



Europäisches  
Patentamt

European  
Patent Office

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des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number: D 0021/99

**D E C I S I O N**  
of the Disciplinary Board of Appeal  
of 8 June 2000.

Appellant: n.n.

Decision under appeal: Decision of the Examination Secretariat dated  
16 June 1999.

**Composition of the Board:**

**Chairman:** W. Moser  
**Members:** B. Schachenmann  
J. P. Seitz  
E. Lyndon-Stanford  
Ch. Kaloniarou

### Summary of Facts and Submissions

- I. The present appeal lies from a decision of the Examination Secretariat refusing the appellant's application for enrolment for the 1999 European qualifying examination.
  
- II. For the purposes of enrolment the appellant had filed application papers together with a Certificate of training or employment. It followed therefrom that she had worked full-time for a period of 3 1/2 years in the Oslo patent department of a company having its place of business in Norway. The Certificate was signed by Mr B., a professional representative working in Brussels as an employee of a Dutch subsidiary of the Norwegian company.
  
- III. The Examination Secretariat asked for more precise data concerning the periods of training. In reply the appellant submitted that, apart from her full time job in the Oslo patent department, the training on the job had been 2 days every month involving discussions on cases with Mr B. and reviewing questions and exercises prepared in connection with two training courses attended by her.
  
- IV. On 15 March 1999 the Examination Secretariat informed the appellant that her application for enrolment did not fulfill the requirements of Article 10(2)(a)(iii) REE. In particular, the physical distance between the appellant in Norway and the supervisor in Belgium in itself excluded the possibility of the control required.

- V. With letter dated 22 April 1999 the appellant applied for an appealable decision. She submitted that the argument concerning the physical distance between her and her supervisor seemed unreasonable as the IT technology of today gave possibilities that almost made geographical distances unimportant.
- VI. With decision of 16 June 1999 the Examination Secretariat refused the application for enrolment for the 1999 European qualifying examination. In its opinion it was not established that the appellant had assisted Mr B. within the meaning of Article 10(2)(a)(iii) REE by constantly taking part in activities pertaining to procedures of which the representative was in fact in charge. In addition, she had not worked under his direct supervision which had required direct control by means of a day-to-day guidance, direction and assistance. All this could not be assured by the IT technology.
- VII. In the statement setting out the grounds for appeal the appellant maintained that she had satisfied the conditions laid down in Article 10(2)(a)(iii) REE. Her submissions can be summarized as follows:
- (i) Being a counsel of industrial property in one of Norway's biggest industrial companies, she was handling all kind of subjects related to intellectual property rights on a full time basis and in direct personal contact with the inventors/researchers. She prepared, filed and prosecuted patent applications in the Norwegian Patent Office, under the PCT and in other countries. European patent applications, responses to official communications and oppositions prepared by herself were filed in the name of the Norwegian company by Mr B. who was the company's in-house attorney having his

place of business in Brussels. Mr B. signed and filed the applications and responses at the EPO if he found them satisfactory. Otherwise, matters were discussed with him when he was in Oslo or, if needed at another point of time, by telephone or e-mail. Thus, she was quite frequently in contact with the European patent system.

(ii) This way of working was quite similar to that of a candidate in a patent department of an industrial company in a EPC Contracting State. Thus, it was unreasonable to consider that the exercise of supervision within the meaning of Article 10(2)(a)(iii) REE implied that the supervisor had to exercise direct control over the work of the candidate by means of a day-to-day guidance.

(iii) It was also unreasonable to assume that the provision referred to above implied that the supervisor and the candidate could not work at different locations. The IT technology of today gave possibilities for supervision also in periods when the candidate or the supervisor was absent from the office. In particular, the e-mail system allowed more flexible supervision than before, even if the candidate and the supervisor work at different places.

VIII. In an annex to the summons to oral proceedings the Disciplinary Board of Appeal set out that Mr B. seemed to have acted as professional representative for the Norwegian company and that the relevant provision for the appellant would therefore be that of sub-paragraph (i) of Article 10(2)(a) REE referring to a training as an assistant to a professional representative. This

provision required a full-time training period in one of the EPC Contracting States under the supervision of the professional representative. Since the appellant was working full-time in the patent department of a Norwegian company in Oslo, she did not seem to have complied with these requirements even if she could contact her supervisor by telephone or e-mail.

IX. At the oral proceedings held on 8 June 2000 the appellant and Mr B., who assisted her (Article 17 of the Regulation on discipline for professional representatives in conjunction with Article 27(4) REE), insisted on sub-paragraph (iii) of Article 10(2)(a) REE as the applicable provision. They maintained that, even if Mr B. was not employed by the Norwegian company, their companies belonged to the same group and, as a matter of fact, Mr B. was a member of the group's patent department as was the appellant. The Dutch subsidiary was used as seat in a EPC Contracting State for the group's representative before the EPO. Since the time Mr B. had joined the group, it was the policy to file European patent applications in the name of the Norwegian company which does not have its place of business in a EPC Contracting State. However, Mr B. was working in the Oslo offices for two days every month. In reply to a question of the Board, the appellant stated that she and Mr B. had worked substantially on the same hierarchic level during the training period. Only in connection with European patent proceedings had Mr B. the final decision in case of disagreement.

X. At the end of the oral proceedings the appellant requested that the decision under appeal be set aside and that her application for enrolment be accepted for the 2001 European qualifying examination or any later European qualifying examination.

XI. The President of the European Patent Office and the President of the Institute of Professional Representatives before the European Patent Office were given the opportunity to comment. They did not make use of this opportunity. The President of the European Patent Office appointed a representative who was present at the oral proceedings before the Disciplinary Board of Appeal.

