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**Datasheet for the decision
of 18 April 2007**

Case Number: J 0011/06 - 3.1.01

Application Number: 97951473.4

Publication Number: 0941578

IPC: H03K 17/94

Language of the proceedings: EN

Title of invention:

Mouse interface device for providing force feedback

Applicant:

Immersion Corporation

Opponent:

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Headword:

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Relevant legal provisions:

EPC Art. 86(2)(3), 122(1)

EPC R. 69(1)

Keyword:

"Re-establishment of rights (no)"

"All due care (no)"

Decisions cited:

J 0012/84, J 0013/90, J 0027/90, T 0014/89

Catchword:

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Case Number: J 0011/06 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 18 April 2007

Appellant: Immersion Corporation
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San Jose, CA 95131 (US)

Representative: Fiener, Josef
Patentanw. J. Fiener et col.
Postfach 12 49
D-87712 Mindelheim (DE)

Decision under appeal: Decision of the Receiving Section of the
European Patent Office of 28 December 2005.

Composition of the Board:

Chairman: M. Günzel
Members: P. Schmitz
T. Bokor

Summary of Facts and Submissions

- I. European patent application 97951473.4 was filed as international application PCT/US97/21601 on 25 November 1997. The renewal fee for the 5th year fell due on 30 November 2001. Since the fee had not been paid by the due date, the notice drawing attention to Article 86(2) EPC was issued on 8 January 2002. By communication under Rule 69(1) EPC dated 12 July 2002, the applicant was informed that the application was deemed to be withdrawn under Article 86(3) EPC.
- II. On 23 September 2002, an application for re-establishment of rights was filed. The fee for re-establishment, as well as the renewal fee for the fifth year with surcharge were paid on the same day. The applicant's representative submitted that the failure to pay the renewal fee was only realised on receipt of the Rule 69(1) EPC communication. He had not received the notice drawing attention to Article 86(2) EPC. It should be noted that on 10 January 2002 a notice drawing attention to Article 86(2) EPC had been received in another case where the renewal fee was also due in November. The grace period was then noted by the secretary with all due care. In the present case, the renewal fee payments were handled by the US representative. However, this representative changed his law firm in April/May 2002, including a reorganisation and removal, and, additionally, some time later a change of representative took place. Apparently, there was some confusion caused by this reorganisation. Thus there seemed to be an isolated mistake within a normally satisfactory system caused by the transfer of responsibility.

- III. As evidence, *inter alia*, a copy of the representative's mail book showing the mail entries between 2 and 21 January 2002 was filed. In addition, a letter dated 13 May 2002 from the applicant's former US representative in which he informed the European representative that the prosecution of the application had been transferred to a new US representative and that future instructions should be sought from him was submitted.
- IV. On 28 February 2003, the Receiving Section issued a communication pursuant to Article 113 EPC, setting out that the grounds presented were not sufficient. It had not been demonstrated that all due care had been observed. The communication under Article 86(2) EPC was a courtesy service and according to decision J 12/84 (OJ EPO 1985, 108), no rights could be invoked from the omission of such a communication. A time limit of 2 months was set which, on the applicant's request, was extended seven times.
- V. In a letter of 11 June 2004, the applicant's representative finally declared that no further evidence could be obtained from the US representative involved and that a decision should be taken based on the arguments and evidence presented in his letter of 23 September 2002. In addition, it should be taken into consideration that recently several EP-patents had been granted on behalf of the applicant. This fact showed that all due care had usually been taken, i.e. that the applicant's annuity system worked very well. In the present case there was an isolated procedural mistake, apparently caused by several changes of responsibility.

- VI. In a decision dated 28 December 2005, the Receiving Section decided in its first order that the request for re-establishment of rights was admissible. In its second order, it decided that the request was rejected since the applicant had not been able to demonstrate that all due care required by the circumstances was taken.
- VII. Notice of appeal was filed on 6 March 2006. The appeal fee having been paid on 24 February 2006. In the statement setting out the grounds of appeal received on 8 April 2006, the appellant did not present any new facts or evidence but reiterated that he was of the opinion that all due care had been observed, in particular as regards the change of responsibility. Thus the request to have the applicant's right re-established appeared to be appropriate and substantiated. As a matter of precaution, oral proceedings were requested.
- VIII. On 26 January 2007 the appellant was duly summoned to oral proceedings. In the annex to the summons the Board expressed its preliminary opinion that the appellant's request for re-establishment of rights did not seem to be allowable.
- IX. Oral proceedings took place on 18 April 2007 in the absence of the appellant, who had notified the Board the day before that he would not attend.

