositary institution.

1.2 Article 48(2)(a) PCT reads: "Any Contracting State shall, as far as that State is concerned, excuse, for reasons admitted under its national law, any delay in meeting any time limit".

Consequently, a Euro-PCT applicant who has not carried out a certain procedural act within the time limit prescribed in the PCT can take advantage of the relevant provisions of the EPC concerning re-establishment of rights (Article 122 EPC) in all cases where the direct European applicant too may invoke them if he fails to observe the relevant time limit.

1.3 Moreover, Article 150(2) EPC states that "International applications filed under the Cooperation Treaty may be the subject of proceedings before the European Patent Office. In such proceedings, the provisions of that Treaty shall be applied, supplemented by the provisions of this Convention".

1.4 Under these provisions of the PCT and EPC, Article 122 EPC is applicable to Euro-PCT applicants, i.e. they can have their rights re-established in the event of failure to observe all time limits not excluded from re-establishment under Article 122(5) EPC.

1.5 The first question to be answered for deciding the present case is thus whether restitutio under Article 122 EPC can apply to the EPC time limit which is the EPC equivalent to Rule 13^{bis}.4 PCT, namely the time limit of Rule 28(2)(a) EPC.

2. *Restitutio and Rule 28(2)(a) EPC*

2.1 The European Patent Convention and its Implementing Regulations both are dated 5 October 1973. At that time Rule 28(2) EPC read (insofar as relevant):

"The information referred to in paragraph 1(c) may be submitted within a period of two months after the filing of the application."

The wording of Rule 28(2) EPC has changed somewhat subsequently, but at all times a time limit has been set for providing information referred to in Rule 28(1)(c) EPC concerning a deposited microorganism.

2.2 In its decision G 2/93 (OJ EPO 1995, 275) the Enlarged Board of Appeal gave the following answer to the point of law referred:

"The information concerning the file number of a culture deposit according to Rule 28(1)(c) EPC may not be submitted after expiry of the time limit set out in Rule 28(2)(a) EPC."

This made clear that failure to submit the information within the time limit involved the direct loss of the right to have this information in the text of the application. Failure to submit the information within the time limit thus amounted to a direct loss

of a right, for which the only possible cure is restitutio in integrum under the provisions of Article 122 EPC, if the conditions for this are met.

2.3 In the decision under appeal the effect of decision G 2/93 has been misunderstood. This Enlarged Board decision overruled the view expressed in J 8/87 (OJ EPO 1989, 9) that failure to submit the culture deposit information within the time limit amounted only to a deficiency, which an applicant had to have drawn to his attention and given an opportunity to correct. On this overruled view there would have been no loss of a right on failing to submit the information within the time limit, and accordingly no need and no possibility for restitutio in integrum.

2.4 That in decision G 2/93 the Enlarged Board indicated in point 13 of the Reasons that the indication of the file number of a culture deposit is **substantive** is no indication that the Enlarged Board considered that restitutio in integrum under Article 122 EPC would not apply: the Enlarged Board was answering a quite different question.

2.5 Article 122 EPC provides a remedy for the special case where in spite of all due care required by the circumstances having been taken, inability to observe a time limit has caused a loss of any right. For it not to apply to a time limit, this must be specifically excluded. The time limit of Rule 28(2)(a) EPC is not so excluded by Article 122(5) EPC. Contrary to the reasons given in the decision under appeal, the conclusion to be drawn from the fact that Article 122(5) EPC excludes only certain time limits stated in the articles of the Convention itself, whereas it does not exclude any time limits set out in the rules of the Implementing Regulations, is that time limits in the rules of the Implementing Regulations are generally open to restitutio in integrum if failure to observe them leads to a loss of rights.

2.6 Further, as Rule 28(2) EPC has always contained a time limit since the signing of the Convention and its Implementing Regulations in their original form on 5 October 1973, there can be no presumption of any intention to exclude the time limit of

Rule 28(2) EPC from restitutio in integrum under Article 122 EPC. The protection of the public is safeguarded by the provisions of Article 122(6) EPC.

2.7 For these reasons, the board concludes that the provisions of Article 122 EPC are applicable to the time limit set by Rule 28(2)(a) EPC and thus to the time limit of Rule 13^{bis}.4 PCT.

3. *Referral back*

3.1 The first instance has not considered whether the formal criteria of Article 122(2)(3) EPC, namely the application being filed within two months from the removal of the cause of non-compliance, the omitted act being completed and the fee being paid within this period, and the application being made within one year immediately following the expired time period have been met, though this appears arguably to be the case. Nor, as appears from its decision, did the first instance consider whether for the purposes of Article 122 EPC the criterion of due care required by the circumstances is met in the present case. In order to ensure the right to two instances, the board thus considers it appropriate to make use of the power granted to it under Article 111(1) EPC to remit the case to the examining division for further prosecution.

3.2 In view of the complications by the interaction of PCT and EPC provisions, the board would remark that the result of the application for restitutio in the present case, should be the same as the result if it were an application for restitutio into the 16-month time limit of Rule 28(2)(a) EPC by an applicant for a direct European patent and all communications to the International Bureau, and the European Patent Office, in whatever capacity, had all been made to the European Patent Office. It would also appear that the evidence relating to the circumstances in which the non-observance occurred may not be sufficiently detailed.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.