

Veröffentlichung im Amtsblatt	Ja /Nein
Publication in the Official Journal	Yes /No
Publication au Journal Officiel	Oui /Non

Aktenzeichen / Case Number / N^o du recours : J 3/88

Anmeldenummer / Filing No / N^o de la demande : 83 903 715.7

Veröffentlichungs-Nr. / Publication No / N^o de la publication : 012 4589

Bezeichnung der Erfindung: Flossing Device

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : A 61C 15/00

ENTSCHEIDUNG / DECISION

vom / of / du 19 July 1988

Anmelder / Applicant / Demandeur : Beggs, George et al.

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Supervision of assistant/Beggs

EPO / EPC / CBE Article 122

Schlagwort / Keyword / Mot clé : "Re-establishment of rights" (refused)

Leitsatz / Headnote / Sommaire

Europäisches
Patentamt
Beschwerdekammern

European Patent
Office
Boards of Appeal

Office européen
des brevets
Chambres de recours



Case Number : J 3/88

D E C I S I O N
of the Legal Board of Appeal
of 19 July 1988

Appellant : Beggs, George, et al.
Colorado Springs
Colorado 80906, USA

Representative : Pavane, Martin
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New York, New York 10176
USA

Decision under appeal : Decision of the Receiving Section of the European Patent Office dated 29 June 1987 rejecting the request dated 21 July 1986 for re-establishment in the period specified in Article 86(2) EPC for payment of the renewal fee due for the third year for European patent application No. 83 903 715.7.

Composition of the Board :

Chairman : P. Ford
Members : W. Moser
R. Schulte

Summary of Facts and Submissions

- I. Euro-PCT application No. 83 903 715.7 was filed on 21 October 1983. In accordance with Article 86(1) and Rule 37(1) EPC, the renewal fee for the third year therefore became due on 31 October 1985.
- II. In its communication dated 3 December 1985, the Receiving Section of the EPO informed the Appellant that, although the payment of the renewal fee had not been made within the prescribed time limit, in accordance with Article 86 (2) EPC it could still be validly paid within 6 months of the due date (i.e. until 30 April 1986), provided that within this period the additional fee was also paid.
- III. The renewal fee for the third year and the additional fee were not paid in due time. Consequently, in a communication under Rule 69(1) EPC dated 9 June 1986 and received by the professional representative before or on 24 June 1986, the Appellant was informed that, in accordance with Article 86(3) EPC, the application was deemed to be withdrawn.
- IV. By letter dated 21 July 1986, received by the EPO on 24 July 1986, the Appellant filed an application for re-establishment of rights according to Article 122 EPC.
- V. In a letter dated 13 October 1986, the Receiving Section informed the Appellant of its provisional opinion that either the professional representative or the US patent attorney had failed to take all due care required by the circumstances. The Appellant was therefore invited to explain in particular why two fees reminders, the last one even having been sent by registered mail with acknowledgement of receipt, failed to reach the competent

person and to submit "affidavits" from the US patent attorney and his administrative staff on this matter.

VI. On 9 March 1987, the Appellant filed a written declaration under oath by the US patent attorney in which the following facts were set out:

- By letter dated 25 July 1984, the US patent attorney was advised by the professional representative that the European patent application of the Appellant had been allotted the filing date of 21 October 1983. Subsequently, the US patent attorney communicated this letter to the "docket clerk" (hereinafter: first "docket clerk") employed in his office for the purpose of checking the due dates, especially as regards the payment of the renewal fees. But the first "docket clerk" most likely did not immediately deal with this letter transmittal, presumably since the next renewal fee was not due for more than one year after the arrival of this letter. She left the office of the US patent attorney in June 1986. On 12 August 1985, a second "docket clerk" had been hired to relieve the first one of docketing responsibilities. The first "docket clerk" continued to perform para-legal services until she left.
- On or about 20 July 1985, the office of the US patent attorney should have received the first fees reminder from the professional representative dated 15 July 1985. But it may be presumed that the first "docket clerk" did not take action on this reminder due to the forthcoming modification of her duties and intended that her successor should do so, there being still plenty of time before the due date.
- The second fees reminder dated 31 January 1986 was not

taken into account by the second "docket clerk" despite the strict instructions he had received as regards the checking of due dates, especially those concerning the payment of renewal fees in every country. As a result, the US patent attorney and his colleagues decided to dismiss the second "docket clerk" by 1 August 1986.

