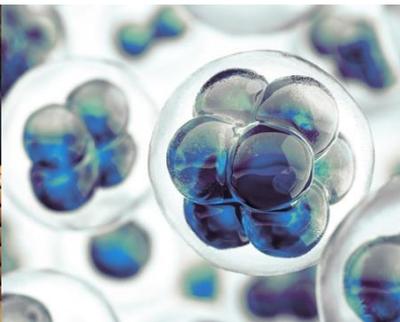




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Implementation of adopted common practices: Re-establishment of rights – online workshop



Composition of Working Group 4

Convergence WG 4

“Re-establishment of rights”

23 participating Contracting States + 1 Extension State

AL, BE , BG, CZ, DE, ES, FI, FR, GB, HR, HU, IS, IT, LV, LT, MK, NL, NO, **PL**,
RS, SE, SM, TR + ME

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EPO

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Observers (epi, BusinessEurope)

Re-establishment of rights: general definition

Re-establishment of rights can generally be defined as the recourse against the loss of rights caused by the missing of a time limit (as set in the relevant law or by the office/authority), which would cause in particular:

- a patent application to be **deemed withdrawn**, or
- a **granted patent to lapse**, or also
- the loss of a means of redress.

Substantive requirement for re-establishment of rights

- Most participating offices identified “all due care” / “due care” / “on legitimate grounds” / “through no fault of their own” / “due diligence” as the requirement to be demonstrated in a request for re-establishment.
- Some respondents identified the less stringent requirement of **unintentionality** as the one required for re-establishment of rights in their jurisdictions.

All respondents indicated that the requirement to be fulfilled is stipulated in their relevant law.

Common practice proposal

Outline of areas in common practice proposal

1. Notification on loss of rights;
2. Minimum elements for the filing of requests for re-establishment of rights;
3. Minimum elements for communications or decisions on requests for re-establishment of rights, including proposed description of allowability;
4. Publication of decisions on re-establishment of rights.

Area 1 – Notification on loss of rights

Proposed notification on loss of rights - 1

- Goal of the proposal – in particular with a view to increased online communication, offices should systematically inform applicants or patent proprietors if an application is deemed withdrawn or if a patent has lapsed or ceased to take effect otherwise.

→ *Practice in most members of the Working Group*

Proposed notification on loss of rights - 2

- Information on loss of rights should be made available to all relevant parties by offices, where possible via electronic means;
- This information should be provided 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 (not limited to re-establishment of rights).

Area 2 – Minimum elements for the filing of requests for re-establishment of rights

Proposed requests for re-establishment of rights, minimum elements - 1

Goal of the proposal - importance of accurate/complete information for the filing of re-establishment requests.

- *More user-friendly procedure for requesters;*
- *More efficient procedure for offices.*

Proposed requests for re-establishment of rights, minimum elements - 2

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

- Name (+address, if applicable) of **requester** (such as patent applicant/proprietor);
- Name and address of **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;

Proposed requests for re-establishment of rights, minimum elements - 3

- **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.**

Area 3 – Minimum elements for communications/ decisions on re-establishment of rights

Proposed minimum elements for communications/decisions - 1

- Goal of the proposal - more harmonized decision-making within and across offices by a list of minimum elements to be included in communications on intended rejection of re-establishment of rights requests, or negative decisions.

→ *Increased legal certainty;*

→ *Clarity for users.*

Proposed minimum elements for communications/decisions - 2

Premises

- **Date** of communication/decision;
- Name (+ address, if applicable) of **requester**;
- Name and address of **representative** (if applicable);
- **Application/Patent number**;
- Summary of **facts and evidence** as far as necessary;

Reasons for decision

- **Admissibility** of the request (formal requirements);
- **Allowability** (“all due care” or any other applicable requirement) in particular where the request is deemed admissible;

General definition of “all due care” requirement in Appendix

Tenor of decision + Appeal/means of redress

- **Preliminary opinion / Operative part of the decision**
- **Possibility to comment/Possibility for appeal or means of legal redress**;

- **Name/Signature of responsible department / Officer.**

Proposed description of allowability

- The “all due care” requirement proposed to be understood according to the following elements:
 - an **appropriate level of care** taken under the circumstances
 - by a **reasonably diligent applicant/patent proprietor** or their **representative**.
- The circumstances have to be evaluating **as a whole and on a case-by-case basis and in light of the situation before the time limit expired.**
- Given the above, has the time limit been missed due to **exceptional circumstances**, or due to an **isolated mistake in a normally satisfactory monitoring system?**

Area 4 – Publication of decisions on re-establishment of rights

Proposed publication of decisions

Goal of the proposal - broader dissemination of practice.

→ *Increased transparency;*

→ *Clarity for users.*

Proposed publication of decisions

- 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.



Thank you for your attention!

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