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**Datasheet for the decision
of 19 February 2016**

Case Number: T 0629/15 - 3.3.03
Application Number: 08742619.3
Publication Number: 2155794
IPC: C08F8/00, C08L53/00, C08J3/075,
C08L51/06
Language of the proceedings: EN

Title of invention:

SOFT AND STRONG ELASTOMERIC COMPOSITIONS FROM SEMICRYSTALLINE-AMORPHOUS POLYOLEFIN BLOCK COPOLYMERS

Applicant:

The Regents of the University of California

Headword:

Re-establishment of rights - payment of renewal fee

Relevant legal provisions:

EPC Art. 113(1), 122(1), 122(2)
EPC R. 51, 112(1), 136(1)
RPBA Art. 15(3)

Keyword:

Re-establishment of rights - time limit for paying renewal fee
Re-establishment of rights -
time limit for filing request for re-establishment -
two months of the removal of the cause of non-compliance

Decisions cited:

J 0007/82, J 0017/89, J 0027/90, J 0016/93, J 0024/97,
J 0019/04, J 0001/07, J 0004/07, J 0012/10, J 0005/13,
T 1704/06, T 0942/12

Catchword:



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Case Number: T 0629/15 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 19 February 2016

Appellant: The Regents of the University of California
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Oakland, CA 94607 (US)

Representative: Leeming, John Gerard
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 10 November
2014 rejecting a request for re-establishment of
rights**

Composition of the Board:

Chairman M. C. Gordon
Members: C. Brandt
O. Dury
D. Marquis
R. Cramer

Summary of Facts and Submissions

- I. The appeal lies from the decision of the Examining Division, announced on 10 November 2014, rejecting the applicant's request of 26 February 2013 for re-establishment of rights into the time limit for payment of the 5th year renewal fee with additional fee. The Examining Division also stated that the patent application was deemed to be withdrawn as of 1 November 2012. The Examining Division held that the cause of non-compliance was removed not only once the then European representative had been informed by the US applicant's US representative on 8 January 2013 of the erroneous nature of the non-payment of the 5th year renewal fee, but when the European representative had received the communication of loss of rights pursuant to Rule 112(1) EPC of 10 December 2012 on 11 December 2012. Despite the fact that the US applicant used a US representative as well as a service firm (Lumen Patent Firm) for the payment of renewal fees, the European representative remained responsible for the application. The European representative's awareness of the lack of payment of the renewal fee was therefore to be considered as sufficient to remove the cause of non-compliance. Hence, the time limit for filing the request for re-establishment expired on 11 February 2013, so that the request filed on 26 February 2013 was filed after the expiry of the deadline and was to be found inadmissible. The Examining Division referred to a number of decisions of the Boards of Appeal to support its findings.
- II. The appellant filed a Notice of Appeal on 9 January 2015. With the statement setting out the grounds of appeal filed on 6 March 2015 the appellant requests:

(1) as the main request that the applicant's rights in relation to the time limit for payment of the fifth year renewal fee with additional fee be re-established and that the application be remitted to the Examining Division for completion of substantive examination thereof,

(2) as a first auxiliary request that the Board of Appeal finds the request for re-establishment to be admissible and remits the application to the Examining Division for consideration of allowability of the request for re-establishment,

(3) as a second Auxiliary Request that oral proceedings be held if the Board is unable to grant either of the above requests without them.

III. The appellant's arguments as submitted with the statement of grounds of appeal can be summarized as follows:

For a professional representative to know that the erroneous non-payment of a fee has occurred, he must be aware not only that the fee has not been paid, but also that it should have been paid. If a professional representative has been instructed to do something and inadvertently fails to do so, then he only needs to become aware that the thing was not done to know that something is amiss. But that was not the case here.

On receipt of the Noting of Loss of Rights communication, the European representative became aware that the renewal fee had not been paid. He reported the communication promptly on 20 December 2012. The evidence showed that it was not until the telephone conversation of 8 January 2013 (with the US

representative) that he became aware of the circumstance that it should have been paid that allowed him to conclude that something was amiss.

Noting of Loss of Rights communications were an everyday occurrence for professional representatives and the vast majority of them did not relate to any error. Thus a professional representative could not rush to take remedial action each time a Noting of Loss of Rights communication is received, but must first investigate whether the rights lost have been intentionally given up. Such an investigation could not begin until the fact that the non-payment was unintentional has been established.

