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Aktenzeichen

File Number

Numéro du dossier

J 21 192 - 311

In der Anlage erhalten Sie

- eine Kopie des Berichtigungsbeschlusses
- ein korrigiertes Vorblatt (Form 3030)
- einen Leitsatz / Orientierungssatz (Form 3030)
- \_\_\_\_\_

Please find enclosed

- a copy of the decision correcting errors
- a corrected covering page (Form 3030)
- a headnote / catchword (Form 3030)
- \_\_\_\_\_

Veuillez trouver en annexe

- une copie de la décision rectifiant des erreurs
- une page de garde (Form 3030) corrigée
- un sommaire / une phrase vedette (Form 3030)
- \_\_\_\_\_

Anmeldung Nr. / Patent Nr.:

\_\_\_\_\_

(soweit nicht aus der Anlage ersichtlich)

Application No. / Patent No.:

87 90 70 61

(if not apparent from enclosure)

Demande n° / Brevet n°:

\_\_\_\_\_

(si le n° n'apparaît pas sur l'annexe)



Case Number: J 0021/92 - 3.1.1

**D E C I S I O N** of 20 April 1995  
correcting errors in the decision of the  
Legal Board of Appeal 3.1.1  
of 16 March 1995

**Appellant:** Massachusetts Institute of Technology  
77 Massachusetts Avenue  
Cambridge, MA 02139 (US)

**Representative:** Holdcroft, James Gerald, Dr.  
Graham Watt & Co.  
Riverhead Sevenoaks  
Kent TN13 2BN (GB)

**Decision under appeal:** Decision of the Receiving Section of the European Patent Office dated 3 February 1992, rejecting a request for re-establishment of rights pursuant to Article 122(5) EPC into the time limit pursuant to Article 86(2) EPC in respect of the fourth year renewal fee on application No. 87 907 061.3.

**Composition of the Board:**

**Chairman:** R. L. J. Schulte  
**Members:** S. C. Perryman  
J. C. M. de Preter

In application of Rule 89 EPC the Decision given on 16 March 1995 is hereby corrected as follows:

On page 1, line 3 and 8 and  
on page 3, line 8 the application number 88 913 336.2  
reads 88 910 336.2.

The Registrar:

The Chairman:

M. Beer

R. L. J. Schulte

**Internal distribution code:**

- (A)  Publication in OJ  
(B)  To Chairmen and Members  
(C)  To Chairmen

**D E C I S I O N**  
**of 16 March 1995**

**Case Number:** J 0021/92 - 3.1.1

**Application Number:** 87907061.3

**Publication Number:** 0324789

**IPC:** C12N 15/00

**Language of the proceedings:** EN

**Title of invention:**

Methods of regulating metabolic stability of proteins

**Applicant:**

Massachusetts Institute of Technology

**Opponent:**

-

**Headword:**

Re-establishment/MASSACHUSETTS I

**Relevant legal norms:**

EPC Art. 122

**Keyword:**

-

**Decisions cited:**

**Catchword:**

-



Case Number: J 0021/92 - 3.1.1

**D E C I S I O N**  
**of the Legal Board of Appeal 3.1.1**  
**of 16 March 1995**

**Appellant:** Massachusetts Institute of Technology  
77 Massachusetts Avenue  
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**Representative:** Holdcroft, James Gerald, Dr.  
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**Composition of the Board:**

**Chairman:** R. L. J. Schulte  
**Members:** S. C. Perryman  
J. C. M. de Preter

## Summary of Facts and Submissions

I. European patent application 87 907 061.3 (the subject of Appeal J 21/92) was filed on 1 October 1987, and European patent application 88 910 336.2 (the subject of Appeal J 24/92) on 21 October 1988, both in the name of the Appellant, Massachusetts Institute of Technology ("MIT"). The fourth year renewal fee on application 87 907 061.3 was due by 31 October 1990, and the third year renewal fee on application 88 910 336.2 was due by the same date, but neither was paid by this date. In each case a form 2522, dated 27 November 1990, was sent by the EPO to the authorized European representative ("the European representative"), indicating that the fee had not been paid in the normal period, but that pursuant to Article 86(2) EPC it could still be paid together with a surcharge up to 30 April 1991. No payments were received by this date either, and the EPO by forms 2524, dated 7 June 1991, sent to the European representative, indicated that each of these applications was deemed to be withdrawn. On 6 August 1991, MIT filed a request for re-establishment of rights, under Article 122 EPC, by telefax. At the same time, the fees for re-establishment of rights, as well as the respective third and fourth year renewal fees plus surcharge, were paid.

II. The system operated was such that when a form 2522 concerning the possibility of payment with a surcharge of a renewal fee in an extended period was received by the European representative, it would be sent to the particular firm of US patent attorneys ("the particular US attorneys") handling the global prosecution of applications relating to a particular invention, who in turn would pass it on to MIT's patent administrator for action, if any. The records of the European

representative show that the forms 2522 were forwarded to the particular US attorneys on 29 November 1990. The particular US attorneys had no records that showed that these forms were received, or that they were forwarded to MIT's patent administrator. The forms 2522 were not on record with MIT, and MIT's patent administrator had no recollection of having received them.

