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**Datasheet for the decision  
of 7 December 2012**

**Case Number:** J 0016/11 - 3.1.01

**Application Number:** 06737989.1

**Publication Number:** 1871509

**IPC:** B01D 53/08

**Language of the proceedings:** EN

**Title of invention:**  
Temperature swing adsorption system

**Applicant:**  
Knaebel, Kent S.

**Headword:**  
Restitutio in integrum

**Relevant legal provisions:**  
EPC Art. 122  
EPC R. 136

**Keyword:**  
-

**Decisions cited:**  
J 0003/93, J 0018/98, T 0257/07

**Catchword:**  
-



Case Number: J 0016/11 - 3.1.01

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.01  
of 7 December 2012

**Appellant:** Knaebel, Kent S.  
(Patent Proprietor) 8000 McKintrick Road  
Plain City, OH 43064 (US)

**Representative:** Lecomte, Didier  
Lecomte & Partners Sàrl  
P.O. Box 1623  
L-1016 Luxembourg (LU)

**Decision under appeal:** Decision of the Receiving Section of the  
European Patent Office posted 10 August 2011.

**Composition of the Board:**

**Chairman:** C. Vallet  
**Members:** T. Bokor  
D. T. Keeling

## **Summary of Facts and Submissions**

- I. The appeal lies from the decision of the Receiving Section dated 10 August 2011 refusing the request for re-establishment of rights filed by the applicant and relating to European patent application No 06 737 989.1 filed on 14 March 2006 as international application PCT/US 2006/008873 which entered the European phase on 23 October 2007.
- II. The renewal fee for the third year, due on 31 March 2008, was not paid.
- III. On 20 May 2008, the EPO sent to the then designated representative ( Mr. J.M. Schmitz of Dennemeyer and Associates) a letter by which it drew attention to Rule 51(2) EPC and Article 2 No. 5 of the Rules relating to Fees. By this communication the applicant was informed that the fee for the third year had not been paid by the due date, but could still be validly paid up to the last day of the sixth calendar month following the due date, provided that the surcharge was also paid. The renewal fee was not paid within the time limit.
- IV. On 6 November 2008 the EPO issued a notification to the applicant's representative stating that under Article 86(1) EPC the application was deemed to be withdrawn due to the non-payment of the third year renewal fee and the additional fee.
- V. On 19 December 2008, the EPO was informed that Mr. D. Lecomte of Lecomte and Partners had been

appointed as the new European representative, replacing Mr. Schmitz who had resigned.

VI. By a letter dated 8 January 2009, the representative filed a request for re-establishment of rights under Article 122 EPC and paid the corresponding fee. The renewal fee for the third year and the surcharge were also paid on the same day. The grounds for re-establishment can be summarised as follows:

- At the beginning of 2008 the applicant had no prospective licensee any more for European countries so that he did not consider paying the renewal fee for the third year.
- later on the applicant, then travelling for his business in India, found new perspectives for the invention and intended to pay the renewal fee with the surcharge on his return.
- instead of staying two weeks in India as originally planned, the applicant worked there for about four months. Back in his office on 20 September 2008, the applicant had to face a lot of tasks and for some unclear reasons he did not come across the notice of his American attorneys Mueller and Smith informing him about the possibility of late payment with a surcharge until 30 September 2008.
- the applicant was thus not aware of the imminence of the deadline which was missed.

- the European representative sent to the US agent (Mueller and Smith) several reminders relating to the deadline for payment of the renewal fee for the third year and relating to the possibility of late payment with surcharge.
- the former attorney of Mueller and Smith, who had meanwhile left the company, had marked the patent application abandoned and the staff member who took over the case did not see any reason to follow up the final deadline.
- the non-compliance with the time limit was noticed on 12 November 2008, when the notification of loss of right was received.

