

Decision of the Legal Board of Appeal dated 5 October 2011

J 0008/10

(Translation)

Composition of the board:

Chairwoman: B. Günzel

Members: F. Blumer

E. Dufrasne

Applicant: N.N.

Headword: n/a

Relevant legal provisions:

Article: 134(1), (2) and (8), 134a(1)(c) EPC

Rule: 152(1), (2), (6), (10) and (11) EPC

Keyword: "Legal practitioner as member of association of representatives (no)"

Headnote:

As the rules on the filing of authorisations stand, a legal practitioner cannot be treated as a member of an association of representatives within the meaning of Rule 152(11) EPC.

Summary of facts and submissions

I. The contested decision relates to registration of an association of representatives under Rule 152(11) EPC. The appellant is a legal practitioner authorised to practise in Germany. On 25 September 2008, he and 11 professional representatives (European patent attorneys) applied for registration as an association. The EPO's Legal Division duly registered the 11 professional representatives as association No. xxx, but by letter of 21 November 2008 said the appellant could not be registered

as a member; only professional representatives could form associations. The appellant then requested an appealable decision.

II. The appellant's registration as a member of association No. xxx was refused by the contested decision dated 15 July 2009, on the basis in particular of the "Communication on matters concerning representation before the EPO" (OJ EPO 1979, 92) and the decision, cited therein, on the interpretation of Rule 101(9) EPC 1973 (now Rule 152(11) EPC) taken by the Administrative Council of the European Patent Organisation in December 1978, namely that an association could consist "solely of professional representatives on the EPO list in private practice".

III. On 15 September 2009, the appellant filed an appeal against the decision of 15 July 2009; the appeal fee was paid on the same day. The statement of grounds of appeal was filed on 11 November 2009.

IV. In that statement it was argued in particular that the wording and rationale of Rule 152(11) EPC did not justify treating legal practitioners differently from professional representatives. The rule referred to "representatives", not "professional representatives". Under Article 134(8) EPC, representation in proceedings before the EPO could be undertaken by a nationally qualified legal practitioner "in the same way as by a professional representative". So the term "representative" in Rule 152(11) EPC covered not only professional representatives but also legal practitioners entitled to act under Article 134(8) EPC.

V. Under "historical" and "teleological interpretation", the appellant argued that the intention had always been for legal practitioners to be on the same footing as professional representatives as regards entitlement to act. The sense and purpose of Article 134 EPC was to ensure that only highly qualified people represented parties before the EPO. In the EPC and its legislative history, no fundamental doubts that legal practitioners were thus qualified could be found. The supervisory mechanisms of the EPO and *epi* (Institute of professional representatives before the EPO) for professional representatives, and the national supervisory mechanisms for legal practitioners, had clearly been regarded as equivalent. There was therefore no

justification for regulating registration as a member of an association differently for legal practitioners as opposed to professional representatives.

VI. In a communication issued on 21 February 2011, the board summarised its provisional opinion. In the light of the EPO communication referred to in point II above it understood the Council's 1978 interpretation decision to mean that

- (i) an association could only comprise professional representatives,
- (ii) the professional representatives had to be in private practice, and
- (iii) only professional representatives could act in business matters in the association's name.

VII. The board noted that the second of these cumulative conditions no longer applied, since J 16/96 (OJ EPO 1998, 347) had found that associations within the meaning of Rule 152(11) EPC (Rule 101(9) EPC 1973 at the time) could also include professional representatives not in private practice. But it saw no compelling grounds for waiving the other two registration conditions.

VIII. In the board's provisional opinion, another reason why legal practitioners could be treated differently from professional representatives in authorisation matters was that the former – unlike the latter – were not subject to the disciplinary authority of the EPO and *epi*. The board pointed out that the two groups of professionals had different relationships to the EPO. In particular, only professional representatives were entered on the list of representatives kept by the EPO under Article 134(1) and (2) EPC.

IX. The board added that applying Rule 152(11) EPC to associations to which legal practitioners also belonged would be at odds with the President's decision of 12 July 2007 on the filing of authorisations (OJ EPO, special edition 3/2007, 128). The rule (Article 2 of the decision) that an authorised legal practitioner always had to file a signed authorisation or a reference to a general authorisation already on file could be circumvented if legal practitioners were admitted to associations under Rule 152(11) EPC.

