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**Datasheet for the decision  
of 10 December 2007**

**Case Number:** J 0006/07 - 3.1.01

**Application Number:** 03727742.3

**Publication Number:** 1515914

**IPC:** C02F 1/00

**Language of the proceedings:** EN

**Title of invention:**

Electrochemical wet oxidation method for hydrocarbons mixed with water or with soil

**Applicant:**

Ninolakis, Markos

**Opponent:**

-

**Headword:**

Restitutio/ NINOLAKIS

**Relevant legal provisions:**

EPC Art. 112(1), 122(1), (2), (3)

**Keyword:**

"Restitutio in integrum (no)"

"Referral of question to Enlarged Board of Appeal (no)"

**Decisions cited:**

D 0006/82, J 0012/84, J 0023/87, J 0017/89, T 0516/91,  
J 0005/94, J 0002/96, J 0003/96, J 0018/98, J 0027/01,  
J 0002/02, J 0011/06

**Catchword:**

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Case Number: J 0006/07 - 3.1.01

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.01  
of 10 December 2007

**Appellant:** Ninolakis, Markos  
Viopa Soudas 73 200  
Chania (GR)

**Representative:** Madgwick, Paul Roland  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office of 27 October 2006.

**Composition of the Board:**

**Chairman:** B. Günzel  
**Members:** K. Garnett  
C. Heath

## Summary of Facts and Submissions

- I. This is an appeal against the decision of the Examining Division dated 27 October 2006 by which (a) the request of the applicant (hereafter "the appellant") for *restitutio in integrum* under Article 122 EPC in respect of the period for payment of the renewal fee for the third year was refused and (b) the application was stated to be deemed to be withdrawn with effect from 3 January 2006. A notice of appeal against the decision was filed on 20 December 2006, together with appeal fee, and the statement setting out the grounds of appeal was filed on 2 March 2007.
- II. The appellant had filed European patent application No. 03727742.3 on 5 June 2003, claiming priority from an earlier Greek application filed on 5 June 2002. The renewal fee for the third year fell due on 30 June 2005. On 3 August 2005, the Office sent the appellant a notice in the usual form drawing his attention to the fact that the renewal fee had not been paid. On 13 February 2006, the Office sent the appellant a notice under Rule 69(1) EPC noting a loss of rights (i.e., that the application was deemed to be withdrawn) as a result of his failure to pay the renewal fee and the additional fee within the prescribed time. This notice was returned to the Office undelivered. As a result of a subsequent telephone conversation between the Formalities Officer and the appellant, the appellant filed an application for *restitutio in integrum* on 26 May 2006, together with the appropriate fees. Reasons for failure to comply with the time limit for payment of the renewal fee were filed on 20 July

2006. Throughout this period, the appellant was acting in person.

III. The facts relied on as set out in the application for *restitutio* can be summarised as follows:

- (a) The appellant did not receive letters from the Office in the relevant period and in particular the notice sent to him in August 2005. He had moved premises earlier in 2005 but the owner of his former premises did not inform him of letters that arrived at his former address. In addition, the post office did not forward post to his new address, contrary to his instructions.
- (b) In about July 2005, the Greek patent office informed him that the law had changed and that he did not have to pay renewal fees for the first four years. He stated in the application that the Greek patent office "informs me that the law change and I don't have to pay renewal fees for the first four years. At the moment that no letter came to my address I conclude it was the same for the EPO."
- (c) In December 2005, in relation to a separate application, he sent the Office a notice of change of address and assumed this change would be noted in relation to all his European applications.

IV. The Examining Division refused the application for *restitutio in integrum* on the grounds that the appellant had not exercised all due care: his payment system was not sufficiently well organised to ensure

compliance with the time limits (see points 2 and 4 of the Reasons). Reference was also made to the fact the appellant did not observe the time limits because he wrongly interpreted the Greek Patent Regulations and for some reason his post was not forwarded to him. See paragraphs 1 and 3 of the reasons.

V. The grounds of appeal filed on behalf of the appellant (who by now was professionally represented) are as follows:

- (a) At the relevant time, the appellant was acting in person. He is a businessman and engineer and although he is the proprietor of several Greek patents and European patent applications, he has no special training in patent matters. When judging the standard of care required for the purposes of Article 122 EPC, allowance should be made for the fact that the appellant was an individual who had not appointed a representative and was neither familiar with the requirements of the EPC nor in possession of an established office organization attuned to ensuring procedural deadlines were met (see J 5/94). In its decision, the Examining Division had applied the wrong standard of care, namely that appropriate to the office of a professional representative or the patent department of a large firm.
  
