

**Internal distribution code:**

- (A) [ - ] Publication in OJ
- (B) [ - ] To Chairmen and Members
- (C) [ - ] To Chairmen
- (D) [ X ] No distribution

**Datasheet for the decision  
of 15 April 2016**

**Case Number:** T 1815/15 - 3.2.03

**Application Number:** 96936998.2

**Publication Number:** 0857242

**IPC:** E03D13/00

**Language of the proceedings:** EN

**Title of invention:**

HORIZONTAL-FLOW OIL-SEALANT-PRESERVING DRAIN ODOR TRAP

**Patent Proprietor:**

Falcon Waterfree Technologies, LLC

**Opponents:**

IFÖ Sanitär AB  
URIDAN A/S  
John Reese

**Headword:**

**Relevant legal provisions:**

EPC Art. 122  
EPC R. 82(3), 88(2), 136

**Keyword:**

Admissibility of appeal - (yes) Violation of the principle of  
legitime expectations (no) Reestablishment of rights for  
paying the surcharge Rule 82(3) EPC (yes)

**Decisions cited:**

G 0005/88, G 0001/90, J 0041/92, J 0002/94, T 0529/09

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

European Patent Office  
D-80298 MUNICH  
GERMANY  
Tel. +49 (0) 89 2399-0  
Fax +49 (0) 89 2399-4465

Case Number: T 1815/15 - 3.2.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.03**  
**of 15 April 2016**

**Appellant:** Falcon Waterfree Technologies, LLC  
(Patent Proprietor) 2255 Barry Avenue  
Los Angeles, CA 90064 (US)

**Representative:** Ricker, Mathias  
Wallinger Ricker Schlotter Tostmann  
Patent- und Rechtsanwälte  
Zweibrückenstrasse 5-7  
80331 München (DE)

**Respondent:** IFÖ Sanitär AB  
(Opponent 1) Box 140  
29522 Bromölla (SE)

**Respondent:** URIDAN A/S  
(Opponent 2) Snerlevej 3  
6100 Haderslev (DK)

**Respondent:** John Reese  
(Opponent 3) Aaroesund Landevej 150  
6100 Haderslev (DK)

**Representative:** Mann, Volker  
Patentanwälte  
Bonnekamp & Sparing  
Goltsteinstrasse 19  
40211 Düsseldorf (DE)

**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 23 July 2015  
revoking European patent No. 0857242 pursuant to  
Article 101(3)(b) EPC.**

**Composition of the Board:**

**Chairman**            G. Ashley  
**Members:**            C. Donnelly  
                          M.-B. Tardo-Dino

## **Summary of Facts and Submissions**

- I. By decision T 0319/11 of 20 October 2014 dispatched on 12 November 2014, the Board remitted the case to the opposition division with the order to maintain European patent 0857242 in amended form.
- II. By a communication pursuant to Rule 82(2) EPC dated 10 December 2014, the opposition division requested the patent proprietor to pay the fee for publication of a new specification and to file translation of the mentioned claims in the other two official languages within three months of notification of this communication.
- III. By a communication dated 24 April 2015 pursuant to Rule 82(3) EPC, the opposition division pointed out that the fee for publishing the specification had not been paid, and that the translation of the claims had not been filed in due time. The patent proprietor was reminded that it could still validly perform these omitted acts within two months, provided it paid a surcharge.
- IV. The patent proprietor filed the translation and paid the fee for publishing on 3 July 2015, but failed to pay the surcharge.
- V. By the decision of 23 July 2015, the opposition division revoked European patent 0857242. The decision reads as follows:

"By the communication pursuant to Rule 82(2) EPC dated [*sic*] the proprietor of the patent had been requested within a period of three months

1. to pay the fee for printing a new specification of the European patent
2. to file a translation of any amended claims into the two other official languages other than the language of the proceedings.

These requirements were not complied within due time. By the communication dated 24 April 2015 it was pointed to the proprietor of the patent that the acts requested could still be validly performed within a period of two months from notification of said communication, provided that within this two-month period a surcharge of EUR 120 (Art.2(9) Rfees) be paid.

The proprietor did not

-perform the required acts in full and due time,  
but.....

-pay the surcharge in due time, *but the fee was not paid* (note from the Board: this part in italics was added by the opposition division to the form).

The European patent has to be revoked for failure to validly comply with the requirements under Rule 82(2) and (3) EPC".

- VI. By a letter received on 30 July 2015 the patent proprietor filed an appeal against the above mentioned decision, and paid the appeal fee.
- VII. By a letter received on 3 September 2015 the patent proprietor then filed a request for re-establishment of rights according to Article 122(1) EPC with respect to the non-observation of the time limit according to Rule 82(3) EPC and paid the surcharge required by Rule 82(3) EPC.

