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**Datasheet for the decision
of 8 December 2023**

Case Number: T 0231/23 - 3.2.03

Application Number: 14807425.5

Publication Number: 3004481

IPC: E04B5/32, E02D27/01, E04C5/16,
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E04B5/21, E04B5/36

Language of the proceedings: EN

Title of invention:

METHOD AND APPARATUS FOR FORMING A FORMWORK FOR A CONCRETE SLAB

Applicant:

Parodi, Fabio

Headword:

Relevant legal provisions:

EPC Art. 122(1)
EPC R. 130(1), 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 (no)

Decisions cited:

J 0001/20, T 1678/21, T 1570/20, T 1547/20, T 1995/19,
T 1588/15, T 2251/12, T 0812/04, J 0027/90

Catchword:

1.) The removal of the cause of non-compliance with a time limit under Rule 136(1) EPC occurs, as a rule, on the date on which the person responsible for the application vis-à-vis the EPO becomes aware of the fact that the time limit has not been observed, for example by receipt of a loss of rights communication under Rule 112(1) EPC. If a professional representative is appointed, the representative is the person responsible for the application vis-a-vis the EPO (Reasons 3 and 4).

2.) Regarding time limits for the payment of fees, an appointed professional representative remains the person responsible for the application vis-a-vis the EPO, and thus the person whose knowledge matters in assessing when the cause of non-compliance was removed, irrespective of whether a third party other than the representative is responsible for the payment of fees. Hence, also when a time limit for the payment of fees was missed, removal of the cause of non-compliance in principle occurs on the date on which an appointed professional representative receives the corresponding loss of rights communication (Reasons 5). The removal of the cause of non-compliance does not require any additional knowledge on the part of the professional representative about possible reasons for missing the time limit, such as whether the non-payment of renewal fees had been intentional or not (Reasons 7).



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Case Number: T 0231/23 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 8 December 2023

Appellant: Parodi, Fabio
(Patent Proprietor) Waikato Mail Centre
Hamilton 3240 (NZ)

Representative: Murgitroyd & Company
Murgitroyd House
165-169 Scotland Street
Glasgow G5 8PL (GB)

Decision under appeal: Decision of the examining division of the
European Patent Office posted on 29 June 2022
rejecting the request for re-establishment into
the time limit for paying the renewal fee for
the 6th year with surcharge and declaring
European patent application No. 14807425.5
deemed to be withdrawn.

Composition of the Board:

Chair C. Herberhold
Members: N. Obrovski
B. Miller
M. Olapinski
D. Prietzel-Funk

Summary of Facts and Submissions

- I. The applicant's (appellant's) appeal lies against the examining division's decision issued on 29 June 2022 on European patent application No. 14807425.5. In this decision, the appellant's request for re-establishment of rights in respect of the time limit for paying the renewal fee for the 6th year with surcharge was rejected and it was stated that the European patent application was deemed to be withdrawn with effect as of 3 January 2020.

- II. Mr Broderick is the appellant's professional representative in the proceedings before the EPO. At the time relevant to the assessment of the appellant's request for re-establishment of rights, Mr Broderick worked for Urquhart-Dykes&Lord LLP, hereinafter UDL. UDL was subsequently acquired by Murgitroyd, Mr Broderick's current employer. Within UDL, Jayne Wainman and Alison Perry were at the relevant time responsible for renewal payments. UDL received the appellant's instructions through Mr Betteridge from Paris Mill IP, a non-European patent attorney who acted as the appellant's representative in New Zealand (see points 2 and 3 of Mr Broderick's affidavit).

