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**Datasheet for the decision
of 21 November 2016**

Case Number: J 0009/16 - 3.1.01

Application Number: 13157648.0

Publication Number: 2624523

IPC: H04L29/06

Language of the proceedings: EN

Title of invention:

System and method for data stream fragmentation with scalability

Applicant:

Comcast Cable Communications, LLC

Headword:

Relevant legal provisions:

EPC Art. 87(1), 122(1)

EPC R. 136(1) sentence 1, 136(1) sentence 2

Keyword:

Re-establishment of rights - exceptional circumstances (no) - independent cross-check (no) - all due care (no)

Decisions cited:

T 1962/08, J 0004/07, T 0261/07

Catchword:



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Case Number: J 0009/16 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 21 November 2016

Appellant: Comcast Cable Communications, LLC
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Decision under appeal: Decision of the Receiving Section of the
European Patent Office posted on 18 August 2015
refusing the request for re-establishment of
rights pursuant to Article 122 EPC into the
priority period under Article 87(1) EPC in the
matter of European patent application No.
13157648.0

Composition of the Board:

Chairman B. Müller
Members: T. Bokor
M. Blasi

Summary of Facts and Submissions

I. The appeal is against the decision of the Receiving Section dated 18 August 2015 refusing the request dated 4 March 2013 for re-establishment of rights in respect of the priority period under Article 87(1) EPC.

Summary of events leading up to the present appeal

II. The appellant-applicant, a US company, is the assignee of two US patent applications. It instructed its US agent to file two corresponding applications with the EPO, each of them claiming priority of one of the US applications. The priority period of 12 months pursuant to Article 87(1) EPC expired on 31 January 2013. An assistant of the US agent sent the necessary instructions to an association of professional representatives before the EPO ("EP" representatives, hereafter referred to as "JP"), headquartered in Milan, Italy. The instructions were sent in two successive filing orders by two emails dated 23 January 2013 and received on the same date (at 23:20 hrs and 23:26 hrs local time). More specifically, the emails were sent to an attorney at JP (Mr L.) personally and to a central email address of JP. The filing orders included the following instruction: "Please acknowledge receipt of this communication and be sure to include a copy to [email address of the docketing unit of the US agent]".

III. Mr L. forwarded the emails to the competent unit, namely the Milan Patent Department of JP (hereafter referred to as "PD"). Due to various circumstances, as explained in more detail below, only one of the two filing orders was properly docketed and processed by the PD. The properly docketed application was filed with the EPO on 29 January 2013 (European patent application No. 13153077.6), and a filing report was sent by email to

the US agent on the same day. A separate acknowledgement of receipt had not been sent to the US agent before this filing report, for neither one of the two filing orders.

- IV. On 26 February 2013 the US agent sent an enquiry to JP concerning the non-reported application. At this point in time the error was discovered at JP, and JP filed the second European patent application (the present application) on 4 March 2013 and the priority of the earlier US application was claimed.
- V. Simultaneously with the filing of the present application, JP also submitted a request for re-establishment of rights. This request explicitly stated that the appellant had become aware of the missed priority period on 26 February 2013, and "therefore, the two-month time limit for complying to the Re-establishment requirements will lapse on 26.04.2013". It was further stated that the appellant intended to file the "grounds on which the present request of Re-establishment is based ... in due time". Fees were paid, but no fee for re-establishment.
- VI. The fee for re-establishment was allegedly paid by way of a debit order faxed on 6 March 2013. This debit order could not be found at the EPO, either at the time or subsequently. A copy of the debit order was submitted later by the appellant, and was accepted by the Receiving Section as proof of payment with the effective date of 6 March 2013.
- VII. The EPO issued a communication pursuant to Rule 52 EPC dated 21 March 2013 (EPO Form 1051, version 01.09) calling the appellant's attention to the missed priority period and to the possibility of re-establishment of rights under Article 122 EPC, as well as to the formal requirements of Rule 136(1) EPC, including the time limit provided for by

that rule. No reference was made to the request for re-establishment that had already been filed (see point V above).

