



## Determining The Deadline For Requesting Re-Establishment at the EPO

Patent offices across the globe have various restoration provisions that may be used to remedy a missed deadline. At the European Patent Office, re-establishment of rights under Article 122 EPC may be used to recover rights if a deadline is missed that directly results in loss of rights relating to a European patent application or granted patent. As set out in Article 122(1) EPC, the European Patent Office shall re-establish rights if the applicant or proprietor can demonstrate that they were unable to observe the missed time limit in spite of all due care required by the circumstances having been taken. The deadline for requesting re-establishment of rights is provided in Rule 136(1) EPC which specifies that in most cases the deadline is the earliest of (i) two months from the so-called “removal of the cause of non-compliance” and (ii) one year from the expiry of the unobserved time limit.

As set out in Rule 136(3) EPC, re-establishment of rights is ruled out in respect of the period for requesting re-establishment of rights itself. Accordingly, there is no remedy for late filing of a request for re-establishment of rights. It is therefore crucially important that the deadline provided in Rule 136(1) EPC is met. However, this may be complicated by the fact that the determination of the deadline may not be clear-cut. This briefing considers the factors relevant to calculation of the deadline.

### 1. Removal of the cause of non-compliance

Unless the originally missed deadline expired more than 10 months previously, the deadline for requesting re-establishment of rights is usually set by the requirement to request re-establishment of rights within two months of the removal of the cause of non-compliance. The cause of non-compliance may be thought of as the reason that the applicant or proprietor was unable to observe the missed time limit. The date when it is considered that the obstacle is removed starts the two month period.

#### 1.1 Time limit missed due to error

The cause of non-compliance is very often an error which resulted in the relevant person being unaware of the original deadline or failing to take the necessary action. In this case, removal of the cause of non-compliance is commonly, but not always, the date on which it is discovered that the original deadline has been missed. That is, removal of the cause of non-compliance is often the date of discovery of the error.

##### 1.1.1 Events triggering the two month time limit

Under Rule 112(1) EPC, if the EPO notes that a loss of rights has occurred in connection with a European patent or application, it will issue a notice to this effect. Often, it is receipt of this notice of loss of rights that results in discovery of the error that had caused the deadline to be missed. It is established in the case law (see J 27/90, J 16/93 and J 22/97) that, in the absence of

circumstances to the contrary, receipt of the notice of loss of rights by the applicant or the European representative removes the cause of non-compliance.

It is important to note that, in cases where receipt of the notice of loss of rights removes the cause of non-compliance, the two month time limit for requesting re-establishment of rights runs from the date of actual receipt (J 7/82, confirmed in J 32/86). The legal fiction of Rule 126(2) EPC, under which prior to 1 November 2023 a letter from the EPO is deemed to have been delivered to the addressee on the tenth day following the date of the letter, has no effect on the date of removal of the cause of non-compliance as set out in T428/98 and confirmed in T 2251/12. It is the actual date of receipt that is used to calculate the deadline.

However, the receipt of a loss of rights notice following an erroneously missed deadline does not necessarily trigger the two month period for requesting re-establishment of rights. In T 900/90, the Board of Appeal emphasised that in cases in which receipt of the notice of loss of rights is considered to remove the cause of non-compliance, it must be established that neither the European representative nor the applicant was aware that rights had been lost *before* the receipt of the notice. The cause of non-compliance may be removed before the notice of loss of rights is received if a person responsible for the application becomes aware of the loss of rights in another way. In that scenario, the cause of non-compliance is removed on the date that person becomes aware of the erroneously missed deadline.

In certain circumstances, the cause of non-compliance may be found to have been removed later than the date of receipt of the notice of loss of rights. However, the onus is on the applicant to overcome the presumption that the cause of non-compliance was removed by the receipt of the loss of rights notice. This was the case in J 29/86, for instance, wherein confusion surrounding the procedure for responding to a notice of allowance meant that the applicant did not realise that any rights had been finally lost, despite receipt of a notice of loss of rights. Here, the cause of non-compliance was removed only when the applicant received a later communication, clarifying the procedure and advising that re-establishment of rights should be requested.

In another case, J 16/93, the representative experienced difficulties in reporting a notice of loss of rights to the applicant, as the applicant had not been able to notify their representative of a change in address due to serious illness. The cause of non-compliance was considered removed when the representative was finally able to contact the applicant, some time after the representative had received the notice of loss of rights.

