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Annex 8
Report of the EPPC

Working Group 4 – Re-establishment of rights

Second meeting



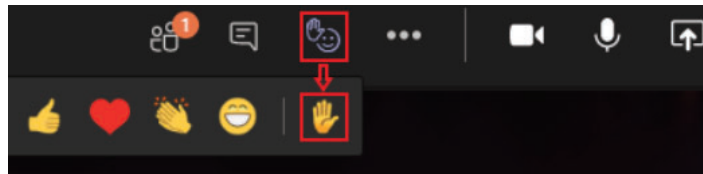
Teodora Kandeва

Chairperson WG4 - D5222 European Legal Affairs

27 April 2021

Organisation of today's meeting

- Microphones should be turned off (muted) by default
- Please click “raise hand” button if you wish to intervene



- Once the chair has given you the floor, turn on (unmute) your microphone
- Turn off (mute) your microphone again

Agenda

- Goal of today's meeting

- Areas of practice to explore as potential candidates for convergence
 - Area 1 – Noting of loss of rights
 - Area 2 – Charging of a single re-establishment fee (when applicable)
 - Area 3 – Use of guidelines/templates & coversheet
 - Area 4 – Variation in applying the requirement for re-establishment of rights

- Other ideas & topics for discussion

- Next steps

Goal of today's meeting

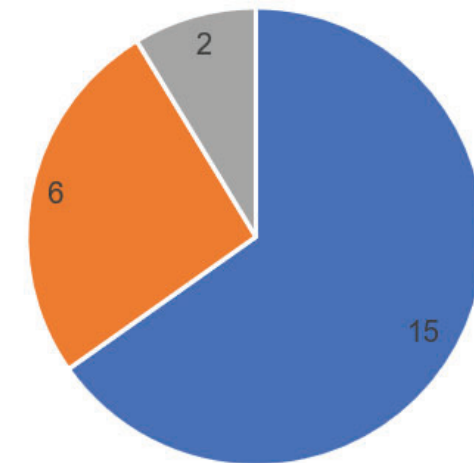
- Discussion of possible candidate areas for convergence.
- Clarification of practice in these selected areas.
- Other ideas for areas of convergence?
- First selection of candidate areas for convergence of practice.
- Discussion on other topics of interest.

First candidate area

Information on loss of rights

Information on loss of rights sent out to relevant party(ies)

- According to the answers to the questionnaire, **most offices send out information on loss of rights.**
- However, some variations exist: in some jurisdictions, this information is not systematically sent (HR, DE), whereas in others (BE, HU, FI, LT, NO) it is sent depending on the type of right concerned.
- *Clarification of the practice at the EPO and other participating offices.*



- Yes
- Depends on the right/variable
- No/Decision issued with possible redress

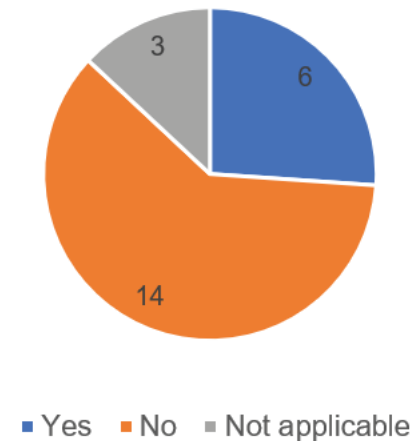
Second candidate area

**Charging of a single re-establishment fee
(when applicable)**

Payment of multiple fees for re-establishment

- **The majority of offices do not charge a re-establishment fee for each omitted, independent procedural act.**
- 6 offices (AL, CZ, LT, ME, PL, EPO) indicated that they charge a re-establishment fee for each omitted, independent act.
- *At the EPO, this practice was clarified in the Examination Guidelines in 2017.*