- VIII.A debit order for a fee for re-establishment dated 8 April 2013 was received by the EPO on the same day. The appellant later stated in a letter dated 14 June 2013 that this payment was essentially erroneous ("incorrectly paid a second time"), as a paralegal "was not aware that such fee had already been paid on 6 March 2013".
- IX. Detailed grounds in support of the request were received by the EPO on 26 April 2013. These stated that the time limit for requesting re-establishment of rights in respect of the priority period had expired on 31 March 2013, and that the fee had been paid on 6 March 2013. The grounds explained the handling of incoming mail at JP and specifically the events which had occurred after the receipt of the filing orders on 23 January 2013 (at 23:20 hrs local time) and in the following days until the discovery of the error (see points 12, 13 and 31 below for details).
- X. Following an exchange of several letters, the decision under appeal was issued. It found the request for re-establishment of rights to be admissible but not allowable. It held that JP's docketing system did not have an independent cross-check, and further that Mr L. and the US agent had failed to take all due care.
- XI. The notice of appeal was filed on 2 October 2015, and the appeal fee was paid on the same day. The statement of grounds of appeal was filed on 18 December 2015.
- XII. In a communication issued with the summons to oral proceedings dated 24 August 2016 the Board indicated that

the request for re-establishment of rights could possibly be regarded as admissible, but it was still questionable whether all parties involved had taken all due care. Hence the appeal did not appear to be allowable. Specifically, the Board noted that an independent cross-check did not appear to exist in JP's docketing system, and further neither the EP representatives nor the US agent seemed to have handled the filing orders correctly, in that the EP representatives had not confirmed receipt of the filing orders and the US agent had not investigated this.

XIII. With a letter dated 21 October 2016 the appellant commented on the Board's observations and provided additional arguments.

XIV. Oral proceedings were held on 21 November 2016, at the end of which the decision was announced.

XV. The relevant arguments of the appellant may be summarised as follows:

All due care as required by Article 122 EPC had been taken by all parties involved, namely the applicant, the EP representatives JP and the US agent. The error was isolated, and exceptional circumstances were present, which had occurred simultaneously and prevented the timely discovery of the error. The assistants involved were well trained and experienced. Both the EP representatives and the US agent employed a sophisticated system for monitoring time limits and file management in general (the AS400 database and the IP Master Docketing System (IP MDS), respectively). As to the EP representatives, their time limit monitoring system did include an independent cross-check. Confirmations of receipt for incoming orders were sent, depending on the circumstances either separately or

only in the form of the filing report. An earlier confirmation of receipt sent to the US agent in the present case would not have prevented the error. As to the US agent, he had enquired with his assistant about the EP filings, but the assistant had mistaken the filing report of 29 January 2013 as relating to both applications, and thus had erroneously informed the US agent that both filings had been dealt with. Eventually, the IP MDS had flagged the missing input still in time for requesting re-establishment of rights, as evidence of the reliability of the overall system and as such as evidence of all due care on the part of the US agent.

XVI. The appellant requests that the decision under appeal be set aside and that its rights with respect to the priority period under Article 87(1) EPC for claiming priority of the previous application No. US 13/362,766 of 31 January 2012 be re-established.

Reasons for the Decision

1. The appeal is admissible.

Admissibility of the request for re-establishment of rights

2. The Board has serious reservations concerning the admissibility of the original request for re-establishment of rights of 4 March 2013. All the facts point to an error in law, in that the request wrongly stated that the correct time limit for filing the request would be triggered by the removal of the cause of non-compliance (Rule 136(1), **first** sentence, EPC), instead of the applicable time limit, namely the fixed two months following the expiry of the time limit specified in Article 87(1) EPC that was missed (Rule 136(1), **second**

sentence, EPC). However, the Board notes that the Receiving Section apparently overlooked the request for re-establishment (see point V) which had already been filed by the time it issued the communication pointing out the missed time limit (see point VII). At this stage it would not have been inappropriate to deal with the request to some extent, even if it was somewhat ambiguously worded and clearly incomplete at that time, and to point out the attorney's error. However, in the light of its shortness and the wording used in the request, such as "the Applicant is going to request Re-establishment..." it was not at all apparent that this letter was intended to constitute the request, but rather conveyed the impression that the request proper was going to follow later. On this basis, it is not apparent that the Receiving Section actually had a firm duty to examine this submission at that time under the principle of good faith. Therefore, it is at least questionable that there was any omission on the part of the Receiving Section, and therefore it is also questionable if such perceived omission would actually have established an entitlement on the part of the appellant to be exempted from the applicable provision of the EPC under the principle of good faith. However, this question need not be decided, in the light of the Board's findings on the allowability of the request for re-establishment.

