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Aktenzeichen / Case Number / N^o du recours : J 23/88 - 3.1.1

Anmeldenummer / Filing No / N^o de la demande : 85 901 176.9

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Bezeichnung der Erfindung: Zero crossing switching modulation systems and
Title of invention: methods
Titre de l'invention :

Klassifikation / Classification / Classement : H04 B 14/00

ENTSCHEIDUNG / DECISION

vom / of / du 25 April 1989

Anmelder / Applicant / Demandeur : Webb, Leon C.

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPU / EPC / CBE Articles 114(1), 134 & 133(2) EPC; Rules 90(1)(a) &
90(1)(c) EPC; Articles 27(7) & 49 PCT

Schlagwort / Keyword / Mot clé : "Interruption of proceedings by legal incapacity
of a representative from outside the
Contracting States (allowed)"

Leitsatz / Headnote / Sommaire

Europäisches
Patentamt

Beschwerdekammern

European Patent
Office

Boards of Appeal

Office européen
des brevets

Chambres de recours



Case Number : J 23/88 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal
of 25 April 1989

Appellant : Webb, Leon C.
7306 Mt. Sherman Road
Longmont, CO. 80501
USA

Representative : Baillie, Iain Cameron
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Isartorplatz 5
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Decision under appeal : Decision of the Receiving Section of
the European Patent Office dated
11 April 1988.

Composition of the Board :

Chairman : P. Ford
Members : J. Stephens-Ofner
E. Persson

Summary of Facts and Submissions

- I. Euro PCT application no. 85 901 176.9 was filed as international application PCT/US 85/00165 on 1 February 1985, claiming US priorities of 1 February and 29 May 1984. The Applicant, an American citizen of Colorado USA, used the services of a US patent attorney, also of Colorado USA, who was at the time the president, and therefore a corporate officer, of ITC, a company which, under a licence agreement with the Applicant, was contractually responsible for the filing and prosecution worldwide of patents for inventions made by the Applicant.

- II. The Receiving Section informed the US patent attorney on 6 September 1985 that the application was due to enter the European regional phase on 1 October 1985, and later (29 November 1985) sent a reminder to him, warning that the requisite fees had not been paid within the one month period prescribed by Rule 104b(1) EPC, the time limit provided for in Article 22 PCT having expired on Monday 4 November 1985. The Applicant was given the opportunity to pay all fees due within the period of grace of two months under Rule 85a EPC.

- III. The period of grace under Rule 85a EPC expired on 7 January 1986, but the fees and the surcharge had still not been paid.

- IV. Further correspondence ensued between the Applicant himself and the Office during 1986, from which it is apparent that the Applicant was under the impression that all formalities had been duly complied with by the US patent attorney who, as a corporate officer of ITC, was under US national law authorised to act for him. It is

clear from the evidence before the Board that at all relevant times when the PCT application could have entered the European regional phase upon the fulfilment of the requisite formalities and payment of fees, the US patent attorney was so severely disturbed in his mind, as a result of a prolonged overdose of anti-histamine and other medications, that he was quite unable to perform his professional duties. For this reason, and for this reason alone, the requisite fees remained unpaid and the prescribed formalities were not fulfilled.

V. On the 25 February 1987 a Mr. Stephen Basset, formerly a consulting Vice-President for Corporate Finance of ITC, learnt of the problems affecting the application in suit, and of the reasons for the numerous procedural deficiencies in its prosecution from the PCT to the European regional phase. At this time Mr. Basset was already acting president of ITC, a post which he took over from the US Patent Attorney on 19 February 1987 who, on 3 March 1987, formally resigned from the Board of ITC. A Board meeting was immediately convened and held on the same day to consider the procedural problems in the prosecution of the application in suit, and outside patent counsel was instructed to advise on the precise status of the application, and on the steps needed to remedy all the defects.

