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

Case Number: T 1444/15 - 3.2.02

Application Number: 09820881.2

Publication Number: 2348980

IPC: A61B5/05

Language of the proceedings: EN

Title of invention:

DYNAMIC BIPLANE ROENTGEN STEREOPHOTOGRAMMETRIC ANALYSIS

Applicant:

Papaioannou, George

Headword:

Re-establishment of rights

Relevant legal provisions:

EPC Art. 122(1)

Keyword:

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

Decisions cited:

J 0005/80, J 0016/93, J 0005/94, J 0011/03, J 0019/04,
J 0001/07, J 0005/13, R 0018/13, T 0166/87, T 1355/09

Catchword:



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Case Number: T 1444/15 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 8 June 2018

Appellant: Papaioannou, George
(Applicant) 925 W. Montclair Avenue
Glendale, WI 53217 (US)

Representative: Grünecker Patent- und Rechtsanwälte
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 26 February
2015 refusing European patent application No.
09820881.2 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman E. Dufrasne
Members: S. Böttcher
D. Ceccarelli
M. Stern
L. Bühler

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 fourth year with additional fee.
- II. The renewal fee for the fourth year for the present application fell due on 31 October 2012 and payment of that fee, together with a surcharge, could still have been validly effected within the subsequent six-month period. However, the EPO received no payment by the expiry of that period.
- III. With a communication dated 7 June 2013, the EPO informed the applicant of a loss of rights under Rule 12(1) EPC.
- IV. On 15 July 2013 the applicant filed a request for re-establishment of rights, paid the renewal fee with surcharge and the fee for re-establishment. Oral proceedings were also requested as a precautionary measure.
- V. In support of his request for re-establishment the applicant who is also the inventor, submitted that he was responsible for ensuring payment of renewal fees. A monitoring system primarily relying on the reminders sent to the applicant by a payment service provider, CPA, was in place. Due to exceptional pressure and an extremely heavy workload attributed to a prototype demonstration for an investor, negotiations with a new distributor and the due diligence process for a second round of funding for the companies set up to commercialise the applicant's inventions, he omitted to

instruct CPA on 15 April 2013, which was the final date for payment of the renewal fees entered in the applicant's calendar, to pay the due fees for the present patent application and two further applications. As a consequence, the renewal fee for the fourth year and the additional fee were not paid. In support of these facts, a declaration of the applicant dated 13 July 2013 (D1) and of the applicant's US representative dated 15 July 2013 (D2) were filed, along with a copy of the reminders sent to the applicant by CPA and his representatives (Annexes A to D to document D1 and Attachment 1 to document D2).

- VI. By communication dated 14 August 2013 the Examining Division informed the applicant of its preliminary view that the request could not be granted.
- VII. In response to the communication from the Examining Division, the applicant argued that the standard of care applicable to unrepresented individuals (J 5/94, and T 1401/94) should be applied to the applicant, and that according to decision T 635/94 an exceptionally heavy workload can justify the re-establishment of rights under Article 122 EPC.
- VIII. The Examining Division was enlarged by the addition of a legally qualified examiner (Article 18(2) EPC). On 4 August 2014 the Examining Division summoned the applicant to oral proceedings which took place on 27 November 2014.
- IX. With decision dated 26 February 2015, the Examining Division refused the request for re-establishment of rights under Article 122 EPC. The Examining Division found that the applicant's US representative, his European professional representative and the payment

service provider had exercised all due care required by the circumstances by satisfactorily monitoring the relevant deadlines and by duly informing the applicant. However, the applicant, who had failed to give instructions with respect to the payment of renewal fees, had not taken all due care required. His failure to give instructions could not be excused as an isolated mistake within a normally satisfactory system since the applicant's reliance on his calendar entry could not be considered as a satisfactory system for monitoring the time limits for the payment of renewal fees. The applicant could also not be considered to be an unrepresented individual who is subject to a less stringent standard of all due care. Finally the missing of the time limit was not seen as resulting from exceptional circumstances.

- X. On 8 May 2015, the applicant (appellant) filed notice of appeal and paid the appeal fee. On 8 July 2015, the appellant filed his statement of grounds of appeal and on 12 October 2015 a second declaration of the applicant dated 8 July 2015 (D3).