Allowability of the request for re-establishment of rights

3. Under Article 122(1) EPC, for re-establishment to be allowed the requester must show that he missed the time limit despite taking all due care required by the circumstances.
4. On the basis of the submissions, at first sight it may appear that the missing of the time limit in the present

case is attributable to the fact that the data relating to the relevant time limit, i.e. essentially the data from the filing order, was not processed and thus was not recorded at all in JP's time limit monitoring system. The circumstances surrounding the error all appear to relate to JP's general docketing system, such that the error occurred entirely within its sphere of influence. In that case, what must be examined first and foremost is all due care on the part of the EP representatives.

5. However, in the present case the filing order came from the US agent, who acted on behalf of the applicant in dealing with the EP representatives. The error occurred, so to speak, essentially at the interface between the two agents. Therefore, all due care on the part of the US agent also needs to be examined. This is in line with the case law of the Boards of Appeal (see e.g. J 4/07, Reasons, point 3).
6. In the light of the findings below on a lack of all due care on the part of both the EP representatives and the US agent, the Board sees no need to examine the actions of the US company as applicant in order to decide on the appeal.

All due care on the part of the EP representatives

7. For cases where the cause of non-compliance with a time limit involves some error in the carrying out of the party's intention to comply with the time limit, the case law has established the criterion that all due care is considered to have been taken if non-compliance with the time limit results either from **exceptional circumstances** or from an **isolated mistake within a normally satisfactory monitoring system**, see Case Law of the EPO

Boards of Appeal ("CLBA"), 8th ed., 2016, Chapters III.E.5.2. and III.E.5.4.

Isolated error in a normally satisfactory system/requirement for an independent cross-check

8. The appellant argues that the error, i.e. the failure to process the data from the filing order, was an isolated one in a normally satisfactory system. The Board sees no reason to doubt that this error was isolated, in the sense that no loss of rights had occurred due to an error at JP over a long period of time, and only a single oversight by a single person apparently caused the missing of the time limit by JP. The Board also accepts, in favour of the appellant, that the assistants chosen for the work (Ms T., the head paralegal, and Mr V. working in the mailroom) were suitable, properly instructed in the tasks to be performed and reasonably supervised over their work.
9. The question that needs to be addressed is whether the described docketing system at JP for incoming new orders can be qualified as a normally satisfactory system in the sense that it comprises an independent cross-check. It is noted that a system is not inevitably satisfactory merely because an error is isolated. This is only an indication, but in itself no proof of a satisfactory system. On the basis of the submissions it is undisputed that JP's PD cannot be regarded as a small office, and therefore an independent cross-check would normally be required, according to established case law of the Boards of Appeal.
10. There is a substantial body of case law addressing what an independent cross-check must entail. A useful overview is provided in case T 1962/08, along with CLBA, Chapter

III.E.5.4.4 (page 620 of the English edition). According to the Boards' case law, the independent cross-check can be achieved by maintaining a single database of time limits, which is checked independently by two different persons. Alternatively, two independent databases can be provided, but it is still required that they are handled by two different persons. To what extent a system can be expected to be "fail-safe", as held by certain decisions, need not be examined here, but some redundancy of the system in the above sense is indeed important.

11. The majority of re-establishment cases concern situations where a recorded time limit was not followed up, or where the time limit was not recorded at all. It is not apparent to the Board that a different standard of all due care should apply to these two situations. Accordingly, it appears reasonable to also expect an independent cross-check when data is entered in a time limit monitoring system, and not only for the strict "monitoring" of time limits already recorded (cf. in this respect T 261/07 where a decision by the opposition division had never been entered in the mail room database). The appellant itself did not call this into question.

