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**Datasheet for the decision
of 27 October 2017**

Case Number: T 1954/13 - 3.3.04

Application Number: 10163081.2

Publication Number: 2230256

IPC: C07K16/46, A61K39/21,
C07K16/10, C07K16/18

Language of the proceedings: EN

Title of invention:

Antibodies with simultaneous subsite specificities to protein
and lipid epitopes

Applicant:

The United States of America as represented by the
Secretary of the Army, Walter Reed Army Institute
Of Research (WRAIR)

Headword:

Re-establishment of rights

Relevant legal provisions:

EPC Art. 122(1), 108
EPC 1973 Art. 108
EPC R. 136, 101(1)

Keyword:

Re-establishment of rights - time limit for filing notice of appeal - due care on the part of the applicant - all due care (no)

Appeal deemed not filed

Reimbursement of appeal fee - (yes)

Decisions cited:

J 0002/78, J 0005/80, J 0021/80, J 0016/82, T 0105/85,
J 0024/87, J 0019/90, T 0489/93, T 1100/97, T 0445/98,
T 0778/00, T 0122/02, J 0019/04, T 0439/06, T 1026/06,
J 0001/07, J 0004/07, T 0585/08, T 1289/10, T 2210/10,
T 2274/11, J 0015/14, T 1325/15, T 2450/16

Catchword:

Re-establishment of rights into the period for filing the appeal



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Case Number: T 1954/13 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 27 October 2017

Appellant: The United States of America as represented by
(Applicant) the Secretary of the Army, Walter Reed Army
Institute
Of Research (WRAIR)
503 Robert Grant Ave.
Silber Spring MD 20910 (US)

Representative: Arends, William Gerrit
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 14 March 2013
refusing European patent application No.
10163081.2 pursuant to Article 97(2) EPC**

Composition of the Board:

Chair G. Alt
Members: M. Blasi
R. Morawetz

Summary of Facts and Submissions

- I. The appeal was lodged against the decision of the examining division, posted on 14 March 2013, refusing European patent application No. 10 163 081.2.
- II. On 24 July 2013, the applicant (appellant) filed notice of appeal and a statement of grounds of appeal, together with a request for re-establishment of rights. The appeal fee and the fee for re-establishment of rights were paid on the same date.
- III. The appellant requested re-establishment of rights in respect of the time limit for filing an appeal and that the contested decision be set aside and a patent be granted based on one of the sets of claims filed as main or auxiliary requests with the statement of grounds of appeal.
- IV. In a communication accompanying the summons to oral proceedings, the board informed the appellant of its preliminary opinion that the request for re-establishment of rights was admissible, but not allowable. The board further indicated that the oral proceedings would be restricted to the issue of re-establishment.
- V. In reply, the appellant informed the board that nobody would be attending the oral proceedings on behalf of the appellant. No further submissions in relation to the request for re-establishment were made.
- VI. At the end of the oral proceedings, which took place in the appellant's absence, the board's decision was announced.

VII. The appellant essentially presented the following arguments in support of the request for re-establishment of rights:

The failure to meet the two-month time limit for filing the appeal can be considered to fall into either of the two categories: being "due to exceptional circumstances" or constituting an "isolated mistake within a normally satisfactory monitoring system".

The person in charge at the appellant, Ms Arwine, is a patent attorney and manages over 500 cases. She uses the services of a US attorney, *inter alia*, to remind her of deadlines. The European representative receives Ms Arwine's instructions via the US attorney.

Due to the coincidence of a delay in funding by the US Government for the US Army (and therefore the appellant) and the timing of renewing the contract between the appellant and the US attorney, a "STOP WORK" order had to be issued by Ms Arwine on 9 September 2012. This coincidence was exceptional and beyond either party's control.

The STOP WORK order required that the level of communication between Ms Arwine and the US attorney be reduced to a minimum. Accordingly, the US attorney instructed the European representative to take no further action on this case.

The European representative continued to inform the US attorney about the progress of the examination proceedings and continued to send reminders involving deadlines, such as the summons to oral proceedings to be held before the examining division, the final date for making written submissions before the oral

proceedings and the refusal of the application. The latter was reported to the US attorney on 25 March 2013.

No reports were passed on by the US attorney to Ms Arwine about the fact that the application had proceeded to being refused. However, by an e-mail of 14 May 2013, sent by the US attorney despite the STOP WORK order, Ms Arwine was informed of the final deadline in this case, namely of the time limit for filing an appeal.

This e-mail had not been received by Ms Arwine because of IT issues that had occurred at the appellant.

