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Aktenzeichen / Case Number / N° du recours : J 02/86, J 03/86 (Consolidated)

Anmeldenummer / Filing No / N° de la demande : a) 84 103 272.5

Veröffentlichungs-Nr. / Publication No / N° de la publication : b) 84 103 253.5

Bezeichnung der Erfindung: a) Conditional branch unit for microprogrammed  
Title of invention: data processor

Titre de l'invention : b) Alu and condition code control unit for data  
processor

Klassifikation / Classification / Classement : a) G 06F 9/26 b) G 06F 9/30

### ENTSCHEIDUNG / DECISION

vom / of / du

21 October 1986

Anmelder / Applicant / Demandeur :

Motorola, Inc.

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : "Isolated mistake - restitutio/Motorola"

EPÜ / EPC / CBE Article 122

Kennwort / Keyword / Mot clé : "Isolated mistake - restitutio"

### Leitsatz / Headnote / Sommaire

Article 122 EPC is intended to ensure that in appropriate cases the loss of substantive rights does not result from an isolated procedural mistake within a normally satisfactory system.



Case Number : J 02/86, J 03/86

**D E C I S I O N**  
of the Legal Board of Appeal  
of 21 October 1986

**Appellant :** Motorola, Inc.  
1303 East Algonquin Road  
Schaumburg, Illinois GO196  
US

**Representative :** Ibbotson, Harold  
Motorola Ltd  
Patent and Licensing Operations - Europe  
Jays Close  
Viabes Industrial Estate  
Basingstoke  
Hampshire RG22 4PD

**Decisions under appeal :** Decisions of the Receiving Section  
dated 16 July 1985

**Composition of the Board :**

**Chairman :** P. Ford  
**Member :** G. D. Paterson  
**Member :** E. Persson

### Summary of Facts and Submissions

- I. On 30 April 1980 the Appellant filed European patent application No. 80 301 418.2 at the European Patent Office, through the services of his professional representative, a partner in a firm of European patent attorneys who have an office in London. On 23 and 24 March 1984, respectively, the Appellant filed as divisional applications of the above parent application, European patent applications Nos. 84 103 253.5 and 84 103 272.5, through the same professional representative.
  
- II. The renewal fees for each of the two divisional applications in respect of their third and fourth years calculated from the date of filing of the parent application were already due pursuant to Article 86(1) EPC at the respective dates of filing of the divisional applications. On 23 and 24 July 1984, respectively, the four month periods for paying said renewal fees provided by Rule 37(3) EPC expired, and said renewal fees were not paid by then. By notices and a telex dated 3 September and 17 September 1984, respectively, the representative was informed by the Receiving Section that, pursuant to Article 86(2) EPC, said renewal fees could be validly paid within six months of the due dates, i.e. by 23 and 24 September 1984, respectively, provided that the additional fees (10% of the renewal fees) were paid at the same time.
  
- III. The renewal fees for the two divisional applications in respect of the fifth year became due on 30 April 1984, but had not been paid by the beginning of September 1984. The representative was also informed by notices from the European Patent Office dated 3 September and 17 September

1984 respectively, that these renewal fees could be validly paid within six months of the due date, i.e. by 30 September 1984, provided that the additional fees were paid at the same time.

- IV. The fifth year renewal fees were duly paid (by the representative) on 27 and 20 September respectively, together with the additional fees due pursuant to Article 86(2) EPC. However, no payment was made in respect of the third and fourth year renewal fees within the six month period provided for by Article 86(2) EPC. Payment of such third and fourth year fees, together with the additional fees, for both divisional applications was made on 27 September and 25 September 1984 respectively by telexed debit orders, i.e. 3 days and 1 day too late respectively.
- V. The Receiving Section informed the representative by letters dated 12 November and 6 November 1984 that the respective divisional applications were deemed to be withdrawn because the renewal fees in respect of the third and fourth years were not paid in due time, pursuant to Article 86(3) EPC. By a letter dated 19 November 1984 which was received by the EPO on 21 November 1984 the representative filed an application for re-establishment of rights under Article 122 EPC in respect of each divisional application. The fees for said applications were paid on 20 November 1984.
- VI. Said letter dated 19 November 1984 was signed personally by the representative, and stated grounds on which the application under Article 122 EPC was based, and set out facts relied upon, which are here summarized:

The failure to pay the fees in time was "because of the circumstances arising from the arrangements for the payment of maintenance fees" between the representative's office and the Appellant. The arrangement was that the representative was responsible for filing and prosecution of European applications, and the Appellant was responsible for payment of maintenance fees.

No action was therefore expected from the representative in respect of the various reminders sent by the EPO. However, on 19 September 1984 the representative did in fact instruct his office to pay the 5th year renewal fee in respect of one of the divisional applications, and also sent a telex to the European attorney of the U.K. subsidiary of the Applicant company in respect of the 3rd and 4th year renewal fees due by 24 September 1984 for the same divisional application.

