



## Re-Establishment of Rights at the European Patent Office Under Article 122 EPC

Re-establishment of rights under Article 122 EPC may be used to recover rights lost as a result of missing a deadline set by the European Patent Office. The requirements of this provision are shared with a number of restoration systems worldwide. There is much variation from regime to regime. However, the European Patent Office approach is well established, with a history of case law that makes it clear what is needed to successfully recover rights in Europe.

### 1 - Applicability of Re-Establishment of Rights at the European Patent Office Under Article 122 EPC

Re-establishment of rights provides the ultimate remedy for missing just about every deadline that may be faced by an applicant or patentee when dealing with the European Patent Office. It is applicable both to procedures relating to patent applications and procedures relating to granted patents. It is applicable to the missing of any deadline which directly results in any loss of rights, namely not just deadlines resulting in the loss of a patent or patent application in its entirety. The only European Patent Office deadline for applicants or patentees for which it does not provide the ultimate remedy is the deadline for requesting re-establishment of rights itself, in order that this deadline is final.

Re-establishment of rights is therefore explicitly available for, and commonly used in respect of, renewal fee payments beyond the end of the six month grace period. It is also available for re-establishing a claim to priority, where a European application or International application claiming priority was not filed within the one year Paris Convention period. More detail relating to a late-filed International application is provided in our separate briefing on this topic. Furthermore, re-establishment of rights is available as the last resort for missing the deadline for bringing an International application into the European regional phase. More detail relating to late entry into the European regional phase is provided in a further separate briefing.

It is important to remember, however, that re-establishment of rights is only available in respect of missed deadlines. It may be too late to take a particular action without having missed a deadline. The classic example is the filing of a divisional application. One may only file a divisional application based on a pending application. Therefore, a time constraint may be imposed on the filing of a divisional application, for example before a pending application is deemed withdrawn, finally refused or granted. However, such a time constraint is not a deadline per se. Accordingly, it is not possible to request re-establishment of rights if you miss the opportunity to file the divisional application because the parent application ceases to remain pending.

It should also be noted that re-establishment of rights does not

apply to non-European Patent Office deadlines. This includes, for example, the deadline for payment of extension fees beyond the grace period - although the European Patent Office collects the extension fees on behalf of the extension states, it is not (strictly) a European Patent Office deadline. Furthermore, re-establishment of rights is not generally available for parties other than the applicants or patentees. It is not, for example, available in respect of the deadline for filing an opposition to a European patent or the deadline for filing a notice of appeal against a decision by the opposition division to maintain a patent. Exceptionally, G1/86 provided that an appellant already known as an opponent may request re-establishment of rights in respect of the deadline for filing the grounds of appeal provided the notice of appeal was validly filed.

As the deadline for requesting unitary effect of a European Patent is set by the European Patent Office, re-establishment of rights is available if this deadline is missed. This is made explicit in the Unitary Patent Rules, and is a welcome provision given that the term for requesting unitary effect is very short (just one month from grant of the European Patent). However, it is important to note that re-establishment of rights is not available with respect to the deadline for responding to a notice from the European Patent Office advising of deficiencies in the request for unitary effect. Re-establishment of rights is though available for renewal fee payments beyond the end of the six month grace period, given that renewal fees for Unitary Patents are payable to the European Patent Office.

A further area for caution relates to the interaction between the provisions for further processing, provided by Article 121 EPC, with the provision for providing re-establishment of rights under Article 122 EPC. Specifically, Rule 136(3) EPC specifies that re-establishment of rights is not available in respect of a deadline for which further processing is available. Further processing provides the straightforward procedural remedy for missing many European Patent Office deadlines, in which the missing of the initial deadline is deemed not to have occurred on payment of the requisite fee and completion of the omitted act within two months of notification of the loss of rights.

However, this does not mean that re-establishment of rights is not available as the ultimate remedy for such missed deadlines. This is because the deadline for requesting further processing itself may be made the subject of a request for re-establishment of rights.

Therefore, the effect of Rule 136(3) EPC is that one cannot directly request re-establishment of rights in respect of such deadlines but must do so by the route of requesting re-establishment of rights in respect of the further processing deadline and simultaneously using the further processing

provisions of Article 121 EPC in order to respond to the original deadline.