- XI. The appellant argued that the Examining Division had wrongly assumed that the appellant had overlooked his calendar entry for 15 April 2013 reminding him to instruct CPA to pay the renewal fees. The appellant had on the contrary regularly checked his calendar and had taken notice of this entry but had forgotten to return CPA's final renewal notice with his instructions for payment due to his exceptionally heavy workload on that day. Moreover, the Examining Division had failed to apply the standard of care applicable to unrepresented individuals. The appellant had a normally satisfactory system for monitoring the time limits in place but was

prevented by his unforeseeable heavy workload from responding to the reminders from CPA.

- XII. On 12 March 2018, the Board issued a summons to oral proceedings. In a communication accompanying the summons, it gave its preliminary opinion.
- XIII. Oral proceedings were held on 8 June 2018 in the absence of the appellant.
- XIV. The appellant had requested in writing 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 fourth 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 (J 5/80 of 7 July 1981, OJ EPO 1981, 343, Reasons 4).

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" (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, neither the appellant's European professional representative nor his US representative were responsible for ensuring renewal fee payments. It was agreed that the responsibility rested upon the applicant and inventor who employed the services of CPA to monitor the time limits and to effect payment.

All due care by the appellant's representatives

5. Despite not being responsible for the payment of renewal fees, both the appellant's European professional representative and his US representative informed the appellant of an impending loss of rights with respect to the present application after having received the EPO communication dated 5 December 2012 (see Annex C to document D1). Considering their "secondary responsibility", the Board is satisfied that the appellant's representatives acted with all due care required by the circumstances.

All due care by the payment service provider

6. The Board concurs with the Examining Division's finding that CPA, the applicant's payment service provider, had exercised all due care required by the circumstances by satisfactorily monitoring the relevant deadlines and by duly informing the applicant. The payment service provider sent three reminders in total, dated 15 July 2012 (Annex A to document D1), 21 October 2012 (Annex B to document D1), and 20 March 2013 (Annex D to document D1), and drew the appellant's attention to the final date for paying the renewal fees, i.e. 30 April 2013, and the consequence of a lapse.

All due care by the appellant

7. An applicant may organise the payment of renewal fees in a way where the payment of renewal fees ultimately depends, as in the present case, on the approval of a single person who relies on the monitoring of the time limits and the sending of reminders 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. Should a situation arise requiring extensive business-related travel and involving a heavy workload over an extended period of time, a diligent and careful applicant can be expected to take precautionary measures to prevent a loss of rights.
8. In the present case, it can be acknowledged that the prototype demonstration for an investor, the negotiations with a new distributor and the due diligence process for a second round of funding

amounted to a unusually heavy workload and involved extensive travel for the appellant in March and April 2013. However, this situation cannot have come as a complete surprise, although individual tasks may have required more work than envisaged. Therefore, the appellant could reasonably have been expected to take into account that he might be prevented, for some time, from taking care of the payment of renewal fees during this period of limited availability. Moreover, the appellant received four reminders in total, dated 15 July 2012 (Annex A to document D1), 21 October 2012 (Annex B to document D1), 24 January 2013 (Annex C to document D1), and 20 March 2013 (Annex D to document D1), some of which were received before the period of unusually heavy workload and extensive travel.

Appropriate provisions should have been made to ensure that the respective time limits could be observed, possibly with the help of other persons. However, there is no evidence showing that any precautionary measure was taken by the appellant in view of the impending workload and travel. In such circumstances where the observance of a time limit entirely depends on a single person who, in view of impending extensive workload and travel, does not take the necessary precautions so that the time limits can be met if he is prevented from giving timely instructions, the Examining Division's finding of absence of due care is justified.

9. Moreover, it is questionable whether the appellant had arranged a proper system for the payment of renewal fees that can be regarded as normally satisfactory. The monitoring system in place relied on the reminders sent to the appellant. However, the initial decision taken by the appellant upon receipt of the patent renewal notice on 16 July 2012 to pay the renewal fees later "in view of the financial situation" of the start-up

