

CHAMBRE DE RECOURS JURIDIQUE  
30 NOVEMBRE 1984  
J 01/84

DOSSIERS BREVETS 1984.VI.J 36

GUIDE DE LECTURE

Restitutio in integrum : oui

I - LES FAITS

- 1er mars 1979 : ORNSTEIN dépose une demande de brevet européen n.79.300.305.4 par l'intermédiaire d'un mandataire.
- 31 mars 1982 : Echéance de la quatrième annuité, sans paiement.
- 30 septembre 1982 : Fin du délai de grâce de l'article 86(2) CBE, sans paiement.
- 3 novembre 1982 : Conformément à la règle 69(1) CBE, l'OEB avise le mandataire du déposant que la demande est réputée retirée en application de l'article 86(3) CBE et l'informe de la possibilité de former un recours selon l'article 69(2).
- 16 mars 1983 : Le mandataire du déposant forme un recours en restitutio in integrum (article 122 CBE).
- 23 mars 1983 : Le montant de la quatrième annuité, la surtaxe de retard et la taxe de recours parviennent à l'OEB.
- 29 juillet 1983 : L'OEB rejette le recours en restitutio in integrum au motif (erronné) du non-paiement des sommes dues.
- 20 septembre 1983 : Le déposant fait appel
- 16 février 1984 : La Chambre de Recours juridique avise le déposant qu'elle rectifie la décision du 2 juillet 1983 et lui demande d'établir qu'il a "fait preuve de toute la vigilance nécessaire par les circonstances" conformément à l'article 122.1 CBE.
- 11 avril 1984 : Un nouveau mandataire fournit des informations sur les raisons du retard. Le premier mandataire éprouvait des difficultés qu'il s'efforçait de résoudre de son mieux, ainsi que le prouvent d'autres demandes de restauration accueillies pendant la même période.
- 30 novembre 1984 : La Chambre de Recours juridique reforme la décision du 29 juillet 1983, restaure le déposant dans ses droits et ordonne le remboursement de la taxe d'appel.

## II - LE DROIT

### A - LE PROBLEME

Dans quelle mesure l'erreur du mandataire peut-elle justifier la restauration au titre de l'article 122 CBE ?

### B - LA SOLUTION

#### 1°/ Enoncé de la solution

5. "La situation dans la présente espèce est inhabituelle, en ce que la preuve est rapportée devant la Chambre qu'à l'époque où le paiement de l'annuité a été omis et où la restauration a été demandée, le mandataire du déposant conduisait ses affaires pratiquement seul, dans un grand désarroi personnel. Les choses ont tourné mal, mais il est équitable d'admettre qu'il avait fait de son mieux pour les redresser. La preuve de ces difficultés se trouvait déjà dans les dossiers de l'OEB en relation avec les demandes de restauration faites antérieurement".
6. "Dans les circonstances très exceptionnelles de l'espèce, la Chambre considère donc qu'il serait opportun de tenir compte de tels éléments de preuve. En conséquence, la Chambre est en situation de prendre une décision en tenant compte de toutes les circonstances de l'affaire".
8. "La Chambre déclare donc pouvoir ordonner la restauration des droits".

#### 2°/ Commentaire de la solution

Tout en rappelant le caractère exceptionnel des faits (le mandataire a demandé à ce que les preuves par lui fournies restent confidentielles), la Chambre de recours admet que l'erreur du mandataire puisse justifier la restauration. Le mandataire est réputé avoir fait "preuve de toute la vigilance nécessitée par les circonstances" au sens de l'article 122 de la Convention de Munich, dès lors qu'il a fait son possible pour surmonter les difficultés qu'il éprouvait dans la conduite de ses affaires et qui expliquent le non-paiement des annuités.

