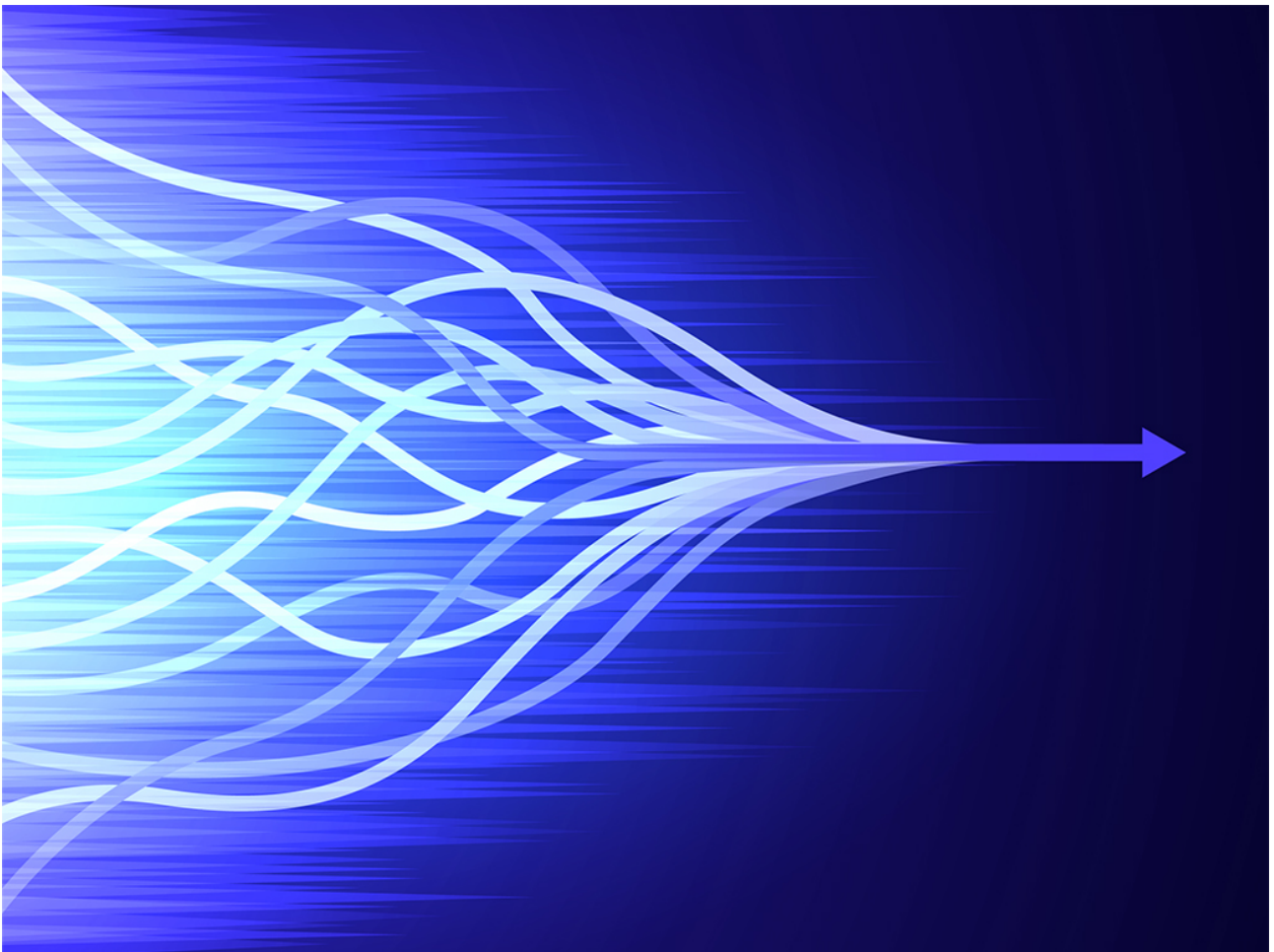


# Convergence of practice

## Common practice as regards re-establishment of rights

March 2022



## **Common practice as regards re-establishment of rights**

Having regard to the legal remedy of re-establishment of rights, as enshrined in Article 122 and Rule 136 EPC and national laws of EPC contracting and extension states, as well as in Article 12 of the Patent Law Treaty;

