

3.4. Loss of rights as a direct consequence by virtue of the EPC

Under Art. 122(1) EPC rights cannot be re-established unless they have previously been lost as a direct consequence of the non-observance of a time limit vis-à-vis the EPO.

In J 1/80 (OJ 1980, 289) certified copies of priority documents had not been filed within the 16-month period provided for in R. 38(3) EPC 1973. The Legal Board of Appeal found that, according to the Convention, there was a deficiency only if the priority documents had not been filed by the end of the period. It could only be said that there was a deficiency thereafter and the applicant should have been given an opportunity to remedy that deficiency within a further period (Art. 91(2), R. 41(1), 84 EPC 1973). There could only be a loss of rights if the applicant did not then take advantage of this opportunity.

In J 23/14 the Legal Board held that, notwithstanding the wording of Art. 86(1) EPC 2000 and R. 51 EPC (in the version in force until 31 December 2016), and for the sake of the protection of legitimate expectations of the users of the European patent system, a patent application was deemed to be withdrawn only upon expiry of the six-month grace period for paying the renewal fee with additional fee under R. 51(2) EPC, in accordance with the case law that prevailed before decision T 1402/13 of 31 May 2016. See also J 7/16.

In T 1403/16 the board found that one of the basic preconditions for applying Art. 122(1) EPC was not fulfilled in the case in hand, namely that non-compliance with the time limit lead directly to a loss of rights. In opposition proceedings, in the event of a failure to reply in due time to a communication from the opposition division, there is no loss of rights which occurs automatically by operation of law. The board held that re-establishment of rights was not available in the event of non-compliance with a time limit set in a communication under Art. 101(1) EPC. This conclusion equally applied to the time limit under R. 84(1) EPC.

4. Admissibility of requests for re-establishment of rights

4.1. Time limits for filing a request for re-establishment (Rule 136(1) EPC)

The time limits for filing a request for re-establishment are set out in R. 136(1) EPC (see also Art. 122(2) EPC 1973). In principle, a request must be filed within two months of removal of the cause of non-compliance and, at the latest, within one year after expiry of the unobserved time limit; R. 136(1), second sentence, EPC provides for two exceptions: a request for re-establishment in respect of the periods specified in Art. 87(1) EPC (priority) and Art. 112a(4) EPC (petition for review by the Enlarged Board of Appeal) must be filed within two months of expiry of the unobserved time limit. Hence the case law summarised in this chapter III.E.4.1.1 is not applicable to such cases, but the principles laid down in this chapter III.E.4.1.2 are likely to be transferable to the two-month period under R. 136(1), second sentence, EPC. Under R. 136(1), third sentence, EPC, the request for re-establishment of rights is not deemed to have been filed until the prescribed fee has been paid.