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**Datasheet for the decision
of 8 March 2018**

Case Number: T 2120/14 - 3.3.01

Application Number: 05847652.4

Publication Number: 1846513

IPC: C09D5/00, C09D5/18

Language of the proceedings: EN

Title of invention:
INTUMESCENT COATING COMPOSITIONS

Applicant:
W. & J. Leigh & Co.

Headword:
Re-establishment of rights

Relevant legal provisions:
EPC Art. 122(1)

Keyword:
Re-establishment of rights - (no) - due care on the part of
the applicant (no)

Decisions cited:
J 0005/80, J 0016/93, J 0019/04, J 0001/07, J 0005/13,
R 0018/13

Catchword:



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Case Number: T 2120/14 - 3.3.01

D E C I S I O N
of Technical Board of Appeal 3.3.01
of 8 March 2018

Appellant: W. & J. Leigh & Co.
(Patent Proprietor) Tower Works,
Kestor Street
Bolton BL2 2AL (GB)

Representative: Wilson Gunn
Blackfriars House
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Manchester M3 2JA (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 22 April 2014
in the matter of European patent application
No. 05847652.4 rejecting the request for re-
establishment of rights in respect of the time
limit for payment of the renewal fee for the 5th
year with additional fee pursuant to
Article 122(2) EPC

Composition of the Board:

Chairman A. Lindner
Members: T. Sommerfeld
L. Bühler
G. Seufert
M. Blasi

Summary of Facts and Submissions

- I. The appeal lies from a decision of the examining division rejecting the applicant's request for re-establishment of rights in respect of the time limit for payment of the renewal fee for the fifth year with additional fee.
- II. In view of the applicant's request for oral proceedings, the examining division was enlarged by the addition of a legally qualified examiner (Article 18(2) EPC).
- III. The examining division found that the applicant's authorised representative had exercised all due care required by the circumstances by satisfactorily monitoring the relevant deadlines and by duly informing the applicant. However, the person responsible on the part of the applicant for giving instructions with respect to the payment of renewal fees and making advance payments had not taken all due care. He had failed to take appropriate measures in order to be able to respond, during a period of unusually heavy workload and extensive travel, to the representative's letters seeking instructions with respect to the payment of renewal fees.
- IV. On 23 June 2014, the applicant (appellant) filed notice of appeal and paid the appeal fee. On 19 August 2014, the appellant filed its statement of grounds of appeal.
- V. The appellant's submissions in support of its request for re-establishment of rights may be summarised as follows:

- (a) The payment of renewal fees was arranged as follows: The renewal department of the authorised representative monitored time limits for renewal fee payment. Reminders were sent to Mr A. Taylor, the appellant's head of science, requesting his instructions and advance payment before executing the payment of renewal fees.
- (b) The renewal fee for the fifth year for the present application fell due on 31 December 2009. The renewal department sent two reminders on 10 September 2009 and 19 November 2009. Since no instructions were received, a third reminder was sent on 19 January 2010. All the reminders for payment of the renewal fees were sent by post to Mr Taylor's business address. During the period over which the reminders were sent, Mr Taylor had to cover the then vacant position of Technical Manager, which entailed providing technical support off-site. Therefore, his travel schedule increased and he was often out of office. He did not instruct either someone at the office or the authorised representative to forward the renewal reminders by email, since he returned to his office between the short trips. In his absence, however, the reminders for the renewal fees were put on a pile of unsolicited "junk" mail by an unidentified person at the office. On his return, therefore, Mr Taylor did not take note of the reminders.
- (c) In a letter dated 10 June 2010, the authorised representative sought final instructions with respect to the impending grant of European patent application No. 05847654.0 (see case T 2106/14) and reminded Mr Taylor that the final date for payment of the renewal fees was 30 June 2010 for the

present application as well. This letter was sent by post only. It was put on the pile of unsolicited "junk" mail. Mr Taylor therefore did not take note of this reminder, and the time limit for payment with additional fee was missed. The omission was only discovered when the loss of rights communication was received.

- VI. On 11 September 2017, the board summoned to oral proceedings. In a communication accompanying the summons, it gave its preliminary opinion.

- VII. Oral proceedings were held on 8 March 2018 in the absence of the appellant, which had informed the board in a letter dated 5 March 2018 that it would not attend.

- VIII. The appellant requested that the decision under appeal be set aside and that the request for re-establishment of rights in respect of the time limit for payment of the renewal fee for the fifth year with additional fee be allowed.