VII. On 10 August 2011, the Receiving Section issued the contested decision refusing the request for re-establishment of rights. The reasons for this decision are in essence the following:

- When an applicant is represented by a professional representative, the duty of care laid down by Article 122(1) EPC lies with the representative and with the applicant. The latter has the duty to take all due care required by the circumstances, among others to give the appropriate instructions to his representative in due time so that the time limit which he is aware of can be met.
- The Legal Board of Appeal ruled in decision J 03/93 that the duty to exercise all due care applies first and foremost to the applicant and then to the professional representative by virtue

of the delegation resulting from his appointment. Where the representative had acted correctly, this would not exempt his client from suffering the consequences of his own mistake, or even negligence.

- According to the representative's letter dated 8 January 2009, the applicant, when returning from India, overlooked the last reminder and did not consider instructing his US patent attorney.
  
- The applicant has not proven he had correctly instructed his patent attorney as to the payment of the renewal fees and taken all necessary measures in order to avoid a loss of rights.

VIII. Against this decision the applicant filed a notice of appeal on 19 October 2011 and paid the appeal fee on the same day.

IX. In the statement of grounds of appeal, filed on 7 December 2011, it was argued that the contested decision had not sufficiently taken into account all the relevant circumstances of the case, namely that

- (a) The third renewal fee was not paid because the firm Mueller and Smith knew that the applicant did not intend to maintain his application since no prospective licensee was available.
  
- (b) The applicant only discovered new perspectives for developing his invention during his stay in India and thus intended to renew the European patent application.

- (c) The firm Mueller and Smith informed the applicant by a letter of June 2008 of the possibility to pay the renewal fee for the third year with a surcharge until 30 September 2008.
- (d) But at that time the applicant was in India and his stay lasted unexpectedly about four months instead of two weeks as originally scheduled, he had to work there under very difficult conditions in general and especially without any usual communication means i.e. telephone, fax, internet. When he returned to his office in the United States on 20 September 2008 he was exhausted due to the hard working days he had in India and to the journey itself. Furthermore, he had to cope with a lot of mails and work in his office.
- (e) But most important is the fact that the applicant was not aware of the deadline for paying the renewal fee for the third year with a surcharge because in fact he did not receive any reminder from Mueller and Smith probably due to a crucial problem with the fax machine in his office (cf. declaration of Dr Knaebel in annex 1 of letter of 13 August 2009).

X. The Board sent a communication on 14 August 2012 and summoned the appellant to oral proceedings. In this communication the Board expressed the preliminary view that

- the reference point for examining the circumstances under which the applicant, and his

representatives, were expected to exercise all due care was 30 September 2008, i.e. the end of the time limit under R 51(2) EPC to pay the renewal fee with surcharge.

- the duty to exercise all due care applied first to the applicant and then by virtue of the delegation, to the professional representative. This duty applied also to a non-authorized representative such as an US attorney.
  
- it was undisputed that the applicant intended to abandon the application which is the reason why the renewal fee for the third year, due on 31 March 2008, had not been paid.
  
- the arguments put forward in order to explain the reasons why the renewal fee had not been paid during the grace period, namely the long business trip to India itself and the very limited communication means in that country needed to be further evidenced.
  
- the Board, supposing for the sake of the argument that this trip took place, expressed doubt as to the impossibility for the applicant to reach his U.S. representative from India in order to give him updated instructions. The Board also questioned why these instructions were not sent to the representative between 20 and 30 September 2008, although the applicant was back in his office in the USA at that time.



- XI. In his last submissions dated 7 November 2012, the appellant explained in a sworn statement that he never gave instructions to abandon the application. He also stated that he did not receive the letter dated 18 December 2007 from his U.S. agent designed to inform him that the renewal fee was due in March 2008, nor did he receive any further reminder. As a consequence, he was not aware of any due date related to the payment of the third renewal fee and thus had no updated instructions to transmit. The circumstances relating to his two stays in India which took place respectively in May- June 2007 and January- February 2008 were as previously described as regards communication means but of minor interest due to his ignorance of a "looming" deadline.
- XII. With a letter dated 3 December 2012, the Board was informed that neither the representative nor the applicant would attend oral proceedings on 7 December 2012. The requests to set aside the decision under appeal and to order the resumption of the grant procedure were maintained.
- XIII. The oral proceedings took place on 7 December 2012 in the absence of the appellant.