If the STOP WORK order had not been in place, it is almost certain that the US attorney would have sent further reminders, as was their usual practice. The main form of communication between Ms Arwine and the US attorney was via e-mail. This form of communication had proved reliable for many years without any cause for confusion or miscommunication. The e-mail delivery failure was an isolated incident within a normally satisfactory system of communication.

Reasons for the Decision

Absence of the appellant at the oral proceedings

1. As announced in advance, the appellant, having been duly summoned, did not attend the oral proceedings. The board decided to continue the proceedings in accordance with Rule 115(2) EPC and to treat the

appellant as relying on its written case in accordance with Article 15(3) RPBA.

Request for re-establishment

2. According to Article 108 EPC, the notice of appeal has to be filed at the European Patent Office (EPO) within two months of notification of the decision. The notice of appeal is not deemed to have been filed until the fee for appeal has been paid.
3. In the present case, the decision under appeal was posted on 14 March 2013. In the absence of any evidence on file that the European professional representative had received the decision by the deemed notification date pursuant to Rule 126(2) EPC (24 March 2013), the board considers 25 March 2013, i.e. the date on which according to the appellant's submissions the European representative had informed the US attorney of the decision, as being the date of its notification. Accordingly, the two-month time limit pursuant to Article 108, first sentence, EPC expired on Monday, 27 May 2013 (Rule 131(1), (4) and Rule 134(1) EPC).
4. By that date, the notice of appeal had not been filed, nor had the appeal fee been paid. Rather, the filing of the notice of appeal and the payment of the appeal fee occurred outside the prescribed time limit, namely with the request for re-establishment of rights. Consequently, the appeal can only be considered as to the substance if the request for re-establishment of rights can be granted.

Admissibility of the request for re-establishment of rights

5. Re-establishment of rights is available to an applicant whose patent application has been refused and is not ruled out pursuant to Article 122(4) and Rule 136(3) EPC in respect of the time limit for filing the appeal under Article 108, first sentence, EPC.
6. Pursuant to Rule 136(1), first sentence, EPC, the request for re-establishment of rights must be filed in writing within two months of the removal of the cause of non-compliance with the period, but at the latest within one year of the unobserved time limit. The board notes that the date of removal of the cause of non-compliance cannot predate the expiry of the unobserved time limit. Therefore, a request for re-establishment of rights filed within two months from expiry of the unobserved time limit is filed in due time.
7. In the present case, the two-months time limit for filing the appeal expired on 27 May 2013 (see point 3 above). The request for re-establishment of rights received on 24 July 2013 was thus filed within two months from expiry of the unobserved time limit in accordance with Rule 136(1) EPC.
8. The further requirements under Rule 136(1) and (2) EPC are likewise fulfilled because a statement of grounds on which the request for re-establishment of rights was based and the facts relied upon was submitted, the fee for re-establishment was paid and the omitted acts, i.e. the filing of the notice of appeal and the payment of the appeal fee, were completed in due time.
9. Hence, the request for re-establishment of rights is admissible.

Allowability of the request for re-establishment of rights

10. Pursuant to Article 122(1) EPC, an applicant for a European patent 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 EPO will have his rights re-established upon request if the non-observance of this time limit has the direct consequence of causing the loss of any right or means of redress. Hence, the decisive question to be asked in the context of re-establishment of rights is not whether there was an intention to perform an act that was then inadvertently omitted, but whether all due care was taken in order to perform the omitted act.
11. In considering whether "all due care required by the circumstances" has been taken, the circumstances of each case must be considered as a whole. The requirement of "all due care" must be judged in view of the situation existing before the time limit expired. This means that any measures taken by the party to meet the time limit must be assessed according to the circumstances as they were at that time (see J 1/07, Reasons, point 4.1).
12. What "all due care" calls for depends on the specific circumstances of the case. In this respect, not only the individual circumstances of the person concerned have to be taken into consideration, but also, for example, the kind of time limit that needs to be observed and the legal consequences of missing it (see J 1/07, Reasons, point 4.6). For cases where the cause of non-compliance with a time limit involves some error in the carrying out of the party's intention to comply with the time limit, the case law has established that "all due care" is considered to have

been taken, in particular, if the non-compliance with the time limit results either from exceptional circumstances or from an isolated mistake within a normally satisfactory monitoring system (cf. Case Law of the Boards of Appeal, 8th edition, July 2016, III.E.5.2). Furthermore, in determining whether all due care has been taken, the board must look not only at the acts of the appellant, but also the acts of all the persons the appellant has asked to act on their behalf (see J 5/80, OJ EPO 1981, 343, Reasons, point 4). Where there are two representatives - a European representative and a non-European domestic representative - the duty of due care applies to both of them (see J 4/07, Reasons, point 3).

