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**Datasheet for the decision
of 25 January 2022**

Case Number: J 0001/22 - 3.1.01

Application Number: XXXXXXXX.X

Publication Number:

IPC:

Language of the proceedings: EN

Title of invention:

-

Applicant:

N.N.

Headword:

Re-establishment into priority period

Relevant legal provisions:

EPC Art. 122(2)
EPC R. 136(1), 136(2)

Keyword:

Re-establishment of rights - priority period - request not duly substantiated

Decisions cited:

J 0015/10, T 0324/90, T 0667/92, T 0261/07

Catchword:



Juristische Beschwerdekammer
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Chambre de recours juridique

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Case Number: J 0001/22 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 25 January 2022

Appellant: N.N.
(Applicant)

Representative: N.N.

Decision under appeal: Decision of the Receiving Section of the European Patent Office dated 1 September 2021 rejecting the request for re-establishment of rights in respect of the priority period.

Composition of the Board:

Chairman W. Sekretaruk
Members: F. Bostedt
L. Basterreix

Summary of Facts and Submissions

- I. The appeal lies from the decision of the Receiving Section, dated 1 September 2021. This decision rejected the appellant's request for re-establishment of rights in respect of the priority period and stated that European patent application no. XXXXXXXX.X did not enjoy a right of priority with respect to US application no. YY/YYYYYY dated 1 July 2019.
- II. The relevant facts leading to the decision under appeal are as follows.
- (a) On 28 July 2020 the applicant (appellant) filed the patent application at issue, claiming priority from a US application dated 1 July 2019.
- (b) By letter dated 29 July 2020, the applicant filed a request for re-establishment of rights in respect of the priority period and paid the relevant fee. The applicant submitted that the deadline of 1 July 2020 had been missed due to an isolated human mistake having occurred in a well-functioning system managing the deadlines of the applicant's US associate (US law firm Oblon). The appellant added that "detailed grounds and facts, and evidences supporting this request will be submitted in few days".
- (c) On 25 September 2020, the applicant filed a further letter, confirming what it had submitted on 29 July 2020 and adding that the error was made by an experienced and well-trained clerk. It set out the corresponding facts, inter alia, who that clerk was, that she was highly reliable but had

accidentally omitted to create a record in the law firm's filing system in relation to filing a European patent application, and that the error was due to the fact that the US application from which priority was claimed had not been filed by the same firm but by another US law firm. Several pieces of evidence were proffered, including a declaration by the clerk.

- (d) In a communication pursuant to Article 113 EPC, dated 2 February 2021, the examining division informed the applicant that the request for re-establishment was deemed inadmissible because, although this request was filed on 29 July 2020, i.e. within time limit specified in Rule 136(1), second sentence, EPC, it did not include a reasoned statement. Such reasoned statement was only filed on 25 September 2020, i.e. outside the relevant time limit.

- (e) On 29 March 2021, the applicant replied to the communication of the examining division. It asserted that all relevant information had been submitted in its request for re-establishment by clearly identifying and describing the grounds for the request: the responsible person (the "who") was clearly identified as a clerk of the law firm Oblon, and the reason for non-observance of the deadline (the "why") was clearly quoted as an isolated human error. Therefore, the grounds were established on time and the evidence provided in September 2020 was admissible. In this context, the applicant also referred to several decisions of the Boards of Appeal.

(f) On 12 May 2021, the examining division issued a further communication pursuant to Article 113 EPC, informing the applicant that the request for re-establishment was still deemed inadmissible. It referred to the case law of the Boards of Appeal according to which, as a condition for the admissibility of a request for re-establishment of rights, a duly substantiated statement of grounds had to be submitted within the time limit for filing the request. A request for re-establishment of rights which relied on general statements only and contained no specific facts did not satisfy the requirement for a duly substantiated request under Rule 136(2), first sentence, EPC. The examining division concluded that the request filed on 29 July 2020 did not include a reasoned statement, and that it was too generic and not duly substantiated. The grounds were only filed on 25 September 2020, i.e. outside the period for requesting re-establishment of rights in respect of the priority period. The case law mentioned by the applicant was not relevant to the case in issue.

In its communication of 12 May 2021, the examining division invited the applicant to file further comments within two months from notification of that communication. However, the applicant did not file any further observations.

III. In its statement of 10 January 2022 setting out the grounds of appeal, the applicant (appellant) repeated what it had submitted in its letter of 29 March 2021. It also again referred to several decisions of the Boards of Appeal (T 324/90, T 667/92, T 261/07).

Reasons for the Decision

1. The appeal is admissible.

The law applicable to the re-establishment of rights relevant to the appeal

2. The request for re-establishment of rights must be rejected, if the requirements laid down in the Implementing Regulations are not fulfilled (see Article 122(2) EPC). Such requirements are set out in Rule 136 EPC:

According to Rule 136(1), second sentence, EPC, the request for re-establishment of rights under Article 122 EPC in respect of the period specified in Article 87(1) EPC must be filed within two months of expiry of that period.

