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**Datasheet for the decision  
of 18 June 2019**

**Case Number:** J 0006/18 - 3.1.01

**Application Number:** 13875211.8

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**IPC:** C07K14/00, C07K14/545,  
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**Language of the proceedings:** EN

**Title of invention:**  
IL-1BETA INHIBITOR COMPOSITION AND USE THEREOF

**Applicant:**  
R-Pharm International, LLC

**Headword:**

**Relevant legal provisions:**  
EPC Art. 122(1)  
EPC R. 112(1), 136(1)

**Keyword:**

Re-establishment of rights - time limit for filing request for re-establishment - two months of the removal of the cause of non-compliance - all due care (yes)

**Decisions cited:**

**Catchword:**



**Juristische Beschwerdekammer**  
**Legal Board of Appeal**  
**Chambre de recours juridique**

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Case Number: J 0006/18 - 3.1.01

**D E C I S I O N**  
**of the Legal Board of Appeal 3.1.01**  
**of 18 June 2019**

**Appellant:** R-Pharm International, LLC  
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**Representative:** HGF Limited  
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**Decision under appeal:** Decision of the Receiving Section of the  
European Patent Office posted on 26 January 2018  
rejecting the request for re-establishment of  
rights under Article 122 EPC and declaring that  
European patent application No. 13875211.8 is  
deemed to be withdrawn

**Composition of the Board:**

**Chairman** W. Sekretaruk  
**Members:** S. Fernández de Córdoba  
D. Rogers

## **Summary of Facts and Submissions**

- I. The appellant (who shall be referred to interchangeably as the "applicant" or "appellant" in what follows) contests the decision of the Receiving Section rejecting its request for re-establishment of rights and declaring that European patent application 13 875 211.8 is deemed to be withdrawn with effect as of 1 September 2016.
- II. In a communication dated 6 April 2016 the Receiving Section informed the applicant that the renewal fee for the fourth year, falling due on 29 February 2016, had not been paid and reminded it 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 It also drew its attention to Article 86(1) EPC whereby an application is deemed withdrawn if the renewal fee and the additional fee are not paid in due time.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. In the absence of any payment, the Receiving Section, in a communication of 28 September 2016, 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 fourth year and the additional fee had not been paid in due time.
- IV. The above mentioned communications were addressed to the professional representative indicated as representative for the European phase (hereinafter "European professional representative").
- V. On 1 June 2017, the European professional representative requested re-establishment of rights, paid the fourth renewal fee with surcharge and the fee

for re-establishment of rights. It submitted inter alia that the applicant had no responsibility for monitoring renewal fee deadlines or for instructing the European professional representatives to pay the renewal fees. This responsibility had been transferred completely to a US attorney, Dr Korkhin, a sole practitioner, working at SciTech Legal P.C. ("SciTech"). SciTech was thus responsible for instructing the European professional representative to pay renewal fees in respect of this application.

Further, the European professional representative stated that it sent numerous reminders to SciTech with respect to the payment of the fourth renewal fee. In July 2016, shortly before the final date for payment of the renewal fee with surcharge on 31 August 2016, Dr Korkhin at SciTech upgraded his computing system which ran the software used to monitor deadlines and renewal fee payments. It only emerged during evidence gathering for the present request for re-establishment that after this upgrade timely reminders failed to appear in the docket and Dr Korkhin was thus not notified by the system of the missed renewal fee with surcharge payment.

- VI. In a communication pursuant to Article 113 EPC dated 5 July 2017, the Receiving Section expressed its preliminary view that the request for re-establishment of rights was inadmissible and not allowable.
  
- VII. In response to this communication, the European professional representative, in a letter dated 6 September 2017, further substantiated the reasons for the admissibility and allowability of the request. It stated, inter alia, that the removal of the cause of non-compliance did not occur on 30 September 2016, i.e.

when the communication pursuant to Rule 112(1) EPC was received by SciTech. Contrary to the view of the Receiving Section, the removal of the cause of non-compliance occurred either on 1 April 2017 or on 4 April 2017: the applicant itself became aware that the application was deemed to be withdrawn on 1 April 2017 and contacted the European professional representative by email dated 4 April 2017. Only on receipt of this email did the European professional representative become aware that it was never the intention of the applicant to withdraw the application.

- VIII. After a second communication under Article 113 EPC and a further response letter dated 12 January 2018, the Receiving Section rejected the request for re-establishment of rights by decision of 26 January 2018.

In the decision's reasons, the request was considered to be inadmissible since the request had been filed outside the period defined in Rule 136(1) EPC of two months from the removal of the cause of non-compliance. The date of the removal was the date on which the responsible person became aware or should have become aware of the omission. The responsible person was the US attorney, Dr Korkhin of SciTech, since the applicant had transferred all responsibility for monitoring renewal fee deadlines, and for instructing payment of renewal fees to the US attorney. The communication noting the loss of rights was sent to him by the European professional representative via email to three different SciTech email addresses on 30 September 2016, this being the date of removal of the cause of non-compliance.