Payment of fee for each omitted, independent procedural act

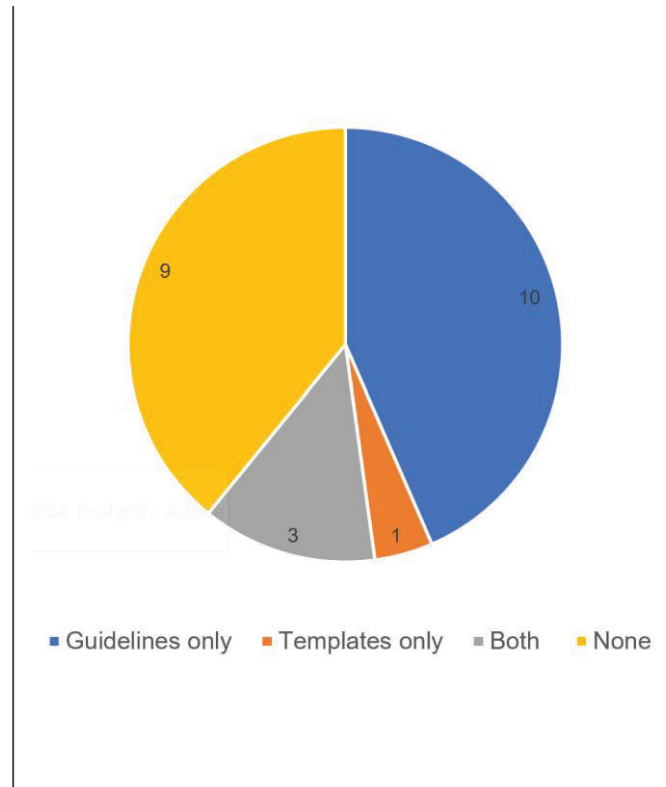


Third candidate area

Guidelines for re-establishment requests Coversheet for decisions

Guidelines/Templates for filing a request on re-establishment

- According to the answers received, 10 offices provide guidelines; 4 offices provide both guidelines and templates or a template only.
- HR, IT, LV, LT, ME, PL, SM, RS and EPO do not provide guidelines nor templates for filing a request.
- *At the EPO, information is contained in the guidelines for examination, GL E-VIII, 3.*



Issuing of decision on re-establishment

Content of positive decisions:

- As the granting of re-establishment does not have a negative impact on the requesting party, some offices issue simplified decisions (or with minimal reasoning).

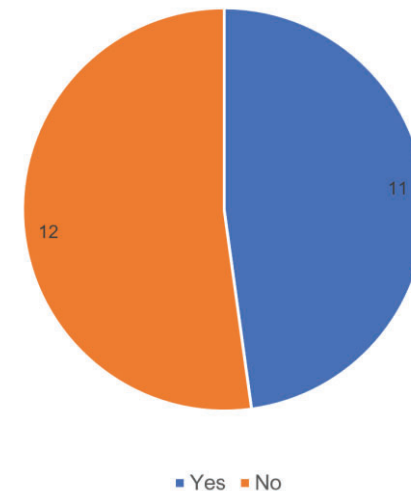
Content of negative decisions:

- As for negative decisions on re-establishment of rights, all participating offices but one indicated that the decision needs to be **reasoned**.
- The vast majority indicated that a reference to **the possibility to appeal** the decision must be included.

Use of a form/template for the issuing of a decision

- **Use of form/template:** AL, BE, CZ, FR, DE, HU, NL, NO, TR, UK.
- **No** use of form/template by the following respondents: HR, FI, IS, IT, LV, LT, ME, PL, SM, RS, ES, SE, [EPO].
- Under the PCT, a **cover-page** with checkboxes is used, identifying the main grounds for the decision (forms PCT/RO/158 and /159).

Use of a template/Form by the office or authority



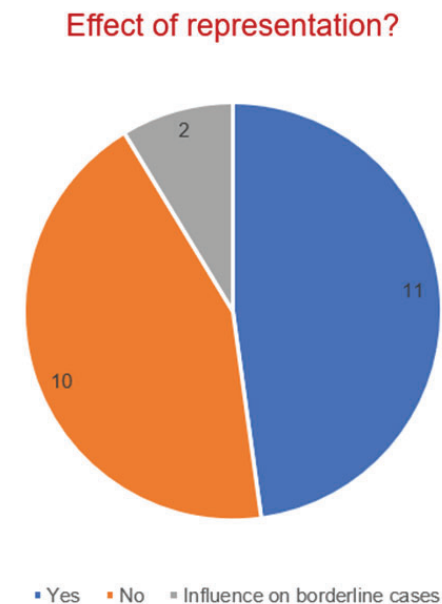
Fourth candidate area

Possible variation in applying the requirement for re-establishment

Effect of representation on substantive requirement

- According to the answers provided, a majority (13) of participating offices indicated an **impact on the requirement for re-establishment when an applicant/patent owner is represented.**
- 10 respondents indicated no impact on the evaluation of the requirement (AL, HR, HU, IT, NO, SM, RS, ES, TR, UK).

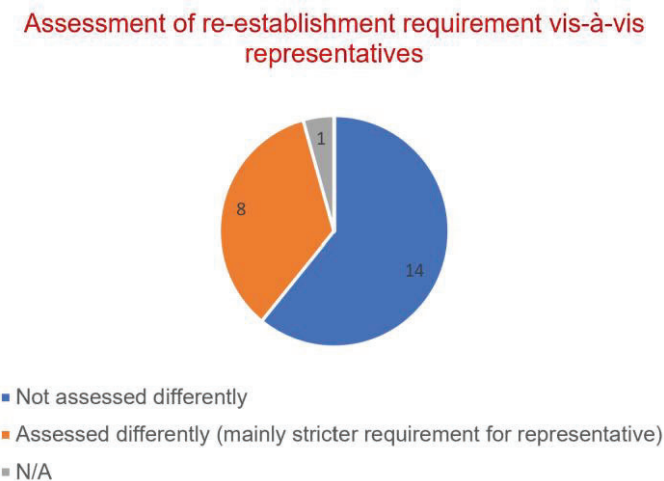
Apparently very split practice as regards effect of representation.



