



Case Number: D 0034/07

D E C I S I O N
of the Disciplinary Board of Appeal
of 11 January 2008

Appellant: n.n.

Representative: 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 to refuse his application for enrolment for the European qualifying examination ("EQE") 2008. The notice of appeal and the statement of grounds of appeal were both filed on 12 September 2007 on which date the appeal fee was also paid. The appellant requests that the decision under appeal be set aside and that the Examination Secretariat be ordered to grant his application for enrolment for the EQE 2008.
- II. In the refused application for enrolment the appellant indicated that he had worked full-time for a period of three years as an assistant to, and under the direct supervision of, a person who had represented his employer, X. A/S, before the European Patent Office under Article 133(3) EPC 1973. According to the *Certificate of training or employment* filed together with the application form that person was Mr B., head of the patent department of X. A/S.
- III. According to the decision under appeal, the filed *Certificate of training or employment* could only be considered to cover a period of one year and five months since a general authorisation authorizing Mr B. to represent X. A/S in proceedings before the EPO was only filed on 6 September 2006 and no general authorization existed before this time. For the period from 21 January 2005 until 6 September 2006, Mr B. was therefore not an employee representing X. A/S in proceedings established by the EPC according to Article 133(3) EPC 1973 so that the conditions of

Article 10(2)(a)(iii) REE were not fulfilled for the appellant.

IV. This finding was contested by the appellant. His arguments as submitted in the statement of the grounds of appeal and in a reply to a communication of the Board can be summarized as follows:

The Examination Secretariat failed to consider that already on 3 May 2004 a trainee in the patent department of X. A/S, Mr T., had filed, for the purposes of enrolment for the EQE 2005, a certified copy of a power of attorney with regard to Mr B. with the Examination Secretariat. Even if the official form (EPO form 1004 "General authorization") was not used for that document, it followed from its content that Mr B. was authorized to represent X. A/S in all proceedings before the European Patent Office as of May 2004. Indeed, during the time period before the filing of the general authorization Mr B. himself had represented X. A/S before the EPO in a case concerning suspension under Rule 13 EPC 1973. Moreover, he took part in a wide range of activities pertaining to European patent applications and attended most of the oral proceedings before the EPO relating to X. A/S, although external professional representatives formally acted on behalf of his company. Therefore, during the entire three-year period in question, Mr B. represented his employer before the EPO in accordance with Article 133(3) EPC as required by Articles 10(2)(a)(ii) and (iii) REE.

Furthermore, in the particular circumstances of the appellant's case, the principle of legitimate

expectations should have been considered. In application of this principle, measures taken by the Secretariat should not have violated the reasonable expectation of the appellant that his period of training at X. A/S under the supervision of Mr B. would be recognised by the Secretariat. This expectation was justified by the fact that in previous years the Secretariat had accepted other trainees, in particular Mr T., from the same patent department with the same training experience to sit the EQE. This fact led to the legitimate expectation of the appellant from the very outset of his training period that the supervision by Mr B. was sufficient to qualify him for enrolment for the EQE. Indeed, in an interview preceding his employment at X. A/S the appellant had discussed this issue with Mr B. who, in all good faith, had referred to other trainees in the patent department of X. A/S who meanwhile had been accepted by the Secretariat to sit the EQE. This fact was one of the appellant's main reasons to accept employment in the patent department of X. A/S.

- V. The Disciplinary Board of Appeal issued letters dated 11 December 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 pointed out that the requirements for enrolment to the EQE were designed to ensure that a candidate had been trained on a full time basis by a person who was himself dealing on a day to day basis with European patent applications and

oppositions before the EPO. It would appear that the appellant's employer was not doing this. It also appeared that any interaction with the employer's external patent attorneys was not of sufficient duration to make up the deficit.

VI. Oral proceedings were held on 11 January 2008. The President of the EPO nominated Mr Machwirth to attend on her behalf (Article 14 RDR).

Reasons for the Decision

1. The appeal complies with the provisions of Article 27(1) and (2) REE and is therefore admissible.
2. The appellant, for the purposes of his enrolment for the EQE 2008, refers to Article 10(2)(a) subparagraph (iii) REE which requires full-time work during a training period of at least three years as an assistant to, and under the direct supervision of, a person as defined in subparagraph (ii), i.e. a person who has represented an employer with residence in a Contracting State before the EPO "in accordance with Article 133(3) EPC" during the training period.
3. The first issue to be dealt with in the present case is whether or not the appellant's trainer, Mr B., has indeed complied with the requirements of subparagraph (ii) of Article 10(2)(a) REE during the relevant training period. The Examination Secretariat has denied this based on the finding that a general authorisation in accordance with Article 133(3) EPC 1973 of Mr B. was only filed on 6 September 2006 whilst the appellant's

training period had already started on 21 January 2005. Thus, during the first part of the appellant's training period Mr B. did not comply with the requirements of subparagraph (ii) referred to above. The Board concurs with this finding for the following reason:

3.1 As the Disciplinary Board of Appeal has judged in case D 4/07 (in a different composition) the words "in accordance with Article 133(3) EPC" in Article 10(2)(a)(ii) REE mean that this Article cannot be complied with unless (as the case may be) the trainer or trainee has, throughout the training period, held an authorization under Rule 101 EPC 1973. It continued by stating that of the two types of authorization covered by that Rule, only a general authorization could give a person in question the necessary full-time work in a wide range of activities pertaining to European patent applications of European patents. The present Board in principle agrees with this finding even if it would not exclude that, in particular circumstances, Article 10(2)(a)(ii) REE could also be complied with where authorizations were filed on a case by case basis throughout the training period.

