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**Datasheet for the decision
of 11 October 2024**

Case Number: T 0178/23 - 3.4.03

Application Number: 19768992.0

Publication Number: 3753049

IPC: H01L23/36, H01L23/373,
H01L21/48, H01L23/00,
H01L23/488, H01L25/065

Language of the proceedings: EN

Title of invention:

SILVER-INDIUM TRANSIENT LIQUID PHASE METHOD OF BONDING
SEMICONDUCTOR DEVICE AND HEAT-SPREADING MOUNT AND
SEMICONDUCTOR STRUCTURE HAVING SILVER-INDIUM TRANSIENT LIQUID
PHASE BONDING JOINT

Applicant:

Light-Med (USA), Inc.

Headword:

Re-establishment of rights/Light-Med

Relevant legal provisions:

EPC Art. 108, 122(1), 122(2)
EPC R. 136(1), 136(2)

Keyword:

Re-establishment of rights - missed time limit for filing notice of appeal and for paying appeal fee - missed time limit for filing statement of grounds of appeal - one or two re-establishment fees due (left undecided) - request duly substantiated (no) - inability to observe a time limit (no) - request admissible (no)
Admissibility of appeal - appeal deemed not to have been filed

Decisions cited:

G 0001/18, J 0029/86, J 0026/95, J 0007/16, T 0315/87,
T 2017/12, T 1823/16

Catchword:

A party is not unable to observe a time limit vis-à-vis the EPO within the meaning of Article 122(1) EPC if the obstacle relied on by the party does not relate to an error in the carrying out of the party's actual intention to meet a specific time limit, but only to a previous error as to motive in relation to the intention to use a legal remedy entailing a time limit (see section 5.3.5).



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Case Number: T 0178/23 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 11 October 2024

Appellant: Light-Med (USA), Inc.
(Patent Proprietor) 1130 Calle Cordillera
San Clemente, CA 92673 (US)

Representative: Groth & Co. KB
P.O. Box 6107
102 32 Stockholm (SE)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 25 August 2022
granting European patent No. 3753049 pursuant to
Article 97(1) EPC**

Composition of the Board:

Chairman T. Häusser
Members: G. Decker
A. Böhm-Pélissier

Summary of Facts and Submissions

- I. The appeal lies from the examining division's decision posted on 25 August 2022 granting European patent No. 3 753 049 pursuant to Article 97(1) EPC.
- II. In a communication under Rule 71(3) EPC dated 20 May 2022, the examining division informed the applicant about its intention to grant a European patent on the basis of European application No. 19 768 992.0. Although the international application WO 2020/226626 A1 on which the European application was based contained Figures 1 to 7 as drawings and the appellant made no amendment requests regarding the drawings during the examination proceedings, no drawings were listed as part of the application to be granted in the communication under Rule 71(3) EPC. The annexed text intended for grant did not contain any drawings either.
- III. In a letter dated 16 August 2022, the applicant approved the text communicated by the examining division and submitted translations of the claims into German and French. On the same day, it paid the fee for grant and publication.
- IV. By decision dated 25 August 2022, taking effect on the date on which the European Patent Bulletin mentioned the grant (i.e. on 21 September 2022), the examining division decided to grant European patent No. 3 753 049 pursuant to Article 97(1) EPC.
- V. By letter dated 23 January 2023, the applicant (hereinafter: "appellant") filed notice of appeal against the examining division's decision of

25 August 2022. On the same date it paid the appeal fee.

VI. In the same letter the appellant provided a statement of grounds of appeal setting out the reasons for its requests that the decision under appeal be set aside and that the case be remitted to the department of first instance with the order to grant a patent based on the application documents including the complete set of Figures 1 to 7.

VII. In a communication of 14 February 2023 noting a loss of rights pursuant to Rule 112(1) EPC, the board drew the appellant's attention to the fact that:

- the appeal fee had been paid out of time
- the notice of appeal had been filed out of time
- the appeal was accordingly deemed not to have been filed under Article 108, second sentence, EPC

VIII. By letter dated 2 March 2023, the appellant requested re-establishment of rights under Article 122 EPC "*since [it had been] unable to observe the time limit vis-à-vis Article 102 [sic] EPC*", thereby "*los[ing] the right to appeal*". On the same day the appellant paid one fee for re-establishment of rights.

IX. In support of its request for re-establishment of rights, the appellant submitted the following facts and arguments.

- (a) The appellant had been made aware of the missing drawings during the patent validation phase. By an informal communication dated 5 January 2023, the

Italian Patent Office had informed the appellant that the drawings were missing in the Italian validation. The date of this communication was the date of the removal of the cause of non-compliance within the meaning of Rule 136(1), first sentence, EPC.