### Reasons for the Decision

1. The appeal complies with Article 27(1) and (2) REE. Thus, it is admissible.
2. Candidates who apply for enrolment for the European qualifying examination must be able to satisfy the Secretariat that at the date of the examination they comply with at least one of the sub-paragraphs (i) to (iii) of Article 10(2)(a) REE concerning practical experience.
3. In the circumstances of the present case the Examination Secretariat denied that the candidate met the conditions of sub-paragraph (iii) of Article 10(2)(a) REE on which she had based her application for enrolment. Thus, the issue at stake is whether the appellant complied with the requirements of this sub-paragraph or any of the sub-paragraphs (i) or (ii) of Article 10(2)(a) REE.

The provisions referred to above define three possible ways to achieve the practical experience required. It was a decision of the legislator that only these three ways of training can be recognised for enrolment

purposes. They are connected with the permitted forms of action before the EPO laid down in Articles 133 and 134 EPC (see decision D 25/96, OJ EPO 1998, 45, point 3.3.1 of the reasons).

- 3.1 **Sub-paragraph (i)** of Article 10(2)(a) REE refers to a full-time training in one of the Contracting States under the supervision of a person entered on the list of professional representatives referred to in Article 134(1) EPC, as an assistant to that person or those persons. The requirement that the training period must be spent in one of the Contracting States is a consequence of Article 134(2)b) EPC according to which persons entered on the list must have their place of business or employment within the territory of one of the Contracting States.

In the present case the supervisor of the appellant, Mr B., is a person entered on the list of professional representatives having his employment within one of the Contracting States. In this capacity he acted as a representative for the Norwegian company by which the appellant was employed during the training period. However, in contrast to him, the appellant was working in Norway for the whole period in question and thus was at no time working "in one of the Contracting States". On this ground, the appellant's activity during the relevant period does not comply with sub-paragraph (i) of Article 10(2)(a) REE.

- 3.2 The second type of practical experience as defined in **sub-paragraph (ii)** of this Article relates to full-time work in the employment of a natural or legal person whose residence or place of business is within a Contracting State, as a representative of the employer before the EPO. This type of training is connected with Article 133(3) EPC according to which companies having

their place of business in a Contracting State of the EPC may be represented before the EPO by an employee who need not be a professional representative. Thus, the place of business of the employer in a Contracting State is a material condition for this type of practical experience.

However, for the whole period in question the appellant was in the employment of the Norwegian company which does not have its base of business within the territory of the Contracting States, although some of its subsidiary companies do so. Thus, she could not act as a representative for this company under Article 133(3) EPC and her activity did not, for this reason, comply with sub-paragraph (ii).

3.3 **Sub-paragraph (iii)** refers to full-time work as an assistant to, and under the direct supervision of, a person as defined in sub-paragraph (ii), i.e. an employee representing his employer before the EPO in accordance with Article 133(3) EPC. It is this provision on which the appellant based her application for enrolment.

Regarding this type of training, the only relevant person for whom the appellant could have worked as an assistant is Mr B. (see paragraph II, supra). However, there was no assertion that he represented anyone other than the Norwegian company during the relevant period (see paragraph IX, supra). As a professional representative acting for a company not having its place of business within the territory of the Contracting States, Mr B. is not a person as defined in sub-paragraph (ii). For this reason alone, the appellant did not meet the criteria of sub-paragraph (iii) in conjunction with sub-paragraph (ii).



Moreover, according to sub-paragraph (iii), the candidate's work "as an assistant" must be full-time. However, as follows from the facts and submissions (supra), the appellant's activity was divided between preparing, filing and prosecuting European patent applications (about five per year) and preparing, filing and prosecuting other patent applications in the Norwegian Patent Office, under the PCT and in other countries. Mr B. was not involved in the latter work. At least for the period after 1993, which is the only relevant period in relation to sub-paragraph (iii), the appellant was working on her own responsibility for all matters other than European patent applications, and was not working in any way with Mr B.. Thus, the appellant was not working full-time in any way with Mr B. and also for this reason did not comply with the requirements of subparagraph (iii). It therefore can be left open whether, in view of the fact that her position was equal to that of Mr B. in the group's hierarchy, she could properly be described as an "assistant" to Mr B..

4. The appellant further argued that her activities were quite similar to those of a candidate in a patent department of an industrial company in a EPC Contracting State and that modern IT technology allowed more flexible supervision than before. However, as mentioned above, practical experience is to be recognised for enrolment purposes if acquired as part of the activities admissible under Article 10(2)(a) REE, i.e. the three forms of training permitted in this provision. Given this "evaluation-by-type" approach, it is not possible to examine individual conditions of training to ascertain whether they provided suitable preparation for the examination unless the training period was completed in one of the permitted forms.

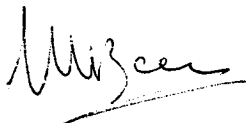
5. For these reasons, the Examination Secretariat was correct to refuse the appellant's application for enrolment for the 1999 European qualifying examination. The appellant's request regarding an application for enrolment for the 2001 European qualifying examination or any later examination cannot be granted on the basis of the present facts.

**Order**

**For these reasons it is decided that:**

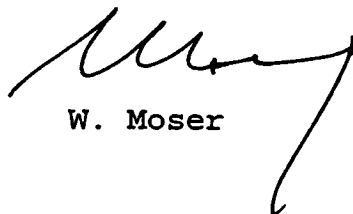
The appeal is dismissed.

The Registrar:



M. Beer

The Chairman:



W. Moser