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Aktenzeichen / Case Number / N^o du recours : J 19/84

Anmeldenummer / Filing No / N^o de la demande : 79302661.8

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Bezeichnung der Erfindung:

Title of invention: Tubular carton and blank for making it

Titre de l'invention :

ENTSCHEIDUNG / DECISION

vom / of / du 12 November 1984

Anmelder/Patentinhaber:

THE MEAD CORPORATION

Applicant/Proprietor of the patent:

Demandeur/Titulaire du brevet :

Stichwort / Headword / Référence :

re-establishment of rights/text of application/MEAD

EPÜ / EPC / CBE Articles 113(2), 122(1)

Leitsatz / Headnote / Sommaire

Europäisches
Patentamt
Beschwerdekammern

European Patent
Office
Boards of Appeal

Office européen
des brevets
Chambres de recours



Case Number: J 19/84

DECISION
of the Legal Board of Appeal
of 12 November 1984

Appellant: THE MEAD CORPORATION
Mead World Headquarters
Courthouse Plaza Northeast
Dayton, Ohio 45463
US

Representative: Hepworth, John
J.M. Hepworth & Co.
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London, WC1V 6DE
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Decision under appeal: Decision of the Formalities Officer of Directorate
General 2 dated 3 May 1984 rejecting European
Patent Application No. 79302661.8 in pursuance
of Articles 97(1) and (2) and 113(2) EPC.

Composition of the Board:

Chairman: R. Singer
Member: P. Ford
Member: O. Bossung

SUMMARY OF FACTS AND SUBMISSIONS

- I. European patent application No. 79303661.8 was filed on 22 November 1979 and published under No. 0013479 on 23 July 1980.
- II. In the course of substantive examination of the application, by a Communication pursuant to Rule 51(4) and (5) EPC, issued on 10 August 1983, the Examining Division informed the applicant's representative that it was intended to grant a European patent in the text indicated in the Communication.
- III. On 17 October 1983, the representative wrote to the Examining Division concerning certain amendments desired to the text of the main claim and the corresponding statement of invention. A photocopy of the text of the main claim as originally filed, showing desired handwritten amendments, was enclosed with the representatives' letter. As can be clearly seen from the copy document, the handwritten amendments at the bottom of the page were not completely reproduced on the copy.
- IV. Nevertheless, on 9 December 1983, the Examining Division issued a new Communication pursuant to Rule 51(4) and (5) EPC stating, inter alia, that the amendments requested in the letter of 17 October 1983 had been made. The copy of the main claim as amended by the Examining Division, which was sent to the representative with the Communication dated 9 December did not conform in all respects with the amendments requested by the representative and, in particular, included words apparently intended to replace the words omitted from the representative's text but which were not agreed with the representative.
- V. According to the representative, he sent a letter to the Examining Division dated 19 December 1983, a copy of which he has produced, pointing out that there was a difference in wording between the claim which accompanied the Communication dated 9 December and the claim which had accompanied his letter dated 17 October 1983. Unfortunately, the letter dated 19 December 1983 never reached the file of the case and there is no evidence that it was ever received by the European Patent Office.

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- VI. As the Examining Division in fact heard nothing from the representative, and no fees for grant and printing and no translations of the claims were received, on 3 May 1984 a Formalities Officer, acting for Directorate General 2, issued the decision under appeal, refusing the European patent application.
- VII. On 3 July 1984 the appellant's representative lodged Notice of appeal and a Statement of Grounds. In the Statement of Grounds it was submitted that by the letter of 19 December 1983 the representative had raised objection in due time to the Communication dated 9 December. Accordingly, examination of the application should have been resumed. In any event, there exists no text of the application agreed with the applicants. The decision to refuse the application should be set aside, examination should be resumed and the appeal fee should be reimbursed.
- VIII. By mistake, the representative's office sent the voucher for payment of the appeal fee and the representative's cheque drawn in favour of the EPO therefor, to the appellant in the U.S.A., by whom they were subsequently returned. Thus the appeal fee, received by the EPO on 8 August 1984, was not paid in due time.
- IX. The appellant applied for re-establishment of rights by letter dated 30 July 1984. In response to a request for further information from the Legal Board of Appeal, the representative explained, in a letter dated 17 September 1984, that the voucher and cheque must inadvertently have become attached to the reporting letter to his client owing to the use of paper clips, rather than staples, in his office to fasten documents together. The despatching of mail was the responsibility of the representative's secretary. So far as was known, this was the first time that such a mistake had occurred but, to prevent its recurrence, documents would in future be fastened together by stapling. The fee for re-establishment of rights was duly paid.

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REASONS FOR THE DECISION

1. The appeal fee having been paid out of time, it is necessary for the appellant to be re-established in its rights if the appeal is to be considered admissible.

2. Article 122(1) EPC, in effect makes it a condition for re-establishment of rights that the person applying for re-establishment shows that "all due care required by the circumstances" was taken. The appellant's representative submits that the posting of the voucher and cheque for the appeal fee to the appellant was clearly inadvertent and that the mistake was not one of a kind that had previously occurred. That it was an inadvertent mistake can be considered to be self-evident and the Board is prepared to accept the representative's statement that a mistake of this kind had not previously occurred. Since the responsibility for despatching the representative's mail was that of his secretary, the Board has normally to consider whether the employee concerned was carefully chosen, properly instructed and reasonably supervised (cf. Decisions of the Board J 05/80 dated 7 July 1981 in OJ EPO 1981, 173 and J 16/82 dated 2 March 1983, in OJ EPO 1983, 262). However, in the present case, since the inadvertent mistake is one that could be made once by a secretary fulfilling all those requirements, there is no need to question these matters in the absence of any evidence of general carelessness on her part. In all the circumstances, the Board is prepared to consider that the requisite standard of care has been established.

3. Since all the other requirements of Articles 106 to 108 and Rule 64 EPC have been fulfilled, the Board considers the appeal to be admissible.

4. It is clear from the file of the case that the appellant is correct to contend that the decision to refuse the European patent application was taken on a text which was neither that submitted to the EPO nor agreed by the applicant for the patent.

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At the time when the decision to refuse was taken, the disapproval communicated by the letter of 17 October 1983 was still effective.

The amendments made by the Examining Division to the text submitted with the letter of 17 October 1983 were more than simple, non-controversial, corrections of obvious clerical errors. Accordingly, the express consent of the applicant, through its representative, was necessary before they could be regarded as agreed.

5. It follows that the decision under appeal must be set aside as it was not taken in accordance with Article 113(2) EPC. This was inter alia a substantial procedural violation which justifies reimbursement of the appeal fee.

ORDER

For these reasons,

it is ordered that:

1. The appellant is re-established in its rights and the appeal is deemed to have been filed and the appeal fee to have been paid in due time.
2. The decision to refuse the European patent application dated 3 May 1984 is set aside.
3. The appeal fee shall be reimbursed to the appellant .
4. The European patent application is remitted to the Examining Division for examination to be resumed.