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**Datasheet for the decision
of 12 July 2018**

Case Number: J 0016/17 - 3.1.01

Application Number: 12740277.4

Publication Number: 2750567

IPC: A47J43/28, A47G21/02

Language of the proceedings: EN

Title of invention:
DOUBLE SERRATED FORK

Applicant:
Elezi, Dashamir

Headword:

Relevant legal provisions:
EPC R. 103(1) (a), 113(1), 136(2)
EPC Art. 122, 111(1)
RPBA Art. 11

Keyword:

Incorrect form of decision under appeal - missing name of responsible employee
Re-establishment of rights - request admissible (no)
Remittal to the department of first instance - special reasons for not remitting the case

Decisions cited:

J 0007/82, J 0007/12, T 1093/05, T 2076/11

Catchword:

The requirement laid down in Rule 113(1) EPC, according to which decisions from the European Patent Office must be signed by and state the name of the employee responsible, is not just a mere formality but an essential procedural step in the decision-taking process. The name and the signature serve to identify the decision's authors and express that they unconditionally assume responsibility for its content. This requirement is aimed at preventing arbitrariness and abuse and ensuring that it can be verified that the competent body has taken the decision. It therefore constitutes an embodiment of the rule of law. As a consequence, a violation of the requirement pursuant to Rule 113(1) EPC amounts to a substantial procedural violation and renders the decision erroneous (Reasons, point 2.3).



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Case Number: J 0016/17 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 12 July 2018

Appellant: Elezi, Dashamir
(Applicant) Lagja Nr. 17 Str. Prokop Sorra
Nr. 984 Durres (AL)

Representative: Dodbiba, Eno
Str. Naim Frasheri, pa. 60/3
Shk. 1, P.60/3, Ap.16
Tirana (AL)

Decision under appeal: Decision of the examining division of the
European Patent Office posted on 28 July 2017
rejecting the request for re-establishment of
rights under Article 122(1) EPC in respect of
the period for payment of the renewal fee for
the fifth year with surcharge and declaring that
European patent application No. 12 740 277.4 is
deemed to be withdrawn

Composition of the Board:

Chairwoman C. Vallet
Members: G. Decker
P. Schmitz

Summary of Facts and Submissions

- I. The appellant (applicant) contests the decision of the examining division rejecting his request for re-establishment of rights and declaring that European patent application No. 12 740 277.4 is deemed to be withdrawn.

- II. In a communication of 3 August 2016 the examining division had informed the appellant that the renewal fee for the fifth year, falling due on 30 June 2016, had not been paid and reminded him that the unpaid fee and the additional fee could be paid up to the last day of the sixth calendar month following the due date. It also drew his attention to Article 86(1) EPC whereby an application is deemed withdrawn if the renewal fee and the additional fee are not paid in due time.

- III. The appellant's professional representative informed the European Patent Office (EPO) in a letter dated "*6th January 2016*" that the appellant had been unable to observe the time limit for the payment of the renewal fee "*due to very unexpected subjective reasons and personal unforeseen circumstances*". At the same time, re-establishment of rights under Article 122 EPC was requested. The EPO received said letter on 9 January 2017 as a pdf document attached to the professional representative's email enquiry with the EPO's Customer Services, asking for acknowledgement of receipt of a letter allegedly faxed on 8 January 2017.

- IV. In the absence of any payment, the examining division, in a communication of 27 January 2017, noted a loss of rights pursuant to Rule 112(1) EPC and informed the appellant that the European patent application was deemed to be withdrawn under Article 86(1) EPC since

the renewal fee for the fifth year and the additional fee had not been paid in due time.

- V. By fax dated "30th January 2016", received by the EPO on 31 January 2017, the professional representative again requested re-establishment of rights and explained that the appellant had been unable to pay the fees "*due to unexpected subjective reasons and personal unforeseen circumstances*". The fee for the request for re-establishment of rights was received by the EPO on 1 February 2017.
- VI. The payment of the renewal fee for the fifth year and the additional fee was made by bank transfer and entered the EPO's bank account on 15 March 2017.
- VII. In a communication pursuant to Article 113 EPC, the examining division informed the professional representative that it held the request for re-establishment of rights inadmissible. The reasons for the failure to observe the time limit had not been sufficiently explained and the omitted act had not been performed within a period of two months from the removal of the cause of non-compliance. The removal date was considered to be 9 January 2017 at the latest. However, the missing fees could have been considered paid in due time on condition that the requirements set out in Article 7(3) and (4) of the Rules relating to Fees were fulfilled. The appellant was therefore invited to provide suitable evidence from his bank and given the opportunity to file any further comments substantiating his statement of grounds within a period of two months.
- VIII. In response to this communication, the professional representative, in a letter dated 13 June 2017, further substantiated the reasons why the appellant was unable

