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**Datasheet for the decision  
of 8 March 2022**

**Case Number:** J 0013/21 - 3.1.01

**Application Number:** 16908348.2

**Publication Number:**

**IPC:** A61B17/50

**Language of the proceedings:** EN

**Title of invention:**

SYSTEM, APPARATUS, AND METHOD FOR FOLLICULAR UNIT EXTRACTION

**Applicant:**

Devroye Instruments LLC

**Headword:**

**Relevant legal provisions:**

EPC R. 51(2), 136(1), 139 sentence 1, 159(1)  
RFees Art. 5(1), Art. 6(1), Art. 7(1)  
Arrangements for Deposit Accounts

**Keyword:**

Bank transfer - request for correction in payment under Rule  
139 EPC  
Re-establishment of rights - entry into the European phase  
Principle of legitimate expectations

**Decisions cited:**

G 0002/97, G 0001/12, J 0013/90, J 0026/95, J 0008/19,  
T 0014/89, T 1000/19

**Catchword:**



**Juristische Beschwerdekammer**  
**Legal Board of Appeal**  
**Chambre de recours juridique**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

Case Number: J 0013/21 - 3.1.01

**D E C I S I O N**  
**of the Legal Board of Appeal 3.1.01**  
**of 8 March 2022**

**Appellant:** Devroye Instruments LLC  
(Applicant) 109 West 112th Street 66  
New York, NY 10026 (US)

**Representative:** Quintelier, Claude  
B.v.b.a. Koala  
Calabriëlaan 53/9  
1200 Bruxelles (BE)

**Decision under appeal:** **Decision of the Receiving Section of the  
European Patent Office posted on 30 June 2021 in  
the matter of European patent application No.  
16908348.2.**

**Composition of the Board:**

**Chairman** W. Sekretaruk  
**Members:** S. Fernández de Córdoba  
K. Kerber-Zubrzycka

## **Summary of Facts and Submissions**

- I. The applicant (appellant) contests the decision of the Receiving Section rejecting the requests for re-establishment of rights and declaring that European patent application 16908348.2 is deemed to be withdrawn as of 6 February 2019.
- II. The application, filed as international patent application PCT/US2016/054149, did not enter the European phase within the 31-month time limit, which expired on 5 February 2019.
- III. In a communication dated 13 March 2019, the Receiving Section informed the applicant that the renewal fee for the third year, falling due on 5 February 2019 (Rule 159(1)(g) EPC), had not been paid and reminded the applicant that the unpaid fee and the additional fee could be paid within sixth months of the due date. It also drew attention to Article 86(1) EPC, in accordance with which an application is deemed withdrawn if the renewal fee and the additional fee are not paid in due time.
- IV. In a further communication dated 15 March 2019, the Receiving Section noted a loss of rights pursuant to Rule 112(1) EPC and informed the applicant that the European patent application was deemed to be withdrawn since the following further acts required for entry into the European phase in accordance with Rule 159(1) EPC had not been completed in due time:
- payment of the filing fee and additional page fee
  - payment of the designation fee
  - payment of the search fee

- filing of the request for examination and payment of the examination fee

- V. On 11 December 2019, the applicant requested re-establishment of rights. EPO Form 1010 ("Payment of fees and expenses") was annexed indicating bank transfer as the mode of payment and the payment of fees including one fee for re-establishment of rights and fees for further processing (except the fee for further processing for the failure to file the written request for examination).
- VI. In a communication pursuant to Article 113 EPC dated 18 March 2020, the Receiving Section expressed its preliminary view that the request for re-establishment of rights was inadmissible because five re-establishment fees were due and only one was paid. In response to this communication, the applicant, in a letter dated 18 May 2020, submitted further reasons for the admissibility of the request, requested correction of a transcription error in the fee calculation sheet (Form 1010) under Rule 139 EPC and paid four additional re-establishment fees.
- VII. After a second communication under Article 113 EPC and a further response letter, the Receiving Section rejected the requests for correction under Rule 139 EPC and for re-establishment of rights by the decision of 30 June 2021.