Considering the importance of providing applicants and patent proprietors with consistent and timely notification on loss of rights, and its possible legal remedies;

Considering the importance of providing applicants and patent proprietors with sufficient information on how to best draft requests for re-establishment of rights by defining a set of minimum formal elements for the filing of such requests;

Considering the importance of increased harmonisation, transparency and legal certainty through well-structured and consistent communications or decisions on requests for re-establishment of rights, in particular refusal or intended refusal of such requests;

Considering the importance of enhancing legal certainty and transparency by making available, including at first instance, decisions on re-establishment of rights;

Noting that any common practice will be implemented on a voluntary basis;

After consulting the Committee on Patent Law;

The Administrative Council at its meeting on 22 March 2022 approved the following common practice as regards re-establishment of rights:

### **Notification on loss of rights**

Offices should ensure availability, where possible via electronic means, of information on loss of rights. This information should be made available to relevant parties, such as applicants or patent proprietors either before the loss of rights has occurred or after, depending on the type of omitted act concerned.

It should contain all necessary indication on the possible means of redress available.

### **Minimum elements for the filing of requests for re-establishment of rights**

The following elements are to be indicated in a request for re-establishment of rights:

- Name of the requester;
- Address of the requester, if applicable;
- Name and address of the representative, if applicable;
- Application/patent number;
- Grounds for the request, including claimed date of removal of the cause of non-compliance to be provided together with the request or within the time limit indicated by the office;

- Facts and evidence supporting the grounds for the request, to be provided together with the request or within the time limit indicated by the office;
- Completion of omitted act(s), either at the time of the request or within the time limit indicated by the office;
- Payment of the re-establishment fee(s), if applicable;
- Signature and date.

### **Minimum elements for communications or decisions on requests for re-establishment of rights**

Having due regard to any data protection considerations, the following elements are provided in communications or decisions on requests for re-establishment of rights, in particular in cases of a refusal or intended refusal of such requests:

- Date of communication/decision;
- Name of the requester;
- Address of the requester, if applicable;
- Name and address of the representative, if applicable;
- Application/patent number;
- Summary of facts and evidence as far as necessary;
- Admissibility of the request;
- Allowability ("all due care"<sup>1</sup> or any other applicable requirement), in particular where the request is deemed admissible;
- Preliminary opinion/Operative part of the decision;
- Possibility to comment /Possibility for appeal or means of legal redress;
- Name/Signature of responsible department/officer.

### **Publication of decisions on re-establishment of rights**

Having due regard to any data protection considerations and any applicable legal restrictions, offices should ensure that decisions on re-establishment of rights are published or can be made available for consultation either via file inspection or upon request.

---

<sup>1</sup> See Appendix

## **Appendix**

The "all due care" requirement is to be understood as an appropriate level of care taken under the circumstances by a reasonably diligent applicant/patent proprietor or their representative, when applicable. This requirement is to be considered as being met when, by evaluating the circumstances as a whole and on a case-by-case basis and in light of the situation before the time limit expired, the time limit has been missed either due to exceptional circumstances, or due to an isolated mistake in a normally satisfactory monitoring system.

## 1. Background

With the adoption of the Strategic Plan 2023, discussions were launched on a convergence programme aimed at reducing or overcoming differences in administrative practices by setting common practices in identified areas where a more uniform approach would provide the most beneficial results for both users and patent offices. At its 51st meeting, the Committee on Patent Law gave a favourable opinion on the convergence of practice programme (CA/PL 14/19). Re-establishment of rights was identified as an area for a possible convergence of practice. Pursuant to the working method established by the Committee on Patent Law, a working group, namely Working Group 4 – Re-establishment of rights, was set up to explore possible common practices in this area. The work of the group was planned to be concluded by the end of 2021.

