

Pitfalls in procedures before the EPO

Selected decisions by the Boards of Appeal

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Agenda

- Language issues
- Postponement of oral proceedings
- Problems on entry into EP Phase
- Assignments and priority
- Procedural issues
- Re-establishment of rights
- When is late too late? – late filing of evidence, requests or arguments



Language Issues

Consequences of G1/15

Translations in Examination – T655/13

- Examining division cites a Japanese document as main prior art (D1)
- Examining Division *must provide the translation* used in the examination proceedings of at least the relevant sections of the document
- Why? The board needs to be able to examine the reasons for the decision



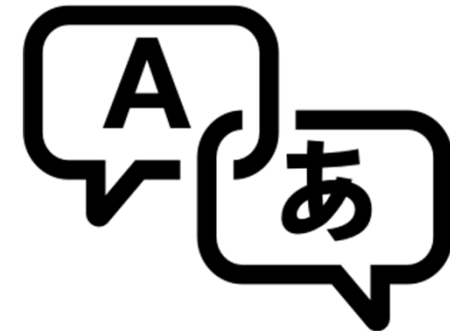
Machine Translations

- **Guidelines G-IV 4.1**

- Appropriate for the examiner to rely on a machine translation of a document in a non-official language
- If a party objects to the use of a specific machine translation, that party bears the burden of adducing evidence (in the form of, for instance, an improved translation of the whole or salient parts of the document) showing the extent to which the quality of the machine translation is defective and should therefore not be relied upon.

- **T 1332/12:**

- In opposition an originally filed (machine) translation into English of a prior-art document may later be brought into conformity with the original



Language of divisional - Rule 36(2) EPC

- A divisional application shall be filed in the language of the proceedings for the earlier application. If the latter was not in an official language of the European Patent Office, the divisional application may be filed in the language of the earlier application; a translation into the language of the proceedings for the earlier application shall then be filed within two months of the filing of the divisional application...

J 13/14 – language problems...

- PCT application filed in German
- On entry into the European phase, an English translation was filed, but German was used as language as the proceedings.
- A divisional application was filed in English

J 13/14

- Exception in Rule 36(2) from the requirement that divisional must be filed in language of proceedings of parent only applies to applications not originally in one of the 3 allowed languages.
- The divisional application was not processed as a European divisional application
- Correction not possible!



Oral Proceedings

postponements

Postponement of oral proceedings

- Guidelines E-III 7.1.1
 - Postponement of oral proceedings only upon serious reasons
 - Example: serious illness
 - Sufficiently substantiated written statement indicating reasons is required

How about this?

- Oral proceedings before ED summoned
 - Final date for written submissions: 6 January
- On 30 December, postponement of the oral proceedings and of the final date for filing written submissions requested:
 - The patent had just been transferred to different applicant
 - Change of representative likely.
- The request was refused:
 - Sale was not considered a serious reason.
 - New applicant could have familiarized himself with application in advance
- Application was refused

T 1705/14

- The Examining Division has discretion to postpone the final date for written submissions and the date of oral proceedings
- Examining Division has to provide separate reasoning for not allowing postponement of final date for written submissions
- Not doing so was a procedural violation
- Case remitted to 1st instance
- However:
 - The applicant could have filed submissions even after the final date, but did not
 - Therefore, no refund of the appeal fee
- So: try to request postponement, but act if the request is not granted

The day before oral proceedings

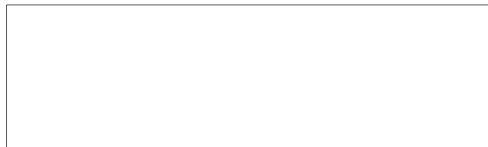
- Fax by representative:
 - *"As discussed by telephone today with the Chairman of the Examining Division, the representative on this case has been taken ill and is not able to attend the EPO for the Oral Proceedings scheduled for 6 February 2013 (tomorrow).*

Regrettably, we ask for the Oral Proceedings to be postponed. Please let us know the new date for the Oral Proceedings."
- Fax from Examining Division:
 - Just illness, not serious illness
 - Request not sufficiently substantiated
 - Date of oral proceedings maintained

How serious does an illness have to be?
How much reasoning is required?

T 447/13

- “Serious illness”:
 - an illness which is sufficiently serious to prevent the representative travelling to oral proceedings and presenting the case on the appointed day
- Examining Division must *explain why it considers the substantiation insufficient*. In other words, it should state in clear terms what, in its opinion, should have been submitted or explained



Problems on entry into EP Phase

What a mess...