X. In oral proceedings on 5 October 2011 the appellant explained how large law firms acting before the EPO operated, and the advantages for them of being able to register as an association. Those advantages became particularly apparent when individual representatives joined or left the association, because the changed composition of the registered association led automatically to changed authorisation arrangements for multiple sets of proceedings, so changes did not have to be indicated separately for each one. In view of Article 134(8) and Rule 152 EPC, it was not justifiable for legal practitioners working in such firms to be deprived of those advantages.

XI. The appellant explained that it was often the firm – rather than an individual professional representative – that a client would instruct to act in proceedings before the EPO, and many firms employed legal practitioners as well as professional representatives, who often worked together for the client. Since the EPC's entry into force, representation by legal practitioners had never led to any major problems, mainly because those who acted before the EPO were in any case well versed in patent matters, for example due to their technical training. In such an environment, interested legal practitioners had a legitimate right to equal treatment with professional representatives as regards associations of representatives.

XII. The appellant requested that the contested decision be set aside and that he be admitted to association No. xxx.

Reasons for the decision

1. The appeal is admissible (see summary of facts and submissions, point III).

2. The board's first task is to establish the rules applicable, how they interact, and how far they are binding on the boards.

2.1 The main provision governing entitlement to act in proceedings before the EPO is Article 134 EPC, legal practitioners' entitlement to act being regulated in particular by its paragraph 8. Rule 152 EPC governs the filing and effects of authorisations, its paragraph 11 being concerned with authorisation of associations of representatives.

The EPC revision has not significantly altered these provisions: Rule 152(11) EPC corresponds to Rule 101(9) EPC 1973.

2.2 Rule 152(1) EPC was the basis for the President's decision of 12 July 2007 on the filing of authorisations (OJ EPO special edition 3/2007, 128, hereinafter "decision on the filing of authorisations"), which stipulated (in its Articles 1 and 2) that professional representatives had to file an authorisation only in certain cases, whereas legal practitioners always had to do so. This exercise of regulatory powers under Rule 152(1) EPC thus drew a distinction (as did the President's earlier decision dated 19 July 1991 on the filing of authorisations, OJ EPO 1991, 489) between professional representatives and legal practitioners, even though Rule 152(1) EPC refers only to "representatives" and thus to both groups.

2.3 The board sees no reason to doubt that the decision on the filing of authorisations is lawful, and hence binding also on the boards of appeal. It is covered by the President's regulatory discretion under Rule 152(1) EPC, and contains nothing which suggests that discretion was misused. The distinction between professional representatives and legal practitioners seems appropriate, not arbitrary. Professional representatives are subject to the disciplinary authority of the Institute of professional representatives (*epi*) or the EPO (Article 134a(1)(c) EPC); for legal practitioners, in contrast, disciplinary authority is exercised under national law by national organisations or authorities. A professional representative's entitlement to act can be ascertained by simply consulting the list maintained by the EPO under Article 134(1) and (2) EPC. A legal practitioner's is much harder to establish. In the interests of transparency it is at least desirable for clients to know at any time whether they are being represented by a professional representative (who will be technically qualified), or by a legal practitioner (who may not be). Such transparency is promoted by requiring legal practitioners always to submit an authorisation.

2.4 The decision on the filing of authorisations contains no provisions specific to associations of representatives, and therefore no derogations, from its filing requirements, that might apply to such associations or their members.

2.5 In December 1978, after discussing the possible deletion of Rule 101(9) EPC 1973 – a subsequent addition to the Implementing Regulations which is identical in substance to today's Rule 152(11) EPC – the Administrative Council took a decision on how this rule should be interpreted (hereinafter "interpretation decision"), namely that an "association of representatives" within the meaning of Rule 101(9) EPC 1973 was to be taken as meaning an association consisting solely of professional representatives on the EPO list in private practice ("Communication on matters concerning representation before the EPO", OJ EPO 1979, 92, point 1, second paragraph; see also the notice in OJ EPO 1978, 281). So by limiting the scope of the term to professional representatives, the interpretation decision put a narrower construction on the wording of Rule 152(11) EPC, if "representative" in that provision is assumed to refer also to legal practitioners authorised to act before the EPO.