- (b) Regarding the "all due care" criterion under Article 122(1) EPC, the appellant submitted the following under the heading "Summary":

"In spite of all due care required by the circumstances having been taken, we were unable to observe the time limit to appeal, since we were unaware of the missing drawings which could not be reasonably expected from the examining division's intention to grant a European patent on the basis of its application."

- (c) The appellant referred to the previously filed notice of appeal and enclosed a copy of it *"to complete the grounds and facts and to ensure that the omitted act has been performed"*.

X. In a communication under Article 15(1) RPBA, the board expressed its preliminary opinion that:

- the request for re-establishment of rights had not been sufficiently substantiated,
- the appellant had not been "unable" to observe the time limits under Article 108 EPC,
- the appellant had not taken all the due care required by the circumstances.

Consequently, it appeared to the board that the request for re-establishment of rights was inadmissible and in any case not allowable, and therefore the appeal should be deemed not to have been filed.

XI. In reply to the board's communication, the appellant submitted arguments as to why the request for re-establishment of rights was sufficiently substantiated, why the appellant was unable to observe the time limits under Article 108 EPC and why it had taken all the due care required by the circumstances. In this context, the appellant provided "*additional highly relevant information*" which it had "*discovered*" "*[a]fter a careful review of the prosecution history*" and which "*complete[d] the timely filed request for re-establishment*". These additional facts may be summarised as follows.

- (a) The examining division's communication under Article 94(3) EPC already did not list the drawings and was only based on the claims and the description.
- (b) The examining division's communication under Rule 71(3) EPC was entered into the docketing system of the professional representative's law firm with a one-month period for the text intended for grant to be reviewed by the patent attorney responsible. At that time, this person was Mr X. Within the above one-month period, Mr X sent a letter to the appellant stating that the proposed changes were considered acceptable. An invoice was sent to the appellant stating one hour's work for "*[r]eviewing the text for grant*".

- (c) Mr X followed the law firm's procedures for reviewing the text intended for grant but committed a mistake by not noting the absence of figures. This mistake occurred because the examining division's two communications under Article 94(3) EPC and Rule 71(3) EPC, which mistakenly omitted to list the drawings, led Mr X to believe that the application at issue did in fact not contain any drawings.
- (d) The appellant instructed the professional representative, and a response to the communication under Rule 71(3) EPC was filed including the approval of the text intended for grant.
- (e) One day after the decision to grant had been issued, instructions were sent to the professional representative's validation partner for the patent to be validated in Spain and Italy. The administrative work was handled by the paralegal Ms P.
- (f) Shortly after, Mr X left the law firm and the responsibility for the patent at issue was transferred to the professional representatives Mr Y and Mr Z. They informed the appellant about the missing drawings after they had learned about the issue from the Italian Patent Office, and they immediately filed the appeal.

XII. Oral proceedings before the board took place on 11 October 2024. The appellant's final requests were that the decision under appeal be set aside and that the case be remitted to the department of first instance with the order to grant a patent based on the application documents including the complete set of

Figures 1 to 7. The appellant also requested re-establishment of rights under Article 122 EPC in relation to the non-observance of the time limits under Article 108 EPC for filing the notice of appeal and the statement of grounds of appeal and for paying the appeal fee.

XIII. The appellant's arguments where relevant to the present decision may be summarised as follows.

(a) The request for re-establishment was sufficiently substantiated. The request letter had to be read together with the letter with the statement setting out the grounds of appeal to which the appellant had referred. In those two letters, the appellant had set forth the precise cause of non-compliance with the time limit concerned, specified at what time and under which circumstances the cause occurred and was removed, and presented the core facts making it possible to consider whether all due care required by the circumstances had been taken in order to comply with the time limit concerned. The core facts regarding the requirement of "all due care" were at least implicitly contained in the two letters. The additional information given in the reply to the board's communication merely constituted clarifying facts supporting the core facts that had already been set out before. What mattered was that the appellant had acted in good faith.

(b) The appellant was unable to observe the time limits under Article 108 EPC because of the following objective facts. The examining division's communications under Article 94(3) EPC and Rule 71(3) EPC contained misleading information, as

they omitted to list the drawings as the basis for the examination and as part of the version of the application intended for grant. This constituted a substantial procedural violation. The professional representative responsible for the application at issue had relied on the accuracy of these communications and had thus been acting in good faith.

- (c) The appellant had taken all the due care required by the circumstances. It was true that the case law on "an isolated mistake in an otherwise satisfactory system" cannot normally be relied on to ignore a failure of the professional representative themselves to act, unless there were special circumstances. In the case in hand, however, there were such special circumstances. This was because the appellant, having trusted the misleading information provided in the examining division's communications and thus having acted in good faith, could rely on the principle of the protection of legitimate expectations. Therefore, the isolated mistake of not discovering the missing drawings was excusable.