2005:

- German applicant files PCT application with USPTO, The application is assigned number PCT1

2006:

- application enters EP phase; assigned number EP1

2008:

- USPTO forwards PCT application to IB, as USPTO is not competent as RO!
- IB assigns new appl. no. PCT2
- EPO assigns new EP appl. number EP2
- EPO informs applicant that EP2 is deemed withdrawn for failure to enter EP phase
- IB informs applicant that fees for international phase had not been paid and invites applicant to pay within 1 month
- IB informs applicant that PCT2 is deemed withdrawn



2014:

- Receiving Section consolidates proceedings for EP1 and EP2 (now only EP1),
- withdraws earlier notice of loss of rights, but declares that EP1 cannot be processed as it was deemed withdrawn in the international phase.
- Time limit for review under Art. 24(2) and 25(2) PCT were expired

PCT review and excuse procedure

- IF PCT application is lost during PCT phase (e.g. deemed withdrawal), there is no remedy in the international phase.
 - Remedies should be sought before designated offices:
 - In case of erroneous determinations: Art. 25(2) PCT which provides a time limit
 - In case of correct determinations: Art. 24(2) PCT which does not explicitly provide a time limit
1. Does the same time limit apply?
 2. Can the EP application after entry into EP phase still be affected by a subsequent determination by the IB way past the 31 month time limit?
 3. Can the applicant be excused because he acted in good faith?

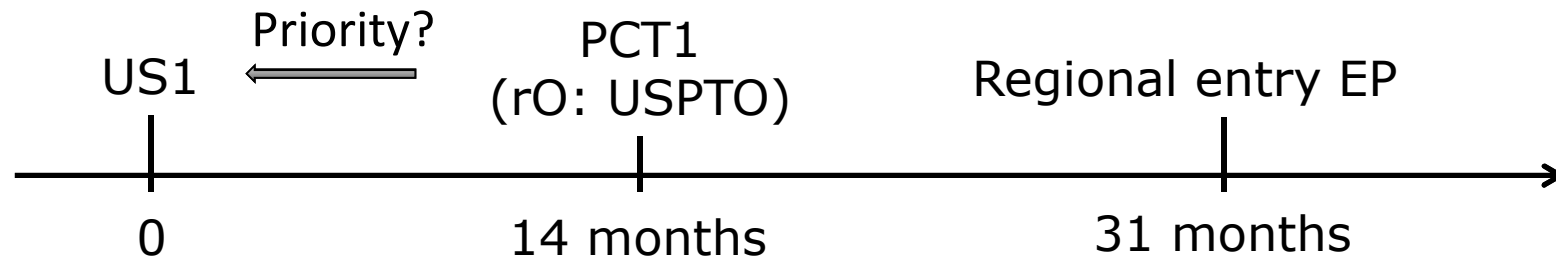
J 19/16

1. Does the same time limit apply?
 - No! The time limit for making a request to be excused under Article 24(2) PCT is subject to national law only. The two-month time limit pursuant to Article 25 PCT is therefore not applicable under Article 24(2) PCT.

2. Can the EP application after entry into EP phase still be affected by a subsequent determination by the IB way past the 31 month time limit?
 - Yes! There is no time limit for the RO/IB to determine that the international application is deemed withdrawn due to failure to pay the prescribed fees

3. Can the applicant be excused because he acted in good faith?
 - No! The applicant should have immediately acted when IB informed about loss of rights in 2008

Restoration of right of priority - J13/16



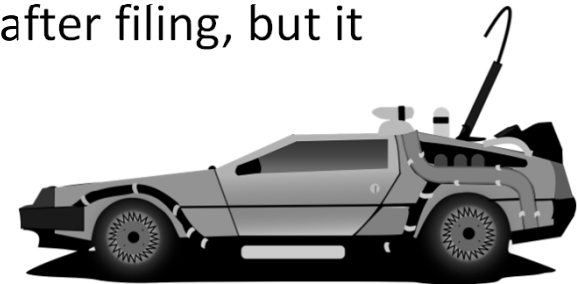
- Request for restoration of priority filed with USPTO as rO (Rule 26*bis*.3 PCT) - Granted under "unintentional" criterion.
- Restoration not effective before the EPO as designated Office, since the EPO applies the "due care" criterion (Rule 49ter.1(b) PCT).
- The applicant must file a (new) request for restoration of a right of priority under Rule 49ter.2 PCT with the EPO acting as designated Office
- Re-establishment of rights under Article 122 EPC is ruled out in respect of the 1-month period under Rule 49ter.2(b)(i) PCT for filing a request for restoration of a right of priority.

