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**Datasheet for the decision
of 23 August 2010**

Case Number: J 0008/09 - 3.1.01

Application Number: 04025916.0

Publication Number: 1652485

IPC: A61B 17/64

Language of the proceedings: EN

Title of invention:
Tension guide fixator

Applicant:
Rodrigues da Costa Martins, José Manuel

Headword:
Re-establishment of rights

Relevant legal provisions:
EPC Art. 122(1), 106-108
EPC R. 99
RPBA Art. 12

Relevant legal provisions (EPC 1973):

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Keyword:
"Restitutio in integrum (no)"
"Applicant acting alone"
"Due care (no)"

Decisions cited:
T 0287/84, T 0635/94, J 0027/01, J 0005/94, J 0002/02,
J 0006/07, J 0005/97, J 0002/86, J 0003/86, J 0009/86,
J 0028/92, J 0044/92, J 0048/92

Catchword:

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Case Number: J 0008/09 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 23 August 2010

Appellant: Rodrigues da Costa Martins, José Manuel
(Applicant) Prta. Luis Camoes, 3
P-2815-152 Ch. Caparica (PT)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 24 February 2009
rejecting a request for re-establishment of
rights.

Composition of the Board:

Chairman: B. Günzel
Members: C. Vallet
C. Rennie-Smith

Summary of Facts and Submissions

- I. This is an appeal against the decision of the Examining Division dated 24 February 2009 by which the request of the appellant (the applicant) for re-establishment of rights concerning his European patent application No. 04 025 916 was refused and the application was declared to be deemed to be withdrawn.
- II. The appellant had filed European patent application No. 04 025 916 on 02 November 2004. The renewal fee for the fourth year, which fell due on 30 November 2007, was not paid. By a letter dated 4 January 2008 the European Patent Office (EPO) drew the appellant's attention to the provision of Rule 51(2) EPC according to which the renewal fee may still be paid within six months of the due date, provided that an additional fee is also paid within that period. Since no fee was received a "Noting of loss of rights under Rule 112(1) EPC" communication (Form 2524) was sent on 10 July 2008, informing the appellant that the application was deemed to be withdrawn and that he might request re-establishment of rights within a period of two months. The communication was returned undelivered to the EPO and re-sent first on 7 August 2008 and again on 5 September 2008. On 16 September 2008, an employee of the EPO telephoned the appellant concerning a payment made by him which could not be allocated to a specific file. In that conversation he was at his request told how to apply for re-establishment of rights.

III. By a letter dated 24 September 2008, received at the EPO on 13 October 2008, the appellant requested re-establishment of rights. He paid the renewal fee for the fourth year, the additional fee and the fee for re-establishment of rights on the same date.

IV. The reasoning of the impugned decision rejecting his request, can be summarised as follows:

- The appellant does not explain what his system for monitoring time limits of fee payments is and how it works so that he fails to demonstrate, as required by the established case law, whether he took "all due care required by the circumstances" i.e. whether this system is effective to avoid delays and that the loss of rights results in fact from an "isolated procedural mistake within a normally satisfactory system" (J 2/86, J 3/86, OJ EPO 1987, 362, J 9/86, J 28/92).
- The Notice drawing attention to Rule 51(2) EPC, sent on 4 January 2008, is a voluntary service on the part of the EPO. It remains up to the appellant to ensure that the prescribed fee is being paid in time. No claim for re-establishment of rights can be derived from the absence of such a communication.
- Neither the argument according to which the appellant changed his place of work from 1 January 2006 to 30 June 2008 nor that the postal service in Portugal is not reliable is relevant. The same applies to the confusion resulting from the filing of a new application: the search fee,

filing fee and fee for further processing were paid on 20 August 2008, after the expiry of the time limit for payment of the fourth renewal fee with additional fee for the present application.

V. Against the decision, dated and posted on 24 February 2009, rejecting his request the appellant lodged an appeal received at the EPO on 24 April 2009, and paid the appeal fee on the same date. The statement setting out the grounds of appeal was received on 22 June 2009.