Normal treatment of incoming orders at JP

12. The appellant submits that instructions incoming by email are handled at JP by Mr V. (working in the mailroom) and Ms T. (the head paralegal of the Milan PD). The normal procedure for handling them is as follows:

First, Mr V. performs the following steps:

(step a) - reading and printing an order email sent by a client, in more detail:

(step a-1) - moving new order emails to a special subfolder called ISTRUZIONI CLIENTI
(step a-2) - stamping the date of receipt on the printed order
(step a-3) - placing the stamped paper copies in the inbox of Ms T.

Subsequently Ms T. proceeds by performing the following steps:

(step b-1) - cross-checking the stamped paper copies against the content of the ISTRUZIONI CLIENTI subfolder, in the sense that she checks if there is a paper copy corresponding to the email in the ISTRUZIONI CLIENTI subfolder, and *vice versa*, if there is an email in the subfolder corresponding to the paper copy in her inbox
(step b-2) - adding a note to each paper copy to confirm that the cross-check has been completed
(step c) - entering the new case in the department database (AS400) to generate a JP record identified by a unique reference number
(step d) - creating a paper file and printing all documents attached to the client email
(step e) - reviewing in detail the documents and client instructions
(step f) - docketing relevant deadlines.

Details leading to the error

13. The appellant submits that an error occurred within this procedure. The printed paper copy relating to one of the two filing orders disappeared from Ms T.'s inbox without anyone noticing this. The exact cause of this disappearance could not be reproduced with certainty, but it was inferred from the circumstances that it may have been inadvertently knocked out of Ms T.'s inbox tray and

subsequently slid under a copying machine, where it remained unnoticed (until found again after 26 February 2013 during a search for the cause of the error). In addition, in performing (step b-1), Ms T. also overlooked the fact that two seemingly identical orders were in fact two distinct orders. As a result, only one of them was eventually docketed.

14. In the decision under appeal, the Receiving Section held that the performance of steps (a) to (f) did not satisfy the requirement for an independent cross-check (see point 5 of the Reasons). The Board agrees, because there was no independent, i.e. parallel (or redundant), cross-check by a different person.

15. The question may arise at this point what exactly ought to have been cross-checked and by whom. The Receiving Section's decision may have conveyed the impression that the work-sharing between Mr V. and Ms T. as presented was fundamentally wrong. The Board wishes to clarify that this is not necessarily the case. It holds that it is not for the EPO to dictate how docketing and time limit monitoring must be organised in any given office, or to suggest how any given system could be improved, in order to comply with the "all due care" requirement. Applicants and professional representatives are free to organise their work, as a matter of principle. This is also true in the present case, where many ways could have been possible within or in addition to JP's existing docketing system to ensure that a second person checked at least the recording of a new incoming order and the applicable time limits and the corresponding tasks in JP's database (and from there it could be assumed that they would be followed up, again presuming a suitable time limit monitoring system).

16. In the present case the Board is unable to identify any person at JP who actually did (or at least was expected to) check, independently of the head paralegal, Ms T., if a new order (which is obviously not yet recorded in the time monitoring system) did get properly recorded. Apparently neither the attorney who had received the appellant's emails with the filing instructions, Mr L., nor Mr V. from the mailroom nor anybody else was expected to do this as a matter of routine, as already indicated in the Board's communication. However, this does not mean that the Board would have expected specifically Mr L. or Mr V. to perform this cross-check. As mentioned above, such a check could have been built into the procedures in a number of ways.
17. The appellant submitted that there was an element of an independent cross-check in the docketing system which ensured that new incoming orders were properly recorded. Firstly, Mr V. performed an initial check, separating new orders from all incoming mail. Secondly, Ms T. performed a second independent check, and also performed a cross-check between the emails and the paper copies (see (step b-1) in point 12 above).
18. This cannot be accepted by the Board as an independent cross-check. As explained above, in this context the term "independent" means that two distinct persons need to convince themselves that the crucial action(s) required for observing a time limit, or the very recording of the time limit, as in the present case, did take place, either by performing the required act themselves or by checking if someone else has performed it. Thus a genuine independent cross-check will inevitably result in a certain redundancy in the system, in that, for instance, one of the persons involved will not effectively process a case (or a particular step in dealing with a case), but