Priority

Right to claim priority

T 577/11 – No retroactive transfer

- Art. 87(1) EPC: the applicant of a previous application or “his successor in title” has a right to claim priority.
- Any transfer of right to priority needs to take place prior to the filing of EP application
- In the present case, the agreement was executed after filing, but it explicitly stated that it had retroactive effect
- Retroactive transfer not accepted by EPO!
- So, at the time of filing, the applicant did not enjoy the right to claim priority!



T 1201/14 – Entitlement to claim priority

- What is the standard of proof when showing that an effective transfer of right had occurred in due time?
- What national law to be applied?

T 1201/14 – Formal requirements?

- EPC contains neither guidance as to the formal requirements for a valid transfer of the ownership of the right of priority nor conflict-of-laws provisions for that purpose.
 - No separate formal assignment "in writing" required under the EPC
 - Even an implicit transfer of a particular right may be accepted when it is sufficiently clear that the parties formed an agreement and what they agreed.
 - No established jurisprudence of the Boards of Appeal as regards the national law generally applicable to the question of the transfer of the right of priority
- It is up to the applicant/proprietor to prove that right was indeed transferred
- See also T 1103/15



Procedural issues

Conduct of the EPO
... and of the parties

What's wrong with this decision?



European Patent Office
80298 MUNICH
GERMANY

Questions about this communication ?
Contact Customer Services at www.epo.org/contact



Dodbiba, Eno
Str. Naim Frasher, pa. 60/3
Shk. 1, P.60/3, Ap.16
Tirana
ALBANIE

Date
28-07-2017

| | |
|---|---|
| Reference DE/04/260311 | Application No./Patent No. 12740277.4 - 1653 / 2750567 |
| Applicant/Proprietor Elezi, Dashamir | |

DECISION

...

17. For this reason, the request for re-establishment is rejected due to its inadmissibility.

Examining Division



J 16/17 – signatures are important

- Rule 113(1) EPC: decisions from the EPO must be signed by and state the name of the employee responsible.
- Not just a mere formality but an essential procedural step in the decision-taking process.
- The name and the signature serve to identify the decision's authors and express that they unconditionally assume responsibility for its content.
- This requirement is aimed at preventing arbitrariness and abuse and ensuring that it can be verified that the competent body has taken the decision.
- Violation of the requirement pursuant to Rule 113(1) EPC amounts to a substantial procedural violation and renders the decision erroneous.

- Appeal fee refunded
 - ...but the decision was upheld in substance

- Similar, if decision signed by wrong person (e.g. the boss of a member of the examining division instead of the member)

Principles for corrections of errors (R. 139 EPC)

G 1/12, reasons 37:

- (a) The correction must introduce what was originally intended.
- (b) Where the original intention is not immediately apparent, the requester bears the burden of proof, which must be a heavy one.
- (c) The error to be remedied may be an incorrect statement or an omission.
- (d) The request for correction must be filed **without delay**.

What does “without delay” mean?

T 579/16 - What does without delay means?

- Depends on the specific circumstances of the case
- Is a subjective criterion which depends on how immediate a reaction could have been expected from the person requesting the error
- "Ohne schuldhaftes Zögern"

Mail not received ??



- Opponent appeals 1st instance decision to reject opposition
- Notice and Grounds of Appeal were sent to the proprietor (registered letters)
- Proprietor did not react
- The patent was revoked by the Board of Appeal without oral proceedings
- The decision was sent to proprietor (registered letter with advice of delivery)
- The proprietor files a petition for review asserting that they never received the notice and grounds of appeal and arguing that their right to be heard had been violated by the immediate revocation of the patent

Petition for Review – R 4/17

- In the event of any dispute, it is incumbent on the EPO to establish that the letter has reached its destination or to establish the date on which the letter was delivered to the addressee
- Implausible? It cannot be expected that the Petitioner proves the negative or provide a plausible explanation
- In the absence of evidence from outside the EPO, the letters must be considered not to have been communicated
- At least for the purposes of Article 113(1) EPC, parties and their representatives have no duty to monitor the proceedings by regularly inspecting the electronic file
- The case was reopened





Re-establishment of rights

Chain of events - payment of appeal fee:

- Standard procedure:
 - Assistant checks account status of EPO debiting account with accounting department
 - If sufficient funds, assistant files notice of appeal and pays fee in epoline
 - Only then, the time limit is closed
- Specific events:
 - Normal assistant replaced by (experienced) substitute
 - Accounting department did not revert when asked about account status
 - Representative decides to file notice of appeal and to wait with payment until answer received from accounting
 - Assistant files notice of appeal and erroneously closes time limit
 - Accounting never got back with an answer, so fee was never paid
- All due care??