Europäisches  
Patentamt  
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European Patent  
Office  
Boards of Appeal

Office européen  
des brevets  
Chambres de recours



Case Number: J 01 / 84

J36

**DECISION**  
**of the Legal Board of Appeal**  
**of 30 November 1984**

**Appellant:** ORNSTEIN, Leonard  
5 Bilton Road  
White Plains  
New York 10607 (US)

**Representative:** Fentiman, Denis Richard et al.  
ELKINGTON & FIFE  
High Holborn House  
52-54 High Holborn  
London WC1V 6SH (GB)

**Decision under appeal:** Decision of the Head of the Formalities  
Section of Directorate General 2 dated  
29 July 1983 rejecting a request for  
re-establishment of rights pursuant to  
Article 122 EPC.

**Composition of the Board:**

Chairman: R. Singer  
Member: P. Ford  
Member: O. Bossung

SUMMARY OF FACTS AND SUBMISSIONS

- I. European patent application No. 79 300 305.4 was filed on behalf of the appellant on 1 March 1979. The renewal fee due in respect of the fourth year fell due on 31 March 1982 but payment was not made either by the due date or within six months thereafter, subject to the payment of an additional fee, as provided by Article 86(2) EPC.
- II. By registered letter dated 30 April 1982, the Formalities Officer acting for Directorate General 2 advised the appellant's representative that payment had not been made by the due date but that it could still be made, with payment of an additional fee, as provided by Article 86(2) EPC. No acknowledgement of the letter was received.
- III. By a further registered letter dated 3 November 1982, constituting a communication pursuant to Rule 69(1) EPC, the Formalities Officer advised the applicant's representative that the fourth renewal fee had not been paid, in spite of the previous letter, and that the European patent application was deemed to be withdrawn pursuant to Article 86(3) EPC. The appellant's representative was informed that if the finding of the EPO was inaccurate he might apply for a decision on the matter in accordance with Rule 69(2) EPC. No acknowledgement of the letter and no application for a decision under Rule 69(2) EPC was received.
- IV. By a letter dated 16 March 1983, the appellant's representative applied under Article 122 EPC for re-establishment of rights, stating that it only came to his notice that the renewal fee for the fourth year had not been paid when he took up the file to attend to the payment of the fee for the fifth year which was due by 31 March 1983. The letter stated that the fee for the fourth year, the additional fee for the late

payment of that fee, the fee for application for re-establishment of rights and the renewal fee for the fifth year had been forwarded to an EPO bank account on 16 March 1983.

- V. The request for re-establishment of rights was rejected by a decision of the Head of the Formalities Section of Directorate General 2 dated 29 July 1983. The substantial ground for rejection of the request was that it was deemed not to have been filed as the fees alleged to have been forwarded to the EPO bank account had not been paid into the account.
- VI. In fact, the information available to the Head of the Formalities Section was incorrect. The fees alleged to have been forwarded had been duly paid into the EPO bank account on 23 March 1983.
- VII. By letter dated 20 September 1983, received on 23 September 1983, the appellant filed a Notice of Appeal and Statement of Grounds of the Appeal. The appellant's representative alleged that the non-payment of the renewal fee for the fourth year had been due to an oversight and that the omitted act had been completed immediately the oversight was appreciated. It was alleged and proved by documents supplied that the fees forwarded to the EPO bank account had been duly paid in on 23 March 1983.
- VIII. Additional information about the circumstances in which the renewal fee for the fourth year had not been paid was given in a letter received by the EPO on 17 November 1983.
- IX. By a communication dated 16 February 1984, the Legal Board of Appeal informed the applicant's representative that it was satisfied that the decision under appeal was not correct in holding that the request for re-establishment of rights must be deemed not to have been filed on the ground that the fee for re-establishment of rights had not been paid. The Board

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was also satisfied that the application for re-establishment of rights had been filed within two months from the removal of the cause of non-compliance with the time limit. However, the Board was not satisfied that the application for re-establishment of rights had set out the facts on which it relied. It was clear that an applicant for re-establishment of rights must set out the facts establishing that all due care required by the circumstances had been taken.