In the decision's reasons, the Receiving Section considered that, *inter alia*, where several independent procedural acts were omitted, each resulting in the application being deemed withdrawn, a fee for re-establishment was due for each omitted act. Consequently, in this case, the applicant had to

request re-establishment into the period for requesting further processing for each of the following omitted acts (and to pay the corresponding re-establishment fees):

- payment of the filing fee and additional page fee (as a unitary procedural act)
- payment of the designation fee
- payment of the search fee
- filing of the request for examination and payment of the examination fee (as a unitary procedural act)

In addition, since the time limit to pay the renewal fee for the third year with surcharge was not observed, a (further) request for re-establishment of rights into the time limit to pay the renewal fee for the third year with surcharge was required.

Thus, five re-establishment fees were due, and only one was paid on 13 December 2019. The remaining four re-establishment fees were only paid on 18 May 2020, i.e. more than two months after the request for re-establishment of rights was filed and, *a fortiori*, more than two months after removal of the cause of non-compliance (on 13 October 2019). Consequently, the Receiving Section considered that four requests for re-establishment of rights were inadmissible because they were not filed within two months of removal of the cause of non-compliance since the fees were not paid within that period (Rule 136(1) EPC).

VIII. The appellant was summoned to oral proceedings before the Board. In a communication sent in preparation for the oral proceedings, the Board informed the appellant of its preliminary opinion on the case.

IX. Oral proceedings before the Board were held on 8 March 2022 at which the appellant essentially reiterated its earlier written submissions. The arguments of the appellant are summarised below in the Reasons for the Decision.

The appellant requested that the decision under appeal be set aside and that the requests for re-establishment of rights be considered admissible.

X. At the end of the oral proceedings, the decision was announced.

### **Reasons for the Decision**

1. Request under Rule 139 EPC to correct the fee calculation sheet

1.1 The appellant requests the correction of a transcription error in the fee calculation sheet (Form 1010 "Payment of fees and expenses") since a mistake was made with respect to the amount of the due fees. According to the appellant, there was a causal link between the transcription error in Form 1010 and the amount transferred by the bank. The fact that the same amount was transferred as indicated in Form 1010 left no doubt that if there had not been a transcription error in the filling in Form 1010, a correct amount would have been transferred to the bank account of the EPO and the (correct amount of all) due fees would have been paid in time. Form 1010 was an integral part of the payment procedure since it allowed to establish the purpose of the payment (Article 6(1) RFees) and could not be dissociated from the amount transferred by the bank. Consequently, since Form 1010 was a document

filed with the EPO, the transcription error mentioned in Form 1010 could and should be corrected under Rule 139 EPC.

The appellant further relied on decision J 8/19 of the Legal Board of Appeal. In this decision, the Board stated that, in accordance with decision G 1/12 of the Enlarged Board of Appeal, corrections of errors under Rule 139 EPC in documents filed with the EPO were generally applicable (Reasons 2.3.3). The Legal Board of Appeal failed to see why this line of argument should not equally apply to the correction of a mistake in a payment form (Reasons 2.3.3(c)). Thus, no exceptions to the general applicability of Rule 139 EPC, which contains the wording "any document", could be made for documents relating to the correction of payments.

In this context, the appellant considered that there was no reason to make a distinction between payment by debit order (as in decisions J 8/19 and T 1000/19) and payment by bank transfer. Both were payment methods allowed by Article 5(1) RFees. Making a distinction would adversely affect those paying by bank transfer.

During the oral proceedings, the appellant invoked the principle of proportionality arguing that it should be given a fair opportunity to defend the case to avoid a loss of rights caused by a mere transcription error.

1.2 The Receiving Section essentially dealt with the appellant's arguments in Reasons 11 to 13 of the contested decision as follows:

"11. In recent cases, the Boards of Appeal have allowed corrections in payment forms (J 8/19, T



1000/19, T 317/19). The decision in J 8/19 is of particular relevance as the Board allowed the correction of a mistake in the amount of the fee to be paid. In that case the applicant had indicated the wrong amount of the appeal fee to be paid by debiting of the appellant's current account.

12. The present situation is materially different to J 8/19. Here, the payment was by bank transfer not debit order. The decisive error was that the instructions given to the bank were to transfer only one re-establishment fee. This is the error which would have to be corrected in order to remedy the non-payment. However, the error in the order given to the bank cannot be corrected under Rule 139 EPC because it is not an error in a document filed with the EPO. Rather, it is a document - or an electronic request - filed with a bank. Rule 139 EPC only permits error in documents filed with the EPO to be corrected.

