Abstract
Applicant, a Japanese company, filed an international application at the Japanese Patent Office in Japanese requesting a European patent. The applicant neither furnished a translation into English nor paid the requisite fees in time to enter the regional phase. The applicant applied for restitutio in integrum, arguing both that due to an error at the post office it never received the mailings from the EPO indicating the deadlines for entering the regional office. The Board determined that the there were no grounds for restitutio in integrum, finding that it is the responsibility of the applicant to be aware of the deadlines.

EPO boards of appeal decisions

Date of decision 09 November 1987
Case number J 0023/87 - 3.1.1

Summary of Facts and Submissions

I. Euro-PCT application xxx was filed with the Japanese Patent Office in Japanese on 4 January 1985 claiming a (first) priority of 4 January 1984. Consequently, in accordance with Article 22(1) PCT in conjunction with Article 158(2) EPC, the time limit for furnishing to the European Patent Office as designated Office under the PCT a translation of the application in one of the Office's official languages expired on 4 September 1985.

II. On 30 October 1985 the Receiving Section of the European Patent Office sent a communication under Rule 69(1) EPC to the applicant informing him that the European patent application was deemed to be withdrawn (according to Article 24(1)(iii) PCT) because of the failure to furnish a translation within the prescribed time limit.

III. On the same day, the Receiving Section sent a further communication to the applicant informing him that the applicable fees (national fee, search fee and designation fees) had not been paid within the prescribed time limit, but could still be validly paid together with a surcharge within a period of grace of two months after 4 October 1985 (Rule 85a EPC in conjunction with Rule 104b(1) EPC).

IV. By letter dated 5 December 1985 and received on 10 December 1985 the applicant, represented by a professional representative in accordance with Article 133(2) EPC, made an application for restitutio in integrum under Article 122 EPC "for the above-mentioned case" stating, inter alia, that lack of

information on the status of the case prevented the applicant from acting in due time. He was, therefore, unable to observe the critical time limits in spite of taking all due care. The fees referred to in paragraph III above were paid on 6 December 1985. On 18 December 1985 a translation of the application into English was filed with the European Patent Office.

V. At the request of the Receiving Section, the applicant's representative, by letter received on 25 March 1986, further explained the facts on which the application for restitutio in integrum relied. It was submitted that the main reason for the non-observance of the time limits in question was an unforeseen major deficiency in the Japanese mailing system which prevented the applicant from receiving the official PCT mail during a period of four months. This submission was supported by a declaration issued on 26 February 1986 by the Yamabana Post Office in Japan.

VI. In the decision under appeal, the Receiving Section rejected the request for restitutio in integrum in respect of the time limit (for furnishing a translation) laid down in Article 22(1) PCT in conjunction with Article 158(2) EPC and declared that the European patent application in question was deemed to be withdrawn according to Article 24(1)(iii) PCT. It was noted in the decision that in August 1985 the Receiving Section had sent information material to the applicant about the requirements for the commencement of the regional phase of the procedure before the European Patent Office (EPO forms 1201 and 1202), which material, however, could not be delivered to the applicant and had been sent back to the European Patent Office. In the reasons for the decision it was pointed out that this fact did not support the request for restitutio in integrum, since there is no obligation for the European Patent Office to inform applicants about the requirements of the proceedings and that applicants cannot rely on the European Patent Office for being informed about all acts to be taken before a designated Office. The applicant had not provided any evidence that he had tried to inform himself in due time on the rules of procedure to be observed. It was added that even if restitutio in integrum should be granted in respect of the time limit for furnishing a translation, the application nevertheless was to be deemed to be withdrawn because the required fees had not been paid in time and no request for restitutio in integrum had been made in that respect.

VII. The applicant filed a Notice of Appeal on 13 September 1986 and duly paid the appeal fee. A Statement of Grounds was filed on 31 October 1986. It was accompanied by a Statutory Declaration by the president of the applicant corporation, Mr Kunio Takeuchi.