3.2 In the circumstances of the present case, it is not disputed that a general authorization of Mr B. was filed with the EPO on 6 September 2006. However, for the time before that date the question arises as to whether the filing of a power of attorney of Mr B. with the Examination Secretariat on 3 May 2004 in connection with the enrolment of Mr T. for the EQE 2005 (see point IV., supra) was sufficient for the purposes of representation under Article 133(3) EPC 1973.

3.3 The relevant legal provisions for answering this question are Article 15 EPC 1973, Article 133(3) EPC 1973, Rule 101(3) EPC 1973 and the Notice of the President of the European Patent Office dated 20th December 1984 concerning general authorizations (OJ EPO 1985, 42). According to Article 133(3) EPC 1973 companies having their residence in a Contracting State "may be represented in proceedings established by this Convention by an employee who must be authorized in accordance with the Implementing Regulations". Rule 101(3) EPC 1973 provides that the President of the EPO may determine the form and content of a general authorization. This he did in the Notice referred to above. In accordance with point 1 of the Notice, the Legal Division is responsible for decisions concerning the registration of general authorizations. From these provisions it follows that a general authorization concerning proceedings established by the EPC must be filed with a department charged with the procedures of the EPC according to Article 15 EPC 1973, in particular the Legal Division who is responsible for its registration.

3.4 However, in the circumstances of the present case, the power of attorney in question was only filed with the Examination Secretariat which is not a department charged with the procedures of the EPC but a special unit created under Article 6 REE to provide the Examination Board and its committees with the necessary administrative facilities. Its duties are listed in Article 9 REE and are strictly limited to matters concerning the EQE. Thus, if a general authorization is filed with the Examination Secretariat only for the

purposes of the EQE and has not been filed with a department of the EPO as defined in Article 15 EPC 1973, it has no effect under Article 133(3) EPC 1973 for proceedings established by the EPC. For this reason, the filing of the power of attorney of Mr B. with the Examination Secretariat on 3 May 2004 was not sufficient to establish that he was authorized under Article 133(3) EPC 1973.

4. The second issue to be considered concerns the principle of legitimate expectations invoked by the appellant. Indeed, according to the jurisprudence of the Disciplinary Board of Appeal this principle is also applicable in proceedings relating to enrolment for the EQE (see D 25/96, point 2.1, OJ EPO 1998, 45). In this connection it is to be considered that the Examination Secretariat had accepted Mr T., a former trainee in the patent department of the appellant's employer who also was supervised by Mr B., to sit the EQE 2005 and that this fact was relevant for the appellant when applying for a job in the patent department of X. A/S. The successful enrolment of Mr T. for the EQE 2005 led Mr B. and the appellant to believe in all good faith that a training period in the patent department of X. A/S under the supervision of Mr B. was considered by the Examination Secretariat to meet the requirements of Article 10(2)(a)(ii) and (iii) REE and, in particular, that the filing of a certified copy of a power of attorney of Mr B. with the Examination Secretariat was sufficient to establish that Mr B. was authorized in accordance with Article 133(3) EPC 1973. The particular circumstances of the enrolment of Mr T. for the EQE 2005 were confirmed by a letter from Mr T. to the Board dated 4 January 2007 stating *inter alia* that he had no

reason to believe that the situation regarding the present patent managers at X. A/S, including the appellant, was any different. This is all the more credible as Mr T. is no longer an employee of X. A/S. Other trainees from the patent department of X. A/S had also been accepted to sit the EQE 2006. Even if in these cases the circumstances may have been somewhat different, they in any case strengthened the expectation of the appellant that he also met the requirements for enrolment for the EQE.

- 4.1 On the basis of these circumstances the Board concludes that the persons involved in the training of the appellant in the patent department of X. A/S could legitimately expect at the outset of his training period that the training complied with the requirements of the REE and would be acknowledged as such by the Examination Secretariat. This legitimate expectation is to be protected.

Order

For these reasons it is decided that:

1. The decision of the Examination Secretariat dated 14 August 2007 is set aside.
2. The appeal fee is reimbursed.
3. The case is remitted to the Examination Secretariat with the order to enrol the appellant for the European qualifying examination in 2008.

The Registrar:

The Chairman:

P. Martorana

P. Messerli