- (b) In fact, the appellant did have a satisfactory system for keeping track of time limits, namely the entries in his diary. Thus, at the beginning of 2005, the appellant had made an entry in his calendar for 6 June 2005, reminding himself to pay

the renewal fee in June 2005. This system would normally have resulted in the fee having been paid on time.

(c) On about 26 May 2005 the appellant moved premises. Moving house is always disruptive and there were clearly many conflicting demands on him at the time.

(d) On 25 July 2005, the appellant visited the Greek patent office. He was aware that renewal fees were due on a number of his applications, and that he had just missed the payment date in respect of the present European application. During his visit he paid renewal fees for the 5th and 6th years in respect of some of his Greek applications but was informed that renewal fees for the 3rd and 4th years had been abolished pursuant to a decision of the Greek patent office. He understood this to apply to his European application. As a result of this information he cancelled the note in his diary relating to the present European patent application and did not pay the renewal fee. If he had been given "the right" information during this visit, he would have been able to pay the outstanding renewal fee and surcharge.

(e) He did not receive the Office's reminder notice of 3 August 2005.

(f) He also did not receive the notice of loss of rights dated 13 February 2006. He first became aware of his failure to pay the renewal fee when

the Formalities Officer telephoned him on 28 March 2006.

- (g) The difference between a national and a European patent application is not a simple concept for a person with no training in such matters. It is perfectly understandable that the appellant would accept from the Greek Office that the abolition of renewal fees for the third and fourth years applied to his European application. It was also perfectly natural for the appellant to turn to the Greek office for information concerning his European application: the Greek office was the Receiving office for the PCT application from which the European application derived and claimed priority, and if granted would result in national rights which would be within the jurisdiction of the national patent offices.
- (h) The present case can be distinguished from J 23/87. In that case, the applicant had failed to exercise due care in the choice of its representative, namely a Japanese patent attorney rather than a qualified European patent attorney. In the present case, the appellant had consulted officials of the Greek patent office, who could be expected to know the procedure under the EPC, at least sufficiently well to refer him to the necessary patent office literature. It was particularly appropriate for the appellant to consult his local patent office because Greek is not one of the official languages of the EPC and the Greek patent office must essentially perform a more comprehensive role in the interface between the applicant and the EPO

than would be the case for example with an applicant in a country that shares one of the official languages of the EPO.

- (i) A distinction must also be made between obtaining incorrect information from a legal adviser and obtaining incorrect information from a national patent office of an EPC country. In the former case the legal adviser has a professional duty to give correct advice, and will be covered by legal liability insurance.

VI. On 20 July 2007, the Board sent the appellant a communication under Rule 12 of the Rules of Procedure of the Boards of Appeal setting out the provisional view of the Board and raising certain matters. In this communication the Board observed that there appeared to be a suggestion that the appellant had actually been misled by the Greek patent office rather than merely having himself made a mistake. As to this, however, the Board noted that: (i) there was no evidence that this was in fact the case; (ii) the suggestion contradicted what had been stated in the application for *restitutio*, and (iii) an appeal was not an appropriate occasion for filing new grounds or facts in support of an application for re-instatement (as had been explained in decision J 18/98).

VII. On 26 September 2007, in response to this communication, there was filed a signed statement of the appellant together with further submissions. In this statement, as well as confirming various matters, the appellant now stated that when he visited the Greek on 25 July 2005: "... I also discussed [my] European applications.



I was told that 3rd and 4th year maintenance fees for patent applications, including European patent applications had been abolished." He added that he was later sent a leaflet concerning maintenance fees, which he says reinforced what he had been told, as it showed no maintenance (ie renewal) fees payable until the fifth year. A copy of the leaflet is exhibited to the statement, but it is in the Greek language and no translation has been supplied. He says he relied on what he had been told by the Greek patent office and therefore crossed out the entry in his diary of 6 June 2005 and subsequently did not pay the renewal fee.

