

Internal distribution code:

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

**Datasheet for the decision
of 23 September 2024**

Case Number: T 1882/23 - 3.5.05

Application Number: 15784742.7

Publication Number: 3205139

IPC: H04W24/08

Language of the proceedings: EN

Title of invention:

Network testing for telecommunications

Applicant:

Truphone Limited

Headword:

Re-establishment of rights

Relevant legal provisions:

EPC Art. 122(1)
EPC R. 130(1), 136(1)

Keyword:

Re-establishment of rights - (no): request for
re-establishment of rights in respect of the time limit for
paying the renewal fee not filed within two months of the
removal of the cause of non-compliance

Decisions cited:

J 0027/90, J 0001/20, T 0942/12, T 0231/23

Catchword:

If the appointed professional representative receives a communication of loss of rights due to the non-payment of fees, the cause of non-compliance with the period is removed pursuant to Rule 136(1), first sentence, EPC on the date of that actual receipt. This is also true where, as in the present case, that representative had been instructed by their client that all renewal matters would be handled by others: such an instruction alone is not a reason for the cause of non-compliance to persist despite the appointed professional representative's actual awareness of the non-compliance.

See point 5 of the Reasons.



Beschwerdekammern
Boards of Appeal
Chambres de recours

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

Case Number: T 1882/23 - 3.5.05

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 23 September 2024

Appellant: Truphone Limited
(Patent Proprietor) 25 Canada Square
London E14 5LQ (GB)

Representative: Boulton Wade Tennant LLP
Salisbury Square House
8 Salisbury Square
London EC4Y 8AP (GB)

Decision under appeal: **Decision of the Examining Division posted on
15 June 2023 rejecting the request for
re-establishment of rights under Article 122 EPC
and declaring the European patent application
deemed to be withdrawn**

Composition of the Board:

Chair K. Bengi-Akyürek
Members: F. Bostedt
C. Almberg
J. Eraso Helguera
K. Peirs

Summary of Facts and Submissions

I. In the decision under appeal, the examining division rejected the applicant's request for re-establishment of rights in respect of the time limit for paying the renewal fee for the fourth year and the additional fee, and deemed the patent application to be withdrawn.

The examining division considered the request to be inadmissible because it had been filed late, and not allowable because the applicant had failed to observe all due care required by the circumstances.

II. The applicant (appellant) requests on appeal that the decision be set aside and that its request for re-establishment of rights in respect of the time limit for paying the renewal fee for the fourth year with surcharge be allowed.

III. To the present decision, the following facts are relevant.

(a) On 28 May 2019, the EPO issued a communication under Rule 112(1) EPC noting a loss of rights ("the communication of loss of rights").

(b) On 4 June 2019, the appellant's then professional representative received the communication of loss of rights (see statement of grounds of appeal, page 2, second paragraph of section "Removal of the cause of Non-Compliance").

(c) On 6 June 2019, the then professional representative, who had been instructed by the appellant that all renewal matters would be handled elsewhere, forwarded this communication to the appellant via email.

- (d) On 10 July 2019, the person employed by the appellant to manage its patent portfolio ("the IP person"), who had been on extended sick leave, saw the email from the professional representative and thus became aware of the notice of loss of rights.
- (e) On 10 September 2019, the appellant filed the request for re-establishment of rights.

Reasons for the Decision

1. The request for re-establishment of rights under Article 122(1) EPC was not filed within two months of the removal of the cause of non-compliance within the meaning of Rule 136(1), first sentence, EPC.
2. The removal of the cause of non-compliance is to be established on a purely factual basis. It occurs, as a rule, on the date on which the person responsible for the application vis-à-vis the EPO becomes aware of the fact that a time limit has not been observed. This awareness is typically the result of the actual receipt of a communication under Rule 112(1) EPC noting a loss of rights (see **T 231/23**, Reasons 3; **J 1/20**, Reasons 2). This has not been disputed by the appellant.
3. The appellant argued that, in the present case, the person responsible for the application vis-à-vis the EPO should be the "IP person". As a consequence, this person's awareness should be decisive, and not that of the professional representative. According to the appellant, the present circumstances illustrate the problems associated with a "hybrid" system, where the representative is not fully responsible for all actions relating to the application, but where other persons,

in this case the in-house IP person, are responsible for the patent portfolio and for managing the payment of renewal fees. In addition, the authorised firm of representatives was specifically told that they were not responsible for paying the renewal fees. Since the professional representative was not responsible for the payment, the representative's awareness was not decisive. Instead, the awareness of the person with actual responsibility for the specific task, in this case the payment of renewal fees, should be decisive. This was the IP person.

4. These arguments are not persuasive.

The question of who is responsible for which task within the appellant's sphere of responsibility cannot be decisive for the issue of determining the point in time when the cause of non-compliance with the period was removed. The removal of the cause of non-compliance is the starting point of the two-month time limit for filing a request for re-establishment of rights under Rule 136(1), first sentence, EPC. Legal certainty requires that the starting point can be clearly and objectively determined and it cannot depend on the circumstances of how the appellant has organised its tasks and representation, whether internally or with the help of external providers.

5. The present board therefore agrees with the current case law on this matter, which is as follows.

Where a professional representative is appointed, it is that representative who is the "person responsible for the application vis-à-vis the EPO" (cf. **J 1/20**, Reasons 2.2). The professional representative remains the person responsible for the application vis-à-vis

the EPO, and thus the person whose awareness is relevant for assessing when the cause of non-compliance with the period was removed, irrespective of whether a third party other than the representative is responsible for the payment of fees (see **J 27/90**, Reasons 2.3). As such, regardless of the contractual arrangements made by the appellant for the payment of fees, the appointed professional representative remains the EPO's single point of contact (**T 231/23**, Reasons 5). This principle is illustrated by Rule 130(1) EPC, according to which all notifications, including those relating to fees, must be addressed to the representative. Therefore, if the appointed professional representative receives a communication of loss of rights due to the non-payment of fees, the cause of non-compliance with the period is removed pursuant to Rule 136(1), first sentence, EPC on the date of that actual receipt. This is also true where, as in the present case, that representative had been instructed by their client that all renewal matters would be handled by others: such an instruction alone is not a reason for the cause of non-compliance to persist despite the appointed professional representative's actual awareness of the non-compliance (see **T 231/23**, Reasons 3, 5 and 8).

6. In the case in hand, it is therefore irrelevant whether, and on which date, the appellant's IP person received the notice of loss of rights.

7. In its written submission, the appellant also referred to **T 942/12**. In that decision, it was held that, where a European representative has been expressly instructed that they are not obliged to monitor the payment of renewal fees, the duty of due care does not require them to nevertheless do so, in particular because it

cannot be expected that the European representative will monitor the payment of renewal fees at their own expense and because the client may have had good reasons for giving such instructions, e.g. to avoid receiving reminders from different sources which would lead to additional work and expense.

However, this decision is not relevant to the question at hand. The above-mentioned findings in **T 942/12** concern solely the question of whether the representative exercised "all due care", i.e. the merits of the request for re-establishment of rights. That is not at issue here. The present case deals exclusively with the question of whose awareness was relevant for the removal of the cause of non-compliance. This question is independent of the question of whether all due care was taken.

8. In summary, the professional representative received the notice of loss of rights on 4 June 2019. The removal of the cause of non-compliance with the period thus occurred on that date.

The request for re-establishment of rights was filed on 10 September 2019 and, therefore, it was not filed within the two-month time limit laid down in Rule 136(1), first sentence, EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



B. Brückner

K. Bengi-Akyürek

Decision electronically authenticated