In practice, this means that, in addition to preparing a case for re-establishment of rights, completing the original omitted act and making payment of the fee for requesting re-establishment of rights, one must also pay the appropriate further processing fee that would have been due had the originally missed deadline been remedied using further processing alone. This may include 50% of any originally unpaid fees.

Making an error in respect of this apparently minor procedural issue is potentially catastrophic. If the additional request for further processing is not included by payment of its requisite fee, such that the submissions are, in effect, a request for re-establishment of rights in respect of the originally missed deadline, the European Patent Office will consider the request inadmissible. Such an error may usually only be discovered after the deadline for requesting re-establishment of rights under Article 122 EPC. Accordingly, it will no longer be possible to correct the submissions or re-submit them. Consequently, it will no longer be possible to take any action to recover the rights lost caused by the originally missed deadline. Sadly, cases are all too often seen in which generally experienced attorneys, but who are inexperienced in restoration procedures, have made this error and it has been too late to fix it.

This is perhaps a useful reminder that, although one may identify an appropriate “normal” level of care to be taken in respect of intellectual property deadlines, when dealing with a restoration procedure, one is already at the last resort. Accordingly, there is no safety net and all possible care must be taken.

## **2 - Specific Requirements for Re-Establishment of Rights**

Article 122(1) EPC specifies that 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 key requirement, therefore, is to prove that “due care” was taken. It is important also to note the qualification “required by the circumstances”. This means that there is not a single absolute test. In practice, therefore, the quantum of care required in order to obtain re-establishment of rights will vary from situation to situation. Further detail regarding what constitutes “due care” is set out in our separate briefing on the topic.

Rule 136(1) EPC specifies the deadline for requesting re-establishment of rights. In most cases, the deadline is the earlier of two months from the so-called “removal of the cause of non-compliance” and one year from the expiry of the unobserved time limit.

Regarding the first part of the deadline calculation, the removal of the cause of non-compliance is commonly, but not always, the date on which it is discovered that a deadline has been missed (in which case the cause of non-compliance was an error which resulted in the relevant person being unaware of the original deadline). In some cases, the European Patent Office may decide that the two months term runs from the date on which the error should have been discovered had due care been taken, which may be significantly earlier. In other cases, the deadline may have been missed for some other reason, in which case the two month term is initiated as soon as this other reason ceases to exist.

Two important consequences should be appreciated. Firstly, the

discovery of an error may start the clock running. It is important, therefore, 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 application for re-establishment of rights at the European Patent Office should not be delayed to the last minute for fear that the European Patent Office disagrees with your assessment of the date on which the cause of non-compliance was removed. Furthermore, it is essential to investigate quickly the circumstances surrounding the discovery of an error (as well as the circumstances surrounding the cause of the original error, namely the missing of the original deadline) and identify suitable evidence that can prove a date of discovery of an error to the European Patent Office in order that one can ascertain a provisional view of the deadline for filing the application for re-establishment of rights. Note that, if the error was discovered as a result of a communication from the European Patent Office, the cause of non-compliance is removed on the actual date of receipt (as ideally demonstrated by evidence) - the 10-day grace period for postal delays does not apply.

Regarding the second part of the due date calculation, it is important to remember that the one year period runs from the expiry of the time limit that is the subject of the request for re-establishment of rights and not necessarily from the originally missed deadline. For example, if the originally missed deadline is one that can be remedied by using further processing (Article 121 EPC), such that the request for re-establishment of rights is formally in respect of the unobserved further processing time limit, the one year period runs from the further processing deadline rather than the original deadline. This may be significantly later.

This is especially the case because the further processing deadline is set by the date of notification from the European Patent Office that the original deadline was missed. In particular in respect of such notifications concerning the late entry into the European Regional Phase of a PCT application, such notifications can become lost and/or may be returned to the European Patent Office (not least because the European Patent Office sends them to the applicant rather than their agent). Consequently, actual notification of the loss of rights resulting from the originally missed deadline may take many months, resulting in a correspondingly deferred further processing deadline and consequently a greatly deferred deadline for requesting re-establishment of rights.

## **3 - Filing an Application for Re-Establishment of Rights**

In order to submit an application for re-establishment of rights at the European Patent Office, it is necessary to (i) pay the official fee(s) for requesting re-establishment of rights, noting that, if multiple deadlines have been missing, multiple re-establishment fees may need to be paid for the request to be admissible, (ii) request re-establishment of rights, (iii) provide the grounds justifying the re-establishment of rights, including proving that the request is timely filed, and (iv) complete the omitted act that should have been performed before the deadline that is the subject of the request for re-establishment of rights.