will merely check if the processing (by someone else) did occur. It is clear that such a cross-check did not take place in the present case. According to the submission presented to the Board, Mr V. did not check if all emails identified by him as incoming new orders did actually reach the stage of steps (c) and (d). In this manner, his contribution cannot be qualified as an independent cross-check for the purposes of checking if the filing order, and hence the relevant time limit, have been recorded. In short, the Board cannot accept that the docketing system at JP did feature an independent cross-check which could have discovered the omission to record the incoming order. It merely had certain safety mechanisms which might possibly have helped to prevent the loss of client instructions or other mail between Mr V. and Ms T., i.e. between the mailroom and the head paralegal, where the latter did the effective recording of the order in the database and also created the paper file. But otherwise the result of the work of the head paralegal was apparently not subject to any independent check, i.e. no cross-check is apparent.

19. In summary, the Board is bound to establish that JP's time limit monitoring system did not have an independent cross-check for checking the recording of new incoming orders.

Exceptional circumstances

20. The appellant further submits that the independent cross-check failed due to the highly unusual combination of several unusual and concurrent circumstances that had occurred. Specifically, Ms T. herself also did not notice that a printed copy was missing, in spite of the fact that there was an email in the subfolder without a

corresponding paper copy. This came about due to the combination of the following four unusual circumstances:

- 1) Ms T. had only one of the two paper copies of the printed email orders, since one paper copy had been lost during her absence;
 - 2) The titles of the two applications sent by the US agent in the ISTRUZIONI CLIENTI subfolder were very similar and quite long, differing only in the addition of two words at the end of one of the titles;
 - 3) The US agent's reference numbers in the ISTRUZIONI CLIENTI subfolder were almost identical – differing only in a single digit out of a total of 13 characters;
 - 4) An email relating to one case was forwarded to the PD by the attorney, Mr L., without comment, while a second email sent immediately thereafter by Mr L. included comments, thus making it appear as though Mr L. had re-sent the same email to include comments.
21. The Board indicated in its communication that it fails to see the presence of "unusual" circumstances, contrary to the appellant's submissions. The loss of the paper copy of the filing order is not an unusual circumstance, but obviously the direct cause of the error itself (in combination with the fact that Ms T. apparently worked on the basis of the paper copies and overlooked the email version of the order, still present in the "ISTRUZIONI CLIENTI" subfolder). That two subsequent orders with partially similar data arrive at a large office does not appear extraordinary, but is to be expected from clients having large patent portfolios, where related inventions are often filed simultaneously. In such cases it is also to be expected that internal reference numbers will differ in only one digit. A person with many years' experience, such as Ms T. according to the submissions,

ought to have been prepared for the receipt of such similar and simultaneous filing orders.

22. The appellant conceded in its response that the circumstances as listed above under (1)-(4) may not be exceptional when considered in isolation, but that their simultaneous appearance must be regarded as "extremely unusual", and precisely this combination had led Ms T. to believe that there was only one order to process.

23. The Board accepts that the combination of these circumstances may be somewhat unusual. It is also plausible that these circumstances misled Ms T. However, the Board considers that circumstances (2) and (3) have their common root in the fact that parallel applications were filed. Circumstance (4), were it not for the similar applications, would appear to be an everyday occurrence. Following the appellant's logic, it would be possible to identify "unusual" circumstances in practically any procedure. It is further noted that there were also significant differences between the two filing orders, explicitly shown on the emails of the US agent (while the titles of the inventions were similar, the inventors were quite different).

24. All in all, it remains the case that Ms T. was led to believe that there was only one filing order for one application because the two filing orders were highly similar. This, in itself, is nothing extraordinary, as explained above. Hence the Board can at most acknowledge the combination of the direct cause of the original error (disappearance of the paper copy) with a somewhat less usual circumstance (receipt of two parallel and similar filing orders). It remains that the error came about under circumstances that may not have been quite usual in all respects but were certainly not extraordinary.