- III. The appellant paid the renewal fee for the 4th and 5th years himself. The renewal fee for the 5th year had to be paid with a surcharge. Against this background, Mr Betteridge from Paris Mill IP suggested to the appellant by email dated 29 August 2018 that he "use the services of our associate to look after this and ongoing renewal fees". The appellant confirmed this to Mr Betteridge, who wrote to Ms Perry from UDL by email dated 30 August 2018 that the appellant would like UDL

"to take over the renewals payments for year 06 onwards". In this email, Mr Betteridge also asked for confirmation of these instructions. Ms Wainman from UDL replied by email dated 30 August 2018: "We will re-open our renewal records, once you confirm that the renewal fee for 2018 has been paid." The renewal fee for 2018 referred to in Ms Wainman's email of 30 August 2018 was the renewal fee for the 5th year, i.e. the last renewal fee which was still paid by the appellant himself, namely in October 2018. The confirmation requested by Ms Wainman was never given. In point 11 of his first affidavit of 14 September 2020, Mr Betteridge states that he does not have any recollection of receiving Ms Wainman's email of 30 August 2018 and that there is no record thereof in his files either.

- IV. Neither anyone from UDL nor Mr Betteridge from Paris Mill IP followed up on the exchange of emails of August 2018. Subsequently, the renewal fee for the 6th year was not paid, neither by UDL nor by the appellant himself.
- V. By communication dated 2 August 2019, the EPO informed UDL that the renewal fee for the 6th year had fallen due on 30 June 2019 and that it could still be validly paid with a surcharge up to 31 December 2019. By email dated 12 August 2019, Ms Wainman from UDL informed Mr Betteridge from Paris Mill IP accordingly, additionally stating that UDL was currently not responsible for renewing this patent application, that UDL was informing Paris Mill IP only as a matter of courtesy, and that UDL would provide no further notification and take no further action unless Paris Mill IP instructed them otherwise. In point 14 of his first affidavit of 14 September 2020, Mr Betteridge states that he does not have any recollection of

receiving Ms Wainman's email dated 12 August 2019 and that there is no record thereof in his files either.

VI. The renewal fee for the 6th year with surcharge was not paid by 31 December 2019. By communication under Rule 112(1) EPC dated 31 January 2020, the EPO informed UDL that a loss of rights had occurred, and that the application was deemed to be withdrawn.

VII. Mr Broderick from UDL states the following in point 20 of his affidavit: "On 7th February 2020, UDL received a notification from the EPO informing us of the lapse of the Patent Application. This would usually be reported to the applicant by the UDL renewals team but the report was overlooked and so the applicant never received the notification of lapse." During the oral proceedings before the examining division, Mr Broderick added that he only become aware of the communication pursuant to Rule 112(1) EPC when he was informed by the non-European representative from Paris Mills IP by email dated 18 July 2020 that the application had lapsed unintentionally. The EPO communication pursuant to Rule 112(1) EPC had not previously been reported to him.

VIII. However, pursuant to point 21 of Mr Broderick's affidavit, he had received a "notification" (communication) from the EPO dated 1 July 2020 informing the applicant that the examination fee had been refunded. According to point 22 of Mr Broderick's affidavit, Mr Broderick informed Mr Betteridge from Paris Mill IP thereof by email dated 2 July 2020. The following is stated in this email: "We have received notification from the EPO that they are refunding the examination fee for this European patent application. The reason for this refund is that the application is

now lapsed as the renewal in respect of the 6th year was not paid." (emphasis by the Board). Hence, Mr Broderick had actual knowledge of the loss of rights due to non-payment of the renewal fee for the 6th year on 2 July 2020 at the latest.

- IX. According to points 16 and 17 of Mr Betteridge's first affidavit of 14 September 2020, Mr Betteridge was informed by Mr Broderick of the lapse of the patent application "due to non-payment of the 6th year renewal fee" on 3 July 2020, and conveyed this information to the appellant by email dated 16 July 2020. After having received the appellant's reply, Mr Betteridge informed Mr Broderick by email dated 18 July 2020 (see also point 18 of Mr Betteridge's first affidavit) that the application had lapsed unintentionally.
- X. In its communication under Article 15(1) RPBA, the Board set out its preliminary opinion that the cause of non-compliance under Rule 136(1) EPC had been removed when the professional representative Mr Broderick had been informed, at the latest on 2 July 2020, about the missed time limit and the lapse of the application. The appellant's request for re-establishment dated 16 September 2020 had not been filed within two months of that date and was therefore inadmissible. Moreover, even if the appellant's request for re-establishment were admissible, it would not be allowable, as Mr Betteridge from Paris Mill IP had not acted with all due care required by the circumstances.
- XI. The appellant submitted that his request for re-establishment of rights in respect of the time limit for paying the renewal fee for the 6th year with surcharge was both admissible and allowable. Regarding admissibility, the appellant essentially referred to

