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**Datasheet for the decision  
of 8 November 2010**

**Case Number:** J 0015/10 - 3.1.01

**Application Number:** 03730269.2

**Publication Number:** 1562727

**IPC:** B27M 1/02

**Language of the proceedings:** EN

**Title of invention:**

A method to produce a decay resistant and weatherproof wooden product with qualities like hardwood

**Patentee:**

Kause, Jaakko

**Opponent:**

-

**Headword:**

Unsubstantiated request for re-establishment of rights  
(inadmissible)

**Relevant legal provisions:**

EPC Art. 122(1)  
EPC R. 136(2)  
RPBA Art. 15

**Relevant legal provisions (EPC 1973):**

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**Keyword:**

"Duly substantiated request for re-establishment of rights  
(no)"

**Decisions cited:**

J 0005/94, J 0018/98, J 0019/05, T 0585/05

**Catchword:**

As condition for the admissibility of a request for re-establishment of rights, a duly substantiated statement of grounds must be submitted within the time limit for filing the request.

A request for re-establishment of rights which relies on general statements only and contains no specific facts does not satisfy the requirement for a duly substantiated request under Rule 136(2), first sentence, EPC.



Case Number: J 0015/10 - 3.1.01

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.01  
of 8 November 2010

**Appellant:** Kause, Jaakko  
(Applicant) Kausentie 230  
27510 Eura (FI)

**Representative:** Nieminen, Taisto Tapani  
Patenttitoimisto T. Nieminen Oy  
Kehräsaari B  
33200 Tampere (FI)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 27 January 2010  
rejecting a request for re-establishment of  
rights.

**Composition of the Board:**

**Chairwoman:** B. Günzel  
**Members:** L. Bühler  
C. Heath

## Summary of Facts and Submissions

- I. The appeal is directed against the decision of the Examining Division dated 27 January 2010. This decision rejected the request of the applicant (hereafter "the appellant") for re-establishment of rights under Article 122 EPC in relation to the period for payment of the renewal fee for the sixth year in respect of Euro-PCT application No. 03730269.2 and stated that the application was deemed to be withdrawn with effect from 6 January 2009.
- II. The renewal fee for the sixth year fell due on 30 June 2008. On 4 August 2008, the Office sent the appellant a notice in the usual form drawing his attention to the fact that the renewal fee had not been paid and that payment of that fee, together with an additional fee, could still be validly effected within six months following the due date. However, the EPO received no payment by the expiry of that period. With a communication pursuant to Rule 112(1) EPC dated 6 February 2009, the EPO informed the appellant that, because the renewal fee for the sixth year and the additional fee had not been paid within the time limit according to Rule 51(2) EPC, the application was deemed to be withdrawn under Article 86(1) EPC.
- III. By letter received on 6 April 2009 the representative, on behalf of the appellant, filed a request for re-establishment of rights under Article 122 EPC. He paid the renewal fee for the sixth year, the additional fee and the fee for re-establishment of rights on the same date. In his request, the appellant stated that responsibility for payment of the renewal fees had been

- transferred to Diamond Wood International, a company that had the right to use the invention. The appellant further set forth that the fees in question had remained unpaid due to a misunderstanding on the part of the owner of the right.
- IV. With notification dated 14 May 2009, the formalities officer acting for the Examining Division informed the appellant that his submissions were not sufficient to assess the request for re-establishment of rights on the merits. He invited the appellant to explain in detail the situation at the time when the loss of rights occurred.
- V. In his response received on 14 July 2009, the appellant maintained that responsibility for payment of the renewal fees had been transferred to a Finnish company, Diamond Wood International, and to his representative. He argued that he had exercised all due care by delegating this responsibility to a representative and the party being entitled to use the invention. He contended that his representative had been responsible for advising Diamond Wood International on the due dates and amounts to be paid and that the representative had discharged his duty by sending a reminder for payment on 16 December 2008. A copy of this reminder (sent by e-mail) was submitted.
- VI. In a communication pursuant to Article 113(1) EPC dated 28 September 2009, the appellant was informed of the intention of the Examining Division to reject the request for re-establishment of rights. A single reminder two weeks before the final deadline for payment of the renewal and the additional fee was

considered to be insufficient to meet the required standard of care.

VII. In his response received on 7 December 2009, the appellant argued that his representative had had no reason to verify payment by Diamond Wood International at the end of December 2008, because the time limits for payment had been observed by Diamond Wood International in the previous years. Thus, this payment arrangement had worked well up to December 2008 when Diamond Wood International forgot to pay.