25. For these reasons, the Board concludes that non-compliance with the time limit in question did not result from exceptional circumstances, so that "all due care" cannot be established on this basis.

Omission of acknowledgement of receipt of instructions

26. The Board indicated in its preliminary opinion that JP failed to take all due care by not sending (separate and more or less immediate) confirmations of receipt for the filing orders, in spite of the US agent's explicit instructions. However, the Board accepts that JP's omission in this respect did not further contribute to the error on the side of JP. As argued by the appellant, the chances of discovering the error at JP would not have been better, because in that case the US agent would not have had any reason to contact JP already before the missed time limit. On the other hand, this does not excuse the US agent for not taking action in a timely fashion, as explained further below in points 31 to 44.

Conclusion

27. The findings above (in points 7 to 25) concerning the EP representatives alone would suffice for refusing the request for re-establishment of rights. The Board will nevertheless also assess the events pertinent to the missing of the time limit in the ambit of the US agent and examine whether the US agent acted with all due care.

All due care on the part of the US agent

28. While the Board accepts that JP's omission in sending separate confirmations of receipt of instructions did not contribute to the missing of the time limit, from the

perspective of the US agent the absence of confirmations was an objective circumstance, which the US agent ought to have noted and reacted to, irrespective of the question how this circumstance is to be assessed with respect to the observation of all due care by the EP representatives.

29. In the grounds of appeal the appellant stated that a "misunderstanding" occurred at the US agent, who otherwise maintained a reliable and well functioning ("robust") docketing system, but this misunderstanding (of the assistant) did "not rise to the level of ... an error as commonly understood". In its response to the Board's communication the appellant argued that this misunderstanding constituted an isolated error. As to the expected level of all due care, the appellant argued that the US agent "merely" had to show the same level of care which could be expected from the applicant itself.

30. In the Board's view a non-European representative can be held responsible for meeting the obligations of any representative whose duty it is to care for his client's interests, irrespective of whether such representative is entitled to represent before the EPO or any other patent office. The monitoring of specific time limits that were set expressly does not depend on knowledge of EPC law. Thus a non-European representative must also establish a reliable monitoring system for such time limits (see J 4/07, Reasons, point 4.2.). Moreover, the principles set out above in point 7. regarding all due care on the part of the EP representatives also apply to the non-European representative. This means, in particular, that a mistake within a normally satisfactory monitoring system can be excused, but in principle only where such a mistake is an isolated one.

Omission to check whether JP acknowledged the receipt of instructions

31. According to the submissions the receipt of the first filing order (on 23 January 2013, at 23:20 hrs) was not acknowledged earlier than with the filing report, and that took place only on 29 January 2013. The filing report was received on the same day by the US agent, i.e. six days after the sending of the original filing order. While it is clear that a filing report inherently confirms the receipt of the filing instructions, the email of the US agent's assistant requested something else.

32. The wording used, "Please acknowledge receipt of this communication", is normally understood to refer to more or less immediate confirmation, not necessarily with some extreme urgency, but certainly as soon as processing of the instructions starts. This practice, i.e. that such a confirmation is normally sent as part of the initial processing of the instructions is implicitly recognised by the appellant when it argues that possibly either Mr L. or Mr V. would have sent the confirmation of receipt.

33. The Board holds that good practice on the part of the receiver would imply that a simple confirmation that instructions were received is sent preferably already on the day of receipt, but at the latest on the next working day. In fact, it is not unusual to send such immediate confirmations even without an explicit request. In any case, they are typically sent without waiting for the initial processing (and even less waiting for the subsequent execution of the instructions), given that these may take quite a long time.

