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**Datasheet for the decision
of 21 January 2020**

Case Number: T 1426/14 - 3.5.01

Application Number: 10732735.5

Publication Number: 2441035

IPC: G06Q10/00

Language of the proceedings: EN

Title of invention:

METHOD AND SYSTEM FOR GENERATING COLLABORATIVE CONTENT

Applicant:

Codigital Limited

Headword:

Re-establishment of rights/CODIGITAL

Relevant legal provisions:

EPC Art. 122

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

Keyword:

Re-establishment of rights - time limit for paying the renewal
fee - all due care (no)

Competence of the Board of Appeal to decide

Decisions cited:

J 0005/80, J 0003/93, J 0017/03, T 0936/90, T 0473/91,
T 0555/08, T 1201/10, T 1381/11, T 0649/13



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Case Number: T 1426/14 - 3.5.01

D E C I S I O N
of Technical Board of Appeal 3.5.01
of 21 January 2020

Appellant: Codigital Limited
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Representative: Gill Jennings & Every LLP
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 30 January 2014
refusing European patent application No.
10732735.5 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman W. Chandler
Members: P. Schmitz
W. Zubrzycki

Summary of Facts and Submissions

- I. The appeal is directed against the decision of the examining division posted on 30 January 2014 to refuse European patent application No. 10 732 735.5. Notice of appeal was filed on 18 March 2014 and the appeal fee was paid on the same day. The statement setting out the grounds of appeal was filed on 30 May 2014.

- II. The renewal fee for the 9th year fell due on 30 June 2018. Since this fee had not been paid, the Notice drawing attention to Rule 51(2) EPC was issued on 3 August 2018, informing the applicant that the renewal fee could still be paid together with an additional fee within six months following the due date. On 7 February 2019, a loss of rights communication under Rule 112(1) EPC was issued stating that the application was deemed to be withdrawn under Article 86(1) EPC because the renewal fee for the 9th year and the additional fee had not been paid.

- III. On 20 March 2019, the appellant requested re-establishment of rights. On the same day, he paid the fee for re-establishment and the renewal fee for the 9th year plus the additional fee.

- IV. The Board issued two communications setting out its preliminary opinion. In reply thereto, the appellant filed further explanations and evidence.

- V. The appellant's arguments which are supported by appropriate evidence can be summarised as follows:
 - (a) The normal procedure with regard to renewal fees in the representative's firm is that they provided details of European applications to CPA Global in

order for them to create renewal reminders to remind the applicant of the necessary due date. It is then the applicant's obligation to instruct CPA Global to pay the outstanding fee. However, in December 2017 CPA Global marked this case as lapsed on their records, so that no reminders were sent to the applicant in respect of the 9th year renewal fee. The reason for this was that, due to financial difficulties, CPA did not give the applicant any credit for the renewal fee for the 8th year and therefore the representatives, exceptionally, paid this fee and invoiced the applicant afterwards. At that stage, CPA Global should have been informed that they retained responsibility. The representative had instructed the record department to do so. The record department updated the internal electronic file system accordingly, from where the information should automatically have been submitted to CPA Global. For unknown reasons, however, this did not happen.

- (b) When a communication from the EPO concerning an overdue renewal fee was received by the representatives, the records department checked whether CPA Global was responsible and whether reminders had been sent to the applicant. In the present case, when the communication of 3 August 2018 was received, the records clerk checked the above-mentioned internal file system to see whether CPA Global was responsible but did not check in CPA Global's records whether reminders had been sent, as should have been done. Since the representative's system showed that CPA Global was responsible, the clerk marked this on the communication and forwarded it to the responsible attorney. The attorney, assuming that such checks had occurred, given the marking on the

communication, made that assumption when reporting it to Mr Hood, the managing director of the applicant, by email on 8 August 2018. In this email, the representative informed Mr Hood that the fee had not been paid in time and could still be paid until 31 December 2018 and asked the applicant about his intentions. In a reply of 3 October 2018, Mr Hood confirmed that he wanted to keep the application alive and would pay the fee.