Said European patent attorney had received no instructions to pay said renewal fees from the Appellant before he received the telex from the representative. He then attempted to pay the 3rd and 4th year renewal fees in respect of the one divisional application, but difficulties arose which caused the payment to be made one day late, on 25 September 1984. As a result the 3rd, 4th and 5th renewal fees for the other divisional application were also paid on 27 September 1984.

All due care was said to have been taken by the representative and by said European patent attorney, and it was said that the requirement for payment of the relevant renewal fees relatively soon after the filing of these divisional application "appears to have been overlooked" by the patent department of the Appellant in the USA.

VII. No further evidence was filed in support of the applications under Article 122 EPC. Decisions dated 16 July 1985 were issued by the Receiving Section in respect of each divisional application, in which it was held that the applications for re-establishment were admissible. The decisions also held that it was clear from the letter dated 19 November 1984 that the Appellant itself had been responsible for payment of the renewal fees in question, but that it was "unaware of the special rules for the payment of renewal fees for a European divisional application under Rule 37(3) EPC" and that a "mistake in the interpretation of the EPC" was no ground for re-establishment.

The decisions also considered the factual circumstances following receipt at the representative's office of the various reminders from the EPO in relation to the renewal fee payment, but held that the failure to pay in time would not have occurred "if the Appellant had acquainted itself thoroughly with the problems of the payment of renewal fees for European divisional applications."

For those reasons each decision held that "the due care required by the circumstances" could not be said to have been exercised; and confirmed that because the telexed debit orders making payment in respect of third and fourth year renewal fees together with the additional fees for each divisional application were not sent until after the expiry of the respective time limits, such renewal fees were not paid in due time, and each divisional application was therefore deemed to be withdrawn.

VIII. On 13 November 1985 the Appellant filed Notices of Appeal in respect of both divisional applications, and paid both appeal fees on the same day. On 22 November 1985 the Appellant filed an identical Statement of Grounds of

Appeal (dated 20 November 1985) for each case, signed by the European patent attorney at the U.K. subsidiary of the Appellant, and accompanied by evidence in the form of four Affidavits sworn respectively by (i) the Appellant's patent counsel, (ii) a patent attorney employed by the Appellant, (iii) the "patent coordinator" employed by the Appellant, (iv) the European patent attorney of the U.K. subsidiary referred to above.

It was submitted in the Statement of Grounds of Appeal, on the basis of the evidence that accompanied it, that although the decisions subject to appeal correctly held that the Appellant had assumed responsibility for the payment of the renewal fees in question, there had in fact been no error by the Appellant in the sense that it was unaware of the requirements of the EPC in this respect; it was said that the error by the Appellant had been a mistaken expectation on the part of its patent coordinator that the office of the U.K. representative would pay the required renewal fees in due time.

- IX. In a communication dated 13 March 1986, the rapporteur queried who had in fact been responsible for payment of the renewal fees in question, having regard to the wording used in the further evidence filed; and having regard to the requirement in Article 122(1) EPC that "all due care required by the circumstances" must be shown to have been taken, he asked for further clarifying information, especially as to the system which had been used by the Appellant to ensure that payment of the kind in question was duly made. Some further information was supplied in the first instance by a letter dated 16 May 1986 from the European patent attorney of the U.K. subsidiary.

- X. As appeals had been filed from two separate decisions but both appeals had been designated to be examined by one Board in a common composition, the Appellant was asked in the above-identified communication whether it consented to the two appeals being dealt with in consolidated proceedings. The Appellant consented to such consolidation in the letter dated 16 May 1986. Accordingly, pursuant to Article 9(2) of the Rules of Procedure of the Boards of Appeal, the Board proceeded to deal with both appeals in consolidated proceedings.
- XI. An oral hearing took place on 21 October 1986, at which said European patent attorney supplied further clarifying information. He stated essentially as follows:
- (i) at the time of filing the parent European patent application in this case, i.e. prior to June 1980, all European patent applications of the Appellant were filed and prosecuted by the office of the U.K. professional representative;
  - (ii) in November 1982 he himself took over the filing and prosecution of European patent applications from the UK office of the professional representative, with the result that from about the beginning of 1983 such U.K. office filed no further European applications on behalf of the Appellant, until the two divisional applications in the present case;
  - (iii) in May 1981 the Appellant instructed the U.K. professional representative not to pay renewal fees for its European applications, because from then on the Appellant would itself be responsible for such payments. (Copies of the relevant correspondence between the Appellant and the office of the U.K. representative were produced at the hearing and



admitted in evidence). From January 1983 such renewal fees were paid by the European patent attorney only after direct instructions from the patent coordinator of the Appellant;

- (iv) because the U.K. professional representative had been responsible for filing and prosecution of the parent application (filed in April 1980), in March 1984 the latter was instructed, as an exception to the then current practice of the Appellant, to file and prosecute the present two divisional applications.