At the relevant time the particular US attorneys' renewals section was working under particular pressure because earlier that year the particular US attorneys had first decided to make payments of renewal fees for which they had responsibility, through a computer annuity firm, and then a few months later the particular US attorneys decided to revert to an in-house system of paying renewal fees. This caused the amount of correspondence with foreign associates on the question of to whom renewal reminders fees were to be sent to be much greater than normal.

At the beginning of 1990 MIT had a reliably working system for paying renewal fees, which was based on responding to renewal reminders sent to MIT by a number of firms of US patent attorneys dealing with the global prosecution of applications. Given that MIT's patent portfolio had expanded to many hundreds of patents this system had however become cumbersome to operate, and MIT decided in the spring of 1990 to centralize and simplify the work involved by arranging for a single computer annuity bureau to take over responsibility for generating renewal reminders and paying renewal fees. The various firms of US patent attorneys MIT was using would remain responsible only for prosecution of the applications. MIT realized that the computer annuity bureau would need an adequate record base, and employees of the latter visited MIT and prepared a listing of the cases identified as being handled by each firm of

attorneys. On the 10 August 1990, MIT's patent administrator wrote to the US attorneys indicating that they would no longer be responsible for foreign annuity payments falling due after 1 October 1990, enclosing the relevant listing for that firm, asking them to cross check it with their own records, and requesting them to inform MIT of any discrepancies. The two European applications 87 907 061.3 and 88 917<sup>0</sup> 336.2 and the relevant renewal dates did not appear on this listing, although the equivalent US and Canadian applications did so appear.

On appeal it was further submitted that of more than six hundred annuities relating to patents for which MIT's patent administrator was responsible between October 1990 and September 1991, only on the two under appeal was there an unintentional failure to pay.

- III. MIT claimed 11 June 1991, the date of receipt of form 2524 at MIT, to be the date of removal of the cause of non-compliance.
- IV. By decisions both dated 3 February 1992 with the same reasoning, the Receiving Section accepted that the requests had been filed in each case within two months from removal of the cause of non-compliance, and that the requirements of Article 122 EPC other than that of showing that all due care had been used were met. However restitutio in each case was denied essentially on the grounds that lack of due care had been shown because MIT's own records had not been sufficient for establishing a renewals database, MIT had not investigated why no answer to their letter of 10 August 1990 to the particular US attorneys had been received, MIT's system was not considered satisfactory, and some actions by MIT's particular US attorneys were considered careless.



V. MIT filed a Notice of Appeal in each case on 23 March 1992 and paid the appeal fee. In the Statement of Grounds filed on 11 June 1992, supported by additional evidence, MIT argued essentially that the criticisms in the decision under appeal were unreasonable and that the evidence showed that MIT had used all due care. The failures by the particular US patent attorneys had been due to quite exceptional circumstances, and should not be attributable to MIT nor prevent restitutio.

#### Reasons for the Decision

1. The appeals are admissible.
2. At the beginning of 1990 MIT had a reliably working system for paying renewal fees, which was based on responding to renewal reminders sent to MIT by a number of firms of US patent attorneys dealing with the global prosecution of applications. Given that MIT's patent portfolio had expanded to many hundreds of patents this system had however become cumbersome to operate, and MIT understandably decided to simplify the work involved by arranging for a single computer annuity bureau to take over responsibility for generating renewal reminders and paying renewal fees. MIT realized that this would require an adequate record base. The computer annuity bureau prepared lists from the record MIT had in its possession, which lists were sent to the firms of US patent attorneys for cross-checking. The steps taken appear to the Board sufficient for MIT to have the reasonable expectation that any discrepancies would be brought to its attention. By an unfortunate coincidence, during the period when MIT was changing its system, the particular US attorneys responsible for the prosecution

of the application in suit, who had previously arranged to make payments of all renewal fees for which they had responsibility, through a computer annuity firm, had reverted to an in-house system of paying renewal fees. This caused the amount of correspondence with foreign associates on the question of to whom renewal reminders fees were to be sent to be much greater than normal, causing great pressure on their renewals department. The evidence from the relevant partner of the particular firm of US attorneys is that despite their responsibilities relating to renewal fees having ceased on said 1 October 1990, communications from the European Patent Office, such as form 2522 would still be passed on to MIT.

It is not in doubt that this form 2522 of 27 November 1990 was sent on by the European representative, although there was no trace of it in the particular US attorney's office. If this form 2522 had been forwarded to MIT, then it appears justified to assume that the renewal fee would have been paid in time, as the inventions had already been licensed, and as of more than six hundred annuities relating to patents for which MIT was responsible between October 1990 and September 1991 only on the two under appeal was the payment omitted.

3. Furthermore, taking into account that the absence of communication of said form 2522 to MIT was the decisive cause of the failure to pay the renewal fee, the Board considers that the unusual combination of the above mentioned quite exceptional circumstances relating both to the reorganization of the system for payment of renewal fees at MIT and to the repeated changes in the system for payment of renewal fees at the particular US attorney's office, complicated by the fact that the latter from 1 October 1990 no longer had responsibility

for MIT's renewal fees, allows said failure to be qualified as having occurred despite all due care required by the circumstances having been taken, and reinstatement should thus be allowed.

**Order**

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

1. The decision under appeal is set aside.
2. The fourth year renewal fee plus surcharge is to be deemed to be paid in due time, and the case is remitted to the first instance for further prosecution.

The Registrar:



M. Beer

The Chairman:



R. L. J. Schulte