### **Reasons for the decision**

1. *Admissibility of the appeal*

The appeal, having been filed in accordance with the provisions of Art 106 to 108 and R.99 EPC, is admissible.

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

2.1 Under Rule 136(1) EPC the request for re-establishment of rights must be filed within two months of the removal of the cause of non-compliance, but at the latest within one year of the expiry of the unobserved time limit.

2.2 In the present case, in the absence of any evidence showing that the appellant or his representatives discovered earlier that the renewal fee had not been paid in due time, the date of the effective reception of the notification issued by the EPO on 6 November 2008, namely on 12 November 2008, stating that under Article 86(1) EPC the application was deemed to be withdrawn due to the non payment of the third year renewal fee and the additional fee, is to be regarded as the date of removal of the cause of non-compliance. The request for re-establishment of rights was filed on 8 January 2009, so that the request is admissible.

3. *Allowability of the request*

3.1 The decision under appeal considered that the reference point for examining the circumstances under which the applicant was expected to exercise all due care was the time limit of Rule 51(2) EPC, i.e. in the present case the final loss of rights that occurred when the renewal fee and the additional fee were not paid by 30 September 2008. The Board shares this view and will thus examine the case on this basis.

- 3.2 Under the provisions of Rule 136(2) EPC, first sentence, 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. This means in particular that the request must firstly define the factual context in which the mistake occurred and secondly adduce convincing evidence in support of the alleged cause of non-compliance.
- 3.3 The Boards of Appeal have consistently ruled that facts pleaded for the first time during the appeal proceedings should not in principle be taken into consideration (see J 18/98, point 4 of the reasons, T 0257/07, point 1.2 of the reasons).
- 3.4 In the present case, the board by its communication informed the appellant that the evidence currently on file did not seem convincing enough for the contested decision to be reversed and, exceptionally, gave the appellant an opportunity to improve its case at this late stage of the proceedings.
- 3.5 However, in its rejoinder the representative of the appellant, instead of filing evidence as suggested by the board, produced a "sworn statement" written by the appellant himself. In this the appellant gave a significantly different version of the facts as compared to what was the case so far and to a large extent in contradiction with the previously described circumstances.
- 3.6 In this new statement and the accompanying letter of the representative, the appellant abandoned the stance taken hitherto, namely that he instructed his US

attorney not to pursue the application because of a lack of commercial perspectives. He also stated - for the first time in the proceedings - that he did not receive from his US representative the reminder dated 18 December 2007 asking for instructions as to the payment of the renewal fee, nor any of the subsequent reminders, so that he had no reason at all to contact his US representative. The reasons for marking the file as abandoned by the US representative were attributed to a "possible misunderstanding", the details of which were not known. The appellant furthermore indicated different dates relating to his trips to India, namely May and June 2007 and from 14 January to 12 February 2008, but these details were now held to be irrelevant, given that the cause of the error was seen in the fact that the appellant was not informed of any of the deadlines.

3.7 The divergence that exists between the chain of events as explained in the grounds of appeal (and also in the request for re-establishment of rights) on the one hand and the version of the events as explained in the last submissions on the other hand is of such an extent that the board is not in a position to establish which version corresponds to the actual situation which led to the loss of the patent. This immediately raises the question whether the last submissions of the appellant are admissible at all, i.e. whether these facts and evidence are to be examined at all by the board (Article 114(2) EPC).