It had not been sufficiently explained how the system upgrade performed in July 2016 on the US attorney's computer system could have influenced the receipt of the email noting the loss of rights sent some months later to three different email addresses belonging to the US attorney. The applicant stated that problems with the server migration carried out by the US attorney affected his email-system. This prevented him from taking the necessary action. The Receiving Section did not find that these arguments demonstrated that all due care had been taken before and at the time of the occurrence. The Receiving Section accepted that an upgrade of a computer system could create a glitch in the functioning of the monitoring system. However, it considered that it had neither been demonstrated that a backup system existed, nor that other precautionary measures to mitigate the negative consequences of a server migration, where the server included such vital components for the well-functioning of the firm as the maintenance of the docketing database, the email-communication and the web services, had been taken. Thus, the Receiving Section deemed the cause of non-compliance as being removed on 30 September 2016.

Further, the request was unallowable since all due care of the US attorney had not been sufficiently demonstrated.

IX. The applicant filed a notice of appeal and paid the appeal fee. In the statement setting out the grounds of appeal the appellant provided additional information to the arguments already submitted in the previous proceedings and filed supporting evidence (declaration of the US attorney, previously filed; reminders from the European professional representative provided by the US attorney, previously filed; and a diagram of the

US attorney's email archive system provided by the US attorney). In particular, information relating to the server migration which included a backup system of all data was provided. It was also explained that since a single server was used for maintenance of the docketing database and email storage, both were migrated at the same time. Upon upgrading the server, the docketing database was restored as well, but it was erroneously no longer pointing to the new correct location. After restoring the correct location, some reminders somehow disappeared.

Furthermore, for some reason, some emails were moved to the Archive folder instead of the Inbox folder on the US attorney's PC.

In the statement setting out the grounds of appeal, it is further explained that, later on, the applicant decided to take over responsibility for international prosecution itself. As a consequence, it became aware that the application was deemed to be withdrawn on 1 April 2017. Accordingly, the appellant considers that it was only on 1 April 2017 that the removal of the cause for non-compliance occurred as this was the earliest date on which anyone who was aware of the intention to pay the renewal fee knew of the fact that it had not been paid. The US attorney did not know that there had been a loss of rights until contacted by the European professional representatives in May 2017.

The appellant requested that the decision under appeal be set aside, that it be re-established in its rights in respect of the period for payment of the renewal fee for the fourth year with surcharge, and that the case be remitted to the department of first instance for



further prosecution. Conditionally, it requested oral proceedings.

- X. In a communication issued together with a summons to oral proceedings, the Board informed the appellant of its provisional opinion on the case.
- XI. With letter dated 13 June 2019 the appellant provided further information relating to the server migration implemented by the US attorney.
- XII. Oral proceedings before the Board were held on 18 June 2019 at which the appellant essentially reiterated its earlier written submissions and further clarified some issues relating to the server migration and back up systems of the US attorney. In particular, Dr Korkhin explained that as well as updating the server software he had implemented a new RAID (Redundant Array of Independent Disks or Drives) for storage protection which was not internally integrated into the new server, but in a separate networked architecture, having a separate network address and its own power supply. The purpose of this was to build greater security into the IT system by having separate power supplies for the hard disks and the server. This placing of the hard disks into a network architecture had the unfortunate and unforeseen consequence that files of email data, when transferred over the network were divided into smaller packages and not delivered chronologically. This appeared to be the cause of the mis-direction of the emails.
- XIII. At the end of the oral proceedings the decision was announced.

## **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. *Admissibility of the request for re-establishment of rights*
  - 2.1 Rule 136(1), first sentence, EPC stipulates that the request for re-establishment of rights under Article 122(1) EPC must be filed in writing within two months of the removal of the cause of non-compliance with the period.
  - 2.2 The removal of the cause of non-compliance normally occurs on the date on which the person responsible for the application is made aware of the fact that a time limit has not been observed. The decisive factor in this is the time when the person responsible ought to have noticed the error if he had taken all due care (established case law, see Case Law of the Boards of Appeal, 8th edition 2016, section III.E.4.1.1 a)).

From the submissions on file, the US attorney, Dr Korkhin, sole practitioner at SciTech "took over all responsibility for ensuring that the application was maintained and processed to grant effectively. This responsibility included formal matters, such as monitoring and instructing on payment of renewal fees." (see letter dated 1 June 2017, page 2). Moreover, it is stated in the same letter that the applicant itself had no responsibility for monitoring renewal fee deadlines, or instructing the European professional representative payment of renewal fees in respect of this application.

Consequently, the Board concurs with the Receiving Section in considering the US attorney as being the person primarily responsible for the application in suit.

- 2.3 The further issue to be determined is the date of removal of the cause of non-compliance and whether, at that date, the person responsible for the application, i.e. the US attorney, ought to have noticed the omission of the payment if it had taken all due care.