Reasons for the Decision

1. Under Article 108, first sentence, EPC, notice of appeal must be filed at the EPO within two months of notification of the decision. The appeal fee must be paid within the same time limit (Article 108, second sentence, EPC). Under Article 108, third sentence, EPC, a statement setting out the grounds of appeal must be filed within four months of notification of the decision.

2. The examining division's decision was posted on 25 August 2022. Consequently, the time limits under Article 108, first and third sentences, EPC expired on 4 November 2022 and 4 January 2023, respectively (Rules 126(2), 131(2) and (4), 134(1) EPC in the versions valid at that time). The appellant did not file the appeal or pay the appeal fee within the time limit under Article 108, first sentence, EPC. Nor did it file the statement setting out the grounds of appeal within the time limit under Article 108, third sentence, EPC.
3. An appeal is deemed not to have been filed where notice of appeal was filed after expiry of the two-month time limit prescribed in Article 108, first sentence, EPC and the appeal fee was paid after expiry of that two-month time limit (see G 1/18, OJ EPO 2020, A26, Headnote 1(b)). If a statement setting out the grounds of appeal is not filed within the four-month time limit prescribed in Article 108, third sentence, EPC, the appeal is inadmissible (Rules 99(2), 101(1) EPC).
4. To prevent these results, the appellant requested re-establishment of rights under Article 122 EPC in relation to the non-observance of the time limits under Article 108 EPC for filing the notice of appeal and the statement of grounds of appeal and for paying the appeal fee.
5. *Admissibility of the request for re-establishment of rights (Article 122(1) and (2) EPC, Rule 136(1) and (2) EPC)*
- 5.1 Number of re-establishment fees due

- 5.1.1 Under Article 122(2) EPC in conjunction with Rule 136(1), third sentence, EPC, the request for re-establishment of rights is not deemed to have been filed until the prescribed fee has been paid.
- 5.1.2 In the case in hand, the appellant missed two different time limits (see point 2. above). Consequently, it could be argued that each of the two time limits, which expired independently of one another, must be considered separately, notwithstanding the fact that they were triggered by the same event (see J 26/95, Headnote 3 and points 5.1 and 5.2 of the Reasons; T 2017/12, OJ EPO 2014, A76, point 2 of the Reasons). On the basis of this case law, the appellant's request for re-establishment would be inadmissible because it paid only one fee within the two-month time limit under Rule 136(1), first sentence, EPC, not two.
- 5.1.3 However, there is also case law in which one re-establishment fee is considered sufficient in the situation in hand because re-establishment in respect of both periods has to be examined together and the result will inevitably be the same (see T 315/87 of 14 February 1989, point 6 of the Reasons; J 7/16, point 3.1 of the Reasons; T 1823/16, point 2 of the Reasons).
- 5.1.4 In view of the considerations below, the question of whether one or two re-establishment fees are required in the circumstances in hand can be left undecided.
- 5.2 Substantiation of the request for re-establishment of rights
 - 5.2.1 Under Rule 136(2), first sentence, EPC, the request for re-establishment must state the grounds on which it is

based and set out the facts on which it relies. It is a condition for the admissibility of a request for re-establishment of rights that a duly substantiated statement of grounds for requesting re-establishment be submitted within the time limit for filing the request. A request for re-establishment of rights complies with the requirement of Rule 136(2), first sentence, EPC if a conclusive case is made, setting out and substantiating the grounds and facts on which the request relies. Thereby it is ascertained that the factual basis for the requested decision is not altered after the expiry of the time limit for the request. Therefore, the request for re-establishment of rights must set forth the precise cause of non-compliance with the time limit concerned, specify at what time and under which circumstances the cause of non-compliance occurred and was removed, and present the core facts making it possible to consider whether all due care required by the circumstances had been taken in order to comply with the time limit concerned. Submissions that have not been filed in due time and that alter the basis on which the original request for re-establishment had been filed are not to be taken into account (see Case Law of the Boards of Appeal of the European Patent Office, 10th edition, 2022 ("CLBA"), III.E.4.4 and III.E.5.1, with further references cited in those chapters).

5.2.2 The board holds that the appellant did not comply with the substantiation requirements set out above.

(a) In the letter requesting re-establishment of rights, the appellant did not present any core facts to make it possible for the board to consider whether the appellant had taken all due care required by the circumstances in order to comply

with the time limits under Article 108 EPC. Rather, in the sentence quoted in point IX.(b) above, the appellant merely reproduced the wording of Article 122(1) EPC ("*In spite of all due care required by the circumstances having been taken, we were unable to observe the time limit to appeal ...*") without setting out any concrete facts demonstrating that it had taken all the due care required by the circumstances. The mere statement that it "*could not be reasonably expected*" that the drawings were missing in the examining division's communication under Rule 71(3) EPC is not sufficient in this regard. Moreover, the statement of grounds of appeal did not (explicitly or implicitly) set out any facts relating to the question of whether the appellant complied with the "all due care" criterion.