A further example is provided in J 22/97. Here, the IP director of the applicant received a notice of loss of rights inviting further processing, but decided not to revive the application on the basis that the claim set provided by his assistant to review in tandem with the notice was not of interest. Subsequently, it was discovered that the assistant had provided the wrong claim set, and that the application should in fact have been maintained. Discovery of this error, rather than receipt of the notice of loss of rights, was taken as removal of the cause of non-compliance.

#### 1.1.2 The relevant person

The identity of the person discovering the error is often relevant to correctly determining the removal of the cause of non-compliance.

If the party concerned is represented by a professional representative, then receipt of a notice of loss of rights by the representative removes the cause of non-compliance in the absence of circumstances to the contrary (J 27/90 and J 24/04). However, if the error is discovered by an employee of the representative, such as an assistant or secretary, the cause of non-compliance may be removed only when the representative themselves is aware of the facts (T 191/82).

This principle was demonstrated in T 629/15. In this case, a European representative sent a notice of loss of rights arising from non-payment of a renewal fee to the applicant's counsel in the US. During a subsequent phone call, it was established that non-payment was erroneous. Re-establishment of rights was requested within two months of the phone call, but not within two months of the European representative receiving the notice of loss of rights. The request was rejected as out of time, as the Board held that the cause of non-compliance was removed by receipt of the notice of the European representative, given that the European representative maintained responsibility for the application. Arguments that the European representative could not have known that non-payment was erroneous when the notice was received were not persuasive.

In some instances, however, the relevant person may be someone different. For example, in J 6/2018, the European representative forwarded a notice of loss of rights arising from non-payment of a renewal fee to the applicant's counsel in the US, who had been specifically entrusted with the monitoring and payment of renewal fees. Due to issues with the US counsel's computer system, the European representative's email was archived and did not appear in his inbox. The Board held that, in normal circumstances, the date of forwarding of the notice to US counsel would remove the cause of non-compliance. However, in view of the technical issues, this did not apply. The cause of non-compliance was instead removed when the applicant subsequently assumed responsibility for the case themselves, and found the notice in the EPO's online file.

#### 1.1.3 The "ought to have" approach

As explained above, determination of the date of removal of the cause of non-compliance usually follows a careful assessment of the events that occurred after the original deadline was missed. There is, however, an established line of case law in which the European Patent Office decided that the two month term may run from the date on which the error *ought* to have been discovered had due care been taken, which may be significantly earlier than the actual discover of the error.

In J 27/88, the Board of Appeal reasoned that "the effective date

of removal of the cause of non-compliance is not necessarily the date at which the omission has been discovered but the date at which it should have been discovered if all due care had been observed". Similarly, T 315/90 set out that removal of the cause of non-compliance "is not necessarily the date of receipt of the communication of the Registrar notifying the loss of rights; it is more precisely the date at which the Appellants should have discovered the committed error if they had taken all due care, due care being a permanent obligation". Likewise, J 27/90 set out that "in the case of an error of facts the removal occurs on the date on which any person responsible for a patent application should have discovered the error made". This line of jurisprudence essentially considers that due care must be exercised not only at the moment when the time limit has not been observed, but also subsequently.

While this "ought to have" approach has been applied in numerous later cases, one recent EPO decision has expressly abandoned the approach. In J 1/20, the Board expressed its doubts that the approach correctly reflects the requirements for re-establishment of rights set out in Article 122 and Rule 136 EPC. The Board noted that neither Article 122 EPC nor Rule 136 EPC provide for the "ought to have" approach in their wording. The Board further noted Article 122 refers to due care only in respect of missing a time limit, which is distinct from removal of the cause of non-compliance. The Board concluded that it is incorrect to apply the due-care criterion as an additional, unwritten admissibility requirement. In the Board's view, removal of the cause of non-compliance with the period is a purely factual criterion, which occurs on the date on which the person responsible for the application/patent actually becomes aware of an error.

This factual approach has been applied in several subsequent cases (e.g. in T 1570/20 and T 1995/19). It therefore appears that there may be shift towards a softer assessment of the date of removal of the cause of non-compliance going forwards. However, it will be appreciated that it is still important that appropriate care is taken, for example by anyone handling correspondence that might draw attention to a deadline being missed.

