Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammer in Disziplinarangelegenheiten | Disciplinary Board of Appeal | Chambre de recours statuant en matière disciplinaire

Case Number: D 0032/07

D E C I S I O N
of the Disciplinary Board of Appeal
of 15 February 2008

Appellant: n.n.

Decision under appeal: **Decision of the Examination Secretariat dated 14 August 2007.**

Composition of the Board:

Chairman: P. Messerli
Members: B. Schachenmann
P. Gendraud

Summary of Facts and Submissions

I. The appellant has appealed against the decision of the Examination Secretariat, dated 14 August 2007, refusing his application for enrolment for the European qualifying examination in 2008. The notice and the grounds of appeal were filed on 11 September 2007 on which date the appeal fee was also paid. Additional submissions were filed on 8 January and 6 February 2008.

II. In his application for enrolment for the EQE 2008 the appellant had referred to a period of professional activity pursuant to Article 10(2)(a)(ii) REE from September 2004 to September 2007. The Examination Secretariat refused the application on the ground that the Certificate of Training filed for this period was only substantiated with a copy of one single authorization to represent the employer in a case before the EPO. This did not fulfil the requirement of having represented the employer before the EPO in accordance with Article 133(3) EPC while taking part in a wide range of activities pertaining to European patent applications and patents as required in Article 10(2)(a)(ii) REE.

III. The appellant contested this finding. The appellant submitted that the underlying thought of Article 10(2)(a) REE, especially when Article 10(4) REE was taken into account, was that only candidates possessing sufficient background knowledge relating to patent applications and patents, in particular European patent applications and patents, could take the EQE. This thought was present in the whole of Article 10(2)(a) REE and fitted the literal meaning of the

provisions. In this context, the number of representations before the EPO was irrelevant as was the number and nature of authorizations. Concerning, in particular, Article 10(2)(a)(ii) REE, it only mattered that a candidate had performed at least one such representation while taking part in a wide range of (other) activities pertaining to European and national patents and patent applications. These conditions, however, were satisfied by the appellant. As the provisions of Article 10(2)(a)(ii) REE were as clear as they could be, there was no room for a narrow interpretation requiring any higher number of representations before the EPO in accordance with Article 133(3) EPC based on an alleged purpose of the REE. Quite to the contrary, as followed from previous decisions of the Disciplinary Board of Appeal, Article 10(2)(a) REE was to be handled liberally at least in borderline cases (see e.g. D 25/96, point 3.3.2). The appellant's situation is to be considered as such a borderline case.

Both, in September 2004, when the appellant started his training, as well as in July 2007 when he intended to enrol for the EQE, the existing case law rejected any such narrow interpretation (see e.g. D 4/86, point 5, last paragraph). A new interpretation of the Article 10(2)(a)(ii) REE requiring a higher number of representations therefore violated the appellant's reasonable expectations, introduced legal uncertainty and led to unequal treatment of candidates.

IV. The appellant therefore requested that the decision under appeal be set aside and that his enrolment for the EQE 2008 be found to meet the requirements set out

in the REE. He also requested, as an auxiliary request, that the acceptable proportion of activities relating to national patent applications and patents be decided upon, as well as the complete effective duration of his period of professional activity.

V. In a communication dated 12 December 2007 the Disciplinary Board of Appeal informed the appellant of its preliminary view. Article 10(2)(a)(ii) REE presupposed that the employer of a candidate utilised the possibility provided for in Article 133(3) EPC, first sentence, to be represented in proceedings before the European Patent Office by an employee. However, in the appellant's case, it was the policy of the employer to outsource representation before the EPO to external patent agents so that, with the exception of a single case in May 2007, the appellant's employer did not make use of the possibility provided for in Article 133(3) EPC. It therefore appeared that the requirements under Article 10(2)(a)(ii) REE were not fulfilled.

VI. The Disciplinary Board of Appeal issued letters dated 23 November 2007 inviting the President of the European Patent Office and the President of the Council of the Institute of Professional Representatives (epi), pursuant to Articles 27(4) REE and 12 RDR, to comment on the case. In a reply dated 10 January 2008 the President of the Council of the Institute of Professional Representatives stated that he had come to the view that the preliminary view of the Board should be followed.