VIII. The further arguments of the appellant as contained in the letter filed on 26 September 2007 can be summarised as follows:

- (a) The statement of the appellant filed with this letter showed that he was told by the Greek patent office that renewal fees for the third and fourth years had been abolished for European applications. His failure to pay the renewal fee in this case was the direct result of this wrong information. The appellant's understanding was confirmed by the brochure he subsequently received.
- (b) It is accepted that, in accordance with decisions such as J 12/84 and J 11/06, the appellant cannot rely on the fact that he did not receive the Office's reminder letter of 3 August 2005 to show that he took all due care. It is argued, however, that the relevance of this fact is that there was then nothing to contradict the wrong information given to him by the Greek patent office.

- (c) In response to the point made by the Board in its communication of 20 July 2007 that an appeal was not an appropriate occasion for filing new grounds or facts in support of an application for reinstatement (see paragraph VI, above), the appellant argued as follows. There was no indication in Article 122(3) EPC as to the extent to which the facts in support of an application must be set out, i.e., how complete they must be. It is inconceivable that the draftsman contemplated that a 100 percent detailed presentation of the facts was required, particularly bearing in mind the fact that the time limit for filing the application was two months from the removal of the cause for non-compliance. A common sense approach indicates that it is inevitable that some of the detail will be filed late.
- (d) As regards decision J 18/98 cited by the Board in its communication in support of this point, the appellant argued, first, that the present case can be distinguished. In J 18/98 there was a shift in the facts put forward, from reliance on details of the applicant's renewal system to reliance on the illness of the person responsible. The Board had decided that because there had originally been no mention of this latter fact, it could not be added to the case. In the present case, the appellant mentioned the wrong information from the Greek patent office at the beginning. The full detail had only appeared in the statement filed on

26 September 2007, after a detailed investigation of his activities at the material time.

(e) Second, the appellant argued that the decision in J 18/98 was "legally suspect". The reasoning had relied on a passage in a legal commentary (Schulte, Patentgesetz, 6th ed. (2001), p. 1208, para. 60) and the interpretation propounded there had relied on decisions of the national courts of a single contracting state (Germany). Those decisions related to national legislation and rules of procedure that do not apply to the EPC. If the factual situation before the Board of Appeal was significantly different from the factual situation on the basis of which the first instance decision was taken, the question was not whether the new facts should be rejected but whether the case should be remitted for a new decision on the correct facts. This principle had not been followed in J 18/98.

(f) Finally, the appellant requested that if the Board considered that the principles in J 18/98 barred the admissibility of the correct factual situation, then this question be referred to the Enlarged Board.

IX. The appellant did not request oral proceedings.

## **Reasons for the Decision**

1. The appeal is admissible.

2. In the course of the reasons for its decision, the Examining Division held the request for *restitutio* admissible but now allowable: a party who applies for *restitutio in integrum* under Article 122 EPC has to show that, in spite of all due care required by the circumstances having been taken, he was unable to observe the relevant time limit. The Examining Division held that this requires that the applicant has a normally satisfactory payment system to ensure compliance with time limits (citing J 2/96, J 3/96, OJ EPO 1987, 362) and that in the present case the appellant's payment system was not sufficiently well organised (see paragraphs 2 and 4 of the reasons).
- 2.1 The Board considers that the latter conclusion did not justify the refusal of the present application since it was not any failure in the appellant's system as such which led to his missing the time limit but rather his mistake about the need to make a renewal payment at all. Indeed, this point is made at paragraphs 1 and 3 of the Examining Division's decision: see paragraph IV, above.
- 2.2 However, although the reasoning of the Examining Division may have been faulty, the Board considers that, for the reasons which are expanded on below, the request for *restitutio* cannot be allowed. It need therefore not be decided whether or not the Examining Division's conclusion that the request for *restitutio in integrum* was admissible was correct.
- 2.3 As regards the appellant's submissions before the Examining Division, it is clear to the Board that the fundamental fact underlying the application for *restitutio* was that the appellant had made a mistake,

which was his assumption that the abolition of renewal fees for the third and fourth years in respect of Greek national applications meant that renewal fees for these years had also been abolished in respect of European applications. This was a mistake of law.