- (c) However, due to a misunderstanding on the applicant's side, the fee was not paid. The applicant had received a renewal fee reminder dated 6 September 2018 from CPA Global concerning its US patent. On 17 October 2018, following a telephone conversation of the same day, Mr Hood again was reminded by CPA Global that the renewal fee for the US patent had to be paid by 21 October 2018. In an email of 18 October 2018, Mr Hood instructed CPA Global to pay. Mr Hood was under the assumption that this payment was in respect of the European patent application, because up to that point in time no renewal fees had had to be paid for the US patent. On 29 November 2018, CPA Global sent an account statement including only one item which was for the US patent. Mr Hood assumed that this statement showed all open items and that the one mentioned was for the European patent application.

- VI. On the appellant's request, oral proceedings took place on 21 January 2020, where the appellant presented detailed explanations. At the end of the oral proceedings the request for re-establishment of rights was refused.

Reasons for the Decision

Board's competence to decide

1. According to Rule 136(4) EPC the department competent to decide on the omitted act shall decide on the request for re-establishment of rights. The noting of loss of rights was issued by the formalities officer on behalf of the examining division. At that time, however, the appeal proceedings were pending. Thus the loss of rights resulting from the failure to pay the renewal fees occurred in the course of the appeal proceedings. Given that with the commencement of the appeal proceedings, the competence to decide on the case has moved from the department of first instance to the Boards of Appeal (T 473/91, OJ EPO 1993, 630, Reasons 1.2), the Board is competent to decide on the request for re-establishment of rights (T 555/08, Reasons 2; see also T 936/90, Reasons 1; T 1381/11, Reasons 2; T 649/13, Reasons 3 and T 1201/10, Reasons 1).

Admissibility of the request for re-establishment

2. The loss of rights communication was issued on 7 February 2019. On receipt of this communication, the representative learnt about the non-payment of the fee and on this date the cause of non-compliance was removed. The request for re-establishment of rights was filed on 20 March 2019 together with grounds on which this request was based and setting out the facts on which it relies. The fee for re-establishment was paid on the same day. The omitted act, i.e. payment of the renewal fee for the 9th year and the additional fee, was also completed on 20 March 2019. Thus, the

requirements of Rule 136 (1) and (2) EPC are fulfilled and the request is admissible.

Allowability of the request

3. According to Article 122(1) EPC, an applicant can have his rights re-established if he has sufficiently shown that in spite of all due care required by the circumstances having been taken, he was unable to observe the time limit. From this it is clear that in the first place it is the applicant who has to observe all due care (J 3/93 of 22 February 1994, point 2.1). If a professional representative is appointed the duty of all due care applies both to the applicant himself and to his professional representative (J 5/80, OJ EPO 1981, 343, point 4, J 17/03 of 18 June 2004, point 5). In considering whether all due care has been observed, the circumstances of each case must be looked at as a whole. The obligation to exercise all due care must be considered in the light of the situation as it stood before the time limit expired (Case Law of the Boards of Appeal, 9th edition 2019, III.E.5.2).

4. For cases where the non-compliance with a time limit involves some error in carrying out the party's intention to comply with the time limit, the case law has established the criterion that 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 system (see references in Case Law of the Boards of Appeal, 9th edition 2019, III.E.5.2).

Due care of the representative

5. On the representative's side two mistakes happened. Firstly, CPA Global was not informed that they again resumed responsibility and thus should send reminders to the applicant. Why this mistake happened is not quite clear because by updating the representative's internal electronic file system the information should have been transferred automatically to CPA Global. The second mistake was made when the communication of 3 August 2018 was received, by not checking in CPA Global's data base whether reminders had been sent to the applicant. This might be qualified as an isolated mistake of the record's clerk. There is no need to decide whether or not the representative's system in relation to CPA Global and setting up a reminder system was satisfactory because the purpose of the whole system, i.e. making the applicant aware of outstanding renewal fees, was achieved since the representative informed the applicant about it. Thus the overall system worked in the end.