- (b) Rather, it was only with the letter of reply to the board's communication that the appellant went into more detail for the first time on possible facts regarding whether the appellant had taken all due care required by the circumstances. In fact, none of the concrete facts listed in points XI.(a) to (f) above had been mentioned in the request for re-establishment of rights or in the statement setting out the grounds of appeal. It follows that the appellant has not merely adduced further evidence clarifying the facts which had already been set out in due time, but has (belatedly) attempted to make a conclusive case. Therefore, the new submissions in the letter of reply are not to be taken into account.

5.2.3 Consequently, the request for re-establishment of rights is inadmissible for lack of substantiation.

- 5.3 Inability to observe a time limit vis-à-vis the EPO
- 5.3.1 Moreover, even if, for the sake of discussion, the request for re-establishment of rights were to be regarded as sufficiently substantiated, it would have to comply with the following additional admissibility criterion.
- 5.3.2 Under Article 122(1) EPC, re-establishment of rights is possible if a proprietor of a European patent who, in spite of all due care required by the circumstances having been taken, was *unable* to observe a time limit vis-à-vis the EPO.
- 5.3.3 According to established case law, the word "unable" in Article 122(1) EPC implies an objective fact or obstacle preventing the required action, e.g. a wrong date inadvertently being entered into a monitoring system (see CLBA, III.E.4.2, with further references cited in that chapter).
- 5.3.4 In most cases the obstacle, i.e. the "cause of non-compliance with the period" within the meaning of Rule 136(1), first sentence, EPC, involves some error in the carrying out of the party's intention to comply with the time limit. The party does not then realise that the error has occurred, and that the time limit has not been complied with, until this fact is brought to their attention (see J 29/86, OJ EPO 1988, 84, point 3 of the Reasons).
- 5.3.5 In the case in hand, the board cannot see any objective fact or obstacle that prevented the appellant from observing the time limits under Article 108 EPC. Rather, the objective facts submitted by the appellant

(see point XIII.(b) above) and the arguments regarding the "all due care" criterion (see point XIII.(c) above) relate to circumstances in the run-up to lodging an appeal for which the time limits have been missed. In other words, the facts relied on by the appellant do not relate to an error in the carrying out of a party's actual intention to meet a specific time limit, but only to an error in relation to the intention to use a legal remedy entailing a time limit. Therefore, the appellant was actually able to file an appeal in due time but failed to do so because of a previous error as to motive, i.e. because it was unaware of the need to file an appeal to rectify the absence of the drawings in the patent specification. This situation differs from those governed by Article 122 EPC where a party did intend to observe a time limit but failed to do so due to objective obstacles.

5.3.6 The following is an example comparable with the circumstances in hand in which it is clear that re-establishment of rights under Article 122 EPC is not an admissible legal remedy.

(a) In a decision under Article 97(2) EPC, the examining division refuses an application on the basis of an objection of lack of inventive step using a document from the state of the art within the meaning of Article 54(3) EPC. The applicant does not realise this error (see Article 56, second sentence, EPC) until six months after the decision, when a third party brings it to the applicant's attention.

(b) In this example, like in the case in hand, the applicant was always in a position to file an appeal in due time, to have the error rectified by

a board of appeal (or by the examining division by way of interlocutory revision under Article 109(1) EPC). The only reason why the applicant did not file an appeal was because it did not recognise the need to do so. Yet if re-establishment were to be allowed in this situation, the time limits under Article 108 EPC would be unduly circumvented.

- 5.3.7 Consequently, the board finds that the appellant's request for re-establishment of rights is also inadmissible on the ground that the appellant was not unable to observe the time limits under Article 108 EPC.

6. In view of the considerations in points 5.2 and 5.3 above, the question of whether the appellant complied with the "all due care" criterion under Article 122(1) EPC is irrelevant.

7. Since the request for re-establishment of rights is inadmissible, the appeal is deemed not to have been filed (see point 3. above). As per G 1/18, Headnote 2, if the appeal is deemed not to have been filed, the appeal fee is to be reimbursed *ex officio*.

Order

For these reasons it is decided that:

1. The request for re-establishment of rights is refused as inadmissible.
2. The appeal is deemed not to have been filed.

The Registrar:

The Chairman:



S. Sánchez Chiquero

T. Häusser

Decision electronically authenticated