Applicability of substantive requirement - representative

- Most respondents indicated a **similar evaluation of the requirement for re-establishment of rights** to the applicant/proprietor and to the mandated representative.
- **Onus is/could be assessed differently (mainly more strictly)** by following respondents:
DE, HU, IS, LT, PL, ES, SE and EPO.

Clarification as to the EPO and other offices' practice → could current practices in fact be more harmonized than it appears?

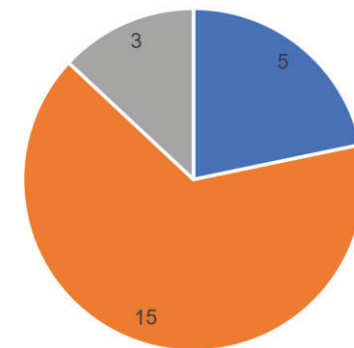


Applicability of substantive requirement – delegation of tasks

- Answers to questionnaire indicated that in most offices (15) the delegation of a task has **no impact** on the evaluation of the re-establishment requirement.
- A minority indicated an impact: BE, ME, NL, SE, EPO. Usually the requirement is applied less strictly.

Clarification as to the EPO and other offices' practice → could current practices in fact be more harmonized than it appears?

Impact of delegation of tasks on evaluation of requirement for re-establishment

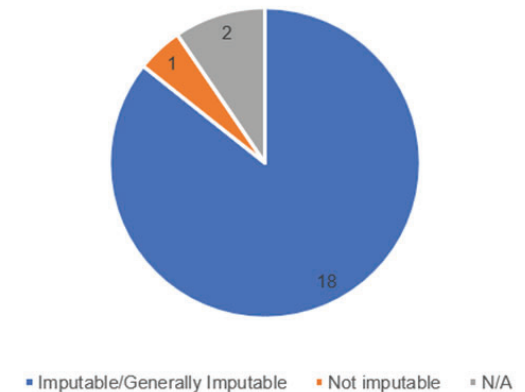


- impact on evaluation of requirement (usually less strict)
- no impact (same level of requirement)
- N/A, other

Applicability of substantive requirement – third parties

- The vast majority of respondents indicated that any error of a third party causing loss of right **is imputable**, at least to a certain degree, to the applicant/proprietor or his/her representative
 - or that such a third party is considered as “part of the system”/ “of a whole” when evaluating the requirement for re-establishment.
- 3 respondents (FR, DE, IT) indicated that an error from a third party **is not imputable / not applicable** to the applicant/proprietor.

Third party error imputable to the patent applicant/proprietor or his/her representative?

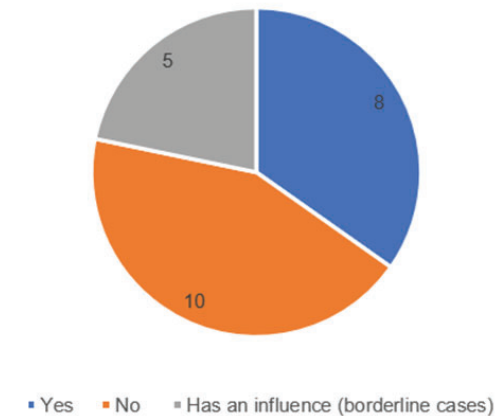


Applicability of substantive requirement – other elements

- For over half of respondents (13), the size of the applicant/proprietor or representative has, at least to a certain degree, an **effect on the evaluation** of the requirement for re-establishment:
 - stricter application of requirement for larger applicants/proprietor or representatives.
- Size of applicant/proprietor or representative is not material in 10 jurisdictions: AL, HR, CZ, HU, IT, ME, NO, SM, RS, UK.

Again, could the current practice be more harmonized than it appears?

Importance of size of applicant/representative?



Exceptional circumstances and the due care requirement

- Exceptional circumstances, though they can be defined in different terms, **are taken into consideration when evaluating a request for re-establishment by all jurisdictions**, without exception.
- According to the replies to the questionnaire, the vast majority of respondents (with the exception of HR, HU, LV, TR) indicated that due care or variants thereof **is considered when exceptional circumstances are invoked**.

Possible convergence?

- Based on clarification of the practice of participating offices, could convergence be pursued by this Working Group on the way the requirement for re-establishment is applied (in particular the all due care requirement)?
- **Possible hurdle- precedents set by the relevant appeal bodies?**
- *Any other ideas for candidate areas?*

Other topics of discussion

- Clarification of the participating offices' practice in the event of a failure to observe the time limit in accordance with **Article 65 EPC** for filing a translation (when applicable) for the validation of a European patent.
- Clarification of the participating office's practice regarding **exclusion from file inspection** of certain elements in a re-establishment file (for instance medical certificates).

Next steps

- Next meeting of the Working Group on 17 June 2021.
- Confirmation of a selection of areas of convergence.
- Discussion of first draft recommendations for a common practice?

Thank you for your participation!