2.6 When the Legal Board of Appeal had to decide whether professional representatives not in private practice could also form associations of representatives within the meaning of Rule 101(9) EPC 1973, it consciously departed from the interpretation decision and decided that such associations did not have to be restricted to professional representatives in private practice (J 16/96). The board in J 16/96 had no need to consider whether legal practitioners too could be members, because the association in question consisted solely of professional representatives.

2.7 In J 16/96 (Reasons 2) the board held that the interpretation decision, although not binding on the boards of appeal, was nonetheless to be taken into account when interpreting Rule 101(9) EPC 1973. The interpretation decision was published in a "Communication on matters concerning representation before the EPO" (OJ EPO 1979, 92) which contains not only the interpretation decision but also various explanations and implementing provisions for its practical application. These parts of the 1979 communication are likewise not binding on the boards, and for interpreting Rule 152(11) EPC are of no more than subordinate significance.

2.8 With the EPC and its Implementing Regulations silent on this matter, the board must base its ruling primarily on the decision on the filing of authorisations, taken by the President under Rule 152(1) EPC to give legal substance to that rule – and, as

such, a normative provision that, unlike those referred to above (point 2.7) as a possible legal basis, does have binding effect for the boards.

3. The appellant explained to the board the practical importance of having associations authorised, or having them entered as representatives in the Register. The advantages of associations became apparent in particular when individual professional representatives joined or left. The larger the firm or association, the more often its composition was likely to change. Registering such changes for an association saved having to amend the registered representation details separately for each individual application the firm was handling.

4. The board agrees with the appellant that wherever the EPC Implementing Regulations refer to an association of representatives they mean the association in its latest composition. So once an association has been authorised, any representative belonging to it is entitled to act for a party if, when he does so, he is practising within it. If authorisation were confined only to those representatives who were practising within the association on the date it was authorised or registered on the EPO's list, the administrative simplifications the appellant mentions (see point 3 above) would not be achieved.

5. Associations of representatives are mentioned in Rules 143(1)(h) and 152(11) EPC. Apart from that, both the EPC and its Implementing Regulations are silent about them. Rule 143 EPC concerns entries in the patent register; its paragraph (1)(h) provides that only the name and address of associations of representatives under Rule 152(11) EPC are entered in the register. Rule 152(11) EPC establishes the legal fiction that the authorisation of an association of representatives is deemed to be an authorisation of any representative who can provide evidence that he practises within that association.

6. Although Rule 152(11) EPC refers to "authorisation of an association of representatives", authorisation does not relate to the association as a legal person; it is granted exclusively to the individual members (J 16/96, Reasons 4.3), even if the authorisation form gives only the name of the law firm or the legal entity (e.g. "XY LLP") and the mandate to act before the EPO is being given to the legal entity. If a

representative addresses a submission to the EPO and expressly signs it on behalf of the legal entity ("for and on behalf of XY LLP" etc.), established EPO practice is to understand him to be signing on behalf of the client. The legal structure of his firm has no relevance for the EPO, even if he is a member of an association under Rule 152(11) EPC. For the EPO, an association is just a plurality of representatives entitled to act, jointly or singly, on a party's behalf (see Rule 152(10) EPC).

7. The appellant wants to be entered as a member of one of the associations on the EPO's list. The EPO makes entries on this list at the request of the representatives wishing to form an association. It does not publish the list, which is merely an internal working tool. It considers case by case whether a representative has provided evidence within the meaning of Rule 152(11) EPC that he practises within a given association. Its internal list helps in practice to provide that evidence, but has no constitutive effect in the sense that any representative listed as member of an association is necessarily deemed authorised if the association itself is authorised.

8. If a legal practitioner wishes to act under Article 134(8) EPC, the EPO considers whether he meets the conditions of that provision (i.e. is qualified in a contracting state and has his place of business and the right to act as a professional representative in patent matters in that state). For professional representatives it does not need to consider whether they are entitled to act before it, because it has its own list of those who are (Article 134(1) EPC). If the legal practitioner fulfils the conditions, the EPO enters his name on a list which – like the list of associations of representatives – it keeps as an internal working tool and does not publish.