Evidence in the form of an affidavit from a partner of the professional representative was filed one week before the oral hearing, but this evidence was not referred to at the hearing. It was accordingly not admitted.

#### Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC, and is therefore admissible.
2. In relation to the further evidence filed with the Grounds of Appeal and during the oral hearing, it is noted that, according to Article 122(3), "the application ... must set out the facts on which it relies". The admission of further evidence during the appeal stage is a matter of discretion under Article 114(2) EPC, and this discretion is normally only exercised so as to admit further evidence which clarifies the facts which were set out in the application for re-establishment. In the present case the Board considers the further evidence to be by way of clarification and therefore admissible. However, in the

absence of such evidence it is understandable that the decisions of the Receiving Section held that the requirements of Article 122(1) EPC had not been established.

3. Having regard to the circumstances set out in paragraph XI above, it is clear that, for a sensible reason, the Appellant arranged in 1984 that the filing and prosecution of these two divisional applications be handled by its U.K. professional representative as an exception to its normal procedure at that point in time. However, prior to June 1980, such handling by the U.K. professional representative had been the standard procedure. Furthermore, at that time payment of renewal fees had also been the responsibility of the office of the U.K. professional representative in respect of cases handled by it.

According to her evidence, the patent coordinator of the Appellant had been familiar with the procedure for handling European cases both before and after June 1980. Since about November 1981 she had been patent coordinator, and as such had been responsible for instructing payment of annuities as appropriate; and for more than two years before then she had been "back-up" to that position. In the case of European applications she instructed the European patent attorney of the U.K. subsidiary to make the actual payment of renewal fees to the European Patent Office.

In the present case, she received correspondence from the U.K. representative in April 1984, reporting the filing of the two divisional application. In accordance with the procedure which had operated previously when such representative had been responsible for filing all the Appellant's European applications, she (wrongly) expected the U.K. representative to be responsible for the renewal

fees which became due on filing these two divisional applications. This expectation was reinforced by the wording of the standard reporting letter which had been sent by the office of the U.K. representative, which indicated (wrongly) that that office would pay the annual renewal fees. However, as set out in paragraph XI (iii) above, from May 1981 the responsibility of the office of the U.K. representative in respect of payment of renewal fees had ceased, and as set out in her evidence, since about November 1981 the patent coordinator herself had been fully responsible inter alia for instructing payment of all European renewal fees.

Thus, as submitted by the Appellant, in the Board's view the failure by the patent coordinator to instruct payment of the renewal fees for the two divisional applications which were due in the present case constituted a mistake on her part.

4. The further evidence filed with the Grounds of Appeal is such as to satisfy the Board that the Appellant had arranged a proper system for the payment of renewal fees, and that the patent coordinator was a suitable person to carry out the responsibilities in respect of payment of renewal fees which had been given to her. Furthermore, the circumstances surrounding the filing of these two divisional applications were special: they were two cases being handled, exceptionally, by the UK representative long after the prosecution of all other European applications had been transferred to the European patent attorney employed by the UK subsidiary. In these special circumstances, the mistake made by the patent coordinator was understandable. The Board recognizes that Article 122 EPC is intended to ensure that in appropriate cases the loss of substantive rights does not result from an isolated procedural mistake within a normally

satisfactory system. Thus, in the Board's view, in spite of all due care required by the circumstances having been taken by the Appellant, the Appellant was unable to pay the third and fourth year renewal fees for these two divisional applications within the time limits required by the EPC (because of such special circumstances).

5. It follows that the Appellant shall have its rights restored in respect of the two divisional applications, pursuant to Article 122(1) EPC, and these applications are no longer deemed to be withdrawn.
  
6. As the appeal is allowed, it is necessary to consider whether the appeal fee should be reimbursed in accordance with Rule 67 EPC. In the Board's view there has been no substantial procedural violation in the present case, and in any event such reimbursement would not be equitable having regard to the fact that it was necessary to file further evidence at the appeal stage in order to clarify the facts which had been set out in the original application for re-establishment of rights.

#### Order

**For these reasons,**

**it is decided that:**

1. The Decision of the Receiving Section of the European Patent Office dated 16 July 1985 is set aside.

2. The Appellant is restored in its rights in relation to the payment of the third and fourth year renewal fees for European patent application Nos. 84 103 253.5 and 84 103 272.5 within the time limits required by the EPC.

*MAP*  
The Registrar

*Joel Ke*

The Chairman

*Peer Lind*

*Q*