



Restoration at the EPO

Sometimes deadlines are missed accidentally – in the real world, mistakes do happen. However, don't panic – at the EPO, missing a deadline does not necessarily mean the end of the line for a patent or application. Restoration may be possible.

There are two hurdles to overcome to restore a patent or application at the EPO – 1) applying for restoration in time, and 2) providing sufficient facts to support the test for restoration.

Deadline

Applying for restoration in time requires two elements to be satisfied: the application for restoration must be within 12 months of the missed date, and also within two months of the removal of the cause of non-compliance.

When it first became known that the deadline was missed is therefore a key question – and one that will start the clock for the deadline for applying for restoration. When was the problem/mistake/issue identified? It might be the date you received a notice of loss of rights, or it might be the date an internal status check flagged a problem.

Whatever the case, the deadline for requesting restoration is two months from the date the mistake was discovered. It may be necessary to provide evidence in support of the correct deadline. Certainly, the sooner you act the better.

All due care

The test for restoration is that the applicant, and any professional law firms/renewal agencies used, took 'all due care in the circumstances'.

Typically, it is necessary to explain that the applicant and/or their attorneys had a system in place for ensuring that deadlines were met, and that the failure to meet this deadline in this particular instance was due to an unexpected break down in an otherwise well-functioning system.

For example, if a renewal deadline was missed, it would be necessary to explain what the applicant's usual system is for renewing at the normal renewal date and why the application was not renewed then. Then we would need to explain what the normal system is for renewing in the six month late renewal period – what would have happened if it had all gone as it should.

Then we need to explain what went wrong. Often it's possible to point to isolated human error from trained experienced staff. Human error is often a reason for allowing a restoration request, especially if there is a solid explanation as to why the human error occurred. Were there unexpected pressures? Was there a typographical error in a date, despite a system including double checks?

The test takes into account the circumstances, and so the standards are lower for small companies and private individuals, where a paper reminder system may be all the due care required. For a large company the EPO expect more significant and sophisticated resources and systems – ideally/often a primary reminder system and a backup reminder system.

Circumstances which can result in the EPO allowing a restoration request include, but are certainly not limited to:

- a relevant person (e.g. the applicant) thought the deadline had been met and thought the reminders were an error;
- no reminders were sent to the applicant due to human error, and so the applicant was unaware of the deadline;
- the applicant was ill and unable to give instructions or gave confused/wrong instructions;
- the applicant planned to decide at the last minute and then a crisis intervened at the relevant timescale and the deadline was overlooked;
- instructions were sent by a relevant party but not received;
- a gross dereliction of duty, such as someone covering up not meeting the deadline when the applicant thought they had;
- the deadline was entered wrongly into a docketing system due to an uncharacteristic human error.

Nearly any sensible reason why the normal system, including any back-up system, broke down will do. BUT we need to show there was a good normal system.

One thing to stress is that the applicant changing their mind after deliberately missing the deadline is not likely to be "all due care" – unless there was a plan to assess the position before the deadline and that plan was not implemented – in which case there was no concrete intent to abandon the patent application anyway.

How we can help

A telephone discussion can kick-start the restoration fact-gathering, prior to drafting statements/affidavits in support of the request. This helps us to fully understand the story and facts behind the request, and allows us to advise on the approach with the best chance of success.

Statements are often needed from the US law firm, and often the EP law firm/whoever was the EP address for service (they should have had a Notice of Loss of Rights and forwarded that on). In the case of a missed renewal, a statement may also be needed from any renewal agency (CPA, CIP or the like) that may have been part of the renewal chain. We may also need something from the applicant themselves – for example if they did give instructions in time and those instructions were not carried out. It all depends on why the deadline was missed, and what story we need to walk the EPO through.

The important thing is to act quickly - call us as soon as the missed deadline is discovered. The two month deadline for requesting restoration can fly by quickly, and can't be extended, so the earlier we can begin gathering the necessary facts, the better chance we will have of successfully restoring the application.

If you have a specific issue you would like to discuss in more detail, please contact your usual Barker Brettell attorney.