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**Datasheet for the decision
of 28 June 2022**

Case Number: J 0008/21 - 3.1.01

Application Number: 18843883.2

Publication Number: 3665752

IPC: H01S5/042, H01S5/024

Language of the proceedings: EN

Title of invention:

DRIVER CIRCUITRY AND SYSTEMS FOR HIGH CURRENT LASER DIODE
ARRAYS

Applicant:

Lawrence Livermore National Security, LLC

Headword:

Restoration of Right of Priority; re-establishment of rights

Relevant legal provisions:

PCT 49ter.2
EPC Art. 122

Keyword:

Re-establishment of rights - (no) - independent cross-check
(no) - isolated mistake within a satisfactory system for
monitoring time limits (no) - principle of proportionality

Decisions cited:

T 0808/03, T 1149/11

Catchword:



Juristische Beschwerdekammer
Legal Board of Appeal
Chambre de recours juridique

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Case Number: J 0008/21 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 28 June 2022

Appellant: Lawrence Livermore National Security, LLC
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Decision under appeal: Decision of the Receiving Section of the
European Patent Office posted on 26 March 2021
refusing restoration of the right of priority
for European patent application EP18843883.2
with respect to US15/673,202 pursuant to
Rule 49ter.2 PCT

Composition of the Board:

Chairman W. Sekretaruk
Members: K. Kerber-Zubrzycka
N. Obrovski

Summary of Facts and Submissions

- I. The appeal is directed against the decision of the Receiving Section of 26 March 2021 to refuse restoration of the right of priority for European patent application EP18843883.2 with respect to US15/673,202.
- II. On 14 August 2018, the appellant filed international application PCT/US2018/046785 with the USPTO as the receiving Office, claiming priority of application US15/673,202 filed on 9 August 2017.
- III. By letter dated 28 September 2018, the appellant filed a request before the USPTO for restoration of the right of priority pursuant to Rule 26*bis*.3 PCT.
- IV. With a decision posted on 18 October 2018, the USPTO decided to restore the right of priority based on the finding that the criterion for restoration applied by it was satisfied, namely that the failure to file the international application within the priority period had been unintentional.
- V. By letter dated 7 February 2020, the appellant requested that the EPO confirm that it "accepts the validity of the priority claim on the basis of the request made by Perkins Coie on basis of the 'due-care' standard on September 28, 2018". As a precaution, the applicant requested a re-establishment of rights pursuant to Article 122 EPC for the priority claim.
- VI. In the decision under appeal dated 26 March 2021, the Receiving Section refused the request of 7 February 2020 for restoration of the right of priority pursuant

to Rule 49ter.2 PCT and stated that European patent application EP18843883.2 did not enjoy a right of priority with respect to US15/673,202.

- VII. By notice of appeal dated 4 June 2021, the appellant requested that the decision under appeal be set aside and that the right of priority for the European patent application be restored.
- VIII. In the statement setting out the grounds of appeal, filed on 3 August 2021, the appellant argued that the failure to file the international application within the priority period had occurred in spite of due care required by the circumstances having been taken in accordance with Rule 49ter.2(a)(i) PCT. The appellant submitted that it had provided instructions on 19 April 2018 to the attorneys at law firm Perkins Coie to file a PCT application in good time before the one-year deadline based on the earlier-filed patent application US15/673,202. The paralegal in charge of the application had been reminded by the docketing system again on the final day about the deadline for filing the PCT application and hence received an independent reminder from the system to avoid that the due date was overlooked or missing in the backup docket. The paralegal had made her first mistake by wrongly converting the client instructions into a "NO filing required". The due date was still docketed in the docketing system. To remove such a date from the system - so the appellant alleged - approval from a supervisor/attorney was required. Here, the paralegal had made her second mistake in not contacting a supervising attorney or the applicant. The deadline was removed from the docketing system, and no further patent application was filed before the one-year deadline.

- IX. The appellant further argued that a factual misassumption in the decision under item 2.13 as well as the reasoning under item 2.9 on the basis of T 808/03 had led to a negative decision by the Receiving Section. Based on the correct facts and taking into account that T 808/03 did not state that a second mistake could not be made by the same person, the restoration of the right of priority should be granted.
- X. The Board arranged for oral proceedings by a summons of 10 February 2022 and issued a communication under Article 15(1) RPBA as an annex.
- XI. By letter dated 11 May 2022, the appellant submitted further arguments.
- XII. Oral proceedings by videoconference via Zoom were held on 28 June 2022. The decision of the Board was announced at the end of the oral proceedings.

Reasons for the Decision

1. The appeal is admissible but unallowable.
2. Under Rule 49ter.2(a) PCT, where an international application claims the priority of an earlier application and has an international filing date later than the date on which the priority period expired but within the period of two months from that date, the designated Office will, on the request of the applicant in accordance with paragraph (b), restore the right of priority if the Office finds that a criterion applied by it ("criterion for restoration") is satisfied. In the case of the EPO, the failure to file the

international application within the priority period must have occurred in spite of due care required by the circumstances having been taken.