- IV. The appellant further submitted that it was unclear whether the appealed decision also addresses the allowability of the request for re-establishment. If it did, then a serious procedural violation had occurred, since the representative had not been given the opportunity at the oral proceedings before the Examining Division to address the allowability of the request for re-establishment. In that event, the refund of the appeal fee is requested. Furthermore, if the Board cannot decide that re-establishment is allowable, the application should be remitted to the Examining Division for consideration of allowability of the request.
- V. With a communication dated 2 December 2015, received by the European representative of the appellant on 8 December 2015, and annexed to the summons to oral proceedings to take place on 19 February 2016 the Board questioned the admissibility of the request for re-establishment on the following grounds:

"In addition to the decisions cited by the Examining Division in the decision under appeal and commented on by the appellant in its statement of grounds of appeal the Board refers to some further, partly more recent decisions of the Boards of Appeal (5.1.-5.7 below). These decisions concern cases and circumstances similar and comparable to the facts of the underlying appeal case, i.e. cases where renewal fees had not been paid in time, a communication of loss of rights was issued and the applicant was an US-based enterprise represented by both a US representative and an European representative, and where a service firm had been charged with the payment of fees with respect to proceedings before the EPO.

In decision J 27/90 (OJ EPO 1993, 422), referred to and commented on by both the Examining Division and the appellant, the board noted that even if renewal fees are paid by someone else (e.g. a US attorney, a service company or even by the applicant himself), the appointed European professional representative remains responsible for the proceedings before the EPO and has to take the necessary steps to ensure payment, if intended. This includes a reliable monitoring system and reminders to the applicant. This decision has been confirmed by several decisions of the Boards of Appeal concerning comparable facts and circumstances (e.g. J 1/07 of 25 July 2007; J 4/07 of 7 July 2008, J 12/10 of 16 June 2011; J 5/13 of 17 January 2014). The Boards of Appeal further stated that, in cases like these, the European professional representative continued to bear a secondary responsibility to advise the appellant properly if either the appellant addressed them or if they became aware of any problem that might affect the appellant's position in respect of the legal status of the patent application and, in particular, the payment

of the renewal fee (J 1/07, point 4.4 of the reasons; J 5/13, point 3.3.2 of the reasons). The Board thereby fully agrees with the appellant that if, as in the present case, the European representative's authorization is silent concerning the payment of renewal fees and he has not received any funds for this purpose, he cannot be expected to pay the fee by advancing money on behalf of the appellant out of his own pocket (cf. J 16/93 of 20 June 1995, point 4.3.3 of the Reasons; J 19/04 of 14 July 2005, point 10 of the Reasons).

According to the case law of the Boards of Appeal the removal of the cause of non-compliance is a matter of fact which has to be determined in the individual circumstances of each case (J 07/82, OJ EPO 1982, 391). In the case of an error of facts the removal occurs on the date on which any person responsible for a patent application, i.e., the European professional representative, should have discovered the error made. If a communication according Rule 112(1) EPC has been duly served, it may, **in the absence of circumstances to the contrary**, be assumed that the removal was effected by this communication.

The appellant has not put forward any convincing argument which could lead to the conclusion that there were **circumstances to the contrary**, with the consequence that it can be assumed that the removal was only effected when the European representative was informed by the applicant's US representative on 8 January 2013 of the erroneous nature of the non-payment of the 5th renewal fee. Taking into account the facts underlying the case at issue, there is no reason why the Board should take the view that the European representative could not have discovered that the non-

payment was unintentional immediately after receipt of the communication of Loss of Rights on 11 December 2012.

The appellant has not provided any arguments, let alone evidence, that the European representative as responsible person had monitored the time limit for the payment of the renewal fee and that he had sent the US applicant or its national representatives reminders or warning letters regarding the impending expiration of that time limit that remained unanswered. If he had done so, one might consider that the mere receipt of a communication of Loss of Rights could be expected by the representative, since after such reminders being left unanswered the representative could assume that no further actions should be taken and the renewal fee should not be paid. It could then probably be concluded that, based on such facts, the cause for non-payment may not yet have been removed by the receipt of a communication of Loss of Rights (see J 19/04 of 14 July 2005, point 5 of the reasons). Apparently, the facts underlying J 19/04 are decisively different from those of the case at issue.

In the absence of any information to the contrary, upon receipt of the communication of Loss of Rights on 11 December 2012 the European representative could and should have established whether something had gone wrong and whether payment of the renewal fee had been unintentionally missed. If, as follows from his submissions, he did not positively know that the appellant did not intend to pay the renewal fee, it was his duty to immediately inform the US patent attorney upon receipt of the Noting of Loss of Rights so as to ascertain whether non-payment had occurred inadvertently, or whether the appellant actually

intended to let the application lapse (see J 12/10 of 16 June 2011, point 3 of the reasons).

It may be true, as the appellant submits, that Noting of Loss of Rights communications are an everyday occurrence for a professional representative and that the vast majority of them do not relate to any error (4.3 above). It may also be accepted that a professional representative cannot rush to take remedial action each time a Noting of Loss of Rights communication is received, but must first investigate whether the rights lost have been intentionally given up. The Board can however not agree with the appellant's allegation that such an investigation cannot begin until the fact that the non-payment was unintentional has been established.