VIII. By decision of 27 January 2010, the Examining Division rejected the request for re-establishment of rights on the grounds that the appellant had failed to show that all due care had been taken to comply with the time limit for payment of the renewal fee for the sixth patent year. The Examining Division held that it was the responsibility of the applicant to monitor time limits as long as he had not chosen to delegate his responsibility to a representative. In case of a professional representative acting on behalf of the applicant, the request for re-establishment of rights was allowable only if both the applicant and his representative had exercised all due care in order to observe the time limit. In the present case, the representative had been responsible for ensuring payment of the renewal fees even if the applicant had requested a third party to pay these. A single reminder two weeks before the final deadline for payment was considered to be insufficient to meet the required standard of care.

IX. A notice of appeal against the decision was filed on 26 March 2010. The appeal fee was paid on the same day. The statement setting out the grounds of appeal was filed on 27 May 2010. The facts and arguments relied on in the statement of grounds of appeal can be summarised as follows:

- (a) The appellant had no duty to monitor the time limits for payment of fees. He had delegated his responsibility regarding the prosecution of the application in suit, including the payment of the renewal fees, to his representative and to Mr Kari Kause, the person responsible within Diamond Wood International, the company entitled to use the invention. Since 2005, renewal fees had been paid to the EPO by Mr Kari Kause. A written declaration of the appellant was filed in support of this assertion.
  
- (b) In June 2008, the appellant's representative contacted Mr Kari Kause regarding payment of the renewal fee for the sixth year for the application in suit. It was then decided that the renewal fee should be paid in December 2008. The representative sent a single reminder for payment by e-mail on 16 December 2008. A single reminder was regarded to be sufficient since this payment arrangement had worked well in the previous years. The reminder could thereafter be monitored on the computer of the person responsible for the payment.
  
- (c) Because Mr Kari Kause was not familiar with the strict time limits for payment, the fees had remained unpaid.

- X. With the summons to oral proceedings the board sent the appellant a communication under Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA, Supplement to OJ EPO 1/2010, p. 39 *et seq.*) setting out the provisional view of the board. In this communication the board observed that the request for re-establishment of rights appeared not to be admissible, since the submissions filed within the time limit for filing the request did not satisfy the requirement for substantiation under Rule 136(2), first sentence, EPC.
- XI. With fax of 5 November 2010 the appellant informed the board that he had decided not to attend or be represented at the oral proceedings. He maintained that the renewal fee had not been paid notwithstanding the instruction of the representative, and that the reasons for this omission were unknown (misunderstanding or forgetfulness).
- XII. Oral proceedings were held as scheduled on 8 November 2010 in the absence of the appellant. After deliberation, the Chairwomen announced the board's decision at the conclusion of the proceedings.

## **Reasons for the Decision**

1. *Non-attendance at oral proceedings*
- 1.1 In the present case, the board decided that it was appropriate to proceed by holding the oral proceedings as scheduled in the absence of the appellant



(cf. Rule 115(2) EPC), particularly in view of the fact that only in the afternoon of 5 November 2010 had the appellant notified the board of its intention not to attend the proceedings.

1.2 The appellant could reasonably have expected that during the oral proceedings the board would consider the objections raised in the communication annexed to the summons to oral proceedings (cf. point X above) which form the basis for the present decision. In deciding not to attend the proceedings, the appellant effectively chose not to avail himself of the opportunity to present his observations and counter-arguments orally, but instead to rely solely on his written case (cf. Article 15(3) RPBA).

1.3 In the present case, the board was in a position to announce a decision at the end of the oral proceedings as foreseen by Article 15(6) RPBA. The reasons on which this decision is based do not constitute a departure from previously raised grounds or evidence that would require the appellant to be given a further opportunity to comment.

2. *Admissibility of the appeal*

The appeal complies with the provisions of Articles 106 to 108 EPC. Therefore it is admissible.

3. *Admissibility of the request for re-establishment of rights*

3.1 Pursuant to Article 122(2) and Rule 136(2), first sentence, EPC, the request for re-establishment of

rights must state the grounds on which it is based and must set out the facts on which it relies. As a condition for the admissibility of the request, a statement of grounds which is sufficiently substantiated must be submitted within the time limit for filing the request for re-establishment of rights (J 19/05 of 24 November 2006, point 4 of the Reasons). If this requirement has been fulfilled, it is then admissible to supplement the facts on condition that the supplementary submissions do not extend beyond the framework of the previous submissions (J 5/94 of 28 September 1994, point 2.3 of the Reasons; J 19/05 of 24 November 2006, point 5 of the Reasons; T 585/08 of 20 October 2009, point 9 of the Reasons).