13. In the present case, the appellant, a US legal entity, used the services of a US attorney who passed on the appellant's instructions to the European representative. On the basis of the submissions and evidence on file, the board cannot establish that all due care required by the circumstances was taken by any of the three.

All due care on the part of the European representative

14. It is established case law that a representative whose authorisation is silent concerning the payment of fees and who has not received any funds for this purpose, cannot be expected to pay the fee by advancing money on behalf of the applicant out of his own pocket (see J 16/93, Reasons, point 4.3.3; J 19/04, Reasons, point 10). However, it is also established jurisprudence that the representative bears a secondary responsibility to advise the applicant properly if either the applicant addresses him or if he becomes aware of any problem that might affect the applicant's

position in respect of the legal status of an application. Appointed attorneys and representatives have the duty to protect the interests of their client (see also J 1/07, Reasons, point 4.4).

15. The board considers that, because the appellant used the services of a US attorney, the European representative was not obliged to contact the appellant direct. The board has not seen any indication in the file which should have prompted the European representative to conclude that the STOP WORK order terminated the representation by the US attorney.
16. It was submitted that reminders had been sent by the European representative to the US attorney and that the US attorney had given instructions not to proceed further.
17. In so doing, the European representative might have complied with his secondary responsibilities and thus taken all due care required by the circumstances. The board notes, however, that there is no evidence on file that supported these assertions, a circumstance to which the board had drawn the appellant's attention in the communication accompanying the summons and in respect of which no further submissions have been made.
18. On this basis, the board is unable to establish that the European representative has taken all due care.

All due care on the part of the US attorney

"STOP WORK" order

19. In the present case, Ms Arwine, the person in charge on behalf of the appellant, relied on a US attorney for

reminding her of deadlines. According to the appellant's own submissions, the STOP WORK order received by the US attorney from Ms Arwine did not specify that it was acceptable for the application to lapse as a result of the order. From the further submission that the STOP WORK order resulted in the level of communication between the US attorney and the appellant being "reduced to a minimum", the board derives that the STOP WORK order did not have the effect of an immediate complete cancellation of the representation. There is no evidence before the board of what the "minimum" level of communication or the scope of the STOP WORK order was.

20. In this context, the board observes that, on the one hand, even though information from the European representative on the progress of the examination proceedings before the EPO and reminders involving deadlines were received, the US attorney did not report to Ms Arwine from receipt of the STOP WORK order of 9 September 2012 until the asserted sending of the e-mail on 14 May 2013.
21. On the other hand, according to the appellant's submissions, the US attorney had sent the e-mail of 14 May 2013 despite the STOP WORK order still being in place and, in particular, in relation to a corresponding Canadian application, had forwarded an "Official Action" to the appellant on 30 April 2013, i.e. likewise at a point in time at which the STOP WORK order was in place.
22. Hence, in view of the latter incidents, the board cannot consider the STOP WORK order as an "exceptional circumstance" in the sense that it prevented the US attorney from forwarding the relevant information to

the appellant. Therefore, in the absence of submissions and evidence that the appellant had explicitly instructed the US attorney not to pass on any information about the status of this application to the appellant, the board cannot establish that, by remaining inactive with respect to the application in suit, albeit having received relevant information from the European representative, the US attorney complied with the requirement of "all due care".

23. In this context, the board notes that, if instructions had been given by the appellant to the effect that no information should be sent to it, this would be an additional aspect for a finding that the appellant itself had not acted with all due care required by the circumstances (see points 29 et seq. for all due care on the part of the appellant).

E-mail of 14 May 2013

24. From the appellant's submissions, the board derives that the e-mail assertedly sent by the US attorney on 14 May 2013 to inform the appellant about the final deadline for filing an appeal, was the sole information sent by the US attorney to the appellant after September 2012, i.e. after the STOP WORK order had been issued.
25. At the time of sending the e-mail, the US attorney and the European representative considered 24 May 2013 as being the last date of the time limit for filing an appeal in the present case. Hence, there were only a few days left for seeking the appellant's instructions and for reacting, if need be.