VI. On 6 April 1987 the Receiving Section were informed by a European professional representative that he was taking over the case and that, in his submission, there had been an interruption of proceedings within Rule 90 EPC. On 15 April 1987 the said representative filed two main requests; the first that the EPO recognise that there has been an interruption of proceedings within the meaning of Rule 90(1)(a) EPC and that, accordingly, the grant procedure be continued now that the interruption has

ceased; and, in the alternative, that rights be re-established under Article 122 EPC. All outstanding fees and surcharges, together with a fee for re-establishment of rights under Article 122 EPC, had been paid on 14 April 1987.

VII. By decision dated 11 April 1988, the Receiving Section disallowed the Applicant's claim under Rule 90(1)(a) EPC, holding that an American patent attorney was not covered by Rule 90(1)(a) EPC, being neither the Applicant nor the Proprietor of a European patent, nor a person authorised by national law to act on his behalf. The decision was based on a strict construction of Rule 90(1)(a), and in particular upon the premise that the relevant category in that Rule (persons authorised by national law) covered tutors or curators of the Applicant/Proprietor but did not extend to a patent attorney authorised under the laws of a non-Contracting State, whose legal incapacity was, therefore, irrelevant to the operation of the above Rule. It also rejected the claim for re-establishment of rights under Article 122 EPC, on the ground that receipt of a telex sent on 28 August 1986 to the Applicant himself, explaining the procedural defects, informing him that the application was deemed to be withdrawn, and at the same time advising him of his rights under Article 122 EPC, was effective to remove the cause of non-compliance. The Applicant had maintained that the relevant date was 25 February 1987, the date on which Mr. Basset became aware of the true state of affairs. Clearly, the earlier date, so the Receiving Section held, rendered an application for re-establishment made on 15 April 1987 inadmissible under Article 122(2) EPC.

VIII. The Appellant duly filed an appeal on 10 June 1988 requesting that the decision of the Receiving Section be set aside. In the Statement of Grounds filed on 11 August 1988 he also requested refund of the appeal fee.

Reasons for the Decision

1. The appeal is admissible.
2. The case falls to be decided upon two distinct grounds, namely, Rule 90 EPC and Article 122 EPC. Since a decision in the Appellant's favour under Rule 90 would make consideration of the alternative ground under Article 122 EPC unnecessary, the Board turns first to the allowability of the appeal under Rule 90 EPC.
3. This rule covers the effect upon proceedings of, *inter alia*, the legal incapacity of certain categories of persons. Since it stands accepted that the US patent attorney was, at all relevant times, legally incapacitated, it only remains for the Board to decide whether or not the Receiving Section's strict construction of Rule 90(1)(a) is correct in law.
4. Although the text of Rule 90(1)(a) differs in the three official languages, leaving some room for the argument that it covers persons authorised not only by, *i.e.* by operation of law, but also persons authorised under national law, the Board, after careful consideration, accepts the strict construction placed upon this Rule by the Receiving Section. Accordingly, the Board comes to the same conclusion as did the first instance, namely that an interruption of proceedings has not taken place under Rule 90(1)(a) EPC.
5. However, the Board has, of its own motion, considered whether or not such interruption has taken place under Rule 90(1)(c) EPC, a ground not specifically relied upon

by the Appellant. According to this sub-section of Rule 90(1), proceedings before the EPO shall be interrupted, *inter alia*, in the event of the legal incapacity of the Representative of an Applicant for a European patent. It is significant, that in contrast to the provisions of Rule 90(1)(a) as a whole, this sub-section makes no mention of the Representative's being appointed under Article 134 EPC, but is wholly silent upon the status of the Representative in this respect. Having regard to the legislative history of Rule 90 EPC, there is convincing support for the conclusion that this difference in the wording of Rule 90(1)(c) from that of Rule 90(1)(a) was deliberately chosen so as to create equal treatment between Applicants in the Contracting and in non-Contracting States (cf. Minutes of the 10th meeting of Working Party I of the inter-governmental conference for the setting up of a European system for the grant of patents, held in Luxembourg, on 22 to 26 November 1971, BR/144/71, § 71).