T 2406/16

- Established criterion:
 - 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**.

T 2406/16

- Normal procedure, when used as intended by an experienced and well trained assistant under the supervision of a carefully acting representative, could under most circumstances provide a satisfactory monitoring system.
- **BUT:**
- “Changing the normal routine of checking whether the appeal fee has been paid when the notice of appeal is being sent and leaving it, instead, to the assistant to pay the appeal fee as soon as she received information from the accounts department regarding the required funds, meant intentionally deviating from a potentially satisfactory system to a system that was subject to uncertainties.”

Missed renewal fee

- Normal procedure:
 - Patentee enters information from representative into renewal system (“Ipendo”).
 - The entered information is cross-checked
 - Renewal payments are then handled automatically by the system
- What happened:
 - Information about EP application has erroneously not been added into the renewal system
 - So: no payment; system did not create any reminders (because it was not aware of the existence of the application)
 - Reminders by the representative had been received but not led to any action
- Applicant requests re-establishment....

J 24/13 – Request allowable?

- A cross-check was only performed in so far as the data *already entered* in IPENDO were compared with documents submitted by the appellant's patent attorneys.
- Such a check is obviously not suitable for detecting missing data in the IPENDO system and therefore cannot be considered as an independent and effective crosschecking system as required by the jurisprudence of the boards of appeal.
- Thus the mistake that the application in suit was not uploaded into IPENDO cannot be considered as an isolated error in a normally satisfactorily working monitoring system.

A Christmas tale *nightmare*

- Time limit for filing notice of appeal: 4 January 2016
- Representative prepared letter on 24 December 2015 and handed it over to assistant
- Only one assistant at work, so representative agreed to do the cross-check after Christmas.
- Letter stated: "The appeal fee is paid via the enclosed EPO form 1010" - but no form 1010 was actually filed.
- On 28 December 2015, the representative checked the acknowledgement of receipt, but did not notice that receipt of form 1010 was not acknowledged.
- 19 April 2016: applicant was informed of the loss of rights due to failure to pay the appeal fee.
- Questions?
 1. Should the EPO have considered the letter as authorization to charge the debit account?
 2. What is the date of removal of the cause of non-compliance?
 3. Did the representative exercise due care?

T 198/16

1. Should the EPO have considered the letter as authorization to charge the debit account?

- Board disagrees with former case law that the expressed intention to pay by debit order is sufficient:
- *“An intention to make a payment remains a (mere) intention and not a payment, no matter whether or not the EPO has access to sufficient funds of the person or entity intending to pay which would, as a matter of fact, make it possible for the EPO to avail itself of those funds. The reason is that the EPO is simply not entitled to do so under its own rules.”*

T 198/16

2. What is the date of removal of the cause of non-compliance?

- Earlier case law applied a due-care criterion:
 - When **should** the non-compliance have be discovered?
- Board has doubts as to whether this is the right approach as it extends the substantive due-care criterion to an admissibility question!
- “The question is whether the representative should have detected the non-filing of Form 1010 before expiry of the time limit for payment of the appeal fee:

if he should have discovered it, then the re-establishment time limit would start (deferred to the end of the period for filing the notice of appeal, i.e. from 28 December 2015 to 4 January 2016) and, for the same reason, in the subsequent substantive analysis, due care in complying with the time limit would also have to be denied.”
- *Ultimately, the board left this question unanswered and turned to question 3!*

T 198/16

3. Did the representative exercise due care? NO!

- Representative did not clearly and expressly instruct the assistant to make the payment!
- Representative's oversight when checking the acknowledgement of receipt is not excusable, even if it may have been an isolated mistake.
- Only isolated mistakes by assistants can be excused.
- "At the outset it should be noted that the need for a double-check of the assistant's work by the representative in the special circumstances described above arose from their agreement. It is therefore immaterial that, in the absence of such special circumstances, a double-check, unlike in the case of monitoring time limits, might not have been required by the EPO's case law."