26. Against the background that the US attorney had not sent any relevant information to the appellant in relation to the application in suit since September 2012, the US attorney, in the board's view, had an increased responsibility to ensure that the information sent so shortly before the expiry of the crucial time limit was actually received by the appellant. The time limits for filing an appeal laid down in Article 108 EPC are indeed absolutely critical; if they are missed, the refusal of a patent application becomes final and no further ordinary legal remedy exists to recover the application. Accordingly, the time limit for filing an appeal needs specific attention (see also T 439/06, OJ EPO 2007, 491, Reasons, point 8).
27. As is generally known, e-mails might not reach their addressee due to, for example, technical reasons. Hence, the mere sending of a single e-mail without seeking confirmation of receipt or a follow-up enquiry does not, in the board's view, meet the standard of "all due care required by the circumstances" in a situation such as the present one, in which the e-mail of 14 May 2013 was the first and sole warning sent to the appellant concerning the forthcoming expiry of a crucial time limit (see also T 2274/11, Reasons, point 5; J 15/14, Reasons, point 3.2; J 19/04, Reasons, point 14 for letter post). Thus, the appellant's argument that the communication via e-mail between the US attorney and the appellant had proved reliable for many years is not relevant in this context.
28. Accordingly, even if it were assumed that the e-mail of 14 May 2013 had indeed been sent, for which there is no evidence on file, the board cannot conclude that all due care required by the circumstances had been taken

in relation to informing the appellant about the time limit for filing an appeal.

All due care on the part of the appellant

29. The board is also unable to conclude that the appellant itself had taken all due care required by the circumstances.
30. Ms Arwine, the person responsible for handling the case on behalf of the appellant, is a patent attorney managing over 500 cases. The board therefore considers that Ms Arwine or the appellant, respectively, was certainly familiar with the circumstance that for the prosecution of patent applications before patent offices, deadlines exist and regularly occur and have to be met in order to prevent a loss of rights.

"STOP WORK" order

31. As already noted above (see point 19), the scope of the STOP WORK order issued by Ms Arwine on 9 September 2012 has not been further specified in the appellant's submissions. Therefore, the extent to which the appellant could still rely on being informed of critical deadlines by the US attorney is unclear. Moreover, no proof with respect to issuing this order has been submitted.
32. From Ms Arwine's submission that the level of communication was reduced "to a minimum", it appears to the board that the appellant could not expect that the STOP WORK order would have no consequence at all, i.e. that work continued as usual. Yet, there is nothing on file which would suggest that measures had been taken

by the appellant in order to somehow compensate for the issuance of the STOP WORK order to the US attorney.

33. Furthermore, the board does not share the appellant's view that the STOP WORK order, which resulted from the coincidence of the delay in funding by the US Government for the US Army (and therefore the appellant) and the timing of renewing the contract between the appellant and the US attorney, represented "exceptional circumstances" that could lead to the conclusion that "all due care" on the part of the appellant had been taken.

34. In fact, the appellant is dependent on receiving funds from the US Government. In the board's view, it does not seem to be exceptional for a budget approval to take longer than expected and the risk of a delay in the allocation of funds is not of an unforeseeable nature. Actually, the granting of funds is a reiterative procedure occurring in cycles, and hence the risk may materialise each time the funding procedure re-starts. Thus, even if the allegations as to the existence and content of the STOP WORK order were proven, the board is not convinced of the exceptional character of these circumstances.

E-mail of 14 May 2013

35. Even if it were assumed that the e-mail of 14 May 2013 had been sent by the US attorney, the board cannot establish that the fact that the e-mail of 14 May 2013 had not been received by the appellant was due to an "isolated incident within a normally satisfactory system of communication" (see request for re-establishment, page 3, last full paragraph).

36. In this respect, it had been submitted by the appellant that *"we have had numerous computer communication issues and new security software imposed. Sometimes we do not receive e-mails or attachments have been stripped off of the e-mail because of the security measures. In addition, we migrated to another e-mail address system and that has caused some difficulty with receipt of messages"* (see request for re-establishment, page 3, 2nd para).
37. These submissions refer to various reasons (numerous computer communication issues, new security software, migration to a different e-mail address system) for the loss of information contained in e-mails that were sent to the appellant. It appears to the board that not all of these events had occurred at the same point in time and that no measures had been taken to prevent the loss of information being communicated by e-mail. No further details or evidence are provided by the appellant and, thus, nothing is on file that would support the appellant's submission.
38. In view of all of the above considerations, the board is not convinced that *"all due care required by the circumstances"* within the meaning of Article 122(1) EPC had been taken in meeting the deadline for filing the appeal. Thus, the request for re-establishment of rights in respect of the two-month time limit under Article 108, first sentence, EPC cannot be granted.

