

Enlarged Board of Appeal EPO, 27 September 1993, Re-establishment - DURION

PATENT LAW

No re-establishment of patent application upon failure to pay examination fee

- **Article 122 EPC is not applicable to the time limit provided in Article 94(2) EPC for paying the examination fee, and that an applicant who has been unable to observe this time limit may not have his rights re-established.**

The Enlarged Board answered the questions which had been referred to it in decision J 16/90, in decision G 3/91 (OJ EPO 1993, 8). It decided that the possibility open to Euro-PCT applicants of having their rights re-established under the former case law of the Legal Board of Appeal stemmed from a misinterpretation of the relevant provisions of the PCT and of the EPC, and that the provisions of Article 122(5) EPC applied both to European and Euro-PCT applicants.

5. It follows that Article 122 EPC is not applicable to the time limit provided in Article 94(2) EPC for paying the examination fee, and that an applicant who has been unable to observe this time limit may not have his rights re-established.

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Enlarged Board of Appeal EPO, 27 September 1993
(C. Payraudeau, F. Antony, G.D. Paterson, E. Persson, R. Schulte, P. van den Berg)

Decision of the Enlarged Board of Appeal dated

27 September 1993

G 6/92

[...]

Applicant:

Duriron Company, Inc.

Headword:

Re-establishment/DURIRON

Summary of the Proceedings

I. In decisions in cases J 15/90 and J 8/91, which each concerns an appeal against a decision of the Receiving Section rejecting a request for re-establishment of rights in respect of the time limit for paying the examination fee for a European patent application, the Legal Board of Appeal has with reference to the earlier case J 16/90 (OJ EPO 1992, 260) referred the following questions to the Enlarged Board:

1. On re-establishment of rights in respect of time limits for payments due at the beginning of the procedure before the EPO:

(a) In the case of European applications, is Article 122 EPC applicable to the time limits in Article 78(2) and Article 79(2) EPC?

(b) In the case of international applications, is Article 122 EPC applicable to the time limit for payment of the

national fee referred to in Article 158(2), second sentence, EPC?

2. On re-establishment of rights in respect of time limits for filing a request for examination:

(a) In the case of European applications, is Article 122 EPC applicable to the time limit in Article 94(2) EPC?

(b) In the case of international applications, is Article 122 EPC applicable to the time limit referred to in Article 150(2), fourth sentence, EPC?

The Legal Board of Appeal also referred the following additional question to the Enlarged Board:

3. If the answer to the questions of law 1b or 2b is negative, that is, re-establishment is precluded in the relevant PCT cases, is the decision of the Enlarged Board of Appeal then also immediately applicable to all pending cases?

II. In point 4 of the reasoning of the two decisions of referral, the Legal Board of Appeal indicated that each of these two cases is only concerned with the above question 2a.

III. Pursuant to Article 8 of its Rules of Procedure, on 1 March 1993 the Enlarged Board decided to consider the referred questions in consolidated proceedings.

IV. The parties to the appeal proceedings before the Legal Board of Appeal, who had been invited by the Enlarged Board to comment on the points of law referred to it, did not submit any observations within the given time limit.

Reasons for the Decision

1. The above question 2a is whether a European patent applicant may have his rights re-established with respect to the time limit provided for in Article 94(2) EPC.

2. With reference to question 2(a), Article 122(5) EPC states that the provisions of Article 122 shall not be applicable to the time limit referred to in Article 94(2) EPC.

3. In decision J 16/90 (mentioned in paragraph I above), the Legal Board of Appeal suggested that its case law relating to international applications (so-called Euro-PCT applications) could be considered to have created an unjustified difference between the treatment accorded to European and Euro-PCT applicants and that, for this reason, there was a possibility that Article 122(5) EPC should be regarded as inapplicable to European applicants as well as Euro-PCT applicants (point 3.1.3 of the reasons in decision J 16/90).

4. The Enlarged Board answered the questions which had been referred to it in decision J 16/90, in decision G 3/91 (OJ EPO 1993, 8). It decided that the possibility open to Euro-PCT applicants of having their rights re-established under the former case law of the Legal Board of Appeal stemmed from a misinterpretation of the relevant provisions of the PCT and of the EPC, and that the provisions of Article 122(5) EPC applied both to European and Euro-PCT applicants.

5. It follows that Article 122 EPC is not applicable to the time limit provided in Article 94(2) EPC for paying the examination fee, and that an applicant who has been unable to observe this time limit may not have his rights re-established.

6. There is no need for the Enlarged Board of Appeal to comment on the other referred questions, since as explained in paragraph II above such questions do not arise in the two cases before the Legal Board of Appeal.

ORDER

For these reasons it is decided that:

The time limit under Article 94, paragraph 2, EPC is excluded from the restitutio in integrum by the provisions of paragraph 5 of Article 122 EPC.