3.8 Given that the new submissions do not complement the already existing facts, but present a new situation, the board holds that these facts and evidence must be

disregarded pursuant to Article 114(2) EPC. These facts clearly do not fulfil the requirements of Rule 136(2) EPC, in that they were not presented in the request for re-establishment of rights. They are also inadmissible pursuant to Article 13(3) RPBA, given that they raise issues which the board cannot be reasonably expected to deal with, such as the questions of due care in the circumstances leading to the alleged misunderstanding between the appellant and his US agents, or the reminders lost between the appellant and his US agents. The board adds that quite apart from the mentioned specific legal provisions under the EPC, bringing completely new and contradicting facts at such a late stage of the proceedings clearly goes against the general duty of fairness and good faith in the proceedings - whether towards the court (here the board) or the other party -, such a general duty being a generally recognised principle of procedural law in the contracting States (Article 125 EPC).

- 3.9 First of all, the board notes that once the last sworn statement of the appellant and the accompanying explanations given in its letter of 7 November 2012 (see point XI above) are completely disregarded - given the scale of the contradictions it brings in the party's case - it does not improve the appellant's case. From this it follows that the doubts of the board remain, due to the lack of reliable evidence on file as explained in the communication of the board (see point X above). In this manner the board finds that it remains unproven that the appellant and his agents did take all due care as required by the circumstances. In particular, it remains unproven that the appellant was

indeed unable to contact his US agents in order to inform them of his intent to keep the patent.

3.10 Secondly, if the board were to admit formally in the proceedings the last submissions of the appellant, and would accept, for the benefit of the appellant, that all its submissions in fact relate to the same set circumstances, then it would again be bound to conclude that Article 122 EPC was not complied with. In the absence of any solid factual basis for the examination of the case, the board can only observe that far from filling the gaps in the account of the facts previously submitted, the last explanations given by the applicant have created a wide discrepancy between the successive versions of these facts so that it has become impossible to determine which (exceptional) circumstances the appellant and/or its representatives had to overcome in order to avoid the loss of rights. As a consequence, the Board is unable to determine whether the requirement of "**all** due care required by the circumstances" was met (emphasis by the Board), simply because the circumstances themselves remain unclear.

3.11 When the factual circumstances surrounding the failure to observe a time limit are not established as in the present case, the board cannot examine who, among the applicant and his representatives, bears the responsibility for the mistake or ascertain where the mistake originated from. In such a situation, it is obviously impossible to determine what the appropriate behaviour should have been in order to avoid the loss of rights. Therefore, the request for re-establishment of rights must fail even if the board were minded to

examine the last submission of the appellant on its merits.

- 3.12 Finally, for the sake of completeness and once more for the benefit of the appellant, if the board were to look away from the fact that the last submission amounts to a completely new case, and were minded to take into consideration **solely** the last version of the events given by the appellant in his sworn statement and the accompanying letter of the representative, the Board would not come to a different conclusion on the appeal. Briefly, according to this last version of events the appellant had no personal action to undertake but relied on his US patent attorney who bore the responsibility for paying the renewal fee together with the European patent attorney. The file contains evidence as to the fact that the European patent attorney sent the appropriate reminders regularly and on time. The question that arises at that point would be why the US patent attorney did not pay the fee in due time on behalf of his client or send him reminder(s), or why none of these reminders were received. This question cannot be answered with a minimum degree of certainty, essentially because it was not part of the debate in the greater part of the proceedings. These focused instead on the notion that it was the applicant who had decided to let the application lapse and changed his mind later, after he had found new business perspectives. Thus in the absence of any reliable and credible explanation, the board can only come to the conclusion that there is no apparent reason which could possibly excuse the non-observance of the time limit. Given the fact that the appellant did not attend the oral proceedings, these

questions could also not be answered during the oral proceedings.

3.13 Since the appellant has not convincingly shown that he took all due care required by the circumstances the application for re-establishment of rights was rightly rejected.

**Order**

**For these reasons it is decided that**

The appeal is dismissed.

The Registrar:

The Chairman:

C. Eickhoff

C. Vallet