- As far as the watching of the due dates is concerned, the office of the US patent attorney is organised as follows:

Every letter mentioning all the particulars (e.g. filing date, reference of the file, country) of a given patent application is sent to the "docket clerk" for preparing the records called "index cards" specifically intended to the watching of the due dates for the payment of the annuities.

Thus, when a reminder from a foreign associate reaches the office of the US patent attorney, it is immediately dispatched to the "docket clerk" who should check whether the "index card" including the corresponding file has been duly marked. If the "docket clerk" notices something wrong, he must immediately refer to the patent attorney in charge of the file.

- VII. On 29 June 1987, the Receiving Section issued a Decision rejecting the application for re-establishment in the period specified in Article 86(2) EPC for payment of the renewal fee due for the third year. The Receiving Section was of the opinion that the US patent attorney did not take all due care required by the circumstances as the organisation of his office regarding the internal forwarding of incoming mail and the docketing system did not guarantee the preservation of the Appellant's rights.

VIII. The Appellant filed notice of appeal against the Decision on 4 September 1987. The appeal fee was duly paid and a written statement of the grounds of the appeal was filed on 5 November 1987. The Appellant requested that the Decision under appeal be set aside and the application for re-establishment in the period specified in Article 86(2) EPC for payment of the renewal fee due for the third year be granted.

The Appellant argues as follows:

- The steps to be taken as regards the payment of renewal fees are routine tasks which have not to be performed by a patent attorney, but rather by one or several assistants.
- According to the Board of Appeal case law, the same strict standards of care are not expected of an assistant as are expected of the applicant or his patent attorney, provided that the latter has shown that he exercised the necessary due care in dealing with the assistant.
- In the present case, the tasks of the "docket clerk" (assistant) are very simple. Therefore, they do not require any specific qualifications. The "docket clerk" has to record the critical dates on an "index card". In addition, he should alert the US patent attorney in charge about three months before the due date month. Finally, after the US patent attorney in charge has requested and obtained instructions from the client and the "index card" has been modified accordingly by the "docket clerk", the latter should check by the end of every month that the client's instructions have been correctly complied with.

- It would therefore not have been useful for the office of the US patent attorney to organise specific training for this simple job.
- The office of the US patent attorney did not experience difficulty with the watching and payment in time of renewal fees until the present case. However, it is true that in the present case the first "docket clerk" did not enter the application on the "index cards", evidently because the due date was more than one year after the transmittal date of the professional representative's letter of 25 July 1984.
- It is not clear how the term "reasonable supervision" used in the Decision of the Receiving Section has to be interpreted. In practice, this supervision obviously took and takes place every time a "docket clerk" alerts a patent attorney in charge on a coming due date. The patent attorney in charge may ask to see the relevant "index card" and remind the "docket clerk" that his job, although simple, is a very important one. This does not require much discussion and checking. On the other hand, a complete check of all pending cases would be unreasonable, since it would involve many hours or days.
- The lack of payment of the renewal fee is primarily due to a culpable error of the second "docket clerk". He omitted to record the application on the basis of the first reminder received on or about 20 July 1985 when he checked (in August 1985) the "index card" "October annuities - August 1st" for 1985. At least he should have reported to a patent attorney. As a matter of fact, he did not alert anybody that something wrong might have occurred. The same culpable error was repeated when the second "docket clerk" received the

second reminder on 5 February 1986.

- It is believed that these two successive and important errors can be qualified as "culpable errors", taking also into account that the second "docket clerk" has been dismissed on 1 August 1986. These "culpable errors" cannot be imputed to the US patent attorney.
- The organisation of the office of the US patent attorney was reliable and in fact has been fully efficient until the present unfortunate case.
- The Board of Appeal is requested to confirm its case law of J 02/86 and J 03/86 (OJ EPO 1987, 368) in the present case.

Moreover, the Appellant asks the Board to confirm his view (which is in line with a recent decision of the French Supreme Court), namely that the date of removal of the cause of non-compliance pursuant to Article 122(2) EPC should be considered with respect to the applicants themselves, and not to any intermediate representative.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. The application for re-establishment of rights is admissible. The removal of the cause of non-compliance with the time limit prescribed in Article 86(2) EPC occurred with the notification, to the professional representative, of the communication pursuant to Rule 69(1) EPC dated 9 June 1986 and received by the professional representative not later than on 24 June

1986. On that day the cause of non-compliance was removed because the professional representative could realize at that time that the time limit had not been complied with (cf. T 191/82, OJ 1985, 189; Re-establishment of rights/FIBRE-CHEM). The application for re-establishment of rights filed on 24 July 1986 can therefore be regarded as having been made in due time.