13. The error which the applicant wishes to correct - the indication in the Form 1010 of only one re-establishment fee - is irrelevant, because it is not causal for the non-payment. Moreover, it has not been proven that there was any error with respect to the intention of the applicant at the time of paying the fees, because the Form 1010 indicates precisely the same amount of fees as actually transferred. Thus, the Form 1010 does not contain a mistake and no correction is possible. To avoid any ambiguities, the receiving section finds that although the applicant is correct that the Form 1010 is a document filed with the EPO, and hence can be corrected under Rule 139 EPC, even if

the Form 1010 were corrected it would not remedy the non-payment."

- 1.3 The Board agrees with the Receiving Section's reasoning. The contested decision correctly pointed out that the current situation was materially different to that of decisions J 8/19 and T 1000/19, which both dealt with payments by debit order.

Contrary to the appellant's view, there are important differences between both methods of payment (payment by debit order and payment by bank transfer) in view of the relevant regulations.

In the first case, in accordance with the Arrangements for Deposit Accounts (ADA, Supplementary publication 4, OJ EPO 2019), any interested person may open a deposit account in the records of the EPO in Munich. Payment of a fee is effected by filing a debit order **with the EPO** using one of the accepted electronic means of filing (see Article 5.1.2 ADA). Debit orders submitted in any other way (e.g. using EPO Form 1010) are invalid and not carried out. The date of receipt by the EPO of the debit order is considered the date of payment (see Article 5.4.1 ADA).

In contrast, for payment through a banking establishment, the Rules relating to Fees apply. In this case, an order **to a bank** to transfer the amount of the payment is given. The date which a payment is considered to have been made to the Office is the date which the amount of the transfer actually enters in a bank account held by the Office (Article 7(1) RFees). This may be later than the date on which the transfer order was given (see Guidelines A-X, 4.1).

Thus, there are major differences between the available options for payment of fees. Users are free to choose the method of payment but have to accept the requirements and consequences of the chosen method. It is also their responsibility to know the relevant legal provisions applicable to the different methods of payment.

The Board concludes that principles applicable to payments made by debit order can generally not be applied by analogy to payments made by bank transfer.

In accordance with Rule 139, first sentence, EPC, only errors in documents filed with the EPO may be corrected. Consequently, an error in a bank transfer order cannot be corrected under Rule 139 EPC because it is not an error in a document filed with the EPO but a document filed with a bank. The requested correction of Form 1010 (whether allowable or not) would not remedy the non-payment, which was not caused by the indications in Form 1010 but by the transfer order given to the bank.

- 1.4 The legislative framework mentioned above does not leave any room for the application of the principle of proportionality. The boards are bound by the EPC. The use of the term "may" in the sentence "errors of transcription may be corrected on request" in Rule 139 EPC does not give power or discretion to the boards to apply this rule in circumstances for which it was clearly not conceived to prevent hardship for the applicant in an individual case. Exceptions to the legal consequences of a failure to observe a time limit require a basis in the EPC.

2. Requests for re-establishment of rights
  - 2.1 Relying on the Guidelines (E-VIII 3.1.3), the Receiving Section considered that, due to their different legal nature, the individual acts required under Rule 159(1) EPC did not form a unitary procedural step but were legally independent requirements subject to independent time limits. Where several procedural acts were omitted, each resulting in the application being deemed withdrawn, a fee for re-establishment was due for each omitted act. It therefore concluded that in the case at hand, five re-establishment requests were necessary and consequently five re-establishment fees were due (see section VII above).
  - 2.2 In its statement of grounds of appeal, the appellant challenged the Receiving Section's view. Since Rule 159 EPC mentioned in the same paragraph (1) several acts as being required for entry into the European phase, they should be considered to have the same legal basis and form a unitary procedural act subject to a unitary time limit. Consequently, payment of a single fee was sufficient for the appellant to be re-established in its rights.
  - 2.3 In J 26/95, the Legal Board of Appeal was dealing with a case where the applicant had failed to reply to a communication pursuant to Article 96(2) and Rule 51(2) EPC 1973. This led to the application being deemed to be withdrawn. The applicant had also failed to pay a renewal fee in due time. The applicant submitted that only one fee was due in connection with its requests for re-establishment in respect of both time limits missed since both time limits had not been complied with for the same reason (serious financial difficulties).

However, the Board held that where time limits expiring independently of one another have been missed by the applicant, each resulting in the application being deemed withdrawn, a request for re-establishment had to be filed in respect of each unobserved time limit. Consequently, a fee for re-establishment had to be paid for each request. It was irrelevant whether the requests for re-establishment were based on the same or different grounds.

