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**Datasheet for the decision
of 13 September 2017**

Case Number: T 2016/16 - 3.3.05

Application Number: 10817590.2

Publication Number: 2480324

IPC: B01F13/08, B01F9/10, C12M1/33,
C12N13/00, B02C17/20

Language of the proceedings: EN

Title of invention:
MAGNETIC LYSIS METHOD AND DEVICE

Applicants:
Akonni Biosystems
Bio-Rad Laboratories, Inc.

Headword:
Re-establishment/AKONNI

Relevant legal provisions:
EPC Art. 108, 122(1), 122(2)
EPC R. 101(1), 126(2), 131(4), 136(1), 136(2)

Keyword:
Re-establishment of rights - due care in dealing with
assistants - cross-check - all due care (no)

Decisions cited:

T 1465/07

Catchword:



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Case Number: T 2016/16 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 13 September 2017

Appellant: Akonni Biosystems
(Applicant 1) 400 Sagner Avenue, Suite 300
Frederick, MD 21701 (US)

Appellant: Bio-Rad Laboratories, Inc.
(Applicant 2) 1000 Alfred Nobel Drive
Hercules, CA 94547 (US)

Representative: Brand, Thomas Louis
TL Brand & Co
17 Hanover Square
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 16 March 2016 refusing European patent application No. 10817590.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman E. Bendl
Members: A. Haderlein
P. Guntz

Summary of Facts and Submissions

- I. The appellants (applicants) lodged an appeal against the decision of the examining division to refuse application No. 10 817 590.2. The impugned decision was posted on 16 March 2016.
- II. The appellants filed a notice of appeal on 20 April 2016 and paid the prescribed fee on the same day.
- III. The statement of grounds of appeal was filed on 22 August 2016. On the same day, a request for re-establishment of rights in respect of the time limit for filing the statement of grounds of appeal was filed and the prescribed fee was paid. With the statement of grounds of appeal, the appellants filed a main request and an auxiliary request.
- IV. The appellants were summoned for oral proceedings.
- V. The board issued a communication pursuant to Article 15(1) RPBA. In its preliminary opinion, it stated that the request for re-establishment of rights appeared to be admissible but it also appeared to be unfounded in particular because no evidence had been filed.
- VI. The appellants filed a copy of a CIPA Patent Administrator Qualification certificate issued in the name of Ms S.
- VII. In their letter dated 7 September 2017, the appellants informed the board that their representative would not be attending the oral proceedings.

VIII. In a telephone conversation on the same day, the rapporteur of the board informed the appellants' representative that, according to the board's preliminary opinion, the request for re-establishment should be refused. The representative confirmed that the appellants' letter of that day was not to be construed as a withdrawal of the appeal.

IX. Oral proceedings before the board took place in the appellants' absence.

X. The appellants' arguments, as far as relevant for the present decision, may be summarised as follows:

The time limit for filing the statement of grounds of appeal was not entered in the docketing system used by the representative's firm. The failure to observe the time limit for filing the statement of grounds of appeal came to light after the representative's client raised a query regarding an invoice on 15 August 2016. Normally, incoming post is checked every day and time limits are recorded in the internal electronic docketing system. The time limits set by any incoming communications are generally identified and recorded by a well-trained, competent and experienced assistant, who has the CIPA Patent Administrator Qualification and who normally performs her duties satisfactorily. The incoming communications are then brought to the attention of the attorneys working on the case and the relevant time limits are double checked. In the present case, the assistant, Ms S., only entered the first, two-month deadline for filing the notice of appeal in the docketing system on receipt of the decision. The appellants' representative, Ms F., was independently monitoring the case for the issuance of the decision and reviewed the docketing system once the decision had

been received. However, the representative, when reviewing the case and the newly received decision, also overlooked the omission of the second, four-month deadline for filing the grounds of appeal. When filing the notice of appeal she did not think to check whether the period for filing the grounds of appeal had been logged in the docketing system as deadlines were recorded on receipt of the communication that sets them, i.e. the impugned decision, and not on the completion of other deadlines to do with the same case. The failure to record the relevant deadline in the system was an isolated mistake in an otherwise satisfactory system. The request for re-establishment should therefore be granted.

- XI. The appellants requested the re-establishment of rights in respect of the time limit for filing the statement of grounds of appeal. The appellants also requested that the contested decision be set aside and that a patent be granted based on the claims of the main request as filed with the grounds of appeal. In the alternative, they requested the grant of a patent based on the auxiliary request filed with the statement of grounds of appeal.

Reasons for the Decision

1. The decision under appeal was posted on 16 March 2016 and was deemed to have been delivered on 26 March 2016 (Rule 126(2) EPC). The time limit for filing the statement of grounds of appeal, therefore, expired on 26 July 2016 (Article 108, third sentence and Rule 131(4) EPC). Thus, the statement of grounds of appeal filed on 22 August 2016 was not filed within the prescribed time limit. The non-compliance with the time

limit has the effect that the appeal is to be considered as inadmissible. Re-establishment of rights is available in this situation (Article 122(1) EPC).