Reasons for the Decision

1. The appeal is admissible.
2. Under Article 122(1) EPC, an applicant for a European patent who, in spite of all due care required by the circumstances having been taken, is unable to observe a time limit vis-à-vis the EPO, with the direct consequence of a loss of rights, will have his rights re-established upon request. The duty of due care under Article 122(1) EPC applies first and foremost to the applicant. If an applicant is represented by a professional representative, a request for re-establishment cannot be acceded to unless the representative himself can show that he has taken the due care required of an applicant or proprietor by Article 122(1) EPC (cf. J 5/80 of 7 July 1981, OJ EPO 1981, 343, Headnote I).
3. The extent of the representative's duties depends on the agreement between the representative and his client. An appointed representative whose authorisation is silent concerning the payment of renewal fees and who has not received any funds for this purpose is not expected to pay the fees by advancing money on behalf of the applicant out of his own pocket (J 16/93 of 20 June 1995, Reasons 4.3.3; J 19/04 of 14 July 2005, Reasons 10; J 1/07 of 25 July 2007, Reasons 4.4; J 5/13 of 17 January 2014, Reasons 3.3.2). Instead, he retains only a "secondary responsibility" (cf. J 1/07 of 25 July 2007, Reasons 4.4) to advise the applicant properly either if the applicant addresses him or if he becomes aware of any problem that might affect the applicant's position in respect of the patent application.

4. In the present case, it was agreed between the appellant and its authorised representative that the latter should monitor the time limits for renewal fee payment and that reminders should be sent to Mr A. Taylor, the appellant's head of science, requesting his instructions and advance payment before executing the payment of renewal fees.
5. The board concurs with the examining division's finding that the applicant's authorised representative had exercised all due care required by the circumstances by satisfactorily monitoring the relevant deadlines and by duly informing the applicant. The time limits for renewal fee payment were monitored by a separate renewal department of the authorised representative. Reminders (which were addressed to Mr Taylor and headed "renewal notice", "final renewal notice" and "important - overdue renewal fees") were sent on 10 September 2009, 19 November 2009 and 19 January 2010. Furthermore, in a letter dated 10 June 2010 the representative drew the appellant's attention to the final date for paying the renewal fees on 30 June 2010.
6. Also, the board finds no fault with the examining division's finding of lack of all due care on the part of the applicant's executive, who was required to give instructions with respect to the payment of renewal fees and to make advance payments.
7. In establishing whether all due care required by the circumstances with a view to meeting time limits in proceedings before the EPO has been taken by the persons engaged in those proceedings, it is necessary to assess how a competent person would reasonably have acted. The board does not dispute that there might be

good reasons for an applicant to organise the payment of renewal fees in such a way that payment ultimately depends, as in the present case, on approval by one of its executives, who relies on the monitoring of time limits and the sending of reminders by an authorised representative or by a payment service provider. However, the person responsible for approving the payment has to make the necessary arrangements for properly responding to requests for instructions expected of him with a view to observing time limits for the payment of renewal fees. In particular, he has the duty to ensure that correspondence seeking instructions with respect to the payment of renewal fees that is addressed to him and received at the correct address is actually brought to his attention. Should a situation arise requiring extensive business-related travel and involving a heavy workload over an extended period of time, a diligent and careful person can be expected to take precautionary measures in order to prevent prolonged interruptions in communication with the authorised representative and ultimately a loss of rights.

8. The appellant has not plausibly shown that Mr Taylor had taken appropriate measures, in view of his impending workload and travel, to ensure that he would not leave undone anything which was expected of him with a view to observing the time limit for payment of the renewal fees. On the contrary, the circumstances show that Mr Taylor took no precautions in order to avoid a loss of rights. From the fact that the reminders for payment of the renewal fees were sent by post and that Mr Taylor's mail was checked by an unknown person, it is clear that Mr Taylor had neither asked the authorised representative to send all correspondence by email nor given any instructions at

his office on how to proceed with letters from the authorised representative in his absence. Otherwise, reminders would not have been sent by post or would not have been considered unsolicited mail. Moreover, Mr Taylor did not check the pile of seemingly unsolicited mail during a period of nine months, or else he would have become aware of at least one of the four reminders. The circumstances were thus not exceptional in the sense that they would, on an objective basis, have prevented Mr Taylor from taking suitable precautions.

9. The appellant contends that Mr Taylor's failure to take precautions constitutes an isolated mistake. According to established case law following decision J 5/80 (OJ EPO 1981, 343), an isolated mistake by an assistant that happens in a normally satisfactory system is excusable. However, it is clear from the travaux préparatoires to Article 122 EPC relied on in decision J 5/80 that the possibility of excusing the negligence of an employee who normally carries out his work in a satisfactory manner was not intended to be extended to the applicant or its professional representative (R 18/13 of 17 March 2014, Reasons 21). Mr Taylor cannot be regarded as an assistant entrusted with routine tasks. As an executive of the appellant, he is acting on behalf of this legal entity. Indeed, there would be no person that could exercise reasonable supervision (*cura in custodiendo*) over Mr Taylor's work. Therefore, the same rigorous care as is demanded of an applicant can be expected of Mr Taylor in the accomplishment of the tasks entrusted to him.

10. In such circumstances as the present, where the observance of a time limit depends entirely on a single person who, in view of his impending extensive workload

and travel, does not take the necessary precautions to ensure that the time limit can be met in case he is prevented from giving timely instructions, the examining division's finding of lack of due care is justified.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. Schalow

A. Lindner

Decision electronically authenticated