The Receiving Section considered that the date when the communication under Rule 112(1) EPC, noting the loss of rights, was sent to the US attorney by the European professional representative via email to three recipients addresses of SciTech on 30 September 2016 was the date of removal of the cause of non-compliance.

In the statement of grounds of appeal and during oral proceedings, the appellant explained in detail why the US attorney could not have become aware of the noting of loss of rights communication already on 30 September 2016.

The appellant confirmed that the communication under Rule 112(1) EPC, which was sent to three different email addresses, was received by the US attorney's computer system on 30 September 2016. However, the different email addresses were configured to forward incoming messages into a single mailbox. As a result of the server migration which had occurred in July 2016, in combination with the implementation of the RAID network architecture, the incoming mail, including the reminders for the payment of the renewal fee and the loss of rights communication, was automatically redirected to the Archive folder instead of appearing

in the Inbox folder. Since no technical problems were noted after the upgrade and the system appeared to be functioning normally, the US attorney had no reason to believe that the upgraded computer system was not working satisfactorily.

Therefore, the US attorney could not become aware on 30 September 2016 that there had been a loss of rights in spite of taking all due care required by the circumstances.

In view of these circumstances, the Board considers that it cannot be assumed that the receipt of the communication under Rule 112(1) EPC by the US attorney's computer system and redirected to the Archived folder as a consequence of the server migration removed the cause of non-compliance.

2.4 The Board agrees with the appellant in considering 1 April 2017 as the earliest date on which any person responsible for the application who was aware of the intention to pay the renewal fee, could know that it had not been paid, this being the date of removal of the cause of non-compliance. At that time, the applicant decided to take over responsibility for the international prosecution of the application itself and, as a consequence, became aware that the application was deemed to be withdrawn on 1 April 2017.

2.5 The request for re-establishment of rights of 1 June 2017 has therefore been filed in the time limit of Rule 136(1) EPC. The omitted act was completed and the fee for re-establishment was paid on time. The request for re-establishment is admissible (Article 122(2) in connection with Rule 136(2) EPC).

3. *Allowability*

3.1 Under Article 122(1) EPC the applicant shall have its rights re-established if it shows that it missed the time limit despite taking all due care required by the circumstances. In the present case, the time limit missed was the payment of the 4th renewal fee with surcharge.

3.2 The appellant alleged that due to an isolated error in server migration, the US attorney did not instruct payment of the renewal fee in time. Because a single server was used for maintenance of the docketing database and for email communications, both were migrated at the same time. The server migration was made in July 2016, shortly before the final date for payment of the renewal fee with surcharge on 31 August 2016.

The server migration affected the docketing database and led reminders for the payment of the renewal fees not being generated by the in-house monitoring system Flex-trac after the computer upgrade in July 2016. Further, the email reminders sent by the European professional representative after the upgrade in July 2016 informing the US attorney that the final deadline for the payment of the fee was approaching moved into the Archive folder due to the server migration issue/ implementation of the RAID network architecture.

With the submission dated 13 June 2019 and during oral proceedings the cause of the error in the server migration has been explained, to the Board's satisfaction, as being a result of the implementation of a new RAID (Redundant Array of Independent Disks or Drives) for storage protection which was not internally integrated into the new server, but in a separate

networked architecture, having a separate network address. In particular, the appellant pointed out that the docketing database as well as the email archive have been transferred to this separate RAID array. The server pointed to the new RAID array via NFS (Network File System) links. An initial incorrect configuration of some NFS links affected data transfer into client software. Over time it also became apparent that technical issues as network lag times combined with substantial sizes of email archive affected timely access to these files on the new RAID array.

- 3.3 Consequently, a technical error occurred in server migration which affected both the docketing database and email communication. This can be considered as an isolated mistake in a system which apparently operated efficiently for several years.

The appellant sufficiently explained that, during seven years, and in order to ensure safe keeping of the files, the server had a redundant networking capability and a 3 hard disk drive linked into a redundant data storage. Additionally, all data had been backed up into a cloud storage Dropbox location. Since no networking failures, storage failures or other server failures were ever observed, the Board concludes that the appellant has shown that a satisfactory system was in place.

- 3.4 Since the US attorney worked as a sole practitioner in a small office where only a limited number of time limits had to be monitored (aprox. 300 - 400 US Patent- and Trademark files and 2 international files), there was in the Board's view no necessity for more redundancy in the system for monitoring time limits.

3.5 For all these reasons, the Board finds that the US attorney's systems which were allegedly in place demonstrate the taking of all due care required by the circumstances. In spite of all due care, the appellant was unable to observe the time limit for paying the 4th renewal fee with surcharge. The requirements of Article 122(1) EPC are thus met and the request for re-establishment of rights of 1 June 2017 is to be allowed.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The appellant is re-established in its rights.

The Registrar:

The Chairman:



C. Eickhoff

W. Sekretaruk

Decision electronically authenticated