VI. The appellant's submissions can be summarised as follows:

He argues that the condition of "all due care required by the circumstances" is fulfilled in the present case given that:

- he is a surgeon with no specific knowledge of procedure and formalities in the field of patent law,
- he was absent from his home for temporary professional reasons,
- he has also filed another patent application, which increased his confusion.

The appellant further submitted that the case law acknowledges that a representative who has been working "under an exceptional heavy work load" can be considered to have carried out his duty with "all due care" (see T 0635/94). The appellant contended that the same should also apply to an individual appellant in an exceptionally complex period of his life.

Moreover the unpaid fee represents an isolated mistake in a normally satisfactory system and the payment of the renewal and additional fee at the time of the

filing of the request for re-establishment of rights clearly displayed the intention of the appellant to maintain the patent. The appellant also submitted the copy of a letter sent to the Examining Division containing the offer to pay the renewal fees from the 5th up to the 20th year in two terms. Finally, the appellant invoked the principle of proportionality and referred to decision J 5/97.

VII. On 22 January 2010, the Board sent the appellant a communication under Rule 12 of the Rules of Procedure of the Boards of Appeal setting out the provisional opinion of the Board that the appeal and the request for re-establishment were admissible but likely to be dismissed. The Board considered first the reasons already assessed by the Examining Division i.e. that the appellant did not explain his system for monitoring the time limits and failed to supply evidence that he was unable to observe this time limit due to an isolated mistake "in spite of all due care required by the circumstances". The Board also agreed with the view that the arguments put forward by the appellant about his change of place of work, the unreliability of the Portuguese postal service and the filing of another patent application before the EPO were irrelevant. Concerning the principle of proportionality, the Board, referring to the case law, explained that this principle could not apply in the present case since it is never a main ground for re-establishment of rights but is used as support of other reasons already substantiating to a certain extent the allowance of the appeal especially when a reliable system for managing the time limit and an isolated mistake in such a system

can be assessed. These conditions are not fulfilled here.

VIII. On 25 March 2010, in response to this communication, the appellant filed a signed statement together with two documents.

He maintained that the Portuguese post office has many flaws and fails to deliver letters as explained in the newspaper "Jornal de Noticias". He did not receive the reminder dated 4 January 2008 although he returned home every weekend at that time, so that he always kept contact with his mail.

The appellant also forwarded a copy of a letter to his bank ordering the payment of the renewal fees for the forthcoming years.

Both documents are in the Portuguese language without translation apart from two lines of the newspaper article.

IX. The appellant requests that the impugned decision be set aside and, consequently, that the re-establishment of rights be granted. He did not request oral proceedings.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 EPC and Rule 99 and is therefore admissible.
2. The appellant requests re-establishment into the time period for payment of the fourth renewal fee with surcharge concerning the application No. 04025916.0.

3. **Admissibility of the request for re-establishment of rights**

- 3.1 According to Rule 136 (1) EPC, the request must be filed within two months from the removal of the cause of non-compliance with the time limit, i.e. normally, from the date on which the appellant or the person responsible for the application becomes aware of the non-observance of the time limit and within one year following the expiry of the unobserved time limit.
- 3.2 In the present case where no other evidence is submitted or can be found in the file that the appellant could have been aware earlier, the starting point of the two month time limit is the date of the notification of the loss of rights under Rule 51(2) EPC. The first and second "Noting of loss of rights" communications, dated respectively 10 July and 7 August 2008 were both returned to the EPO, but the third, dated 5 September 2008, was indeed received. Evidence for that is the content of the telephone conversation between an employee of the EPO and the appellant on 16 September 2008, the file note of which is both headed and refers to "Form 2524". The request filed on 13 October 2008 is thus within the time limit. It was also filed within the one year period after 31 May 2008.
- 3.3 The necessary acts required under Rule 136(1) and (2) EPC, i.e. payment of the fourth renewal fee with surcharge, payment of the fee for re-establishment of rights and the submission of a statement of grounds on which the request is based setting out the facts on which it relies, were also performed in due time.

The appellant's request for re-establishment of rights is therefore admissible.