#### 1.2 Time limit missed due to other reasons

In some cases, non-compliance with the relevant deadline may not be due to an error. Rather, there may have been some obstacle to meeting the deadline. Irrespective of the nature of the obstacle, the two month term for requesting re-establishment of rights is initiated as soon as the obstacle ceases to exist.

##### 1.2.1 Financial difficulties

One such obstacle may be financial difficulty. However, such difficulty will only be considered as a cause of non-compliance when it is beyond the reasonable control of the persons concerned, and they have taken due care to get support without success.

This principle was set out in J 22/88, in which a stateless refugee unemployed for a long time found himself in a difficult financial situation that made it impossible for him to obtain bank credit to pay the fees required for his patent application. The Board considered that the applicant was unable to do more than he did to try to pay the fees, namely to request the Receiving Section to grant him an extension of time for the payment of the fee, to immediately seek credit and to pay the fees as quickly as possible. Therefore, they decided that there was no doubt that the applicant was in financial difficulties beyond his control.

T 1908/09 confirmed that lack of funds will only be accepted as a cause for non-compliance in exceptional cases, and the applicant has tried and failed to obtain funds by all possible routes. In this case, responsibility for prosecution lay with one of two co-applicants, who essentially ceased operations due to the financial crisis of 2009, resulting in a deadline being missed. Following acquisition of the failed co-applicant's rights, a new co-applicant argued in a request for re-establishment of rights that the cause of non-compliance was financial difficulty of the failed co-applicant, and that the cause was removed when the application was transferred. However, the Board considered that the cause of non-compliance was actually removed by receipt of the loss of rights communication. The failed co-applicant's lack of financial resource did not factor because they had not tried all possible routes to obtain funds. In particular, they had not approached the existing co-applicant for assistance.

If unavoidable financial difficulty is a legitimate cause of non-compliance, this is removed at such point that the difficult ceases to exist. This was considered in J 11/98, in which bankruptcy proceedings prevented the applicant from paying a renewal fee when it fell due or within the grace period for payment with surcharge. Such proceedings were taken to be the cause of non-compliance. The cause of non-compliance was considered to be removed at the point that the bankruptcy proceedings transitioned to liquidation proceedings, when the need to protect the applicant's assets (and thus pay the missed fee) became apparent.

#### 1.2.2 Health difficulties

The case law provides that health difficulties may also present an obstacle that contributes to non-compliance with a deadline.

For example, in J 7/16 the Board held that the cause of non-compliance with the missed deadline lay in the fact that the former European representative was not in a position to act properly in the proceedings due to his state of health. In particular, he had suffered several close bereavements, and was also in need of surgery for a medical condition. The date of removal of the cause of non-compliance was taken to be the date on which the applicant had themselves inspected the file and realised that their former representative had not acted properly.

Similarly, in J 7/99, the Board set out that while the cause of non-compliance is generally considered to be removed when the person responsible for the application is made aware of that a deadline has been missed, this is not always the case. In the case in question, European representative suffered a sudden bereavement and was left with clinical depression that meant he was unable to request re-establishment of rights within two months of being made aware of a missed deadline. Thus, the cause of non-compliance was only removed when the representative's mental state recovered sufficiently to take action.

## 2. Practicalities of a deadline determined by the facts

As explained above, the cause of non-compliance and its removal depends on the facts of the case and their interpretation. It is therefore typically important to include in a request for re-establishment of rights detailed evidence and arguments to prove to the European Patent Office that the request has been timely filed, and is therefore admissible, in addition to the detailed evidence and argument required to demonstrate that due care was taken, and that the request is therefore allowable.

Often, when a request for re-establishment of rights is first contemplated, not all of the facts and circumstances surrounding the missed deadline are known. Rather, these are built up as investigation continues and a case for re-establishment of rights is put together. Therefore, the initial assessment of the deadline may change as further information comes to light. It is therefore very important to gather as many details as possible about how the unobserved time limit was missed and when this was realised as quickly as possible, in order to make a well-informed determination of the deadline for requesting re-establishment of rights.

In many cases, it may be apparent that a case can be made for the cause of non-compliance to have been removed on one of several dates. Where possible, it is preferable to file the request for re-establishment of rights within two months of the first such date to avoid it being essential to convince the European Patent Office that the cause of non-compliance was removed on a particular date.