Appeal not deemed filed and refund of the appeal fee

39. In the present case, the notice of appeal and the appeal fee were received outside the two-month time limit pursuant to Article 108, first sentence, EPC, together with the request for re-establishment of

rights.

40. The board is aware of different approaches in the case law of the boards of appeal in situations where either or both the requirements of Article 108, first and second sentence, EPC (i.e. the filing of the notice of appeal and the payment of the appeal fee) have been fulfilled only after expiry of the two-month time limit: In a series of decisions the appeal was considered as deemed not filed and the appeal fee was reimbursed (for the cases that (1) the notice of appeal was filed in due time but (a) no appeal fee was paid - J 2/78 or (b) the appeal fee was paid late - J 24/87, J 16/82, T 105/85; (2) the appeal fee was paid in due time and the notice of appeal was filed late - J 19/90, T 445/98; (3) both, the notice of appeal and the appeal fee were late - J 21/80, OJ EPO 1981, 101, official text in French). In other series, the appeal was rejected as inadmissible in situations mentioned before, either (1) with an order to reimburse the appeal fee (see e.g. T 489/93) or (2) without such order (see e.g. T 122/02 for late appeal fee payment; T 1100/97 and T 2450/16 for late notice of appeal; T 1289/10 and T 2210/10 for both requirements fulfilled late).
41. This board comes to the conclusion that the order in the circumstances of the present case should be that the appeal is deemed not to have been filed and that the appeal fee is to be reimbursed.
42. Firstly, the appeal is deemed not filed in the present case because no notice of appeal had been filed within the two-month time limit, and the appeal fee had not been paid within that time limit either. The board's construction, that in order for the appeal to be deemed

filed not only the notice of appeal must be filed but also the appeal fee must be paid within the two-month time limit of Article 108, first sentence, EPC, is based on the consideration that sentences 1 and 2 of Article 108 EPC are to be read together (see also J 16/82, OJ EPO 1983, 262, Reasons, point 9; T 778/00, OJ EPO 2001, 554, Reasons, point 2.2). The link between the two sentences can be seen more clearly on the basis of the wording of the second sentence in its EPC 1973 version ("**The notice** shall not be deemed to have been filed **until after** the fee for appeal has been paid", emphasis added by the board), and there is no indication in the *travaux préparatoires* to the Act revising the EPC in 2000 that the legislator, except for moving formal requirements to the Implementing Regulations, intended to change Article 108 EPC in substance (see MR/2/00, Art. 108; MR/24/00, point 257). Accordingly, the board interprets Article 108, second sentence, EPC as meaning that payment of the appeal fee within the two-month time limit is a further precondition for an appeal being formed.

This is in line with the general concept of the EPC that a request is only deemed filed (e.g. requests for examination, re-establishment of rights, limitation/revocation, opposition or review) if payment is made in due time. Furthermore, the subsequent filing of the notice of appeal - here in the context of the (unsuccessful) request for re-establishment of rights - can, due to the expiry of the two-month time limit pursuant to Article 108, first sentence, EPC, no longer result in a valid forming of the appeal (see also T 1325/15, Reasons, point 41).

43. Secondly, the board considers that the finding that the appeal is deemed not to have been filed should lead to

a corresponding order. This is a long-standing practice of the boards (see case law cited in point 40), and the board sees no compelling reason for adopting a different approach. The legal basis for such an order can be seen in Article 108 EPC itself, from which the legal consequence is derivable.

In the board's opinion, Rule 101(1) EPC is not in conflict with this approach. This provision stipulates that if the appeal does not comply with Article 108 EPC, *inter alia*, the board must reject it as inadmissible unless any deficiency has been remedied before the relevant period under Article 108 EPC has expired. The board notes, firstly, that the provision refers to "the appeal" which, according to the board's construction, presupposes that an appeal has already come into existence and, secondly, that the explicit reference in Rule 101(1) EPC to Article 108 EPC is not completely redundant as there is scope of application, at least in relation to the statement of grounds of appeal, in case of an appeal having actually been formed.

44. Finally, because the request for re-establishment of rights is rejected and the appeal is deemed not to have been filed, the appeal fee has not fallen due pursuant to Article 4(1) RFees. Thus, the appeal fee was paid without a legal basis and must therefore be reimbursed (see also J 21/80, *supra*; T 1026/06, Reasons, point 6; T 585/08, Reasons, point 24).

Order

For these reasons it is decided that:

1. The request for re-establishment of rights in respect of the two-month time limit under Article 108, first sentence, EPC is rejected.
2. The appeal is deemed not to have been filed.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chair:



P. Cremona

G. Alt

Decision electronically authenticated