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File Number: J 17/90 - 3.1.1  
Application No.: 85 903 592.5  
Publication No.: 0 188 544  
Title of invention: WINDER APPARATUS AND METHOD

Classification: B65H 59/38

**D E C I S I O N**  
of 16 December 1991

Applicant: White, Frances H.

Headword: restitutio/WHITE

EPC Articles 86(2), (3), 122

Keyword: "due care - (no)"

**Headnote**



Case Number : J 17/90 - 3.1.1

**D E C I S I O N**  
of the Legal Board of Appeal  
of 16 December 1991

**Appellant :** White, Frances H., White Eugene F.  
310 Macedonia Church Road  
Monroe  
North Carolina 28110 (US)

**Representative :** Warren, Keith Stanley  
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**Decision under appeal :** Decision of the Head of the Formalities Section  
of the European Patent Office dated 28.12.1989  
refusing a request for re-establishment into the  
time limit pursuant to Article 86(2) EPC.

**Composition of the Board :**

**Chairman :** O. Bossung  
**Members :** J.-C. De Preter  
M. Aúz Castro

## Summary of Facts and Submissions

I. The international application PCT/US 85/01259 was filed on 2 July 1985 in the name of US applicants. This application was given the European patent application number 85 903 592.5.

The renewal fee for the fourth year, which fell due on Monday, 1 August 1988, was not paid on time.

II. On 7 September 1988 a notice drawing attention to the fact that payment was not made by the due date, and to Article 86(2) EPC was sent by the Office to the professional representative in the United Kingdom.

III. Meanwhile, the professional representative, having been invited to file observations upon a communication dated 29 June 1988 with comments by the Examining Division, requested an extension of time by letters of 24 October and 28 December 1988, as he had not yet received instructions from his US associate. After having been granted a new extension of time on 11 January 1989, the same representative requested a further extension of time by letter of 28 February 1989, as he was still awaiting final instructions from his US associate. Moreover, as he wrote, he understood that, as a result of the unsatisfactory behaviour of one of the US associate's employees, the terms for replying to official letters, paying renewal fees, etc., had not been properly diaried in the past, and the necessary actions had not been taken. This situation had only just come to light. As for the renewal fee for the fourth year, it had been paid on 28 February 1989 under the maximum six months extension.

IV. This renewal fee was indeed paid on 28 February 1989 and with telecopy of 1 March 1989, confirmed by a letter of

the same day, the professional representative replied to the EPO communication of 29 June 1988.

- V. With communication of 29 March 1989 (after a first identical communication of 3 March 1989, which however was cancelled by letter of 16 March 1989) the professional representative was advised that the application was deemed to be withdrawn (Article 86(3) EPC).
- VI. With his letter of 2 May, received on 5 May 1989, the professional representative requested principally to state that the payment was made in time. Subsidiarily he referred to the reasons put forward in his letter of 28 February 1989; in addition he explained that the US associate had been under the impression that renewal fees on European applications could be paid up to the end of the month in which they fall due, i.e. until the end of February 1989.
- VII. In his communication of 9 June 1989 the Formalities Officer of the Examining Division referred to Legal Advice No. 5/80 concerning calculation of aggregate time limits to state that the six month period expired on 1 February 1989. As for the application for re-establishment of rights, he insisted to receive affidavits.
- VIII. Declarations of 7 August and 11 August 1989 of the US associate were sent to the Examining Division. No affidavit of the person who had been his assistant (Ms Hamilton) could be forwarded, as she had left his employment in May 1989 and could no more be located.
- IX. On 28 December 1989 the Formalities Officer of the Examining Division issued a Decision rejecting the application for re-establishment on the grounds of lack of all due care.