A call for interest was launched in December 2020, whereupon 23 EPC contracting states and one extension state indicated their interest in participating in the discussions of Working Group 4. At its 52nd meeting, the Committee on Patent Law followed the proposal of the Office to have BUSINESSEUROPE and epi participating as observers in the discussions of the upcoming Convergence Working Groups. Accordingly, BUSINESSEUROPE and epi were invited to nominate a representative. The composition of the Working Group was as follows:

Albania (AL), Belgium (BE), Bulgaria (BG), Croatia (HR), Czech Republic (CZ), Finland (FI), France (FR), Germany (DE), Hungary (HU), Iceland (IS), Italy (IT), Latvia (LV), Lithuania (LT), Montenegro (ME), Netherlands (NL), Norway (NO), North Macedonia (MK), Poland (PL), San Marino (SM), Serbia (RS), Spain (ES), Sweden (SE), Turkey (TR), United Kingdom (UK), BUSINESSEUROPE, epi and the European Patent Office (EPO).

In February 2021, the chairperson of the Working Group (a representative of the EPO) issued a detailed questionnaire to identify the participating offices' practices regarding re-establishment of rights. The answers to this questionnaire were compiled in a summary document which served as a basis for the discussions within the Working Group. At the first meeting of the Working Group (24 March 2021), the chairperson presented a summary document, which aimed at identifying differences and similarities in practices between the participating offices.

Based on the result of the questionnaire, the Working Group identified possible areas of convergence during the two subsequent meetings (27 April and 17 June 2021), with a presentation of a first proposal for a common practice on re-establishment of rights during the fourth meeting (15 September 2021). At its fifth and last meeting on 23 November 2021, the Working Group agreed to recommend to the Administrative Council the enclosed common practice for adoption and any subsequent voluntary implementation.

In parallel to the discussions in the Working Group and in accordance with the methodology agreed by the Committee on Patent Law (see CA/PL 14/19, point 21), users were regularly consulted and updated on the progress of the work via the SACEPO Working Party on Rules on 25 March 2021 and 14 October 2021. In addition, on 23 September 2021, the EPO held a virtual discussion platform for the second pair of convergence topics during which users and offices were informed of the results achieved within the Working Group until then. Also, on 24 November 2021 at its 53rd meeting, the Committee on Patent Law was provided with an update on the work of both Working Group 3 and 4.

## **2. Explanatory remarks to the common practice**

Requests for re-establishment of rights are usually subject to specific formal and substantive requirements governed by national law (or the EPC with regard to the EPO) and jurisprudence. One of the most important differences among the EPC contracting states, as well as the EPO, pertains to the applicable substantive requirement for assessing the allowability of a request for re-establishment of rights. In some jurisdictions it is only necessary for a party to show that the failure to meet a time limit was "unintentional". In other jurisdictions, it is rather the "all due care" requirement which needs to be fulfilled. In addition, variations exist even when jurisdictions may apply similar standards, such as is demonstrated by the requirements of "through no fault of their own" or "legitimate excuse" which, in principle, bear similarities to the "due care" requirement, though less strict.

Variations may also exist with regards to the admissibility of a request for re-establishment of rights. For instance, some jurisdictions require the payment of a re-establishment fee, whereas others do not.

In this context, and given that the Working Group was not mandated to harmonise substantive law, the proposed recommendation for a common practice was carefully drafted to respect variations in admissibility and allowability criteria.

Working Group 4 identified four areas for convergence to form part of a common practice on re-establishment of rights, which is to be implemented and applied by EPC contracting states, extension states and the EPO on a voluntary basis. These four areas are as follows:

- Notification on loss of rights;
- Minimum elements for the filing of a request for re-establishment;
- Minimum elements for the drafting of decisions or communications on re-establishment;
- Availability of decisions on re-establishment.

The proposed common practice aims at an increased access to information, transparency for the users and increased legal certainty through, inter alia, more harmonised communication and decision-drafting. The common practice is also supplemented by an understanding of the "all due care" requirement to support consistency in decision-making on requests for re-establishment of rights, for those jurisdictions applying this requirement.