point 2 of the catchword of J 1/20 and argued that, in the context of a missed renewal payment, the awareness of an error required knowledge that it had been the intention of the applicant to pay the renewal fee which was then missed. Mere knowledge of the missed payment itself was not awareness of an error. The professional representative, Mr Broderick, had been the person responsible for the patent application and had not become aware of the error, i.e. that the renewal fee had not been paid even though the applicant wanted it to be paid, until receipt of Mr Betteridge's email dated 18 July 2020. The appellant's request for re-establishment dated 16 September 2020 had been filed within two months from that date and was therefore admissible.

As this decision does not address the allowability of the appellant's request for re-establishment, his submissions in that regard do not need to be reproduced.

- XII. At the end of the oral proceedings held on 8 December 2023, 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 paying the renewal fee for the 6th year with surcharge be granted.

Reasons for the Decision

1. In view of the appellant's submission dated 7 February 2022 and Mr Broderick's statement in the oral proceedings before the examining division that he had only become aware of the communication pursuant to Rule 112(1) EPC after he had been informed by the representative from Paris Mills IP by email dated

18 July 2020 that the application had lapsed unintentionally, the examining division considered the appellant's request for re-establishment of rights admissible (see point II.15 of the decision under appeal). For the following reasons, the Board does not agree with this assessment.

2. The admissibility of the appellant's request for re-establishment filed on 16 September 2020 depends on whether it was submitted in due time. A request for re-establishment of rights must be filed within two months of the removal of the cause of non-compliance with a time limit vis-à-vis the EPO (Article 122(1) EPC, Rule 136(1) EPC). It is thus decisive when the cause of non-compliance with the time limit to pay the renewal fee together with a surcharge was removed.
3. According to more recent case law, the removal of the cause of non-compliance with a time limit under Rule 136(1) EPC is to be established on a purely factual basis and occurs, as a rule (as to possible exceptions, see point 8. below), on the date on which the person responsible for the application vis-à-vis the EPO becomes aware of the fact that a time limit has not been observed (T 1547/20, Reasons 4.1; T 1995/19, Reasons 6; see also J 27/90, Reasons 2.3, and T 1570/20, Reasons 3), for example by receipt of a loss of rights communication under Rule 112(1) EPC. As a rule, the cause of non-compliance does not persist longer than up to the time at which the previous unawareness of the missed time limit is removed (T 1995/19, Reasons 7).
4. If a professional representative is appointed, the representative is the person responsible for the application vis-à-vis the EPO (J 1/20, Reasons 2 to

2.2). Accordingly, it is established jurisprudence of the Boards of Appeal that if a loss of rights communication under Rule 112(1) EPC is issued to a duly appointed professional representative, the removal of the cause of non-compliance in principle occurs with the actual receipt of such a communication (T 1995/19, Reasons 6; T 2251/12, Reasons 10; T 812/04, Reasons 2.1.1; see also T 1678/21, Reasons 4.4.1 (a), sixth paragraph, applying the rationale underlying J 1/20 to the assessment of when an error under Rule 139 EPC was detected, and referring to a communication having reached "the area of responsibility of the professional representative").

5. Regarding time limits for the payment of fees, an appointed professional representative remains the person responsible for the application vis-à-vis the EPO, and thus the person whose knowledge matters in assessing when the cause of non-compliance was removed, irrespective of whether a third party other than the representative is responsible for the payment of fees (see J 27/90, Reasons 2.3; T 1570/20, Reasons 10). Regardless of which contractual arrangements a party chooses for the payment of fees, an appointed professional representative remains the EPO's single point of contact. Under Rule 130(1) EPC, all notifications, including those relating to fees, must be addressed to the representative. Hence, also in the case of a time limit for the payment of fees being missed, removal of the cause of non-compliance in principle occurs on the date on which an appointed professional representative receives the corresponding loss of rights communication.