VIII. The appellant requests that the decision under appeal be set aside and to be granted "re-establishment of rights in respect of the subject application". His

submissions can be summarised as follows. (a) It is not correct that, as stated in the decision under appeal, the application for restitutio in integrum had been restricted to the time limit for furnishing a translation of the patent application in question. In fact, the application for restitutio had covered also the time limit for paying the fees referred to in paragraph III above. (b) In addition to the deficiency in the Japanese mailing system, there had been other considerable difficulties with which the appellant had to cope in 1985 as explained in detail in the Statutory Declaration by Mr Takeuchi. Thus, as concluded in that Declaration, the time for taking action in Europe regarding the subject application inadvertently passed whilst official information was awaited, resulting in status uncertainty, inadequate advice, ignorance and misunderstanding.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.

2. The Board considers it to be appropriate to deal first with the question, whether restitutio in integrum in respect of the time limit for furnishing a translation of the subject patent application ought to be granted. If it is not so, there is obviously no point in dealing with the problems concerning the time limit for paying the fees referred to in paragraph III above, since, in that case, the patent application must be deemed to be withdrawn under Article 24(1)(iii) PCT.

3. In view of the complexity of the Euro-PCT system, the information given to applicants from the authorities under the PCT and from the European Patent Office at various stages of the procedure as a service measure is clearly very helpful and it is no doubt regrettable when, for one reason or another, such information is not received by the applicants in due time. However, in order to comply with the requirement of taking all due care under Article 122 EPC an applicant may not rely entirely upon such information as a basis for the prosecution of his application but must ensure that, irrespective of such information not being received or being delayed, normally he is capable of observing the basic time limits laid down in the PCT and the EPC. This view is in line with the opinion expressed by the Legal Board of Appeal in decision J 12/84 (OJ EPO 1985, 108).

4. For an applicant who himself is lacking the necessary knowledge of the PCT and the EPC procedures, it is obviously necessary to consult a competent professional representative in order to cope with the procedures involved in such a patent application. It is in this respect also to be noted that, as far as the

proceedings before the European Patent Office are concerned, natural or legal persons not having either a residence or their principal place of business within the territory of one of the Contracting States must, in principle, be represented by a professional representative and act through him in all proceedings established by the EPC, other than in filing the application, and that such professional representation may only be undertaken by professional representatives whose names appear on a list maintained for this purpose by the European Patent Office.

5. In the present case, it appears from the Statutory Declaration by Mr Takeuchi, inter alia, that the appellant corporation, being a small Japanese firm with limited financial resources, has avoided using professional representatives and relied on the knowledge of Japanese patent law acquired by Mr Takeuchi himself during his years in business as far as national applications are concerned, that neither he nor an employee of the firm who assisted him in patent matters had any special knowledge of PCT matters, that, therefore, a Japanese patent attorney was consulted in the present case, that this attorney incorrectly informed Mr Takeuchi and the said employee that "filing in designated countries can be made within twenty months from the PCT filing date" (instead of, correctly, the priority date) and that, due to this mistake in combination with the lack of official information, Mr Takeuchi and the employee concerned were unaware of the need to take action before the European Patent Office at the relevant time. As a possible explanation to the wrong or misleading advice given by the Japanese patent attorney concerned, it is stated in the Statutory Declaration that "Japanese patent attorneys in many instances are not sufficiently familiar with all or some of the PCT rules, practices or procedures".

6. While recognising the considerable difficulties for the appellant to cope with the situation arising out of the present application, the Board is nevertheless unable to accept that there is a proper case for restitutio in integrum. Thus, the Board is not satisfied that the appellant, being completely ignorant about the special procedure to be observed in this case, has chosen a sufficiently competent professional representative and let him properly advise the appellant on the matters involved having had an opportunity to study the details concerning the present application. The impression given by the Statutory Declaration is rather that there has been only some general and insufficient consultation with a Japanese patent attorney which, in the circumstances prevailing, has caused the fatal mistake with regard to the starting point for the twenty month period for furnishing a translation of the subject patent application laid down in Article 22(1) PCT. It might be added that a mistake of this kind on the part of a professional representative, even properly consulted, could hardly be accepted as a ground for granting restitutio in integrum.

7. Consequently, and since the appellant thus has failed to convince the Board that he has exercised all due care required by the circumstances of the present case, the appeal has to be rejected.

ORDER

For these reasons, it is decided that:

1. The appeal is rejected.

2. All fees paid in respect of this patent application, save the fee for the application for restitutio in integrum and the appeal fee, shall be refunded as requested by the appellant's representative.