



Case Number: D 0014/04

D E C I S I O N
of the Disciplinary Board of Appeal
of 31 January 2005

Appellant: N.N.

Representative: N.N.

Decision under appeal: Decision of the Examination Secretariat dated
8 September 2004.

Composition of the Board:

Chairman: B. Schachenmann
Members: R. Menapace
K. Büchel

Summary of Facts and Submissions

- I. On 28 July 2004 the Appellant filed by facsimile the application for enrolment for the European qualifying examination ("EQE") 2005 together with the required further documents and a debit order for the basic fee. The closure date for the application was 30 July 2004.
- II. On 20 August 2004 an e-mail was sent to her on behalf of the EQE Secretariat stating that "the master copy, which needs to be sent to the Examination Secretariat as well, is still outstanding".
- III. By letter dated 8 September 2004 the Appellant was informed of the decision of the Head of the Examination Secretariat to refuse the Appellant's application for enrolment for the EQE in 2005 for the reason that no written confirmation copy had been received within a period of one month of the faxed application, see [Announcement of the EQE 2005] OJ EPO 3/2004, p. 119-120).
- IV. On 5 October 2004 an appeal was filed against said decision together with a debit order in the amount of € 1,020.00 for the appeal fee. It was submitted that it was due to a misunderstanding between the Appellant and her secretary and that the omission to send the confirmation copy was an isolated mistake. Moreover, by the statement in the application form "that the receipt of your application for enrolment will be acknowledged by e-mail. Candidates who have not received an acknowledgment by **31 December 2004** should contact the Examination Secretariat" the Appellant, who had not received any communication by e-mail or otherwise prior

to the decision under appeal, was clearly instructed to wait until said date before contacting the Examination Secretariat in case an e-mail acknowledgment was not received. Therefore the Appellant having no reason to suspect that the confirmation copy had not been sent had also no reason to pay special attention to the one month's term. Furthermore, in view of the conditions governing the facsimile filing of European patent applications the Appellant had all reasons to expect that the Examination Secretariat would have sent such an invitation or otherwise contacted her prior to the refusal of the application whose consequence is that the Appellant will have to wait a whole year before she can sit the EQE.

V. The corresponding original documents (the "confirmation copy") were received by the EQE Secretariat on 7 October 2004.

VI. Annexed to his letter dated 20 January 2005 the President of the EPO made comments pursuant to Article 27(4) of the Regulation on the EQE ("REE") and Article 12 of the Regulation on discipline for professional representatives, in which it was submitted, that Rule 24 EPC is not applicable and it is clearly set out in the Announcement of the EQE 2005, that the written confirmation must be supplied within a non-extendable period of one month. No invitation by the Secretariat to file the confirmation copy being provided or foreseen in the Announcement, the Examination Secretariat has no legal obligation to remind the candidates of that time limit. The reminder sent to the Appellant via e-mail was a courtesy service performed by the Secretariat, on which according to the case law

(decisions J 12/84, J 1/89 and J 27/92 of the Legal Board of Appeal) an applicant cannot rely. Since Article 121 and 122 EPC are not applicable, the argument of all due care having been taken by the candidate is also irrelevant.

Reasons for the decision

1. Facsimile filing is since long recognized in the proceedings under the EPC, national authorities and even judicial bodies as an efficient, reliable and valid alternative to the time-consuming and often less reliable delivery of documents by post. In line with this, facsimile filing is also available in respect of the application for enrolment for the EQE 2005 - see point I.4 of the "Announcement of the European Qualifying Examination 2005" (OJ EPO 2004, 119).

2. According to the conditions governing facsimile filing of patent applications and other documents as laid down by the President of the EPO based on Rule 24(1) and 36(5) EPC in the relatively few cases, where a confirmation is still prescribed, it has to be supplied at the invitation of the Receiving Section/the EPO; the legal sanction for non-compliance with said invitation and its legal basis are expressly indicated: refusal of the Application under Article 91(3) EPC or, respectively, that the facsimile shall be deemed not to have been received, as provided in Rule 36(5) EPC (see Article 4 of the Decision of the President of the EPO dated 26 May 1992, OJ EPO 1992, 299). It is the evident purpose of this regime to preserve as much as possible the advantages of facsimile filing and, at the same