2. According to the appellants' submissions, the failure to observe the time limit for filing the statement of grounds of appeal came to light after the representative's client raised a query regarding an invoice on 15 August 2016. The cause of non-compliance with the time limit under Article 108, third sentence, EPC can therefore be considered to have been removed on that day. The two-month time limit for filing the request for re-establishment of rights in writing (Article 122(2) and Rule 136(1) EPC) was therefore observed by filing the request for re-establishment of rights on 22 August 2016. On the same day, the omitted act, i.e. the filing of the statement of grounds of appeal, was completed and the fee for re-establishment was paid. Furthermore, the request for re-establishment of rights states the grounds and facts on which it is based (Rule 136(2) EPC).

Hence, the request for re-establishment of rights is admissible.

3. The appellants have however not shown that all due care required by the circumstances was taken to comply with the time limit (Article 122(1) EPC).
 - 3.1 In the case at hand, the appellants submit that the failure to comply with the missed time limit resulted from the erroneous omission of the time limit from the docketing system by an assistant and the failure of the representative to identify this omission.

- 3.2 In the case of non-observance of a time limit due to an error, the boards of appeal have established the criterion that due care is considered to have been taken if non-compliance with the time limit resulted either from exceptional circumstances or from an isolated mistake within a normally satisfactory monitoring system (Case Law of the Boards of Appeal (hereinafter "CLBA"), 8th ed., III.E.5.2., penultimate paragraph). It is the appellants' contention that the present case amounts to such an isolated mistake.
- 3.3 The party requesting re-establishment of rights bears the burden of making the case and proving that the requirements are met (CLBA *supra*, III.E.5.2., last paragraph). Thus, in the present case the appellants bear the burden of proof to show the existence of a normally satisfactory monitoring system.
- 3.4 The representative may entrust to an assistant the performance of routine tasks provided that the necessary due care on the part of the representative has been exercised in dealing with the assistant. In this respect, it is incumbent upon the representative to choose a suitable person for the work, to properly instruct that person in the tasks to be performed and to exercise reasonable supervision over the work (CLBA *supra*, III.E.5.5.4b)).
- 3.4.1 According to the appellants' submissions, the assistant was a "well-trained, experienced assistant, who has the CIPA Patent Administrator Qualification". The only evidence provided by the appellants in this respect is a copy of the CIPA Patent Administrator Qualification certificate awarded to Ms S., the assistant to the appellants' representative, in 2009. While this document certainly can serve as proof of Ms S.'s

suitability to perform the routine tasks in question, the appellants have not provided any evidence regarding the alleged "normally satisfactory monitoring system" of the representative's firm, i.e. any proof that would suggest that Ms S. had been properly instructed to perform tasks relating to appeals before the Boards of Appeal of the EPO and in particular relating to their handling in the firm's docketing system. In particular, there is no evidence on file that would suggest that the assistant had been instructed to enter not only the two-month time limit for filing the notice of appeal in the docketing system but also the four-month time limit for filing the statement of grounds of appeal. In this respect, the board also notes that the appellants' contention that the assistant normally performed her duties satisfactorily is not supported by corroborating evidence.

- 3.4.2 The appellants also submit that the time limits entered by the assistant in the docketing system are normally double checked by a patent attorney. In the case at hand however, the representative, Ms F., who was in charge of this double check, also overlooked the omission in the docketing system of the time limit in question.

The board observes that, while an independent cross-check of time limits is normally required in the case of large patent attorney firms (CLBA *supra*, 5.4.4) and in the present case the representative's firm can be considered not to be such a large firm, even with such a system of double checking in place, the representative is not discharged from his or her duty to properly instruct and supervise the assistant (cf. T 1465/07, reasons 18, last paragraph). In the case at hand, the appellants have not shown that the assistant

was properly instructed or that she was properly supervised (cf. 3.4.1 *supra*).

- 3.4.3 Thus, the appellants have not discharged their burden to prove the existence of a normally satisfactory monitoring system. The omission from the docketing system of the time limit for filing the statement of grounds can therefore not be said to equate to an isolated mistake in a normally satisfactory monitoring system.

The question as to whether the representative herself should have noticed, when preparing the notice of appeal, that the time limit for filing the grounds of appeal was not registered in the docketing system need not therefore be addressed.

- 3.5 For these reasons, the request for re-establishment of rights is to be refused.
- 3.6 As the statement of grounds was filed after the time limit under Article 108, third sentence, EPC had elapsed, the appeal is to be rejected as inadmissible (Rule 101(1) EPC).

Order

For these reasons it is decided that:

1. The request for re-establishment of rights is refused.
2. The appeal is rejected as inadmissible.

The Registrar:

The Chairman:



C. Vodz

E. Bendl

Decision electronically authenticated