6. In the present case, the loss of rights communication was received by UDL, the professional representative's

firm, on 7 February 2020. The professional representative Mr Broderick denies that his colleagues at UDL presented this communication to him before 18 July 2020. However, even if the communication itself was, as alleged, indeed not presented to Mr Broderick upon receipt by UDL on 7 February 2020, points 21 and 22 of his own affidavit and his email dated 2 July 2020 confirm that he already had at the very least actual knowledge of the relevant contents of this communication - i.e. lapse of the application due to the non-payment of the renewal fee with surcharge for the 6th year within the prescribed time limit - on 2 July 2020 (see point VIII. above). Hence, at the latest on 2 July 2020, Mr Broderick gained actual knowledge of the missed time limit and the associated loss of rights. In line with the case law referred to above, the removal of the cause of non-compliance thus occurred at the latest on 2 July 2020. This triggered the two-month time limit under Rule 136(1) EPC.

7. The removal of the cause of non-compliance - initiating the start of the two-month time limit under Rule 136(1) EPC - did not require any additional knowledge on the part of the professional representative about possible reasons for missing the time limit, such as whether the non-payment of renewal fees had been intentional or not. Rather, it was sufficient that Mr Broderick became aware of the fact that the time limit for paying the renewal fee for the 6th year with surcharge - i.e. the time limit with regard to which re-establishment of rights was subsequently requested - had not been complied with, this including awareness of the fact that the fee had not been paid (see T 1570/20, Reasons 13). This knowledge objectively enabled the professional representative to take appropriate action, for example

by filing a request for re-establishment of rights within two months of having gained that knowledge.

8. There are no exceptional circumstances in the present case according to which the cause of non-compliance persisted despite the representative's actual knowledge of the missed time limit (see T 1995/19, Reasons 8, with reference to J 1/20, Reasons 3.7.1). In particular, it is neither exceptional that a person other than the professional representative is responsible for the payment of fees (T 1588/15, Reasons 6 and 9), nor that a professional representative must, when receiving a communication on loss of rights, first consult the represented party to establish whether this was intentional, in order to determine whether or not to request re-establishment of rights (T 1570/20, Reasons 9). If a professional representative, who is responsible for the application but not for the payment of fees, becomes aware of a loss of rights due to the non-payment of fees, they must take appropriate action (see J 1/20, Reasons 3.7.1 (ii)), taking account of the possibility that the non-payment of fees and the loss of rights occurred unintentionally.
9. In the present case, the professional representative Mr Broderick acted accordingly and informed the applicant's non-European representative Mr Betteridge from Paris Mill IP about the lapse of the application by email dated 2 July 2020. The Board notes in this context that, when a party is represented, a certain time lag between the European professional representative knowing about the loss of rights (in the present case on 2 July 2020) and the conveyance of this information, possibly through a non-European representative, to the applicant (in the present case

on 16 July 2020, i.e. 14 days after receipt by the representative) is not exceptional, but rather a practical necessity (T 1570/20, Reasons 5; T 1588/15, Reasons 11.2). Rule 136(1) EPC provides a time limit of two months for all necessary steps to be taken in this regard (see T 1588/15, Reasons 11.3).

10. The appellant contested the above conclusions by referring to point 2 of the catchword in J 1/20 which reads as follows:

"Removal of the cause of non-compliance is a question of fact which occurs on the date on which the person responsible for the application or patent actually became aware of an error (actual knowledge), rather than when this person ought to have noticed the error (presumption of knowledge)."

11. The appellant essentially argued that awareness of an error within the meaning of J 1/20 required actual knowledge by the professional representative Mr Broderick that it had been unintentional on the part of the applicant not to pay the renewal fee. This was so because the non-payment of that fee could also have been intentional, in which case it would not have been an error. Thus, Mr Broderick had only become aware of the error on 18 July 2020.