T 1897/17 - Late filing of notice of appeal

- All due care denied:
 - No effective communication and case not dealt with in good time:
 - Several reminders to inventors
 - Appellant only contacted on the day before expiry of time limit
 - No reliable system
 - Assistant was told by (non-EPA) attorney that the case had already been sent off; so the assistant crossed off the time-limit as completed
 - Problem: the attorney was talking about a different case he was also dealing with and which was not on the assistant's list; so the assistant erroneously crossed off the deadline as completed
 - No independent cross check, EPA not involved

What is the status of the appeal?

- Notice of appeal filed late and appeal fee paid late (next working day when the attorney discovered the mistake)?
- More specifically:
 - Is appeal deemed not filed or inadmissible?
 - i.e. is appeal fee to be refunded or not?

T 1897/17

- Reviewed the case law
- Majority of decisions decided "deemed not filed"
- Even referred once to EBoA, but in that case the EBoA found that it did not need to answer (see G1/14).
- T1897/17 followed the minority line and decided "inadmissible"

- Subsequently the president of the EPO asked this question to the EBoA – pending as G1/18

- Maybe we get an answer this time...

When is late too late?

Admissibility of requests, evidence etc.

Late filed evidence

- General criteria:
 - Prima facie relevance
 - Most important criterion in 1st instance (GL E-VI, 2)
 - How late?
 - State of proceedings
 - Why late?
 - Legitimate reaction to development of the proceedings?
 - Misuse of procedure?



Late-filed requests

- General criteria
 - Address raised issues?
 - Legitimate reaction?
 - Based on claims as granted?
 - Convergence?



Late submissions on appeal

- Art. 12(4) RPBA:

Without prejudice to **the power of the Board to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first instance proceedings**, everything presented by the parties under (1) shall be taken into account by the Board if and to the extent it relates to the case under appeal and meets the requirements in (2).

Late-filed documents

- Opponent had not raised any objections against dependent claims 2-4 in written submission.
- At 1st instance oral proceedings, claims 2-4 were attacked but still without citing any prior art.
- During appeal, the appellant-opponent files 5 new documents supporting an attack against dependent claims 2-4.

T 2193/14

- Documents not admitted.
- The Appellant-opponent should have filed the documents during 1st instance opposition when attacking the same claims.

Late filed requests

- Patent was maintained in amended form in 1st instance.
- Only the opponent appealed.
- Patent proprietor's (respondent's) requests on appeal:
 - Main request: Maintenance of the patent in the form accepted by 1st instance.
 - Newly filed 1st auxiliary request based on limitations from the description.
 - 3 further auxiliary requests (2-4) were “re-filed”
 - They had been filed in opposition proceedings.
 - The 3 requests did not include the limitation added in 1st aux. request

T 1903/13

- 1st aux request admitted but not allowed:
 - Claims more narrow than claims accepted in 1st instance
 - Bona fide attempt to overcome grounds of appeal
 - In the end: claims rejected for lack of inventive step.
- 2nd to 4th Aux request not admitted:
 - Even though they had already been filed during 1st instance!
 - Patent proprietor attempted to have claims reviewed that diverged from higher ranking request

Late-filed arguments?

Art. 114 EPC - Examination by EPO of its own motion

- (1) In proceedings before it, the European Patent Office shall examine the facts of its own motion; it shall not be restricted in this examination to the *facts, evidence and arguments* provided by the parties and the relief sought.
- (2) The European Patent Office *may disregard facts or evidence* which are not submitted in due time by the parties concerned.

Earlier case law

- T1621/09:
 - First instance proceedings:
 - New arguments can be introduced at any stage of the proceedings
 - Appeal proceedings:
 - Based on Rules of Procedure of the Boards of Appeal (RPBA):
 - A new argument brought forward in appeal proceedings by a party which would have the effect of amending its case, even if the argument is based on evidence and facts already in the proceedings, can only be introduced into the proceedings at the discretion of the Board of Appeal
- This decision was later followed by other decisions

T 1914/12 - Late arguments cannot be ignored

- Art. 114 EPC distinguishes between
 - a) facts and evidence
 - b) arguments
- Article 114 (2) EPC only provides for a discretionary power with regard to late-filed facts and evidence
- The Rules of Procedure of the Boards of Appeal cannot confer powers which the EPC does not give.
- **The Boards of Appeal do not have a discretion to not admit late arguments which are based on facts that are already in the proceedings.**

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