The above requirements are essentially straightforward but great care is required, particularly if you do not have much experience of the restoration procedure. There are several pitfalls awaiting an attorney that has not previously had experience of restoration

procedures.

At all times it must be remembered that there is no remedy for making an error in a restoration case - this is already the last chance to save an intellectual property right. Accordingly, even an apparently minor error could be fatal. For example, missing the deadline by even one day is a non-recoverable error (made more difficult, as discussed above, by the fact that the determination of the deadline may not be clear-cut). Similarly, missing a required fee payment, which may be part of the action necessary to complete the omitted act, will be a non-recoverable error. Even a typographical error could prove to be non-recoverable, for example if as a result one requested re-establishment of rights in respect of the wrong application and the correct application number were not apparent from the contents of the other papers submitted.

As discussed above, another classic pitfall is to request re-establishment of rights in respect of the wrong deadline, such as requesting re-establishment of rights in respect of the originally missed deadline rather than the deadline for further processing the originally missed deadline.

Even if one makes a recoverable error in the request for re-establishment of rights, it may be extremely damaging to your case in an indirect manner. Central to the judgement regarding whether or not to permit re-establishment of rights is an assessment regarding whether or not due care has been taken. If a further error is made in requesting re-establishment of rights, it may put into the mind of the examiner at the European Patent Office that not enough care is being taken. Therefore, it is of paramount importance that extreme care is taken when preparing and filing the request for re-establishment of rights.

#### **4 - Contents of Grounds for Re-Establishment of Rights**

Considerable care and thought must also be taken when preparing the contents of grounds for re-establishment of rights. It is of course helpful for the strength of the case if the relevant parties have taken due care in respect of deadlines (which has the added benefit of making it less likely that one will ever need to request re-establishment of rights). However, when something does go wrong and a request for re-establishment of rights is required in practice, the manner in which this case is presented can become the most important factor in determining whether or not one is successful.

Essentially, a successful request for re-establishment of rights must tell a good story. The grounds must convey to the examiner the system in place that should have prevented the deadline being missed and should show that this system was appropriate.

Secondly, the grounds should explain to the examiner why the system failed in this particular case and, crucially, why this failure should be considered as an isolated failure that should not have been anticipated and/or that it was reasonable that the system was not sufficiently robust that it could deal with such an unexpected eventuality.

Within a given set of facts, there will be a variety of ways of presenting the circumstances that should be considered in order to put forward the strongest case. Furthermore, it is invariably true that relevant parties will not initially provide all of the information that could be relevant. It is therefore almost always necessary, having considered the initial explanation of events, to investigate further.

It is often the case that circumstances that initially appear to be the most hopeless tend to be the cases that have very relevant information not initially provided. For example, a case initially presented as being caused by a glaring error by an individual, such as a total failure to respond to a perfectly adequate reminder system, may suddenly have its chances of success vastly increased when it is discovered that the individual involved was at the time suffering from a series of traumatic events occurring in their life outside of work. The European Patent Office is typically very sympathetic to cases that are supported by a medical certificate or where it can be established that there were other such factors external to work that affected the performance of a relevant person.

Clearly, the investigation of the case and the preparation of the grounds for re-establishment of rights is a time consuming business if it is to be done properly. Nonetheless, it also must be performed swiftly. This is because the full grounds for re-establishment of rights must be presented within the deadline for requesting re-establishment of rights. The consequences for not preparing the full case within the deadline were clearly shown in J15/10. In that case, the grounds for re-establishment of rights were not substantiated within the deadline for requesting re-establishment of rights and, accordingly, the request was deemed inadmissible.

After the deadline for requesting re-establishment of rights, it is permissible to provide additional information to support the request and, in particular, it is permissible to provide additional evidence that supports the case previously filed. However, any such supplemental information or evidence should support the originally filed request rather than being, in effect, a different grounds for justifying re-establishment of rights. It is therefore important that the full facts of the case are known before the request for re-establishment of rights is filed.

#### **5 - Procedure Before the European Patent Office**

A request for re-establishment of rights will need to be supported by suitable evidence.

