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**Datasheet for the decision
of 9 September 2021**

Case Number: T 1570/20 - 3.2.02

Application Number: 08868287.7

Publication Number: 2230967

IPC: A61B19/00, A61N7/02

Language of the proceedings: EN

Title of invention:
POSITIONING SYSTEM FOR THERMAL THERAPY

Applicant:
National Health Research Institutes

Headword:

Relevant legal provisions:

EPC Art. 122(1), 133(2)
EPC R. 136(1)

Keyword:

Re-establishment of rights - time limit for filing request for
re-establishment - two months of the removal of the cause of
non-compliance - request admissible (no)

Decisions cited:

J 0027/88, J 0027/90, J 0016/93, T 0032/04, T 0812/04,
T 2251/12, T 1588/15, T 0198/16, J 0001/20

Catchword:



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Case Number: T 1570/20 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 9 September 2021

Appellant: National Health Research Institutes
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Miaoli County
Zhunan Town 350
Taiwan Province (TW)

Representative: Lavoix
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 4 October 2019 rejecting the request for re-establishment into the time limit for paying the renewal fee for the 7th year with surcharge and declaring European patent application No. 08868287.7 deemed to be withdrawn**

Composition of the Board:

Chairman M. Alvazzi Delfrate
Members: N. Obrovski
S. Dennler
D. Ceccarelli
C. Schmidt

Summary of Facts and Submissions

- I. The appeal of the applicant (appellant) lies against the decision of the Examining Division of 4 October 2019 on European patent application No. 08868287.7. In this decision, the appellant's request for re-establishment of rights into the time limit for paying the renewal fee for the 7th year with surcharge was rejected and the European patent application was deemed to be withdrawn with effect of 1 July 2015.

- II. The appellant is based in Taiwan. On 22 October 2014, the appellant's US representative (O&R Patent Law) sent a patent renewal instruction list to the appellant, which included the present application. The employee of the appellant who was responsible for this matter did not reply. After a reminder had been sent, the appellant's employee informed O&R Patent Law on 3 December 2014 that the renewal fee for the present application would be paid by a third party. This information was erroneous, as the employee had apparently confused two applications. O&R Patent Law forwarded this erroneous information to the European professional representative representing the appellant under Article 133(2) EPC. The renewal fee for the 7th year was not paid.

- III. By communication of 4 February 2015, the Examining Division informed the European representative that the renewal fee for the 7th year had not been paid by the due date and that it could be paid with surcharge up to the last day of the sixth calendar month following the due date. Otherwise, the European patent application would be deemed withdrawn.

- IV. The appellant's European representative received this communication on 9 February 2015 and forwarded it to O&R Patent Law on 13 February 2015. O&R Patent Law replied to the European representative on 2 June 2015 that "our client tells that they are handling this themselves". The applicant supposedly never received the Examining Division's communication of 4 February 2015. In any case, the renewal fee with surcharge was not paid.
- V. On 31 July 2015, the Examining Division issued a communication on a loss of rights under Rule 112(1) EPC due to the non-payment of the renewal fee with surcharge. The appellant's European representative received this communication on 6 August 2015, had - as was confirmed during the oral proceedings before the Board - as of that day actual knowledge thereof and forwarded it to O&R Patent Law on 11 August 2015. The latter forwarded the information to the applicant, who received it on 22 August 2015. The applicant then sought legal advice from a law firm based in Taiwan (different from the US and European representative). That law firm advised the appellant that the time limit for re-establishment of rights "should be" two months from the applicant's receipt of the communication on 22 August 2015.
- VI. By submission dated and received on 22 October 2015, the appellant requested re-establishment of rights into the time limit for paying the renewal fee for the 7th year. The appellant paid the fee for the re-establishment of rights as well as the renewal fee with surcharge.

- VII. By decision of 4 October 2019, the Examining Division rejected the request for re-establishment, which it deemed both inadmissible and unallowable.
- VIII. On 9 September 2021 oral proceedings took place before the Board.
- IX. The appellant requests that the Examining Division's decision be set aside and that they be re-established into the time limit for paying the renewal fee for the 7th year with surcharge.
- X. Regarding the admissibility of their request for re-establishment, the appellant essentially submitted that the removal of the cause of non-compliance occurred on the date on which the responsible person is actually aware that a time limit has not been observed, including the awareness that an error has occurred in that regard. As the renewal fees had been paid by an annuity provider under the direct instruction of the applicant, the US and the European representatives had been relieved from their responsibility regarding the maintenance of the patent. Hence, the applicant could be considered as the person responsible for the application. If the European representative were to be considered as the person responsible, he had only become aware that an error had occurred once he had been informed thereof by the applicant after 22 August 2015.
- XI. The receipt of the communication on the loss of rights by the European representative did, according to the appellant, not constitute a clear and definite indication of an undesired event. The European representative did not know whether the appellant wanted to abandon the application intentionally or not.

Therefore, the receipt of the communication on the loss of rights by the European representative did not remove the cause of non-compliance. It only obliged the European representative to inform the US representative, who then had to inform the appellant. Only the appellant itself knew the desired status of the application and was able to assess whether an error had occurred or not. As the appellant received the information on the loss of rights on 22 August 2015, the request for re-establishment of rights was filed on 22 October 2015 in due time, namely within two months after removal of the cause of non-compliance.