- 3.2 A request for re-establishment of rights complies with the requirement of Rule 136(2), first sentence, EPC if a conclusive case is made, setting out and substantiating the grounds and facts on which the request relies. Thereby it is ascertained that the factual basis for the requested decision is not altered after the expiry of the time limit for the request (cf. J 19/05 of 24 November 2006, points 4 and 5 of the Reasons; T 585/08 of 20 October 2009, point 9 of the Reasons). Therefore, the request for re-establishment of rights must set forth the precise cause of non-compliance with the time limit concerned (i.e. a fact or obstacle preventing the required action within the time limit), specify at what time and under which circumstances the cause occurred and was removed, and present the core facts making it possible to consider whether all due care required by the circumstances had been taken to comply with the time limit concerned

(cf. J 19/05 of 24 November 2006, point 4 of the Reasons).

3.3 In the request for re-establishment of rights dated 6 April 2009, the appellant merely stated that responsibility for payment of the renewal fees had been transferred to Diamond Wood International, who had the right to use the invention. The appellant further set forth that the omission (i.e. non-compliance with the time limit for payment of the renewal fee) was due to a "misunderstanding" on the part of Diamond Wood International.

3.4 Although the appellant invoked a misunderstanding as obstacle preventing payment of the renewal fee, he did not give any explanation as to of what kind the alleged misunderstanding was, nor when and under which circumstances it had occurred. Nor did he explain how the error led to the omission and why it should be considered excusable. Thus, the actual circumstances surrounding the misunderstanding that allegedly led to the omission were not addressed at all in the request for re-establishment of rights. Moreover, there were gaps in the submissions regarding the respective duties and responsibilities of the persons involved in the payment of the renewal fees.

3.5 The board cannot gather, from the submissions filed within the time limit for the request for re-establishment of rights, facts or grounds which could be considered as a conclusive explanation for the failure to observe the time limit for the payment of the renewal fee. The request relies on general statements only and contains no specific facts. Given

the *a priori* indefinite number of possible "misunderstandings" as reasons for non-observance of the time limit, as well as the total lack of any specific facts in the request, variable explanations are conceivable as to who had misunderstood what and when this had happened. Since the submissions filed within the time limit for filing the request for re-establishment of rights do not substantiate a set of circumstances allowing to determine whether any subsequent introduction of new grounds or facts in support of the request would make out a new factual case or would as such be a complement to the submissions filed within the time limit, the latter do not satisfy the requirement for substantiation under Rule 136(2), first sentence, EPC.

- 3.6 Neither the appellant's submissions dated 14 July 2009 nor his letter dated 7 December 2009 filed in response to the communications of the first instance (cf. points V and VII above) assist the appellant's case. A failure to submit, within the time limit for filing the request for re-establishment, a statement of grounds containing at least the core facts on which the request relies cannot be subsequently remedied by the addition of further facts, as the case law only allows the appellant to supplement, but not to alter, the facts set out in the submissions made within the time limit for filing the request for re-establishment. Facts submitted only with the statement of grounds of appeal are even less able to remedy a lack of substantiation of the initial request for re-establishment of rights (J 18/98 of 16 January 2004, point 4 and 7 of the Reasons).

3.7 But even if the appellant's letters dated 14 July 2009 and 7 December 2009 were to be taken into consideration, these submissions would not remedy, but on the contrary would confirm, the inadequate substantiation of the initial request for re-establishment. In his letter of 14 July 2009, i.e. more than three months after the filing of the request for re-establishment and well after the expiry of the period for requesting re-establishment of rights, the appellant submitted as a new element of fact that his representative had been responsible for giving renewal advice to Diamond Wood International. The appellant contended that the representative had discharged his duty by sending a reminder for payment on 16 December 2008. In response to the communication pursuant to Article 113(1) EPC dated 28 September 2009, the appellant introduced a further element of fact by arguing that his representative had had no reason to verify payment by Diamond Wood International at the end of December 2008, because the time limit for payment had been observed by Diamond Wood International in the previous years. On the other hand, the appellant no longer relied on a misunderstanding on the part of Diamond Wood International as the reason for non-observance of the time limit. The appellant did not advance any other fact or obstacle that had prevented the payment of the renewal fee by Diamond Wood International and could be regarded as pertinent for excusing the omission. Instead, he acknowledged in his letter of 7 December 2009 that "the payment of the renewal fee for the EP-application was forgotten by Diamond Wood International". The variation in the appellant's submissions and the resulting diversity of conceivable explanations for the omission show that the initial

request for re-establishment did neither set out or substantiate in sufficient detail the core facts making it possible to consider whether all due care required by the circumstances had been taken to comply with the time limit concerned.

- 3.8 In view of the above the board comes to the conclusion that the submissions filed by the appellant before the expiry of the period for requesting re-establishment of rights neither state grounds nor set out facts in support of such a request as required by Rule 136(2), first sentence, EPC. The request for re-establishment of rights is therefore inadmissible.

## **Order**

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

The appeal is dismissed.

The Registrar:

The Chairwoman:

C. Eickhoff

B. Günzel