The purpose of the two-month period laid down in Rule 136(1) EPC is to enable parties to carry out the necessary investigations and consultations, as well as to prepare the documentation for submission of a request under Article 122(1) EPC (J 17/89 of 9 January 1990, point 3 of the reasons). Thus, any investigation into whether the payment of the renewal fee had been missed unintentionally or deliberately has to start immediately once the Noting of Loss of Rights communication has been received. If it emerges from that investigation that the time limit has been missed unintentionally then a timely request under Article 122(1), Rule 136(1) EPC has to be filed with the EPO. As explained above, taking into consideration the pertinent case law of the Boards of Appeal this two month time limit normally starts upon receipt of the Noting of Loss of Rights communication. The European representative should therefore without delay have sought confirmation of the unintentional omission to

pay the renewal fee, with indication of the time limit for requesting re-establishment.

The European representative did however not seek such confirmation, but merely forwarded the Noting of Loss of Rights communication by regular mail nine days after its receipt to the US representative, leaving it up to the latter to draw its own conclusions. In such a situation there are no circumstances to the contrary allowing to assume a date of removal of the cause of non compliance later than the date on which the European representative actually received the Loss of Rights communication (J 12/10 of 16 June 2011, point 4 of the reasons).

Furthermore, the Board notes that the factual situation underlying the present appeal case at issue did not prevent the European representative from complying with a two-month time limit ending on 11 February 2013. Even if he only learned during the telephone conversation of 8 January 2013 with the US representative that the non-payment of the renewal fee was unintentional, there was still more than one month left.

Contrary to the appellant's position (statement of grounds of appeal, point 21), decision J 24/97 does not support the present request for re-establishment. In that decision, the Board considered the removal of the cause of non-compliance was when the professional representative "eventually received the instructions to pay the renewal fee", rather than when he received the Noting of Loss of Rights communication. However, that "receipt of instructions" occurred before the receipt of the Noting of Loss of Rights communication. Therefore, it cannot be concluded that the Board in J 24/97 would have arrived at the same decision if, as in

the present case, that "receipt of instructions" occurred after the receipt of the Noting of Loss of Rights communication, and hence the latter probably could have effected the removal of the cause of non-compliance.

At present, the different arguments submitted by the appellant fail to convince the Board that the decision under appeal was mistaken and has to be set aside. In the Board's preliminary view, the rejection of the request for re-establishment was correct and the appeal has to be dismissed.

In the Board's understanding, the decision under appeal was based solely on the lack of admissibility of the request for re-establishment (point 26 of the Examining Division's decision of 10 November 2014). The same is true for this communication of the Board. Consequently, at present, any requests by the appellant relating to the allowability of the request for re-establishment are moot."

- VI. With letter dated 19 January 2016 the appellant submitted **only** the following response to the Board's communication:

"We write to inform you that no representative of the appellant will attend the oral proceedings that are scheduled for 19 February 2016.

We maintain the requests that have been made in the written proceedings and invite the Board to take a decision based on the submissions made in writing."

- VII. Oral proceedings before the Board were held on 19 February 2016 in the absence of the appellant.

At the end of the oral proceedings the Board announced its decision.

Reasons for the Decision

1. In its communication accompanying the summons for oral proceedings the Board, taking account of the impugned decision and the submissions of the appellant, raised objections against the admissibility of the request for re-establishment of rights into the time limit for payment of the 5th year renewal fee with additional fee.
2. This communication explained why, in the Board's opinion, the request for re-establishment of rights lacked admissibility according to Rule 136(1) EPC (see point V. above).
3. The appellant did not reply in substance to these objections (see point VI. above). It indicated that it would not attend the oral proceedings.

There has been no attempt by the appellant to refute or overcome the objections raised in the above communication. The Board has reviewed the factual and legal situation and sees no reason to depart from its preliminary opinion as expressed therein. Finally, in addition to the grounds as set out in the communication dated 2 December 2015 the Board points out that the present case also differs from those cases where the European representative had expressly been instructed not to monitor renewal fees (see T 942/12 of 17 November 2015, point 3.4 of the reasons).

4. Although the appellant did not attend the oral proceedings, the principle of the right to be heard pursuant to Article 113(1) EPC is observed since it only affords the opportunity to be heard and, by absenting itself from the oral proceedings, a party gives up that opportunity (see the explanatory note on Article 15(3) RPBA cited in T 1704/06, point 7.3 of the reasons; see also the Case Law of the Boards of Appeal, 7th Edition 2013, IV.E.4.2.3 c)).

5. Taking account of the preceding observations, the Board concludes that the request for re-establishment of rights into the time limit for payment of the 5th year renewal fee with additional fee is inadmissible, since it has not been filed within two months of the removal of the cause of non-compliance with that time limit (Rule 136(1) EPC) and that for these reasons the rejection of the request by the Examining Division was correct.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



B. ter Heijden

M. C. Gordon

Decision electronically authenticated