2.4 In the Board's view, the individual acts required under Rule 159(1) EPC do not form a unitary procedural step but are legally independent requirements subject to independent time limits although some of them may coincide in a particular case. The legal consequences and possible remedies of not fulfilling the requirements of Rule 159(1) EPC are not identical. The legal consequence provided in Rule 160 EPC (application deemed to be withdrawn) does not apply to all of these requirements. In contrast to some other requirements listed in Rule 159(1) EPC, non-payment of the third renewal fee within the time limit provided for in Rule 159(1)(g) EPC does not lead to an immediate loss of right since the fee can still be paid within a further period of six months. On the other hand, the remedy of further processing is not available with respect to this requirement.

2.5 It follows from the above that in the current case the appellant had to pay more than one re-establishment fee. However, only one re-establishment fee was paid in due time. The remaining re-establishment requests are not deemed to have been filed since the required fees were not paid within two months from the removal of the cause of non-compliance (Rule 136(1) EPC), assuming in

favour of the appellant that, as it alleged, the cause of non-compliance had been removed on the 13 October 2019 (see request for re-establishment of rights dated 11 December 2019, page 2).

2.6 Since at least one of the requests for re-establishment required for avoiding a loss of rights is deemed not to have been filed, the finding of the Receiving Section that the current application is deemed to be withdrawn is correct. As stated in J 26/95 (Reasons 5.3 last sentence), "to which of the requests for re-establishment the fee paid is allocated is irrelevant. In any case, with regard to one of the time limits missed, the legal sanction that the application is deemed withdrawn is final".

3. Principle of legitimate expectations

3.1 The appellant argued that the request for re-establishment was filed two and half days before expiry of the two-month time limit under Rule 136(1) EPC. In accordance with the principle of protection of legitimate expectations, a communication indicating the deficiencies in the fee payments could have been sent by the EPO. This would have made it possible to correct the deficiencies in due time by paying the corresponding fees. The error in Form 1010 was readily identifiable and could have been easily corrected still within the time limit. In support of these arguments, the appellant relied on decisions T 14/89, J 13/90 and T 1000/19.

3.2 In accordance with decision G 2/97 of the Enlarged Board of Appeal, the protection of legitimate expectations requires the EPO to warn the applicant of any loss of rights if such a warning can be expected in

all good faith. This presupposes that the deficiency can be readily identified by the EPO within the framework of the normal handling of the case at the relevant stage of the proceedings and that the user is in a position to correct it within the time limit (G 2/97, Reasons 4.1).

3.3 In the Board's judgement, the principle of protection of legitimate expectations cannot help the appellant in this case. Irrespective of whether the deficiencies were readily identifiable (which in the Board's view appears to be highly questionable), the time for a possible reaction of the EPO was extremely short. The request for re-establishment of rights was filed on 11 December 2019, i.e. two days before the expiry of the two-month time limit under Rule 136(1) EPC. It cannot reasonably be expected that the EPO in the normal course of its business is able to discover deficiencies in a request or a payment and to inform the parties accordingly in such a short time. It would be taking the principle of good faith too far to require an immediate reaction of the EPO in a case such as the current one.

3.4 The decisions cited by the appellant do not support its view. In J 13/90, there was sufficient time for the Office (at least nine days) to draw the applicant's attention to the clearly omitted but necessary payment (see Reasons 8). In T 14/89, the request for re-establishment was filed "at a very early stage in the two-month period laid down in Article 122(2) EPC" (reasons 4), so that if the department of first instance had sent a communication drawing the appellant's attention to obvious deficiencies, "the applicant would surely have remedied these deficiencies within the legal time limit for re-establishment, as he

still had sufficient time - i.e. about six weeks - in which to do so" (Reasons 5). In T 1000/19, the Board did not end up deciding upon whether the principle of legitimate expectations was applicable (see Reasons 3.4).

- 3.5 The Board acknowledges that, as pointed out by the appellant, it is difficult to precisely define the point in time at which the principle of good faith protects the applicant in the circumstances of a concrete case. However, this does not mean that the time span which the EPO effectively has for a reaction or warning loses its importance. Instead, it remains a crucial factor in deciding whether the principle of protection of legitimate expectations has to be applied.

## **Order**

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

The appeal is dismissed.



The Registrar:

The Chairman:



C. Eickhoff

W. Sekretaruk

Decision electronically authenticated