6. There was no need for the representative to send further reminders because the applicant had clearly stated in his reply on 3 October 2018 that he would pay the fee. It is established jurisprudence that even if renewal fees are paid by someone else, the representative retains a secondary responsibility and he has to take the necessary steps to ensure payment if intended. This means that, in the first place, the representative has to ascertain the client's true wishes which might involve sending more than one reminder (Case Law of the Boards of Appeal, 9th edition 2019, III.E.5.5.2 b)). However, in the present case, the representative was informed about the applicant's intentions and he could be sure that the applicant was aware of the running time limit. Once the applicant had clearly indicated that he had taken note and that he

would pay, the representative had fulfilled his obligations and the responsibility shifted to the applicant.

Due care of the applicant

7. Apparently, the applicant company is owned and run by Mr Hood only and therefore it is to be considered as an individual applicant. It is established case law that the same standards of care as those required of a professional representative or a patent department of a large firm cannot be applied to an individual applicant. Nevertheless, he must himself take all possible steps to ensure that he can do, properly and punctually, whatever is required from him during the grant procedure to prevent any loss of rights. He is not entitled to leave anything undone which may reasonably be expected from him with a view to observing time limits (see references in Case Law of the Boards of Appeal, 9th edition 2019, III.E.5.5.1 b)).

8. In the present case, it was the applicant's duty to pay the renewal fees in due time. In this context he had appointed a professional representative and CPA Global to assist him and he could rely on getting necessary reminders which, unfortunately, he did not get from CPA Global as usual. But he was informed by his representative about the outstanding renewal fee and that payment had to be made by 31 December 2018. All due care of an applicant in such a situation requires that he carefully studies the letters he receives from his consultants and gives the required instructions in good time.

9. It is submitted that the applicant was confused because CPA Global had sent reminders with respect to the US patent and that he thought that his instructions to CPA Global to pay were in respect of the European patent application. However, the requests for instructions, both from the representative as well as from CPA Global were very clear. In the representative's email of 8 August 2018, clear reference was made to "European Patent Application No. 10732735.5" on top of this mail and the EPO's notice of 3 August 2018 informing the applicant about the non-payment of the renewal fee was attached. CPA Global's renewal fee notice of 6 September 2018, i.e. one month later, clearly referred to "U.S.A Patent number 8868489, Renewal date 21 April 2018". Apparently, Mr Hood did not react and therefore, CPA Global sent an email on 17 October 2018, following a telephone conversation of the same day, again referring to US patent number 8868489 and explaining that instructions needed to be sent to the US patent office at the latest on the following day. Mr Hood's reply on 18 October 2018 stated that "[t]his email is to confirm that I wish to renew US patent number 8868489. Please advise re payment". From this wording, as well as from the timely context, it is clear that Mr Hood wanted to pay the renewal fee for the US patent and not for the European patent application.
10. The applicant's mistake was that he thought that this payment was in respect of the fee mentioned in the representative's email of 8 August 2018 and that only one payment had to be made. This assumption was reinforced by the account statement sent by CPA Global on 29 November 2018 where only one outstanding fee was mentioned. In the applicant's view this qualified as exceptional circumstances which justified the re-

establishment of rights. The Board does not concur with this view because that mistake could have been avoided if the applicant had properly read the correspondence sent to him by his consultants, which is to be expected from a careful applicant taking part in business life. Upon receipt of the reminder from CPA Global in September 2018, he should have noticed that another application, as well as another due date was mentioned. All due care in this situation would have required that he get in touch with his representative and ask for clarification. At that stage, the applicant had all the necessary information at his disposal but did not follow it up correctly. There were no circumstances which were beyond his control.

11. Therefore all due care on the applicant's side cannot be acknowledged and the request for re-establishment of rights has to be refused. This means that the loss of rights communicated on 7 February 2019 has become final and the application is deemed to be withdrawn. Since the renewal fee for the 9th year and the additional fee were paid after the loss of rights occurred, they were paid without legal basis and therefore have to be reimbursed.

Order

For these reasons it is decided that:

1. The request for re-establishment of rights is refused.
2. The appeal proceedings are terminated.
3. The renewal fee for the 9th year plus the additional fee are to be reimbursed.

The Registrar:

The Chairman:



T. Buschek

W. Chandler

Decision electronically authenticated