12. In the Board's view, the gist of J 1/20 is that removal of the cause of non-compliance within the meaning of Rule 136(1) EPC is a question of fact to which the due-care criterion should not be applied. Accordingly, the cause of non-compliance is only removed on the date on which the person responsible for the application becomes aware of the fact that a time limit has not been observed, and not on an earlier date on which it

ought to have become aware of that fact. As set out in point 3. above, the present Board concurs with this.

13. As to the term "error" in the catchword of J 1/20, the Board considers that this term must not be read in isolation but in the context of the facts of the case underlying that decision. In J 1/20, the applicant was supported by a domestic agent who monitored a P.O. Box in respect of notifications from the EPO. The domestic agent informed the applicant neither of the EPO's communication under Rules 70(2) and 70a(2) EPC nor of the loss of rights communication pursuant to Rule 112(1) EPC. In addition, after reimbursement of the renewal fee, the domestic agent erroneously informed the applicant that there was nothing to be done. As no professional representative had been appointed, the applicant remained the person responsible for the application vis-à-vis the EPO. Hence, it was the applicant's knowledge - and not the domestic agent's knowledge - which mattered for assessing when the cause of non-compliance was removed.

14. In the present Board's view, the Board in J 1/20 considered the applicant's lack of knowledge that a time limit had not been observed (i.e. the applicant's lack of knowledge of the contents of the loss of rights communication) as the "error" referred to in point 2 of the catchword, and the applicant's lack of knowledge of the existence of the possibility of requesting re-establishment of rights as the "error of law" referred to in point 4 of the catchword. Accordingly, the Board in J 1/20 held that the applicant "was not aware until 1 April 2016 of the fact that the time limit for requesting further processing with regard to the time limit for replying to the communication under Rules 70(2) and 70a(2) EPC had not been

observed" (Reasons 3.11, emphasis by the present Board). On 1 April 2016, the cause for non-compliance was removed when a newly appointed European professional representative reviewed the file history and informed the applicant about the contents of the loss-of-rights communication, and also about the possibility of filing a request for re-establishment of rights.

15. The facts of the present case are different from the facts underlying J 1/20. Firstly, in the present case a professional representative was appointed, and it is undisputed by the appellant that it was him - and not the applicant - who was responsible for the application. Secondly, the present case does not involve any error of law. In any case, if one uses the term "error" as it was used in J 1/20, the error in the present case consisted in the professional representative's (i.e. Mr Broderick's) lack of knowledge that the time limit for paying the 6th renewal fee with surcharge had not been observed. As set out above, this error persisted at the latest until 2 July 2020 when Mr Broderick had - as evidenced by his own email, and hence without doubt - knowledge of the fact that this time limit had not been observed, which had led to a loss of rights.
16. In the oral proceedings before the Board, the appellant additionally submitted that the "error" within the meaning of J 1/20 had been Mr Broderick's erroneous belief that the applicant would pay the renewal fee with surcharge himself. However, even if one followed this line of argument, Mr Broderick would have known at the latest as of 2 July 2020 that the applicant had, in fact, not paid the renewal fee himself. Hence, also

pursuant to this approach, the cause of non-compliance would have been removed on 2 July 2020.

17. In general, the present Board is of the view that the term "error" can sometimes be misleading when assessing the factual question as to when the cause of non-compliance within the meaning of Rule 136(1) EPC was removed. Rule 136(1) EPC does not speak about the removal of an error, but about "the removal of the cause of non-compliance". Removal of the cause of non-compliance does not necessarily require the correction of a wrong understanding of reality by a party or its representatives, which is how "error" was understood by the appellant. Rather, as set out above, the cause of non-compliance with a time limit is, as a rule, removed when the person responsible for the application becomes aware that the time limit was not observed, for example by receipt of a loss of rights communication under Rule 112(1) EPC.
18. In conclusion, in the present case, the cause of non-compliance under Rule 136(1) EPC was removed when the professional representative Mr Broderick became aware of the missed time limit and the lapse of the application, which is established to have been the case at the latest on 2 July 2020. The appellant's request for re-establishment dated 16 September 2020 was not filed within two months of that date and is therefore inadmissible.
19. For these reasons, the appeal is not allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



C. Spira

C. Herberhold

Decision electronically authenticated