to observe the time limit. He stated, *inter alia*, that the appellant had learned on 6 January 2017 that, although ordered properly and in time, payment of the due fees had erroneously not been effected by his bank. Moreover, he stated that the payment of the renewal fee for the fifth year plus surcharge had been "*finally effected on 15th March 2017*" and that the appellant had assumed that, as laid down in his national (Albanian) legislation, the relevant time limit would actually end on the last day of the month in which the payment fell due, i.e. on the last day of March 2017.

- IX. By decision of 28 July 2017, the appellant's request for re-establishment of rights under Article 122(1) EPC in respect of the period for payment of the renewal fee for the fifth year with surcharge was rejected. It was further established that the application was deemed to be withdrawn with effect from 3 January 2017 and that all fees paid after that date, with the exception of the fee for re-establishment of rights, would be refunded once the decision had become final.

In the decision's reasons, the request was considered to be inadmissible since the omitted act, i.e. the payment of the renewal fee for the fifth year plus surcharge, had been filed outside the period defined in Rule 136 EPC of two months from the removal of the cause of non-compliance. This period was deemed to have expired on 9 March 2017 at the latest: The date of the removal of the cause of non-compliance was assumed to be 9 January 2017 at the latest since the appellant had realised on 6 January 2017 (the date of his professional representative's first letter requesting re-establishment of rights) or on 9 January 2017 (the date when the professional representative contacted the EPO) at the latest that the time limit for paying the

renewal fee plus surcharge had been missed. Its payment, which entered the EPO's bank account on 15 March 2017, had been effected after expiry of the time limit under Rule 136 EPC and therefore too late.

At the bottom of the decision the seal of the EPO was placed and the words "Examining Division" were stated. However, neither in the header of the decision nor at the bottom was/were the name(s) of the employee(s) responsible stated. The decision was not signed either.

- X. On 11 September 2017 the appellant filed notice of appeal, together with the statement setting out the grounds of appeal. He paid the appeal fee on 6 October 2017.

- XI. In his statement of grounds of appeal, the appellant brought forward essentially the same arguments as already submitted with the letter dated 13 June 2017 (see point VIII above). The appellant requested *"reestablishment of the rights, allowing further annuities payment and this application to progress towards the grant"*. He did not request oral proceedings.

- XII. In a communication pursuant to Article 113 EPC, the board informed the appellant of its provisional opinion on the merits of the case and that it would interpret the appellant's requests in the sense that the decision under appeal was to be set aside, that the appellant was to be re-established in his rights in respect of the period for payment of the renewal fee for the fifth year with surcharge and that the case was to be remitted to the department of first instance for further prosecution.

XIII. In response to this communication, the appellant re-emphasised his modest financial resources and pointed out that the Japan Patent Office had already granted a patent on the basis of a corresponding patent application. Furthermore, he stressed the importance of an invention *per se*, concluding that failure to observe time limits for the payment of annual fees must not compromise the substance of the invention. If rights to a patent application were lost just by missing a term of payment by nine days, inventors with limited resources would be discouraged from applying for European patents.

Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rule 99 EPC and is therefore admissible.
2. *Form of the decision under appeal - Rule 113 EPC*
 - 2.1 Apart from the subject of re-establishment of his rights, the appellant did not invoke any further deficiencies in connection with the impugned decision. However, according to Article 114(1) EPC the EPO "*shall examine the facts of its own motion*" and "*shall not be restricted in this examination to the ... arguments provided by the parties and the relief sought*". Hence, the boards may verify *ex officio* whether or not procedural violations have occurred in first-instance proceedings, particularly when inalienable rights constituting an embodiment of the rule of law are concerned, as is the case here (see point 2.3 below).