4. Allowability of the request

4.1 Under Article 122(1) EPC, an appellant for a European patent, who in spite of having taken all due care required by the circumstances, was unable to observe a time limit vis-à-vis the EPO which has the direct consequence of causing in particular, the deeming of the application to have been withdrawn, shall upon request have his rights re-established.

4.2 In considering whether "all due care required by the circumstances" has been taken, the circumstances of each case must be taken as a whole (see T 287/84, OJ EPO 1985, 333, 338) and must be judged in view of the situation existing before the time limit expired. That means the measures taken by the party to meet the time limit must only be judged with regard to the circumstances as they were at that time.

Not disregarding the fact that the appellant is an individual appellant acting in person, i.e. without the help of a professional representative, the Board must take into consideration whether he exercised the required care in the course of all the procedural steps to ensure that he did what was necessary in time to avoid any loss of rights(see J 27/01 of 11 March 2004, point 3.3.1 of the Reasons).

In this respect, the fact that the appellant is a surgeon without any specific knowledge about procedure and formalities under the European Patent Convention

does not constitute a ground for re-establishment of rights.

In general, a mistake or ignorance of the law is an insufficient ground for re-establishment: see J 5/94 of 28 September 1994, point 3.1 of the reasons; J 27/01 of 11 March 2004, point 3.3.1 of the Reasons, J 2/02 of 9 July 2002, point 8 of the Reasons and J 6/07 of 10 December 2007, points 2.4 and 2.5 of the Reasons. In the last cited decision, this Board expressed the view that "Taking of due care requires that a person engaged in proceedings before the EPO, even when a layman, should acquaint himself with the relevant rules" and further that "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."

Accordingly, the circumstance that the appellant was absent from his usual residence between 1 January 2006 and 30 June 2008 because he was then working in Aveiro, in the North of Portugal, does not play any relevant role in the present case.

The Board can understand that this period of time was a specially difficult one for the appellant and also that it could have caused some disruption in attending to his personal affairs.

However, these explanations are all related to the fact that the appellant was waiting for a reminder from the EPO which he never received (namely the letter dated 4 January 2008) and not to his awareness of the due date for the payment of the renewal fee.

As already stated by the Examining Division, following established case law, the Notice drawing attention to the due date for the payment of the renewal fee is a voluntary service on the part of the EPO and no claim for re-establishment can be derived if the EPO fails to issue or if an applicant fails to receive such a communication.

Consequently, the argument based on the reliability or otherwise of the Portuguese postal service is not relevant either.

4.3 As correctly stated by the Examining Division, the appellant did not provide any information regarding his system for monitoring fee payments, so the Board cannot assess whether this system, if any, is efficient enough to avoid undue delay.

4.4 The circumstance that the appellant filed a second and later patent application is also irrelevant insofar that there is no evidence in the file that, for instance, the appellant paid renewal fees for one application instead of the other, or in any way made a mistake based on actual confusion between the two applications.

4.5 Concerning the principle of proportionality, the appellant relies on the fact that the present patent application is the subject of an agreement with a Swiss company which is already producing the system to which the application relates and argues that, since the loss of rights would jeopardise the production, the consequence of a single late payment of the renewal fee would be disproportionate. In his latest submission he

added that this company refuses now to pay royalties and is trying to copy the system using another name.

The Board agrees with the appellant that the principle of proportionality can be defined as a duty for a court or an administration to find a balance between a party's error and the legally ensuing consequences when a margin of weighing the importance of the circumstances exists (see J 5/97 of 23 September 1999, point 5 of the Reasons).

However, when the Boards of Appeal refer to the principle of proportionality in the case law, it is never as a main ground but in support of other grounds already substantiating, to a certain extent, the allowance of the appeal especially when a reliable system for managing the time limits and an isolated mistake within such a system can be assessed (see J 44/92 and J 48/92 both of 29 November 1996).

As already stated above (point 4.3), the Board cannot find in the submissions of the appellant any description of a system for managing the time limits for the payment of fees. Since the appellant fails to place the Board in a position to assess the reliability of any such system, the Board is unable to assess whether an error in such a system could be treated as an isolated mistake so as to allow re-establishment. For these reasons, the principle of proportionality does not apply in the present case.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

P. Cremona

B. Günzel