9. In view of this, the board concludes that a legal practitioner can act before the EPO "like a professional representative" and that Article 134(8) EPC is not infringed if only professional representatives can form an association under Rule 152(11) EPC. The differing administrative procedures are due firstly to the professional representatives' closer connection with the EPO (see point 2.3 above) and secondly to the differences in the rules governing the filing of authorisations (see below).

10. Rule 152 EPC ("Authorisations") concerns not only the substantive law of authorisation but also the filing of signed forms as proof of authorisation. A person

may in principle be authorised to act even if no signed form has been filed. But if a required authorisation is not filed in due time, any procedural steps taken by the professional representative, other than the filing of a European patent application, are deemed not to have been taken (Rule 152(6) EPC). The effect of this legal fiction is that a representative loses his entitlement to act if he fails to comply with the formalities governing the filing of authorisations.

11. If a legal practitioner entitled to act before the EPO under Article 134(8) EPC were to join an association of representatives, the legal fiction of Rule 152(11) EPC would mean he could take all steps the association was authorised to perform. As Article 2 of the decision on the filing of authorisations stands, any legal practitioner authorised to act before the EPO must file a signed authorisation or a reference to a general authorisation already on file. If he fails to file the authorisation, the EPO asks him to do so (Article 2, second sentence, decision on the filing of authorisations; Rule 152(2) EPC). If he fails to file it in due time, he has no authorisation to act (see point 10 above; Rule 152(6) EPC). If Rule 152(11) EPC were construed to mean that legal practitioners too could belong to an association of representatives, on the one hand they would be considered authorised under Rule 152(11) EPC and on the other, under the rules for filing authorisations, as not authorised if they failed to submit one. As these rules stand (see point 2.8 above), given that they make no exceptions for associations which include legal practitioners (see point 2.4 above), this contradiction can be resolved only by interpreting Rule 152(11) EPC as referring to an association of *professional representatives*. Therefore, legal practitioners are not covered by the legal fiction of Rule 152(11) EPC, and the appeal must be dismissed.

12. The appellant has acknowledged that acceding to his wish that legal practitioners be included in associations under Rule 152(11) EPC would conflict with the existing rules on the filing of authorisations. But he maintains that the President's decision (see point 2.2 above) is a purely administrative provision which has to be weighed against Article 134(8) and Rule 152(11) EPC, and that the decision on the filing of authorisations is certainly not higher-ranking law than the Council's interpretation decision and the "Communication on matters concerning representation before the EPO" (OJ EPO 1979, 92, see point 2.5 above). The board cannot agree. For the

reasons given above (points 2.3 and 2.8), it is bound by the decision on the filing of authorisations taken under Rule 152(1) EPC.

13. In his statement of grounds of appeal, the appellant pointed out that paragraph 11 and the other provisions of Rule 152 EPC referred merely to "representatives", drawing no distinction between professional representatives and legal practitioners. For the board, the term "representatives" requires interpretation. The decision on the filing of authorisations, based on Rule 152(1) EPC, does draw that distinction (see point 2.2 above), which also affects other provisions of Rule 152 EPC. For example, the "required authorisation" mentioned in Rule 152(6) EPC refers implicitly to the decision on the filing of authorisations; as a result, the legal consequences of Rule 152(6) EPC occur under differing conditions for the two professional groups. Similarly with Rule 152(11) EPC: as the law stands and taking Rule 152 EPC in its overall context, the two groups are again treated differently (see point 11 above).

14. How authoritative the Legal Division still considers the interpretation decision on Rule 101(9) EPC 1973 (now Rule 152(11) EPC) to be can remain moot. But the board would point out that in practice the EPO some time ago stopped applying the third criterion laid down in its communication interpreting the Council's decision, i.e. that only professional representatives can act in business matters in the name of the association (see point VI above, confirmed in J 16/96, Reasons 4.3). For example, persons who are neither professional representatives nor legal practitioners are to be found acting on behalf of the association to which the appellant wishes to belong. In this respect, the EPO's procedure for registering associations is no longer as described in the "Communication on matters concerning representation before the EPO" (OJ EPO 1979, 92, see point 2.7 above).

Order

For these reasons it is decided that:

The appeal is dismissed.