Preferably, the evidence should include contemporaneous evidence, such as copies of correspondence, file notes, minutes of meetings or screenshots from case management systems.

It is not usually necessary to provide a sworn declaration from an individual that can attest to the facts. The European Patent Office will accept a letter signed by the European representative that both sets out the facts of the case and argues that these facts demonstrate that due care was taken and that the application for re-establishment of rights was timely filed, together with copies of suitable evidence. In some cases, if little contemporaneous evidence is available or key facts of the case cannot be supported by contemporaneous evidence, it may be beneficial to provide a sworn statement from an individual involved in the circumstances that led to the deadline being missed. However, the European Patent Office often displays a healthy scepticism to such evidence prepared after the event. Accordingly, contemporaneous evidence where available is usually preferable.

After the filing of a request for re-establishment of rights, the European Patent Office may immediately grant the request if they are satisfied that it is admissible and allowable. More commonly, a communication may be issued, requesting some further information and/or evidence or explicitly explaining why they are minded to refuse the request. A two-month period for response is

often set.

Although it is possible to respond to requests for further information and/or evidence and/or to respond to a provisional opinion that re-establishment of rights may be refused, it is highly desirable to include as strong a case as possible when filing a request for re-establishment of rights rather than to hold back some information or evidence to be submitted if necessary later. This is because, when preparing a request for re-establishment of rights, one can control which information is presented and the manner in which it is presented. Once direct questions are asked by the European Patent Office, this control becomes lost. Refusing to provide information that has been requested by the European Patent Office is very likely to have a negative impact on the chances of success.

A key strategy, therefore, when preparing a request for re-establishment of rights is to identify areas of weakness in a case and attempt to present sufficient information and/or evidence relating to the area of weakness that additional questions relating to that part of the case are not raised. It is particularly important to try to avoid piquing the reader's interest in a part of the case in which responding to a request for further information or evidence would very likely result in providing information and/or evidence that would be detrimental to the case.

The subsequent procedure may depend upon the department at the European Patent Office that is competent to make the decision on the request for re-establishment of rights. This will be the department of the European Patent Office that was responsible for the application or patent at the time that the deadline was missed, such as the Receiving Section, Examining Division or Board of Appeal. In most cases, one can demand that Oral Proceedings be held before a negative decision is issued, providing a final opportunity to argue for the request for re-establishment of rights in the event that the European Patent Office intends to reject the request. The exception is cases for which the Receiving Section are the competent department, in which case they may refuse to hold Oral Proceedings unless they consider it "procedurally expedient", which is often not the case.

If the European Patent Office refuses the request for re-establishment of rights, it is usually possible to appeal against the

decision. As an exception, if the competent department is the Board of Appeal, no further level of appeal against their decision is available.

The time taken to get a first instance decision on a request for re-establishment of rights varies greatly. In general, however, an initial response from the Receiving Section or Examining Division, if they are the competent department, may be expected within three to six months and, if the initial response is a request for further information or a preliminary opinion that the request may be refused, a decision at first instance can usually be expected within about a year. However, some cases may take even longer, particularly if the case is complicated, if an appeal against a first instance rejection of re-establishment of rights is required or if the competent department is the Board of Appeal. In such cases, it can be a few years or more before a decision is reached.

## 6 - Renewal Fees

Where the missed deadline that is the subject of the request for re-establishment of rights has resulted in a total loss of rights, such as a patent application being deemed withdrawn, renewal fees are not payable to the European Patent Office while the request for re-establishment of rights is being considered. Under Rule 51(4) EPC, any renewal fees that fall due after the loss of rights has occurred or for which the grace period for payment of renewal fees expired after the loss of rights occurred, become payable after notification of a decision granting re-establishment of rights.

Renewal fees that would have become due after the loss of rights may be paid within four months of notification of the decision granting re-establishment of rights without a surcharge or, within a further two months, with an additional fee. Renewal fees that were already overdue when the loss of rights occurred are payable with an additional fee within six months of the notification of a decision granting re-establishment of rights.

It is important to note that Rule 51(4) EPC does not apply to circumstances in which a partial loss of rights occurs, such as requests to re-establish the effect of a priority claim after the late filing of an application. Similarly, Rule 51(4) EPC does not apply to circumstances in which a missed deadline is recovered by use of further processing under Article 121 EPC.

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