Reasons for the Decision

1. The appeal is admissible.

2. According to Article 27(1) REE an appeal shall lie from decisions of the Examination Board and the Secretariat only on grounds of infringement of the REE or any provision relating to its application. Concerning the appellant's main request the question to be examined is therefore whether the Secretariat, by rejecting the appellant's application for enrolment for the EQE, had infringed Article 10(2)(a)(ii) REE.

3. According to Article 10(2)(a) REE there are only three recognized types of professional training to achieve the practical experience required for enrolment to the EQE:

   (i) a full time training period of at least three years under the supervision of and as an assistant to a professional representative entered on the list referred to in Article 134(1) EPC in which period the training involves taking part in a wide range of activities pertaining to European patent applications or European patents;

   (ii) full time work for a period of at least three years in the employment of an employer whose residence or place of business is in a Contracting State whereby the employment involves representing the employer before the EPO in accordance with Article 133(3) EPC while taking part in a wide range of activities pertaining to European patent applications or European patents;

(iii) full time work for a period of at least three years as an assistant to a person as defined in paragraph (ii) in a wide range of activities pertaining to European patent applications or European patents.

4. As the Disciplinary Board of Appeal found in its decision D 25/96, the forms of training referred to above are connected with the permitted forms of action before the EPO in Articles 133 and 134 EPC. In particular, the type of training under paragraph (ii) refers to candidates employed by an employer in a Contracting State utilising the possibility provided for in Article 133(3), first sentence, EPC, to be represented in proceedings before the European Patent Office by an employee. The requirement of having represented the employer before the EPO obviously serves the purpose of establishing that type (ii) candidates have gained a reasonable amount of personal experience in conducting proceedings before the EPO.

5. From this it follows that the finding of the Secretariat in the decision under appeal did not violate Article 10(2)(a)(ii) REE since a candidate who, during the three years training period, has represented his employer before the EPO only once cannot be said to have gained a reasonable amount of experience in conducting proceedings before the EPO. The appellant's interpretation of this requirement would reduce it to a mere formality which would have no noticeable effect on the candidate's preparation for the EQE. Since the requirement of having represented the employer before the EPO lies at the very heart of this type of training,

the appellant's case cannot either be considered as an admissible borderline situation of a type (ii) activity.

6. The present Board is not competent within the framework of the present proceedings to define *in abstracto* which number of representations would be necessary for a candidate to meet Article 10(2)(a)(ii) REE. However, it appears that the Secretariat, when deciding on future cases, should consider the practical circumstances of type (ii) trainings. It can e.g. hardly be expected that a candidate will be authorized to represent his employer in proceedings before the EPO already from the very outset of the training period. In applying this requirement emphasis should therefore lie more on its purpose in view of a reasonable preparation for the EQE (see point 4, supra) than on the mere number of cases.

7. The appellant's reference to the decisions D 4/86 and D 25/96 does not appear to be relevant for the present case since these decisions concern the type of training as defined in Article 10(2)(a)(i) REE, i.e. training under the supervision of and as an assistant to a professional representative. This type of training does not give rise to the issues to be decided here since the candidates need not (and cannot) have represented a party before the EPO. The appellant could not therefore draw any conclusion from these decisions which would have justified the expectation that the application for enrolment was accepted in the circumstances of his case.

8. With regard to the appellant's auxiliary request it is pointed out that the competence of the Disciplinary Board of Appeal is limited by Article 27(1) REE to examine whether or not decisions of the Examination

Board or the Secretariat infringed the REE or any provision relating to its application. On the other hand, it is the Examination Secretariat which is competent under Article 9(4) REE to decide on the enrolment of candidates in accordance with instructions drawn up by the Examination Board. Thus, it is not up to the Disciplinary Board of Appeal to decide, within the framework of the present proceedings, upon an acceptable proportion of activities relating to national patent applications and patents or upon the complete effective duration of the appellant's period of professional activity in view of a future application for enrolment for the EQE.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

P. Martorana P. Messerli