34. There are good reasons for expecting such immediate confirmation. Co-operation between patent attorneys working in different jurisdictions, such as the present co-operation between the US agent and the European representatives, is based on mutual trust that the partner will handle the case diligently and professionally. A patent attorney sending a filing order to a foreign colleague normally has no influence on the docketing procedures and the general monitoring of time limits at the partner. Thus the only thing that the sender attorney can normally do is wait for confirmation (acknowledgement) of receipt of the filing order, in order to be assured that his responsibility for the proper processing of the foreign filing has been discharged.
35. In the present case the US agent's filing order emails (see Annexes 2 and 3 of the grounds of the request for re-establishment dated 26 April 2013) stated clearly that receipt should be acknowledged, and not only to the sender but also to another email address (i.e. the email address of the docketing unit of the US agent). Instructing the foreign partner to confirm receipt of orders doubtlessly contributes to the diligent handling of the case, because the US agent's responsibility for the timely filing of the applications would have ended upon receipt of the acknowledgement of the order by the EP representatives, but only then. Therefore, it ought to have been of paramount importance for the US agent to check soon after the dispatch of the filing orders if they had also been duly received. Indeed, there is little purpose in instructing a foreign colleague to confirm the receipt of instructions if the return of this confirmation is not checked soon thereafter.

36. The appellant stated in the grounds of appeal that the US agent's procedures foresee that the return of confirmation of receipt of instructions are to be checked, but gave no further details how soon after the dispatch of the instructions this check was normally done.
37. It appears that the standard practice at the US agent's offices did not require the assistant to check the return of the confirmations within a short time frame, possibly well before the issuance of the automatic reminder of the IP MDS, at least nothing contrary has been submitted to the Board in response to the Board's communication which pointed out this issue. In the present case the filing orders were sent on 23 January 2013 (Wednesday), at 17.20 hours (local time in Atlanta), and were received at JP on the same day at 23.20 hours (local time in Milan). Thus the return of the acknowledgement of receipt of the filing order was to be expected on the next day in Atlanta, but even presuming a 24-hour mail processing window at JP, certainly not later than 25 January (Friday). As a consequence, on this day at the latest the return of the confirmations of receipt ought to have been expected by the US agent, in particular by the assistant who knew when the orders had been sent. Given that by this date there was still no confirmation of receipt from the EP representatives, an immediate enquiry at the EP representatives ought to have followed.
38. The appellant argues that the US agent's assistant could trust JP because of its good reputation, so that further enquiries were not perceived as necessary, even after the receipt of only one filing report. The Board finds this argument unconvincing. It is of little help that the US agent's IP MDS reliably monitors time limits, and that the foreign law firm may have a good reputation, if the

instructions are not executed by members of the foreign law firm due to the loss of a communication. It remains that the assistant took no action for a relatively long time, though neither confirmations nor any other relevant correspondence arrived from JP.

39. Furthermore, the explanations given for the lack of action on the part of the US agent even after the receipt of the filing report on 29 January 2013 are anything but satisfactory. After all, almost a month had passed before the US agent discovered that there was simply no trace of a European patent application for which instructions had been sent over a month before and which should have been filed almost a month before. The appellant's argument that the US agent did make some internal enquiries does not change this fact. In this respect it has been submitted that an assistant mistook the filing report as relating to both orders and was therefore satisfied that the orders had been processed. The time limit monitoring system flagged the missing filing data in good time for filing the request for re-establishment of rights, thus proving that all due care was taken by the US agent.

40. In respect of the assistant's mistake, the appellant gave some details how this misunderstanding by the assistant came about, lastly in its response to the Board's communication. However, the filing report of 29 January 2013 itself has not been submitted to the EPO. The appellant argues that it is normal procedure to confirm several filing orders with a single confirmation. The Board accepts that such a procedure may be considered diligent. However, in that case the single confirmation must make an unambiguous and individual reference to each of the individual filing orders, because both the sender and the receiver of the confirmation of receipt need to have a document in hand for each individual file, where

the document is indeed clearly identifiable as relating to that individual file. The sender of the confirmation needs it to prove that he has acted as instructed, while the receiver needs it for the reasons described above, namely to assure himself (and his client) that the case has been safely received (and from there on it could be assumed to be prosecuted according to the instructions).