- X. A reply to this communication was received on 11 April 1984 from another professional representative who stated that he had been instructed to take over the matter from the appellant's previous representative. An authorisation in favour of the new representative was duly filed. More information about the circumstances in which the fourth renewal fee had not been paid was supplied but it was requested that the documents be excluded from inspection pursuant to Article 128(4) and Rule 93(d) EPC.
- XI. On 17 May 1984, the Vice President of the EPO responsible for Appeals made an order under Rule 93(d) EPC excluding the documents in question from inspection on the ground that such inspection would not serve the purpose of informing the public about the European patent application.
- XII. In response to a second communication from the Legal Board of Appeal dated 17 May 1984, the appellant's new representative supplied additional information about the circumstances of the case under cover of a letter dated 14 September 1984.
- XIII. A further order under Rule 93(d) EPC excluding from inspection the documents supplied with the letter of 14 September 1984 was made by the President of the EPO on 27 September 1984.
- XIV. The files of the EPO show that other cases handled by the appellant's previous representative in the period in question

had also been the subject of granted requests for re-establishment of rights or further processing.

REASONS FOR THE DECISION

1. The appeal complies with Articles 106-108 and Rule 64 EPC and is, therefore, admissible.
2. The decision that the appellant's application for re-establishment of rights was deemed not to have been filed as the fee for re-establishment of rights had not been duly paid was based on incorrect information and must accordingly be set aside.
3. The appellant's application for re-establishment of rights was filed within two months from the removal of the cause of non-compliance with the time limit, namely the appreciation by the appellant's former representative that the renewal fee for the fourth year had inadvertently not been paid, and the omitted act was completed by the payment of the fee for that year, together with the additional fee, also within the said period of two months. Furthermore, the application was made within the year immediately following the expiry of the unobserved time limit on 31 March 1982. Accordingly the provisions of Article 122(2) EPC are satisfied.
4. The difficulty in the present case has proved to be that the application as originally presented did not appear to the Legal Board of Appeal to comply with the requirements of Article 122(3) EPC that such an application must not only state the grounds on which it is based (here, an inadvertent oversight) but also set out the facts on which it relies.
5. The situation in the present case is unusual, in that there is evidence before the Board that both at the time when the matter of payment of the renewal fee was overlooked and sub-

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sequently when the re-establishment of rights was applied for the appellant's representative was carrying on his practice virtually single-handed under conditions of extremely acute personal stress. Things went wrong but it is only fair to say that he did his best to put them right. Evidence as to the difficulties he experienced was already in the files of the EPO in relation to the applications for re-establishment of rights previously made by him.

6. In the very exceptional circumstances of the case, therefore, the Board considers that it would be appropriate to take such evidence into account. Accordingly the Board is in a position to take a decision having regard to all the circumstances of the case.
7. From the statement of the representative concerned, it is clear that the failure to pay the fourth renewal fee by the due date was wholly inadvertent, due in the first place to a diary error and due also to confusion of the case in question with another case which the representative had been instructed to abandon, so that when he received notification that the renewal fee for the present case was unpaid and subsequent notification that the European patent application in the present case had lapsed, he disregarded them.
8. The Board is accordingly satisfied that this is a proper case in which to order re-establishment of rights.
9. The decision of the Head of Formalities is being set aside on the ground that it was based on incorrect information available to him. To base a decision on incorrect information constitutes a substantial procedural violation for the purposes of Rule 67 EPC and it is equitable to order reimbursement of the appeal fee.

10. As the fee for re-establishment of rights was duly paid on 24 March 1983, an additional fee of L 1 (one pound sterling) subsequently demanded on the ground that the sterling equivalent of the first mentioned fee had been increased and paid on 17 November 1983, should not have been asked for and must be reimbursed.

ORDER

For these reasons

It is ordered that:

1. The decision of the Head of the Formalities Section of Directorate-General 2 dated 29 July 1983 is set aside and the appellant is restored in his rights in accordance with his request.
2. The appeal fee shall be reimbursed to the appellant.
3. The additional fee of L 1 paid on 17 November 1983 shall be refunded to the appellant.