2.4 In general, even in the case of an applicant who acts without the benefit of a suitably qualified representative, a mistake or ignorance as to the law is an insufficient ground for re-establishment. See e.g., J 5/94, point 3.1 of the Reasons; J 27/01, point 3.3.1 of the Reasons; and J 2/02, point 8 of the Reasons, first paragraph. The reason for this is simply that a person who makes such a mistake generally cannot be said to have taken all due care required by the circumstances; such a mistake is normally inconsistent with and indeed the antithesis of taking of all due care. This is particularly so where, as here, the law is clear. Taking of due care requires that a person engaged in proceedings before the Office, even when a layman, should acquaint himself with the relevant rules. See e.g., D 6/82 OJ EPO 1983, 337, point 8 of the Reasons; T 516/91, point 5 of the Reasons.

2.5 The Board accepts that in certain respects, as submitted by the appellant, the same standards of care as are required of a party who has instructed a professional representative or who has a large patent department are not required of a party who acts for himself: see J 5/94, point 5.4 of the Reasons, relied on by the appellant. The Board also accepts that to a layman the difference between a national and a European patent application may not be simple. However, the very passage in J 5/94 relied on by the appellant makes the

point that an applicant who acts for himself cannot rely on his ignorance of the law. The requirement to take all due care means that he must take all possible steps to ensure that he can do, properly and punctually, whatever is required during the grant procedure to prevent any loss of rights. See also J 2/02, point 8 of the Reasons, first paragraph.

- 2.6 The Board accepts that the fact of the appellant's moving house would have been a disruptive influence on the appellant at the time but he has not shown that this fact played any relevant role in his failure to pay the renewal fee. Again, the fact that the appellant did not receive the reminder letter sent out by the Office in August 2005 may have reinforced the mistaken assumption which the appellant had made but it cannot by itself have reversed the existing underlying position, which was that he had failed to take due care.
- 2.7 Before the Examining Division the appellant therefore did not establish that he took all due care as required by Article 122(1) EPC, and the decision of the Examining Division that the request for *restitutio* was not allowable was thus correct.
3. Furthermore, the Board considers that, even if the appellant's more recent claim that he was expressly told by the Greek patent office that renewal fees for the third and fourth years had been abolished for European applications was accepted as not altering the basis of the application for *restitutio* in an inadmissible way, the appeal would still not be allowed.

3.1 The burden of showing that the applicant took all due care is on the applicant. In the present case, the appellant has not established to the Board's satisfaction that he was expressly told by the Greek patent office that renewal fees for the third and fourth years had been abolished for European applications. First, the original basis of the application, which was that he had made an incorrect assumption (See paragraph 2.3, above), contradicts this claim. No explanation has been given for this change in position. Although English is clearly not the appellant's first language, it has not been suggested that he did not correctly express himself in the application. The Board cannot agree with the submission made in the letter filed on 26 September 2007 that the appellant had mentioned the wrong information from the Greek patent office at the beginning. This is simply not the case. Second, the new contention is put forward on the basis of a single sentence in the statement filed on 26 September 2007 ("I was told that 3rd and 4th year maintenance fees for patent applications, including European patent applications had been abolished.") No information is, however, given about the person who is alleged to have made this statement and, as far as the evidence before the Board goes, no attempt has been made to obtain corroboration from the Greek patent office of such a statement. The appellant says he was sent a leaflet which reinforced what he had been told "as it showed no maintenance fees payable until the 5th year", but the leaflet which he exhibits, besides that facts that it is in Greek and that no translation has been provided, makes not mention of renewal fees for European patent applications and therefore does not corroborate the appellant's case.

3.2 For completeness, it should be pointed out that it has not been necessary in this decision to consider whether, or in what circumstances, reliance on incorrect information from a national office, which is not suggested to be an agent of the EPO, could amount to the taking of all due care.

4. As to the request to refer a question to the Enlarged Board of Appeal, Article 112(1) EPC provides that a Board of Appeal shall refer a question to the Enlarged Board if it considers that a decision of the Enlarged Board is required either to ensure uniform application of the law or because an important point of law arises.

4.1 The appellant has not formulated the question which he wishes to have referred but merely says that if the Board considers that the principles in J 18/98 bar the admissibility of the correct factual situation then this "legal question" be referred to the Enlarged Board.

4.2 The Board is unable to see that there is any question that needs to be referred to the Enlarged Board. For the reasons set out in paragraph 3.1, a decision of the Enlarged Board favourable to the appellant would not in any event result in the appeal being successful.

5. In the circumstances, the appeal must be dismissed.



**Order**

**For these reasons it is decided that:**

1. The request to refer a question to the Enlarged Board of Appeal under Article 112 EPC is refused.
2. The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

B. Günzel