- X. On 23 February 1990 the Appellants filed notice of appeal against the said Decision. The appeal fee was duly paid; a statement of grounds was filed on 27 April 1990 and declarations of the US associate and of one of the appellants was submitted. The Appellants requested that the Decision under appeal be set aside, that the application be allowed to proceed as if the renewal fee in respect of the fourth year had been validly paid, and that an oral hearing be held in the event that the Board of Appeal considered that the application for re-establishment of rights should be refused.
- XI. On 21 October 1991 the professional representative issued a statement in response to the Board's communication of 9 September 1991 and let know that he would not be able to attend the oral proceedings scheduled to take place on 24 October 1991.

#### Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. When a renewal fee has not been paid on or before the due date, the fee may, according to Article 86(2) EPC, be validly paid within six months of the said date, provided that the additional fee is paid at the same time.

If the renewal fee and any additional fee have not been paid in due time the European patent application shall be deemed to be withdrawn (Article 86(3) EPC).

3. Whether the application can nevertheless be continued depends on whether re-establishment of rights in respect

of the time limit for paying the renewal fee together with the additional fee is allowed or not.

4. According to Article 122(1) EPC the applicant who, in spite of all due care required by the circumstances having been taken, was unable to observe a time limit vis-à-vis the European Patent Office shall, upon application, have his rights re-established.
5. The application for re-establishment complies with the formal requirement that it be filed within two months from the removal of the cause of non-compliance with the time limit.
6. Although the professional representative knew since 28 February 1989 that the official EPO letters had not been properly diaried by the US associate's assistant, it appears from his letter of the same date that he then thought that the fee had nevertheless been paid in time. Furthermore, the cause of non-compliance was not removed after the Office communication of 3 March 1989 since it was cancelled on 16 March 1989. Therefore, the said removal has only taken place after the communication of 29 March 1989 so that the application for re-establishment of rights is admissible.
7. Since the fee for re-establishment had been paid within the prescribed time limit, the application also complies with Article 122(3) EPC and is therefore admissible.
8. However, Article 122(1) EPC makes it a condition for re-establishment of rights that the person applying for re-establishment show that "all due care required by the circumstances" was taken.

In the appeal proceedings the Appellants only put forward the unsatisfactory behaviour of Ms Hamilton, the assistant of the US associate, as reason for the late payment.

According to his declaration, the US associate relied upon a computer service (CPAS) to handle payments of annual fees. That service provided printed lists of matters as to which payments were due and on instructions of his office transmitted such payments directly to the office involved.

In that respect it has to be stressed that, when the US associate received from the professional representative an EPO reminder of 11 September 1987, indicating that the third year's renewal fee had not been paid, the application did not appear in CPAS' schedules, so that the US associate instructed Ms Hamilton to investigate and rectify the apparent failure on CPAS' part (see the US associate's declaration of 23 April 1990). However, this was not done. Instead, after Ms Hamilton left her employment in May 1989, the US associate checked with CPAS, who informed him that the EP application was not on their records. Moreover, as appears from the professional representative's letter of 16 August 1989, he had written on 10 November 1988 to the US associate to remind him of the outstanding communication dated 29 June 1988 and had sent him a copy of the EPO notice of 7 September 1988 drawing attention to the non-payment of the fourth year's renewal fee. However, as stated by the US associate, that correspondence (and other correspondence of overseas' correspondents) had not been appropriately handled by Ms Hamilton, who withheld it from filing or improperly filed it without bringing it to his attention. Considering these different alleged errors of Ms Hamilton, the Board is of the opinion that by no doubt she was not a suitable and properly instructed person.

Nor can she be held as a properly supervised person. Indeed it had not even been checked if she duly rectified the omission of the application from CPAS's records in 1987. This lack of supervision results also from the fact that only late in February 1989 did the US associate realise that the EPO communication of 29 June 1988 and the EPO form of 7 September 1988 (and other letters received from overseas' correspondents) had not been appropriately handled.

9. Thus the reasons given by the US associate for the late payment of the renewal fee for the fourth year do not show that he had taken all due care required by the circumstances.

**Order**

**For these reasons, it is decided that:**

**The appeal is dismissed.**

**The Registrar:**

**The Chairman:**

**M. Beer**

**O.P. Bossung**