- time, to the extent as the requirement to file a written confirmation in the conventional way is upheld, to diminish as far as possible the risk of loss of rights for non-compliance with that formal requirement.
3. The Regulation on the EQE ("REE") adopted by the Administrative Council of the EPO (OJ EPO 1994, 7 with later amendments) as well as the implementing provisions thereto drawn up by the Examination Board under Article 7(6) of the Regulation being silent on the way in which applications for the enrolment for examination have to be "addressed to the Secretariat" (Article 21(1) REE), the admission of facsimile filing and its conditions is a matter of discretion by the department responsible for arranging the yearly EQE, i.e. the Secretariat. This discretionary power has to be exercised in a reasonable manner, i.e. oriented towards the objective purpose and in consideration of general legal principles.
 4. The relevant sentence in point I.4 of the Announcement of the EQE 2005 (point 1, above) reads: "Where an application for enrolment is filed by **facsimile**, written confirmation reproducing the contents of the facsimile documents must be supplied within a non-extendable period of one month." Contrary to facsimile filings under the EPC (pt. 2 above), an invitation to file the required confirmation copy is not mentioned, with the effect - at least, as it appears to be the understanding of the Secretariat - that no such formal invitation is issued to the candidate and the one-month time limit has to be calculated from the date of the facsimile filing of the enrolment request. Moreover, the text is silent on what would be the legal

consequence, if the confirmation copy is not received by the Secretariat within said time limit.

5. Under these circumstances the apparent practice of the Secretariat to issue an e-mail warning sent to the candidate's personal mailbox, is not an effective compensation for the greater risk which candidates are exposed to under the regime as set out in the preceding point, neither in law (not mandatory, no effect on the calculation of the time limit for filing the confirmation copy), nor in fact, as the present case demonstrates: it was sent to the candidate, but was apparently not opened or overlooked by her, as it happens more easily where an information is received in purely electronic and thus unofficial form. Furthermore, as the Appellant rightly points out, from the statement at the end of the enrolment form provided by the EPO (EPAForm 51014.3), just above the space for the candidate's signature, a candidate may reasonably understand that she/he has nothing to check as regards the receipt of the documents in question before the indicated date.

6. The fact that the provisions of the EPC concerning further prosecution and re-establishment of rights (and, by the same token, the jurisprudence of the Legal Board of Appeal cited and argued with upon in the President's comments) are not applicable in respect of the time limits governing the enrolment for the EQE, does by no means exempt the Secretariat, which acts on behalf of the EPO, from its obligation to respect well established general legal principles governing all acts of the Office, in particular the protection of legitimate expectations and the obligation to draw

attention to easily remediable deficiencies. Where a department of the Office did not take on its side all "due care" required by the circumstances in this respect, it acted contrary to good faith. To the extent as this was causal for a non-observance of a time limit by a party, such non-observance does not lead to a loss of rights for the affected party - as a matter of course, and thus irrespective of whether the conditions pursuant to Article 122 EPC, including due care by the applicant, are fulfilled or not. However, in the case at hand there is no need to pursue this issue further, since there exist two (other) reasons for which the impugned decision under appeal cannot stand (see below).

7. Special circumstances which would justify stricter conditions for facsimile filings with the EQE Secretariat than with the rest of the EPO with the effect that candidates were exposed to a higher risk of a loss of rights than it is the case when other documents are filed with the EPO by facsimile, are not at all evident. Nor did the decision under appeal invoke such circumstances; rather, the sole ground given for the refusal was the fact, that no confirmation copy had been received within the one-month period. Neither the decision under appeal, nor the Announcement mentioned any legal basis for a refusal, the latter not constituting such a basis already for the mere ground, that it is silent on the legal consequences of not filing a confirmation copy.
8. Given this, the impugned refusal of the application for enrolment for the EQE 2005 is flawed both for inappropriate exercise of discretionary power and for lack of legal basis. For that reason and in view of the

Secretariat's role and resulting duties also in respect of candidates, reimbursement in full of the fee for appeal is equitable in the circumstances of the present case (Article 24(4) REE).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The Appellant's application for enrolment is considered to have been validly filed.
3. Re-imburement of the fee for appeal is ordered.

The Registrar:

The Chairman:

P. Martorana

B. Schachenmann