It is also generally important to try to file any request for re-establishment of rights as soon as is practical, and in good time before the determined deadline. This mitigates the risk of making what is believed to be an in-time request, only for it to become apparent from later-identified facts that the request was filed too late.

Ideally, if the missed deadline is discovered (or other cause of non-compliance is removed) soon enough, it is preferable to request re-establishment of rights within two months of expiry of the unobserved time limit. By filing within two months of the original time limit, it is rational that the cause of non-compliance cannot have been removed more than two months before the filing of the request for re-establishment of rights. This should remove the uncertainty of whether the request will be admissible and reduces the cost of preparing the request because it is not necessary to prevent detailed evidence and arguments that the request is timely filed.

### 3. One year from the expiry of the unobserved time limit

The second part of the calculation of the deadline for requesting re-establishment of rights is to determine the date that is one year from expiry of the unobserved time limit. The one year period runs from the expiry of the time limit that is the subject of the request for re-establishment of rights. Note that the one year period expires regardless of whether the applicant is aware of the loss of rights at the expiry of the period or not (J 7/92).

It is important to note that the time limit that is the subject of the request for re-establishment of rights is not necessarily that of the originally missed deadline. For example, if the originally missed deadline is one that can be remedied by using further processing under Article 121 EPC, the request for re-establishment of rights is formally in respect of the unobserved further processing time limit. In this case, the one year period runs from the further processing deadline rather than the original deadline.

As the further processing deadline is set by the date of notification from the European Patent Office that the original deadline was missed, the further processing deadline may be significantly later than the original deadline.

This may be particularly so for notifications concerning the late entry into the European regional phase of a PCT application, because such notifications are sent to the applicant by mail rather

than to any representative and so can easily become lost and/or may be returned to the European Patent Office. Actual notification of the loss of rights resulting from the originally missed deadline may therefore take many months, resulting in a correspondingly deferred further processing deadline and consequently a greatly deferred deadline for requesting re-establishment of rights.

#### 4. Exceptions

In some exceptional cases, the deadline for requesting re-establishment of rights is not determined using the two-part calculation discussed above.

In particular, Rule 136(1) EPC provides that a request for re-establishment of the right to claim priority for an application filed directly at the European Patent Office must be filed within two months of expiry of the twelve-month term provided in Article 87(1) EPC.

For a PCT application brought into the European regional phase, a request for the European Patent Office as a Designated Office to re-establish the right to claim priority under Rule 49 ter.2 PCT must be filed at the European Patent Office within one month of expiry of the 31 month time limit for entry into the European regional phase or, if relevant, within one month of the effective date of early entry into the European regional phase.

The period for filing a request for unitary effect of a European patent is one month from grant of the European patent. If this

deadline is missed, a request for re-establishment of rights is due within two months from expiry of the one month period.

Finally, a request for re-establishment of the right to file a petition for review must be filed requested within two months of the deadline provided in Rule 112a(4) EPC.

#### 5. Conclusions

In most circumstances, the deadline for requesting re-establishment of rights is the earliest of (i) two months from removal of the cause of non-compliance and (ii) one year from the expiry of the unobserved time limit. There are two important consequences of this.

Firstly, the discovery of an error may start the clock for filing a request for re-establishment of rights running. Therefore, it is important to take immediate action and, where necessary, seek appropriate assistance.

Secondly, the actual deadline may only be determined once all the facts of the case are known, and may be open to argument. Therefore, any request for re-establishment of rights should not be delayed until the last minute in case the European Patent Office reaches a different conclusion on the assessment of the date on which the cause of non-compliance was removed. Furthermore, quick and in-depth investigation of the circumstances surrounding an error and its discovery, and identification of suitable evidence in this respect, is essential in order to gain a clear idea of the deadline for taking action to recover rights.

#### For more information, please contact:

Toby Hopkin – [thopkin@jakemp.com](mailto:thopkin@jakemp.com)  
John Leeming – [jleeming@jakemp.com](mailto:jleeming@jakemp.com)

Lizzie Davenport – [ldavenport@jakemp.com](mailto:ldavenport@jakemp.com)  
Imogen Parry – [iparry@jakemp.com](mailto:iparry@jakemp.com)