2.2 According to Rule 113(1) EPC, "*[a]ny decisions, summonses, notices and communications from the European Patent Office shall be signed by, and state the name of, the employee responsible*". Two exceptions to this general rule are stipulated in Rule 113(2) EPC: Firstly, where the employee responsible produces a document referred to in paragraph 1 using a computer, a seal may replace the signature. Secondly, where the document is produced automatically by a computer, the employee's name may also be dispensed with.

2.3 It follows that for any of the above-mentioned documents that is drawn up individually, at least the name(s) of the person(s) who did so must be given. This requirement is not just a mere formality but an essential procedural step in the decision-taking process. The name and the signature serve to identify the decision's authors and express that they unconditionally assume responsibility for its content. The requirement laid down in Rule 113(1) EPC is aimed at preventing arbitrariness and abuse and ensuring that it can be verified that the competent body has taken the decision. It therefore constitutes an embodiment of the rule of law. As a consequence, a violation of the requirement pursuant to Rule 113(1) EPC amounts to a substantial procedural violation and renders the decision erroneous (see T 2076/11, Reasons 4 and 5; T 1093/05, OJ EPO 2008, 430, Reasons 6).

2.4 In the case at hand, the examining division's decision dated 28 July 2017 was obviously produced using a computer. However, since the decision was individually reasoned and therefore not produced automatically by a computer, the further exception under Rule 113(2) EPC did not apply and the name of the employee responsible could not be dispensed with. The impugned decision,

however, did not bear the name(s) of the employee(s) responsible.

2.5 It was not sufficient either that at the bottom of the decision it was at least stated that it stemmed from the "*Examining Division*": Rule 113(1) EPC expressly requires the name of "*the employee responsible*" and not of the "*department responsible*". Furthermore, stating only the department responsible would also not fulfil the purpose of the requirement to state the person's name, i.e. to identify the person responsible and at the same time to verify whether the person was also competent to take the decision. This becomes particularly apparent in the present case in which the competence to take the decision on requests under Article 122 and Rule 136 EPC was entrusted to formalities officers under Rule 11(3) EPC in conjunction with Article 1 No. 11 and Article 3 of the decision of the President of the EPO, OJ EPO 2014, A6. Indeed, in the present case it is unclear who took the decision under appeal, i.e. the examiners of the examining division or the formalities officer on behalf of the examining division.

2.6 As a result, since the name(s) of the employee(s) responsible for the decision under appeal were omitted, the decision did not comply with the requirements laid down in Rule 113 EPC, which is to be classed as a substantial procedural violation.

3. *Decision on the appeal - Articles 111 EPC and 11 RPBA*

3.1 Due to the substantial procedural violation that occurred, the appeal is allowable to the extent that the decision under appeal is to be set aside. For

reasons of clarity, the board will expressly order this legal consequence.

3.2 As the next step under Article 111(1), second sentence, EPC, the board may either exercise any power within the competence of the examining division or remit the case to it for further prosecution. According to Article 11 RPBA, a board is to remit the case if fundamental deficiencies, such as a substantial procedural violation, are apparent in the first-instance proceedings, unless special reasons present themselves for not doing so.

3.3 In the case at hand, the procedural violation has no effect on the substance of the decision, which was based only on the inadmissibility of the request for re-establishment of rights. Thus, remitting the case to the examining division would cause an unnecessary delay in the proceedings. The board therefore exercises its discretion under Articles 111(1) EPC and 11 RPBA such that it will decide itself on the merits of the appeal.

4. *Request for re-establishment of rights - Article 122, Rule 136 EPC*

4.1 Rule 136(1), first sentence, EPC stipulates that, for a request for re-establishment of rights under Article 122 EPC to be admissible, the request must be filed in writing within two months of the removal of the cause of non-compliance with the period. Moreover, according to Rule 136(2), second sentence, EPC the omitted act must be completed within the relevant period for filing the request.

4.2 The two-month time limit for said request begins with the "*removal of the cause of non-compliance with the*

period", which normally occurs on the date on which the person responsible for the application (the patent applicant or his professional representative) is made aware of the fact that a time limit has not been observed (see Case Law of the Boards of Appeal, 8th edition 2016, section III.E.4.1.1 a), and further references cited there). In the present case, the appellant's professional representative stated in his letter of 13 June 2017 that the appellant had learned on 6 January 2017 that, although ordered properly and in time, payment of the due fees had erroneously not been effected by his bank. Consequently, pursuant to Rule 131(2) and (4) EPC the two-month time limit started on 7 January 2017 and expired on 6 March 2017.