companies commercialising his inventions overrode the later reminders. The appellant entered 15 April 2013 as the final date for giving instructions to CPA to pay the renewal fees. The further reminders received by the appellant, including the patent renewal notice dated 20 March 2013 (Annex D to document D1), were checked against this deadline in his electronic calendar and used as confirmation of this entry. The appellant thus deliberately chose not to react to any of the reminders by giving instructions to pay the renewal fees. Instead, he relied entirely on the entry in his calendar for 15 April 2013 reminding him to pay the renewal fees. Factually, therefore, this entry in the appellant's electronic calendar became the only safeguard against a loss of rights due to the non-observance of the time limit for payment of the renewal fees. This holds even more true since the patent renewal notice dated 20 March 2013 (Annex D to document D1) constituted the final reminder by CPA. The appellant could therefore not expect a further warning from CPA after 15 April 2013, the date the appellant had fixed as the deadline for instructing CPA to pay the renewal fees. Moreover, he had been informed of the consequences of failing to give instructions for payment of renewal fees and additional fees by his US representative in an email of 24 January 2013 (Annex C to document D1) and by CPA reminders dated 21 October 2012 (Annex B to document D1) and 20 March 2013 (Annex D to document D1), all referring to the lapse on 30 April 2013. The observance of this time limit was thus under the appellant's sole responsibility. As a consequence, the payment of the renewal fee for the present and two other patent applications entirely depended upon his ability to properly and punctually accomplish all the duties entered in his calendar for the 15 April 2013.

10. The Board agrees with the Examining Division that an applicant who employs the services of a payment service provider for monitoring the time limits for renewal fees cannot be considered to be an unrepresented individual. But even if it were accepted, for the sake of argument, that less strict standards of care apply to an unrepresented individual applicant working alone, such applicant must nevertheless take all possible steps to ensure that he can do, properly and punctually, whatever is required during the grant procedure to prevent any loss of rights (J 5/94 of 28 September 1994, Reasons 3.1). The appellant has not plausibly shown that he took appropriate measures to ensure that he would not leave undone anything that was expected of him with a view to observing the time limit for payment of the renewal fees. In his second declaration (D3) the appellant stated that he checked his calendar at least once a day to keep track of his duties. He conceded, however, that he did not verify whether there were past due deadlines. He affirmed that he saw the deadline regarding the renewal fees in his calendar, but forgot to give instructions to CPA. There were thus no precautions to safeguard the respect of time limits under his responsibility. A system for monitoring time limits cannot be regarded as conforming to even a less strict standard of due care if it does not guard against the eventuality that the applicant who is responsible for giving instructions for the payment of regularly incurring fees might be prevented from taking care of the deadline entered in the calendar or might simply overlook it.
11. As regards decision T 166/87 of 16 May 1988 relied on by the appellant in the statement of grounds of appeal, it is noted that the deciding board considered that a

cross-check mechanism, especially in relation to one-off payments such as an appeal fee, was not required in a small patent department that normally worked in an efficient and personal manner. However, the deciding board accepted the fact that the system in place had operated efficiently for many years as evidence that this system was normally satisfactory. The omission of payment of the appeal fee was thus excused as an isolated mistake within a normally satisfactory system. In the present case, however, there is no evidence at all that the system arranged by the appellant had operated efficiently for many years. Moreover, the present case concerns the payment of regularly incurring fees and not one-off payments. Finally, the fact that a deficiency in a monitoring system has not previously led to a failure cannot support the finding that the system in question is of a normally satisfactory character. Besides, it is to be noted that the possibility recognised in decision J 5/80 (OJ EPO 1981, 343) 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 as is clear from the *travaux préparatoires* to Article 122 EPC relied on in decision J 5/80 (R 18/13 of 17 March 2014, Reasons 21).

12. Also decisions J 11/03 of 14 April 2005 and T 1355/09 of 10 September 2013 do not support the appellant's case. In J 11/03, the Board found that the monitoring system had proved to work satisfactorily during normal operation. The Board took into account that the internal department that dealt with the payment of fees comprised only the commercial manager and the bookkeeper, and that the latter confused an amount that was payable with an amount that had already been paid. The absence of an additional check of the payments by

the manager was considered not to have impaired the functioning of the system. Similarly, in decision T 1355/09 the Board stressed that the mistake had been made during payment, i.e. whilst accomplishing the act needed to observe the time limit. In such a situation, where non-compliance with a time limit did not result from a mistake in the monitoring of time limits, the duty of cross-checking the accomplishment of the required act could be dispensed with. In the present case, however, non-compliance with the time limit resulted from a mistake in the monitoring of time limits. There is moreover no proof that the monitoring system had worked satisfactorily in the past.

13. For the above reasons, the Board cannot acknowledge the exercise of all due care within the meaning of Article 122(1) EPC. The appeal has therefore to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



D. Hampe

E. Dufrasne

Decision electronically authenticated