6. Now it is of course accepted that Articles 133(2) and 134 EPC, dealing with the representation of natural or legal persons from outside the Contracting States, leave very limited scope for the application of Rule 90(1)(c) EPC to Representatives other than professional Representatives as defined in Article 134 EPC. However, that very limited scope is, in the Board's opinion, afforded by the last three lines of Article 133(2) EPC which provides a limited exception to the normal requirement for professional representation within the meaning of Article 134 EPC, in the case, and only in the case, of the filing of the European patent application. Such a filing can thus validly be made by the Applicant himself or by any Representative duly authorised by him.

7. The present application is an international application under the PCT, for which the EPO acts as the designated office, and is, therefore, under Article 150(3) EPC, deemed to be a European patent application with a date of filing corresponding to the date of filing of the international application, namely, 1 February 1985. The history of this case clearly establishes that during the international phase of the prosecution of this European patent application the US patent attorney was, in accordance with Article 49 PCT, entitled to represent the Applicant and was therefore duly authorised by him to act during that phase of the European patent application.

8. The capacity for representation subsequent to this international phase is dealt with by Article 27(7) PCT: "once the processing of the international application has started in the designated Office, that Office may apply national" (i.e. regional) "law as far as it relates to any requirement that the Applicant be represented by an agent having the right to represent Applicants before the said Office ...". In the present case these special requirements are clearly those of Articles 133(2) and 134 EPC.

Thus, in effect, once the processing of the international application has properly started in the EPO, an American patent attorney would lose his entitlement to act under Article 49 PCT by virtue of the combined effect of Article 27(7) PCT and Articles 133(2) and 134 EPC. Once he lost his representative capacity, any interruption in proceedings occasioned by his death or legal incapacity would no longer be covered by Rule 90(1)(c) EPC.

9. The substantive processing of an international application in the EPO starts by the payment of the fees specified in Rule 104(b)(1) EPC and by the filing of a request for

examination under Article 94(2) EPC in conjunction with Article 150(2) EPC. Only when these acts have been duly performed, can the substantive processing of an international application be deemed to have started in the EPO. Having regard to the fact that the above-mentioned provision of Article 27(7) PCT prevails over any conflicting provision of the EPC, as prescribed by Article 150(2) EPC, the Board takes the view that for the very purpose of starting the processing of the application (by paying fees and filing a request for examination) any Representative meeting the requirements under Article 49 PCT such as an American patent attorney, is competent to act. Such a person is not, of course, a professional Representative within the meaning of Article 134 EPC, but he does fall within the limited scope of Rule 90(1)(c) conferred upon non-professional Representatives by the exception contained in Article 133(2) EPC. This interpretation of the relevant Articles and Rules of the EPC is fully consonant with the views expressed in the preparatory document referred to in paragraph 5 above regarding the desirability of equal treatment of Applicants from Contracting and non-Contracting States.

10. It follows from the above considerations that the US patent attorney in the present case was, at the relevant time, a legally incapacitated Representative of the Applicant within the meaning of Rule 90(1)(c) EPC.
11. Accordingly, the Appellant is entitled to relief under Rule 90 EPC, and it is not therefore necessary for the Board to deal with the second ground of appeal under Article 122 EPC. The fee for re-establishment of rights was paid without purpose and may be refunded accordingly.
12. The request for refund of the appeal fee is, however, not considered to be justified. The Appellant's argument that

the interpretation of Rule 90(1)(a) was wrong has been rejected and there was no failure to consider relevant evidence.

Order

For the above reasons it is decided that:

- (a) The appeal is allowed.
- (b) The case is remitted to the Receiving Section for further prosecution.
- (c) The fee paid under Article 122(2) EPC is to be refunded.
- (d) The request for reimbursement of the appeal fee is refused.

The Registrar:



J. Rückerl

The Chairman:



P. Ford