### **2.1 Notification on loss of rights**

The first area of common practice on notifications on loss of rights aims at fostering a practice which has, to a great extent, been found prevalent amongst the members of the Working Group. It provides that offices should inform applicants or patent proprietors, as the case may be, if an application is deemed withdrawn, or if a patent has lapsed or ceased.

The proposed common practice acknowledges differences in the practice of participating offices concerning the timing of the sending of notifications on loss of rights. Indeed, depending on the omitted act, a notification may be sent either before the loss of rights has occurred or, as is generally the case, after that.

It should be clarified that also those notifications on loss of rights specifying means of legal redress other than re-establishment of rights fall under this area of common practice. Indeed, different means of redress for remedying loss of rights or a grace period for paying renewal fees may be available before re-establishment of rights may become necessary. Such means of redress include in particular further processing, available in a number of European jurisdictions including under the EPC (Article 121 EPC).

Finally, this first area of common practice aims to reflect recent developments as regards communication between patent offices and applicants/proprietors, which are facilitated by the use of electronic means. It should however be noted that the sending of notifications electronically is not a precondition for complying with the common practice.

## **2.2 Minimum elements for the filing of a request for re-establishment of rights**

The general aim of this second area of the common practice is to facilitate the filing of a request for re-establishment of rights (i.e. compliance with the applicable admissibility criteria), possibly by the use of guidelines and templates.

It should however be noted that these minimum elements by no means substitute for or alter the admissibility criteria as defined by each jurisdiction. As such, necessary flexibility is provided in this area of the common practice so as to reflect variations in admissibility criteria. For instance, when it comes to the providing of grounds, fact and evidence, these may need to be filed, depending on the jurisdiction and on the time limit missed, either together with the request, or alternatively, within the time limit indicated by the office.

## **2.3 Minimum elements for the drafting of decisions or communications on re-establishment of rights**

The third area of common practice outlines the minimum elements to be included in a decision or a communication on re-establishment of rights. The aim of this area of common practice is to increase harmonisation amongst offices concerning the information to be provided to applicants/patent proprietors in communications and decisions on re-establishment of rights. This would result in more legal certainty and transparency for users, without however intending to dictate how decisions or communications should be drafted, nor the order in which the various elements are to be presented.

As is the case for the minimum elements for the filing of a re-establishment request, this third area of common practice provides the needed flexibility in order to encompass the practices and legal frameworks of the different offices. In particular, the allowability criteria, to be elaborated primarily in requests which are deemed admissible, is to be evaluated according to the applicable substantive requirement, such as for instance the "all due care", "unintentionality" or the "legitimate excuse" requirements. Given that about half of the participating offices apply the "all due care" requirement, an understanding of this requirement is proposed in the appendix to the common practice. The intent of this proposed understanding is to support more consistent communications/decisions on requests for re-establishment of rights, for which this requirement is applicable, bearing in mind however that offices are ultimately bound by their national law and jurisprudence.

It should be noted that this area of common practice mainly aims at defining those elements which should be included in cases of a refusal or intended refusal of a request on re-establishment of rights. This is particularly the case as regards elements on the substantiation of a communication or decision, such as elaborating on admissibility and allowability, as well as the providing for possible means of redress/possibility to comment. Indeed those elements mainly apply to negative decisions and intended refusals of re-establishment requests.

## **2.4 Availability of decisions on re-establishment of rights**

The fourth area of common practice proposes the making available of communications or decisions at first instance level on re-establishment of rights requests. This would enhance a practice which is already established at certain offices. Availability of communications or decisions would provide applicants/patent proprietors as well as other offices with a means to better understand how the requirements and guidelines on re-establishment requests are applied in particular jurisdictions.

The way of making decisions available is at the discretion of the relevant office, as a decision can either be published or be made available for consultation via file inspection or upon request. In this context, considerations of data protection (and other applicable legal restrictions) have been reflected in the wording of the common practice.