4.3 While the appellant's request for re-establishment of rights was filed in written form by letter faxed on 31 January 2017 and therefore in time and in due form, the payment of the renewal fee for the fifth year and the additional fee entered the EPO's bank account only on 15 March 2017. As stated by the professional representative in his letter dated 13 June 2017 and in the statement setting out the grounds of appeal, the bank order was effected by the appellant that same day. For this reason and also taking into consideration the provisions according to Article 7(3) and (4) of the Rules relating to Fees, the omitted act was made good only after expiry of the relevant time limit set out in Rule 136(2), second sentence, EPC.

4.4 In this respect, the appellant submitted that he had made an error of law in that he had paid the missing fees only on 15 March 2017 on the assumption, by analogy with the corresponding provisions for annuities in his national (Albanian) legislation, that the relevant time limit would actually end on the last day

of the month in which the payment fell due, i.e. on the last day of March 2017. This submission, however, does not alter the fact that the appellant failed to meet the relevant time limit. The appellant did not file a request for re-establishment into the two-month time limit of Rule 136(2), second sentence, EPC in conjunction with Rule 136(1), first sentence, EPC, which would anyway have been inadmissible pursuant to Article 122(4), first sentence, EPC in conjunction with Rule 136(3), second half-sentence, EPC. Moreover, it is established case law that ignorance or incorrect interpretation of a provision of the EPC cannot justify re-establishment of rights; this applies likewise to an unrepresented individual applicant (see Case Law of the Boards of Appeal, 8th edition 2016, section III.E.5.5.1 b), and further references cited there; J 7/12, Reasons 5).

- 4.5 The further arguments brought forward by the appellant are not convincing either. It is true that financial difficulties leading to failure to observe time limits for the payments of fees could constitute grounds for granting re-establishment of rights (see Case Law of the Boards of Appeal, 8th edition 2016, section III.E.4.2.2). The possibility of re-establishment of rights contributes to material justice and therefore aims at protecting an invention. However, in order for the EPO to take account of possible financial difficulties (and other reasons which lead to failure to observe time limits), the applicant must satisfy the formal requirements of Article 122 EPC. In the interest of legal certainty, the EPO's deciding bodies have no discretionary power to admit requests which do not comply with these formal requirements. Thus, failure to observe them inevitably leads to the inadmissibility of the request.

- 4.6 As a result, the appellant's request for re-establishment of rights was inadmissible due to the non-completion of the omitted act within the two-month time limit of Rule 136(1) EPC.
- 4.7 Consequently, the question whether the appellant met the substantive conditions under Article 122(1) EPC, in particular whether all due care required by the circumstances had been taken, does not have any bearing on the outcome of this decision.
5. *Reimbursement of the appeal fee - Rule 103(1)(a) EPC*
- 5.1 Under Rule 103(1)(a) EPC, the appeal fee is to be reimbursed if the appeal is allowable and if such reimbursement is equitable by reason of a substantial procedural violation. The boards may, even in the absence of a request to this effect (as is the case here), examine this issue *ex officio* pursuant to Article 114(1) EPC (see J 7/82, OJ EPO 1982, 391, Reasons 6).
- 5.2 According to the established case law (see Case Law of the Boards of Appeal, 8th edition 2016, section IV.E. 8.6.1), for the reimbursement of the appeal fee to be equitable the boards require a causal link between the substantial procedural violation and the filing of the appeal. When there is no such causal link, the reimbursement of the appeal fee is not equitable.
- 5.3 In the present case, the procedural deficiency in the first-instance proceedings ascertained above is not specifically related to the refusal of the appellant's request for re-establishment of rights. As a consequence, he would have had to file the appeal irrespective of whether or not the substantial

procedural violation had occurred. Hence, under the specific circumstances of the case at hand there is no justification for the reimbursement of the appeal fee.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The request for re-establishment of rights is rejected.
3. The application is deemed to be withdrawn with effect as of 3 January 2017.
4. All fees paid after this date, with the exception of the fee for re-establishment of rights and the appeal fee, are refunded.

The Registrar:

The Chairwoman:



C. Eickhoff

C. Vallet

Decision electronically authenticated