VIII. The statement of grounds of appeal was filed on 30 November 2015.

IX. The appellant's arguments were the following.

- In support of the appeal, the appellant argued that there was a breach of the principle of protection of legitimate expectations. The formalities officer is entrusted with certain duties in accordance with Article 2 of the Decision of the President of the EPO of 2 December 2013, which includes communications under Rule 82(2) and (3) following the instructions of the opposition division. When on 3 July 2015 the patent proprietor filed the translations and paid the publishing fee, but omitted the surcharge, the formalities officer should have brought attention to the omitted payment, ie while it was still possible to remedy the deficiency within the time limit which, according to Rule 82(3) EPC, would have expired on Saturday 4 July 2015 (thus in practice extended to Monday 6 July).  
In such circumstances, where the patent had been defended in the preceding inter partes proceedings and where the patent was "old", the patent proprietor could have expected that the formalities officer would have given a high priority to the case, and have alerted the patent proprietor to the omitted payment.  
Furthermore, the communication under Rule 83(3) EPC was misleading, in that the requirement regarding the surcharge is presented in a normal font style.
- In support of the request for re-establishment it was argued as follows.

The professional representative's firm runs a system for monitoring the time limits based on a double-checking system, including a first control and an independent second control.

For any given case, a first employee (an attorney's clerk) prepares the submissions, including the necessary attachments relevant for the case, and a list of deadlines. This first employee forwards the documents to the corresponding patent attorney for signature.

In the second stage, a room is exclusively dedicated as a work place to an employee specifically and exclusively entrusted with monitoring deadlines. This is the second independent control. Everyday the employee, who has been trained for this particular task, goes to the monitoring room at a certain time of the day and checks the deadlines. In the monitoring room a list of daily deadlines is prepared and updated (see the excerpt of 4 July 2015 enclosure 1, mentioning the deadlines). It is the task of the second employee to compare the outgoing mail with the official document from the EPO underlying the action, which in the present case was the communication under Rule 82(3) EPC.

In the present case both employees, at the first and second stages, were trained and had been working in the office for a certain time.

Despite her knowledge of the requirements regarding Rule 82 (3) EPC, the first employee omitted to enclose, in addition to the required documents and the payment for the publication, the surcharge. In the heading of the letter accompanying the documents sent to the EPO, she also referred to the



wrong paragraph of Rule 82 (paragraph (2) instead of (3)), whereas:

(a) the communication from the EPO she was referring to indicated the right paragraph (Rule 82 (3) EPC), and

(b) she indicated the right paragraph in the entry into the docketing system "PatOrg", "Response to Rule 82(3) EPC", (as is apparent from enclosure 2). The letter containing the submissions was sent to the patent attorney for signature, and then transferred to the monitoring room where the second employee also checked the letter together with the attachments, as prepared by the first employee, and compared it with the entry in the monitoring list for the present case relating to the response to the communication of the EPO pursuant to Rule 82(3) EPC.

Owing to a second, unique and retroactively unexplainable mistake, the second employee failed to notice the omission of the payment of the surcharge required by Rule 82(3) EPC. This non-payment occurred in a monitoring system that otherwise functioned perfectly, and the two employees involved were qualified and experienced patent attorneys' clerks, who had reliably performed their duties in the past and never given reasons to doubt their professional capabilities.

- X. The requests of the appellant were to set aside the decision under appeal and to maintain the patent No 0857242 as upheld by decision T 0319/11. As an auxiliary measure oral proceedings were requested.

It also requested re-establishment of its rights with respect to the non-observation of the time limit according to Rule 82(3) EPC.

## **Reasons for the Decision**

1. The Appeal
  - 1.1 The appeal is admissible since it was filed against an appealable decision (see G 1/90, as set out below), and was substantiated within the required time limit (Article 108 EPC).
  - 1.2 However the appeal is not allowable.

The board cannot see any violation of the principle of protection of legitimate expectations resulting from the fact that the formalities officer did not call the appellant's attention to the non-payment of the surcharge.

The appellant could not expect to be informed of the missing surcharge. Whereas the EPO may be obliged, on the basis of the principle of good faith governing the procedure before the EPO (see G 5/88 OJ EPO 1991, 137), to give prompt information on a specific query, a party may not expect a warning in respect of any deficiency occurring in the course of the proceedings (J 41/92, OJ EPO 1995, 93, point. 2.4 of the reasons and J 2/94 of 21 June 1995). In the present case the appellant could not reasonably expect from the formalities officer that he or she would firstly be aware that it was an "old " patent and consequently that the date of the payment needed special attention, secondly notice that the surcharge was missing, and thirdly inform the appellant of the deficiency because there was only one day left before expiry of the time limit.