3. As regards the requirement of "all due care" within the meaning of Article 122(1) EPC, the US patent attorney must be regarded as the agent of the Appellant. Thus, in order to comply with this requirement, it has to be established that the US patent attorney has taken the due care required of an applicant for or proprietor of a European patent by Article 122(1) EPC (cf. J 05/80; OJ EPO 1981, 343).

This means among other things that, in case of culpable errors committed by the US patent attorney's assistants, the Appellant may only benefit from the provisions of Article 122 EPC if he is able to prove that these assistants were carefully selected and properly instructed in the tasks to be performed, and that a reasonable supervision of their activity has been exercised (cf. J 05/80 above).

4. The "docket clerks" have to be regarded as assistants of the US patent attorney, entrusted with the performance of routine tasks such as noting time limits and checking due dates. In order to be able to carry out these admittedly rather simple tasks properly, they need nevertheless some basic knowledge. In particular, the "docket clerks" should be familiar with the meaning of the various existing time limits for the payment of renewal fees they have to handle as well as the legal consequences in case a particular prescribed time limit is not met. In addition, they must

be able to identify the critical dates of a patent application and to record them on an "index card". Finally, the "docket clerks" ought to be acquainted with the conditions and modalities of informing the US patent attorney in charge about the due dates to be observed. Above all, they should know how to proceed when a fees reminder sent by a professional representative is received by the office of the US patent attorney. Hence it follows that, although no special qualifications are required, it is fairly impossible for a "docket clerk" to perform these routine tasks satisfactorily without having previously been given appropriate instruction and being supervised closely until he is familiar with the job.

5. As regards the present case, the Board takes the view that, for the following reasons, the second "docket clerk" was either not carefully selected or not properly instructed:
 - 5.1 The first "docket clerk" failed to record the Appellant's European patent application on an "index card". In addition, the first fees reminder, which, incidentally, had been received by the office of the US patent attorney in all probability before the second "docket clerk" was hired, was obviously not attended to by the first "docket clerk", and there is no evidence that she ever mentioned it to the second "docket clerk".
 - 5.2 In the first fees reminder it was clearly stated that the renewal fee had to be paid before the end of October 1985. Likewise, the second fees reminder conveyed the information that it was still possible to pay this fee together with an additional fee before the end of April 1986. Furthermore, the professional representative asked in both reminders for instructions to pay. Notwithstanding

this unequivocal situation, the fees reminders remained unanswered.

6. Concerning the supervision of the activity of the second "docket clerk", the Board's comments are as follows:

6.1 A reasonable supervision of the activity of a newly engaged "docket clerk" (such as the second "docket clerk" in this case) implies that his work be periodically checked. In order to be effective to avoid culpable errors, these periodic checks should not be initiated mainly by the "docket clerk" on the occasion of his alerting the patent attorney in charge to a coming due date, but should rather be performed systematically irrespective of such alerts, at least during an initial training period of several months.

6.2 These checks should be aimed at making sure that, especially in consideration of subsequently received fees reminders, the "index cards" are accurately updated.

6.3 In the present case, no evidence is to be found indicating that, in the period from August 1985 until April 1986, the US patent attorney, the first "docket clerk" or any other competent person undertook periodic checks of this kind. The requirements of reasonable supervision (as set out under point 6.1 supra) are therefore not fulfilled. The Board fully endorses the views, expressed in paragraph 8 of the Decision under appeal, on this aspect of the case.

7. Thus, in the Board's view, the Appellant has failed to establish that the US patent attorney has taken the due care required by Article 122 EPC; for it is quite obvious that in the present case (and in contrast to the facts underlying the Decisions of the Legal Board of Appeal J 02/86 and J 03/86) the organisation of the US patent

attorney's office has to be considered deficient as regards the watching of due dates for the payment of renewal fees.

Order

For these reasons, it is decided that:

The appeal is dismissed.

The Registrar:

J. Ruckerl

The Chairman:

P. Ford