41. On the basis of the submissions, it is not apparent how an experienced assistant could have taken the email with the filing report to relate to both of the two distinct filing orders. It was only a single document and it follows from the submissions that it could only contain the identification data of one of the US applications. Contrary to the situation of Ms T. at JP, the assistant knew that there were two parallel applications and therefore she had to expect a confirmation for both. The receipt of a single document should already have triggered her attention, regardless of its content. In any circumstances, this incoming document had to be assigned to the corresponding files, either physically to the paper files or electronically in a suitable database (obviously in the IP MDS). The fact that the data of the other US application was missing ought to have been apparent at the very moment when the US agent's assistant proceeded to assign the filing report to the corresponding files, i.e. the two US applications (even if presuming that there were no separate files yet for their European equivalents). At that moment a duplicate of the filing report ought to have been made, either as a paper copy or electronically, and at that moment it must have become clear that the document referred to only one application. At the very latest when assigning the filing report to the corresponding file, a check ought to have been made as to whether the filing report did indeed contain data unambiguously identifying the US application

to which it was presumed to relate. Thus the error ought to have been discovered by a suitable, properly instructed and reasonably supervised assistant at this point at the latest, quite independently of any reminders from the IP MDS.

42. Alternatively, it must be presumed that the filing report of 29 January 2013 was not allocated to any file at all by the assistant in the offices of the US agent for quite a long time, a procedure which could hardly be qualified as diligent. The Board takes note of the submissions stating that on 7 February 2013 the US agent again enquired with the assistant as a follow-up. At that time, the assistant positively confirmed the filing of both EP applications to him, ostensibly again on the basis of the filing report of 29 January 2013, as no other relevant correspondence between JP and the US agent has been mentioned. On this basis, the Board must assume that the filing report was still not assigned to any file by the assistant at least until 7 February 2013, because she had still not discovered that there was simply no reference to the second US application. The appellant submitted in the oral proceedings before the Board that there is no attempt to conceal any facts concerning the events at the US agent's offices, but did not submit additional details. On this basis, it is not apparent to the Board that the assistant was well trained or that the US agent's system was indeed satisfactory.

43. It also follows from the above that the assistant made two mistakes:
- she did not promptly enquire about the acknowledgements of receipt requested in the filing order emails (see points 31 to 37 above) and
 - she did not take appropriate action after having received the filing report (see points 39 to 42 above).

That means that even if the appellant had established both

- the existence of an adequate system of monitoring time limits in the office of the US agent and
- the fact that the assistant was suitable, properly instructed and reasonably supervised
- which the appellant has not - then the events having taken place in the US agent's office surrounding the European patent application in issue could not be excused as one single isolated mistake, as required by the case law of the Boards of Appeal.

44. As to the further argument that the timely flagging of the missing filing data demonstrates the robustness and reliability of the US agent's system, and as such all due care by the US agent, the Board observes that such an argument would essentially make the "all due care" requirement of Article 122(1) EPC redundant. If the Board were to accept this as proof of the taking of all due care, it would be sufficient for a party to observe the time limit of Rule 136(1) EPC in all those cases where the party was capable of discovering the missing of a time limit on its own (e.g. without any loss of rights communication from the EPO, as is often the case). The Board considers that the requirements of Article 122(1) and Rule 136(1) EPC are distinct and their fulfilment must be examined independently of each other, quite apart from the principle that the requirement of "all due care" under Article 122(1) must be judged first and foremost in view of the situation existing before the time limit expired (see J 4/07, Reasons, point 3). In other words, if the ability of a party to observe the time limit of Rule 136(1) EPC played a role in the assessment of all due care as required by Article 122(1) EPC, then it could by no means be a decisive criterion.

45. In summary,
- an independent cross-check when the data was entered in the time limit monitoring system was missing at JP,
 - no exceptional circumstances surrounding the application in question were present at JP,
 - it is not apparent that the US agent's assistant was well trained or that the US agent's system was satisfactory,
 - the US agent investigated neither the missing acknowledgements of receipt shortly after the sending of the filing orders, nor the missing filing report shortly after having received one out of two, but only much later, so that not one single isolated mistake, but two mistakes in relation to the application in issue were committed within the sphere of influence of the US agent.
46. All in all, on the basis of the totality of the submissions, it has not been proven to the satisfaction of the Board that the EP representatives and the US agent took all due care, and therefore the Board has not been able to establish that the requirements of Article 122(1) EPC are fulfilled.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Eickhoff

B. Müller

Decision electronically authenticated