Reasons for the Decision

1. The admissibility of the request for re-establishment filed on 22 October 2015 depends on whether it was submitted in due time.
2. A request for re-establishment of rights must be filed within two months of the removal of the cause of non-compliance (Rule 136 (1) EPC). It is thus decisive when the cause of non-compliance was removed. If this occurred on 6 August 2015, when the European professional representative was informed about the loss of rights, the request for re-establishment of rights is not admissible. If it occurred on 22 August 2015, when the applicant was informed, the request is admissible.
3. If a professional representative is appointed, the removal of the cause of non-compliance usually occurs on the date on which the professional representative becomes aware of the fact that a time limit has not been observed (see J 27/90, point 2.3 of the Reasons).

The notification of the communication on the loss of rights to the professional representative removes the cause of non-compliance unless there are exceptional circumstances. A person other than the professional representative being responsible for the payment of fees does not constitute exceptional circumstances (see T 1588/15, point 9 of the Reasons). The removal of the cause of non-compliance is normally the actual receipt - and not the deemed notification - of the communication by the professional representative (T 2251/12, point 10 of the Reasons; T 812/04, point 2.1.1 of the Reasons).

4. In J 16/93 the Legal Board was of the view that the cause of non-compliance with a time limit may persist even though the professional representative was duly informed of a loss of rights. The Legal Board made this statement in view of an exceptional "combination of circumstances, which cannot be blamed on either the applicant or its representatives, and which arose in particular from the fact that they had both moved to new addresses and from the illness of a director of the company applying for a European patent". This made it impossible for the professional representative to contact the applicant in due time, in order to establish whether the application had been abandoned by ceasing to pay the renewal fees (see points 4.3.2 and 4.3.3. of the Reasons).
5. The facts underlying the present case are very different. Not only was it possible for the professional representative to inform the appellant about the loss of rights in due time, but the appellant actually was informed thereof in due time: The information reached the appellant on 22 August 2015, i.e. 16 days after receipt by the representative. A

certain time lag between these two events is a practical necessity, in particular when a party is represented (see T 1588/15, point 11.2 of the Reasons), and does not constitute exceptional circumstances.

6. The appellant submitted that:

- Contrary to J 27/90 and T 1588/15, the annuities were not always paid by an annuity provider; rather, there was an erroneous change of the established renewal arrangement during the proceedings.
- Contrary to T 32/04 and J 27/88, the professional representative was not responsible for all proceedings; in particular, the annuities were paid under the direct instruction of the appellant.

7. These purported differences do not justify a different conclusion. The appellant mainly refers to these differences in support of their statement that the professional representative did not know whether the appellant wanted to abandon the application or not. As only the latter was able to assess whether an error had occurred or not, the cause of non-compliance was allegedly only removed when the applicant became aware that a time limit had not been observed.

8. It is, however, not exceptional that a professional representative does not know with certitude, immediately upon receipt of a communication on a loss of rights, whether the lack of payment of a renewal fee by an applicant was intentional or not. The appellant concedes that "in practice, this is not an uncommon situation".

9. This issue can not only arise when there is a change of the fee arrangements during the proceedings, but rather

whenever a professional representative is not responsible for the payment of fees. This, however, does not constitute exceptional circumstances (see point 3 of the Reasons above). Neither is it exceptional that a professional representative must, when receiving a communication on the loss of rights, first consult the represented party to establish whether this was intentional, in order to determine whether to request re-establishment of rights or not.

10. Moreover, the appellant had to act through their professional representative "in all proceedings established by the Convention" (Article 133(2) EPC), and the request for re-establishment of rights could only be made by the latter. The representative remained responsible for the application regardless of by whom the renewal fees were paid, or were supposed to be paid (see J 27/90, point 2.3 of the Reasons).
11. During the oral proceedings before the Board, the appellant referred to T 198/16 and J 1/20 and submitted that the due-care criterion should not be applied to the question when the cause of non-compliance was removed. A presumption of knowledge was not sufficient in that regard; rather, actual knowledge was required, including with regard to the fact that an error had occurred.
12. In J 1/20 it is however also stated that, if a European professional representative is appointed, the party acts through them in all proceedings established by the Convention and notifications are made to them, which implies that removal of the cause of non-compliance occurs in principle when the authorised representative becomes aware of the loss of rights (point 2.2 of the Reasons).

13. It is undisputed that the European professional representative became aware of the loss of rights - due to the non-payment of fees within the prescribed time limit - upon receipt of the Examining Division's communication on 6 August 2015. Therefore, the cause of non-compliance was removed on that date. In the Board's view, removal of the cause of non-compliance did not require any additional knowledge by the professional representative about possible reasons for the loss of rights, such as whether the non-payment of fees was intentional or not. Rather, it was sufficient that the professional representative became aware of the fact that a time limit - namely the time limit with regard to which re-establishment of rights was requested later on - had not been complied with, which included awareness of the fact that nobody had taken care of the payment of fees. As pointed out before, the applicant's arrangement for the payment of fees does not constitute exceptional circumstances.
14. Finally, the appellant submitted that initially an earlier deadline had been set, which was then changed following the advice of the Taiwanese law firm. The involvement of an additional counsel had, according to the appellant, "deleterious effects on the working interactions between the applicant and its representatives and substantially affected proper advice and actions".
15. The appellant is, as any party, free to choose their representatives and advisors. They must, however, also bear the possible negative consequences of their choices and arrangements. In any case, the involvement of the Taiwanese law firm did not have any impact on

the powers of the professional representative under Article 133(2) EPC.

16. In conclusion, the cause of non-compliance under Rule 136(1) EPC was removed when the European professional representative was informed about the loss of rights on 6 August 2015. The request for re-establishment was not filed within two months of that date, and is therefore inadmissible.
17. In view of the above, the allowability of the request of re-establishment does not have to be addressed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



D. Hampe

M. Alvazzi Delfrate

Decision electronically authenticated