3. The EPO applies the "due care" criterion in the framework of Rule 49ter.2(a) PCT in accordance with EPO practice under Article 122 EPC. According to settled case law, due care is considered to have been taken if non-compliance with the time limit results either from exceptional circumstances or from an isolated mistake within a normally satisfactory monitoring system. The party requesting re-establishment of rights bears the burden of making the case and proving that the requirements are met (see Case Law of the Boards of Appeal, 9th edn. 2019, Chapter III.E.5.2).
4. The Board concurs with the decision under appeal that the failure to meet the one-year time limit for filing the PCT application is not the result of an isolated mistake within a normally satisfactory system. In particular, the described procedure for de-docketing deadlines does not fulfil the requirements of an independent cross-check in a large firm as required by the case law of the boards (see Case Law of the Boards of Appeal, 9th edn. 2019, Chapter III.E.5.4.4 a).
5. According to the letter dated 28 September 2018 from Perkins Coie, the internal procedural rules used in the law firm were as follows: "Each paralegal is responsible for tracking deadlines for their patent matters and requesting the docketing department to de-docket each deadline after the desired actions (if any) for responding to the deadline have been taken. A daily reminder is also sent from Perkins Coie's docketing department to each paralegal, reminding the paralegal of daily deadlines. As an additional cross check,

before de-docketing a docketed deadline, the procedures require that the paralegal assigned to a patent matter ensure that it is proper to de-docket a deadline. If unsure whether it is proper to de-docket a deadline, the paralegal should contact either the supervisory attorney(s) for the patent matter and/or the client (e.g., the Applicant) to obtain their approval to de-docket the deadline."

6. As pointed out by the Receiving Section, the described procedure does not amount to a cross-check independent of the person responsible for monitoring time limits because the paralegal decides whether a second person becomes involved or not. If the de-docketing of a deadline by the paralegal and the paralegal's subsequent decision not to contact a supervisor are wrong, the system does not ensure that a second person will notice this mistake at a point in time when it can still be corrected.
7. Furthermore, the Board is not persuaded by the appellant's argument in its letter dated 11 May 2022 that the wording of Perkins Coie's rules was crystal clear in requiring the confirmation of either the attorney or the applicant prior to an instruction to de-docket the deadline. The expressions "if unsure" and "should" leave a twofold margin of appreciation to the paralegal.
8. Incidentally, in the written proceedings, it was discussed whether the Receiving Section had correctly applied the relevant case law of the boards cited by the appellant in its statement of grounds. The appellant had argued that a chain of errors could well be qualified as an isolated mistake within a normally satisfactory system. While this issue is, for the

reasons given above, not decisive anyway, the Board notes that the requirement of an "isolated mistake" is not met if the person responsible for the application makes, as in this case, a second mistake when processing the application (see decisions T 808/03 and T 1149/11).

9. In the written proceedings, the appellant also argued that the one-year time limit had only been missed by five days. However, under Rule 49ter.2(a) PCT, the decisive question is whether due care has been taken. The time by which the time limit was missed has no impact on the assessment of due care.
10. During the oral proceedings, the appellant submitted further arguments which do not resolve the main point set out under item 6. above and therefore did not persuade the Board.
11. Firstly, the appellant argued that no system could fully safeguard against the mistakes of employees. This was confirmed by the fact that the EPO itself sometimes made mistakes when sending out communications, despite having the best computer software and highly professional employees.

This line of argument ("*tu quoque*") amounts to saying that missing a time limit should not be held against the appellant because the EPO itself makes mistakes as well. Two wrongs, however, do not make a right. Moreover, the issue at hand is the appellant's mistakes only, and these are neither explained nor justified by this line of argument. It therefore has no bearing on the finding that Perkins Coie's monitoring system did not provide for an independent cross-check by a second person.

12. Secondly, the appellant argued that the case law of the boards on "due care" had been developed decades ago and was too strict in that it did not reflect the technological and economic circumstances in which law firms organised themselves today. Since that case law had been developed, the volume of patent applications and renewal fees to be managed had multiplied, and office management had become computerised. Thus, it had become disproportionate to require parties or law firms to hire and assign additional employees for performing cross-checks. While IT solutions for performing cross-checks existed, neither the EPO nor the USPTO nor WIPO provided parties or representatives with any such software.

This line of argument is not convincing either. While technological circumstances have indeed changed, missing deadlines can have the same grave legal and economic consequences for clients as before. Hence, changes in technological circumstances eliminate neither the need to require nor the proportionality of requiring large law firms to provide for an independent cross-check by a second person. The Board also considers it feasible for large law firms to use IT when implementing such an independent cross-check, thus using the changes in technological circumstances to their advantage.

13. Thirdly, the appellant argued that the case law of the boards did not properly reflect the international character of the PCT system. Although the PCT system permitted patent offices to apply either the "unintentional" or the "due care" criterion, applicants from all over the world could not be expected to

anticipate how strictly the EPO applied the "due care" criterion, or to organise themselves accordingly.

The Board is not convinced by this line of argument either. As acknowledged by the appellant, the PCT system allows patent offices to apply one of two different criteria for the restoration of the right of priority. When different patent offices can apply different criteria, there can be different results. This is inherent to the PCT system. The criterion applied by the EPO is the "due care" criterion, which is stricter than the "unintentional" criterion. As to the allegation that the application of the "due care" criterion at the EPO is overly strict, the Board notes that the case law recognises the principle of proportionality, according to which the requirement of due care must not be interpreted in an excessive manner that unreasonably restricts access (Case Law of the Boards of Appeal, 9th edn. 2019, Chapter III.E.8). The Board further notes that the case law of the boards on the "due care" criterion is well established and predictable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



C. Eickhoff

W. Sekretaruk

Decision electronically authenticated