According to Rule 136(2), first sentence, EPC, the request must state the grounds on which it is based and set out the facts on which it relies.

The appellant's line of arguments in the appeal proceedings

3. The appellant seeks to set aside the decision under appeal and submits on appeal one line of arguments that may be summarised as follows: the reason the priority had not been claimed in due time had already been stated in the request for re-establishment by clearly identifying and describing the grounds for the request. In particular, the responsible person (the "who") had been clearly identified as a clerk of a law firm and the reason for non-observance of the deadline (the "why") had been clearly quoted as an isolated human

error.

The Board's findings

4. It is uncontested that the appellant missed the period under Article 87(1) EPC when it filed the application in issue on 28 July 2020, that its letter of 29 July 2020 was filed within the two-month time limit set by Rule 136(1), second sentence, EPC, and that its letter of 25 September 2020 was filed outside this time limit.
5. According to the law, the request must not only state the grounds on which it is based but must also "set out the facts on which it relies", see Rule 136(2), first sentence, EPC.
6. The letter of 29 July 2020 contains only one paragraph which may be relied upon to fulfil this requirement; it reads: "The deadline of July 1st, 2020 has been missed due to an isolated human mistake having occurred in a well-functioning system managing the deadlines of our US associate, the firm Oblon which entrusted us with this case".
7. Therefore, the question before the Board is whether this paragraph is detailed enough to be considered as setting out the facts on which the request relies.
 - 7.1 First, contrary to what the appellant seems to submit on appeal, this paragraph does not identify the person responsible for the mistake, i.e. the clerk. Reference to the clerk was only made in the appellant's letter of 25 September 2020, not in its letter of 29 July 2020.

7.2 Second, and in any case, the allegation in this paragraph that the reason for missing the period was an "isolated human mistake having occurred in a well-functioning system managing the deadlines of our US associate, the firm Oblon" is a generic statement that does not contain any facts (apart from the name of the law firm involved). Indeed, this paragraph lacks any explanation as to, for example, the kind of isolated human mistake alleged, when and under which circumstances it had occurred, and how the system, which allegedly was "well-functioning", worked in practice. Nor were any facts presented that would allow an answer to the question of whether the persons involved had observed all due care required by the circumstances.

7.3 The Board concludes that the letter of 29 July 2020 does not fulfil the requirement of setting out the facts on which the request relies as set out under Rule 136(2), first sentence, EPC.

8. The Board also notes that the appellant did not argue in its appeal that the facts submitted with the letter of 25 September 2020 were to be considered as fulfilling the requirements of Rule 136(2), first sentence, EPC. Even if this argument had been raised on appeal, the Board would not have agreed for the following reasons.

8.1 It is clear from the law itself, at least in its English and French text, that evidence needs not be filed together with the request within the time limit of Rule 136(1) EPC. Rule 136(2), first sentence, EPC does not refer to evidence and, therefore, such evidence may be filed later, if necessary. This reading of the law, which also applies when taking into account

the German text, is confirmed by the case law of the Boards of Appeal (see, for example, T 324/90 of 13 March 1991 and the case law cited therein).

- 8.2 However, it is equally clear from the law that all relevant facts have to be filed with the request for re-establishment and thus within the time limit of Rule 136(1) EPC. The Board acknowledges that case law exists according to which it may be permissible to supplement the facts of the request in a later submission (not filed within the time limit of Rule 136(1) EPC), with the proviso that the supplementary submissions do not extend beyond the framework of the initial submissions. However, supplementing facts in such a way is subject to the condition that the request itself is sufficiently substantiated within what is required under Rule 136(2) EPC (see, for example, J 15/10, 8 November 2010, point 3.1 of the Reasons, and the decisions cited therein). As noted above, this condition is not fulfilled in the present case (see point 7 above).

Case law referred to by appellant

9. The appellant also referred to case law of the Boards of Appeal, namely decisions T 324/90, T 667/92 and T 261/07. The appellant did not set out in its appeal how the findings in these cases supported its line of argument. The Board does not see how these decisions can support the appellant's case.

In T 324/90 of 13 March 1991, the board answered the question of whether evidence had to be submitted within the two-month time limit for requesting re-establishment. There was, however, no question that the facts submitted with the request were in any way

insufficient.

In T 667/92 of 10 March 2004, the board was not concerned with a possible lack of facts submitted with the request for re-establishment; rather, the board decided the case on its merits, i.e. whether the facts provided satisfied the requirement of all due care.

In T 261/07 of 27 July 2007, the board considered it appropriate to allow the patent proprietor, after it had presented the facts relevant to its case, to adduce further clarifying evidence in support of its case. Again, this case is not concerned with a possible lack of facts presented in the request for re-establishment, but rather the subsequent submission of evidence.

10. For the foregoing reasons, the Board finds that the decision under appeal correctly rejected the request for re-establishment of rights in respect of the priority period.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Eickhoff

W. Sekretaruk

Decision electronically authenticated