For these reasons the appeal is dismissed.

2. The Request for Re-establishment of Rights

2.1 According to Rule 136(4) EPC the department competent to decide on the omitted act shall decide on the request for re-establishment of rights.

In the current case the patent proprietor filed its request while an appeal was pending.

2.2 This situation was foreseen in G 1/90 (OJ EPO 1991, 275). There, the Enlarged Board decided that the revocation of the patent as a result of the failure to carry out the formalities required by Article 102(4) and (5) EPC (now Rule 82(2) and (3) EPC) required a decision. According to the Enlarged Board, the patent proprietor can then make use of two legal means of redress.

2.3 Loss of rights can be prevented by applying for re-establishment of rights if the relevant requirements are met (Article 122 (1) and (2) EPC). This legal remedy is available to the patent proprietor in opposition proceedings "if the non-observance in question has the direct consequence, by virtue of this Convention, of causing the revocation of the European patent" (Article 122(1) EPC). The patent proprietor may therefore file an application for re-establishment of rights following the removal of the cause of non-compliance with the time limit, even if the decision to revoke has not yet been delivered.

2.4 However, if the patent proprietor disagrees with the conclusion of the opposition division, and maintains that the time limits for the acts in question have been observed, it is entitled to have the decision reviewed

by an independent appeal authority. Such a review, carried out in accordance with the due processes of law, is provided for in Article 106 EPC.

- 2.5 The Enlarged Board also stated that the competent departments can deliver the requisite decisions in such a way so as to avoid fragmenting the proceedings. Depending on the particular circumstances, it may be necessary to consider the decision to revoke along with the decision on the application for re-establishment of rights. If the patent proprietor disputes the conclusion that the time limit has not been observed, and contests the revocation of its patent on those grounds and also applies for re-establishment of rights in the alternative, the Board of Appeal may then decide on both issues in one procedure (last sentence paragraph 14).

Consequently, in line with the reasoning in G 1/90 and by making use of the discretion provided by Article 111(1) EPC, the Board in the current case will decide on the request for re-establishment of rights filed while the appeal was pending (see also T 529/09 of 10 June 2010, which also concerns deciding on both issues).

The allowability of the request

3. Firstly, the date of removal of the cause of non-compliance must be established (Rule 136(1) EPC). The Board accepts that the appellant was made aware of the non-compliance with Rule 82(3) EPC when it was notified of the revocation of its patent for this reason, namely on 23 July 2015. It paid the surcharge and filed the request for re-establishment on 3 September 2015, ie

within two months of the removal of the cause of non compliance and in accordance with Rule 136(1) EPC.

4. As to the requirement of all due care required by Article 122 (1) EPC, it is clear from the explanation and evidence filed by the appellant that the first employee made a mistake by mentioning the wrong paragraph of Rule 82 in the heading of the accompanying letter to the EPO. This letter was in response to the communication from the EPO which referred to the correct paragraph. This may explain why, due to a lapse on concentration, the first employee confused the two paragraphs, and actually performed the formalities required by Rule 82(2) EPC, overlooking the surcharge additionally required by paragraph 3 of the same rule.
5. It appears also that the firm of attorneys representing the patent proprietor is equipped with a monitoring system which would normally detect this kind of mistake. Therefore the mistake by the second employee when comparing the communication from the EPO with the actions performed by the first employee may be ascribed to an isolated error of the second employee. Therefore the board accepts that the failure to spot the error occurred during the second checking may be ascribed to a personal and isolated error in a system which normally should prevent such deficiency.
6. It results from the above that the rights of the appellant in respect of the time limit given in Rule 82(3) EPC should be re-established with the consequence, pursuant to Article 122(3) EPC, that the decision to revoke the patent is deprived of its legal basis and must be set aside.

As the Board has granted the request for re-establishment of rights there was no need to arrange oral proceedings.

## Order

### For these reasons it is decided that:

- 1- The rights of the appellant with respect to the time limit given in Rule 82(3) EPC are re-established.
- 2- The decision under appeal is set aside.
- 3- The case is remitted to the opposition division with the order to maintain the patent in amended form according to decision T 0319/11 dated 24 October 2014 and dispatched on 12 November 2014.

The Registrar:

The Chairman:



C. Spira

G. Ashley

Decision electronically authenticated