Reasons for the decision

1. The appeal satisfies the requirements of Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. In its decision dated 28 December 2005 the Receiving Section has decided in its first order that the request for re-establishment of rights was admissible. Whether or not this decision was correct needs not be decided in the present case.
3. According to Article 122(1) EPC an applicant for a European patent can only then have his rights re-established if he was unable to observe a time limit in spite of all due care required by the circumstances having been taken. In accordance with the established jurisprudence of the Boards of Appeal, re-establishment of rights is intended to ensure that an isolated mistake within a normally satisfactory monitoring system does not result in an irrevocable loss of rights. In such a case the relevant party must show that the system normally worked well (see references in "Case Law of the Boards of Appeal of the European Patent Office, 5th edition 2006", VI.E.6.2).
4. In the present case, the appellant submitted that the notice drawing attention to Article 86(2) EPC had not been received. If it had been received the secretary would have noted it with all due care. As already mentioned in the decision of the Receiving Section, the Legal Board of Appeal ruled in decision J 12/84 (OJ EPO 1985, 108), and ever since, that issuing such a notice was a voluntary service and that the applicant could not derive any rights from the omission of this notice. The

applicant had to ensure that renewal fees for European patent applications are paid in time irrespective of whether the notice has or has not been received. An applicant who relied only on this notice from the EPO might not have his rights re-established in respect of the time limit pursuant to Article 86(2) EPC.

5. During the whole procedure, the appellant's representative has not explained how his monitoring system of time limits normally worked and which measures were taken in order to guarantee the timely payment of renewal fees. Rather, from his submissions it seems that he had relied on the notice from the EPO drawing attention to the grace period under Article 86(2) EPC, which, as set out above, can not be qualified as sufficient. It is the appellant's obligation to establish a satisfactory monitoring system and if a time limit is missed and re-establishment has to be applied for, he has to lay this system open and supply corroborating evidence. Nothing of this has been in done in the present case.
6. In a case where an applicant submits that a satisfactory monitoring system was in place it is not sufficient for him simply to allege that this was the first time of unintended non-payment of a renewal fee which showed that all due care was normally observed. Also the fact that recently several EP-patents had been granted on behalf of the applicant does not prove that a satisfactory system was in place.
7. In addition, the appellant submitted that due to the removal and later change of the US-representative there was some confusion caused by this reorganisation.

However, no details as to why this affected the payment of the renewal fee have been given at all. It seems that this fact does not stand in any relation to the non-observance of the time limit since it seems that the real reason why the time limit was not observed, was the fact that the notice under Article 86(2) EPC was not received and, and it was, as a consequence, not reported to the US-representative by the appellant's professional representative.

8. However, in accordance with the established jurisprudence of the Legal Board of Appeal following decision J 27/90 (OJ EPO 1993, 422), even if renewal fees are paid by someone else (i.e. the US patent attorney, an annuity service or even the applicant himself) the appointed professional representative remains responsible in the procedure before the EPO and he has to take the necessary steps to ensure payment, if intended. This includes a reliable monitoring system, reminders to the applicant, etc. No reasons have been submitted as to which concrete steps, if any, were taken in order to ensure timely payment or at least to clarify in time whether further maintenance of the application was intended. In this context the Board notes that even at the point in time when the appellant's European representative was informed about the change in representation in the US by letter dated 13 May 2002, the payment of the renewal fee for the fifth year with surcharge could still have been validly made had the appellant's European representative taken any action in relation to the new US-representative.

9. The appellant further referred to decisions T 14/89 and J 13/90 and argued that under these decisions his mistake during this "time of change" should be excusable. In decision T 14/89 of 12 June 1989 re-establishment of rights was allowed because a mistake occurred due to an internal reorganisation and a removal. In decision J 13/90 (OJ EPO 1994,456) a mistake happened during a change of attorneys. However, in both cases specific reasons were given as to why the mistakes happened and corroborating evidence was filed. This is not the case here.

10. Since the appellant has not convincingly shown that he has taken all due care required by the circumstances the application for re-establishment of rights has rightly been rejected.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

B. Günzel