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D E C I S I O N
of 25 March 2003

Case Number: J 0021/02 - 3.1.1

Application Number: 98913945.6

Publication Number: 0978162

IPC: H02K 23/60

Language of the proceedings: EN

Title of invention:
Electric Vehicles

Applicant:
Adds, Graham John

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 122

Keyword:
"*Restitution in integrum* - all due care (no)"

Decisions cited:
J 0002/86, J 0003/86

Catchword:
-

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: J 0021/02 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 25 March 2003

Appellant: Adds, Graham John
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Representative: Harman, Michael Godfrey
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 12 June 2002 refusing the request for *restitution in integrum* as for the payment of the fourth renewal fee concerning the European patent application 9891345.6.**

Composition of the Board:

Chairman: J.-C. Saisset
Members: M.-B. Tardo-Dino
M. J. Vogel

Summary of Facts and Submissions

I. The European patent application 98 913 945.6 claiming priority GB 9 706 909 was filed on 31 March 1998.

II. On 8 May 2001 the Office drew the representative's attention to the fact that the fourth renewal fee fell due on 31 March 2001 and that it could still be validly paid up to the last day of the sixth month following the due date provided that the additional fee was paid at the same time pursuant to Article 86(2) EPC.

III. On 8 November 2001 a communication noting of "loss of rights" was sent informing the applicant's representative that the application was deemed to be withdrawn because of failure to pay the renewal fee plus surcharge for the fourth year in due time.

IV. In a letter dated 5 December 2001 the applicant's representative filed a request for restitutio in integrum under Article 122 EPC and paid the corresponding fee, as well as the fourth renewal fee with surcharge.

The applicant's representative repeated his grounds for re-establishment in a second letter dated 18 January 2002.

V. By communication under Article 113 EPC dated 15 February 2002, the applicant's representative was invited to supply further grounds with respect to the provisions of Articles 122(1) and (3) EPC.

VI. The applicant's representative replied by a letter dated 24 February 2002.

VII. On 6 May 2002 a notice pursuant to Article 86(2) EPC and Article 2(5) of the Rules relating to Fees was issued for the fifth renewal fee.

VIII. It is to be noted that concurrently on 22 January 2002 the Examining Division sent a communication to the applicant's representative inviting him to file amendments to the description, claims and drawings in accordance with the observations made in the communication. This communication was withdrawn by a letter dated 28 January 2002.

IX. In the decision dated 12 June 2002 which is now under appeal the Formalities Officer acting on behalf of the Examining Division refused the application for re-establishment of rights.

X. In a letter dated 20 August 2002 the applicant filed a notice of appeal, and paid the appeal fee at the same date.

To support the request for re-establishment of rights the notice of appeal mainly sets out the same grounds as supplied before the Examining Division.

However, the appellant adds that the EPO itself can make mistakes since after issuing the communication dated 22 January 2002 (see point VIII supra-), the Office sent a letter on 28 January 2002 asking the applicant to consider the said communication "null and void".

XI. The appellant requests that the decision of the first instance refusing the re-establishment of rights be set aside.

Reasons for the Decision

1. As a preliminary remark, the Board observes that irrespective of the possible setting into motion a procedure under Rule 69 EPC for loss of rights connected with the non payment of the fifth renewal fee it must take a decision about the present appeal.

2. The Board considers that the notice of appeal contains sufficient specific grounds of appeal to meet the requirements of admissibility under Article 108 EPC last sentence. The other requirements of the EPC being met the appeal is admissible.

3. The appellant did not request oral proceedings and the Board is of the opinion that in his written submissions he set out all the legal and factual points to be considered in the present decision. His right to be heard has thus been fully observed.

4. As regards the criteria concerning "all due care" required by Article 122 EPC as set out in the general case law the Board has to ascertain whether the omission of payment of the renewal fee within the time limit was the result of exceptional circumstances or of an isolated error within a normally satisfactory monitoring system (See for instance J 2/86, and J 3/86, OJ 1987, 362).

5. In the present appeal the appellant submits no further facts evidence or arguments than those already submitted before the first instance, but it emphasizes that the EPO made a mistake.

6. As regards that alleged mistake, namely the communication dated 22 January 2002 issued by the Office as if the procedure for the grant of the patent were continuing, the Board considers that the appellant cannot rely on such a fact in justifying his case.

A mistake made by the Office without any link to the applicant's non-observance of a time limit cannot exempt the professional representative from his obligation to take all due care in the circumstances.

In other words the erroneous communication of the EPO which relates to the filing of amendments is a totally independent and irrelevant fact which cannot be considered as evidence of all due care as required by Article 122(1) EPC.

Thus, this mistake has no connection with the representative's duty to observe all due care.

7. Moreover, the appellant admits that he was unable to determine the precise circumstances which resulted in the non-payment of the renewal fee. He puts forward as an explanation the fact that a corresponding American application was filed and was pending at the same time as the European application. This would presumably be the cause of the omission of payment of the fourth European renewal fee, possibly when cancelling a US reminder date after a US response, the entry in the record system of payment of the EP renewal fee might have been cancelled accidently.

He filed only letters relating to another case dealt with by the firm with which he is associated where the UK Patent Office overlooked one of the two requests set

out in the same letter from the applicant. The implication is that this kind of mistake may occur every time a group of items are associated or related.

8. The Board considers that the above-mentioned example, which has nothing to do with the pending case, is unrelated to the present circumstances.

Moreover, this kind of situation (two pending applications one in US and another before the EPO) is a normal one and it is the duty of professional representatives to manage such a situation by using a "normally" effective monitoring system with failsafe systems.

9. As far as a normally satisfactory monitoring system is concerned, the appellant merely stated that he had personally trained and supervised his staff and such an omission had never happened in the past. He pointed out that he had taken steps to prevent any similar occurrence in the future.

However, he did not file evidence of how his monitoring system worked, and which control methods were used to prevent such omissions, with the result that the requirement of all due care is not substantiated.

Moreover, the representative's declaration that he took steps to prevent any similar event in the future is an implicit acknowledgment that all due care in the present case has not been exercised.

Order

For these reasons it is decided that:

The appeal is dismissed

The Registrar: The Chairman:

S. Fabiani J.-C. Saisset