

**Beschwerdekammern des
Europäischen Patentamts**

**Boards of Appeal of the
European Patent Office**

**Chambres de recours de
l'Office européen des brevets**

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Please find enclosed the headnote of the decision *J271 90 - 3.1.1.*

Veuillez trouver en annexe une copie du sommaire de la décision

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Publication in the Official Journal Yes / No

File Number: J 27/90 - 3.1.1
Application No.: 86 114 479.8
Publication No.: 0 223 082
Title of invention: Release and alignment mechanism for jet-propelled
projectiles
Classification: F41F 3/04

D E C I S I O N
of 7 November 1991

Applicant: BRUNSWICK CORPORATION

Ver.

Headword: Restitutio/BRUNSWICK

EPC Articles 122(1)(2), 133(2), 134, Rule 69

Keyword: "Re-establishment of rights - admissibility", "professional
representative", "external renewal fee payment agency", "removal of
the cause of non-compliance"

Headnote

1. In the absence of circumstances to the contrary a communication under Rule 69(1) EPC to the professional representative qualified under Article 134 EPC and appointed in accordance with Article 133(2) by the person entitled to the patent application removes the cause of non-compliance. This applies also when parties instruct the (European) professional representatives via their (national) patent attorney.

2. The appointment of an independent service firm for the payment of renewal fees (a so-called "renewal fee payment agency") does not constitute such circumstances to the contrary. The professional representative remains responsible for the application notwithstanding the fact that the Applicants use such a payment agency.

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Case Number : J 27/90 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 7 November 1991

Appellant : BRUNSWICK CORPORATION
One Brunswick Plaza
Shokie
Illinois 60076 (US)

Representative : Alden, Thomas Stanley
A.A. THORNTON & CO.
Northumberland House
303-306 High Holborn
London WC1V 7LE (GB)

Decision under appeal : Decision of the Formalities Section of the
European Patent Office dated 18 May 1990 refusing
European patent application No. 86 114 479.8
pursuant to Article 86(2) EPC.

Composition of the Board :

Chairman : O. Bossung
Members : M. Schar
J.-C. De Preter

Summary of Facts and Submissions

- I. European patent application No. 86 114 479.8 was filed on 18 October 1986 as one of two divisional applications of European patent application No. 83 303 942.3, filed on 6 July 1983. In accordance with Article 86(1), Rule 37(1) and Rule 85(1) EPC, the renewal fee for the sixth year became due on 1 August 1988.
- II. In its communication dated 6 September 1988 the Receiving Section of the EPO informed the Appellants that, although the renewal fee had not been paid within the prescribed time limit, it could still be validly paid within 6 months of the due date (i.e. until 1 February 1989) provided that the additional fee was also paid within this period (Art. 86(2) EPC).
- III. The renewal fee and the additional fee were not paid in due time. Consequently, in a communication under Rule 69(1) EPC dated 6 March 1989 and received by the Appellants' professional representative on 10 March 1989, the Appellants were informed that, in accordance with Article 86(3) EPC, the application was deemed to be withdrawn.
- IV. By telecopy, dated 5 June 1989 and received by the EPO on the same day (duly confirmed by letter received on 7 June 1989) the Appellants filed an application for re-establishment of rights under Article 122 EPC and they also paid all fees in question.
- V. In a letter dated 28 July 1989, the Receiving Section informed the Appellants of its provisional opinion that the application for re-establishment was filed too late and that all due care required by the circumstances did not seem to have been taken.

VI. On 1 November 1989, the Appellants filed a letter in which the following facts were added:

- The Appellants used a computerized service firm, a so-called "renewal fee payment agency", for the payment of renewal fees (annuities) on their patent applications. The professional representative confirmed in the name of the Applicants that this did not release him from his obligation to report and to forward copies of the communications dated 6 September 1988 and 6 March 1989.
- On or about April 1988 the Appellants decided that all their patent portfolio should be handled by a different renewal fee payment agency. Therefore the agency formerly responsible was requested by the Appellants to remove their cases from the record and to transfer them to the newly appointed agency. This transfer was not properly executed in that the present application was removed from the old agency's records but not added to the records of the new one. The applicants' patent department overlooked this because they had allocated "substantially identical docket numbers" to the files relating to the invention in question. The Appellants further alleged that the circumstances of the present case were special because the US patent application remained undivided while the European application was divided.
- The professional representative informed the Appellants' US patent attorney by letter dated 6 October 1988 that the time limit which had expired on 1 August 1988 had not been met and by letter dated 15 March 1989 that the application had been deemed to be withdrawn.
- Only through a telephone conversation with their US patent attorney on 18 May 1989 did the Appellants

themselves become aware that their instructions had not been implemented.

- VII. On 18 May 1990, the Formalities Section of the Examining Division issued a Decision rejecting the application for re-establishment on the grounds of lack of all due care and held that the question of whether the two months time limit provided for in Article 122(2) EPC had been observed did not need to be considered. Nevertheless the first Instance indicated that they considered the request for restitutio had been filed too late.
- VIII. On 16 July 1990 the Appellants filed notice of appeal against the said decision. The appeal fee was duly paid and a written Statement of Grounds was filed on 17 September 1990. The Appellants request 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 sixth year be granted.

The Appellants do not contest the statement of facts contained in the decision under appeal. Furthermore they refer mainly to their allegations presented before the first instance.

- IX. By a communication dated 22 February 1991 the Board of Appeal informed the Appellants that there were doubts about the allegation that the removal of the cause of non-compliance was not the awareness of the representative but of the Appellants themselves.
- X. In their reply dated 3 April 1991 the Appellants filed an auxiliary request for oral proceedings in the event the Board intended to dismiss the appeal. Furthermore they submitted the following arguments:

- There were two lines of communication, one dealing with technical and procedural matters and the prosecution of the application, comprising the professional representative and the US Patent Attorney of the Applicants, and one which dealt with the payment of renewal fees, instructed by the Applicants. This was wholly compatible with the EPC and with the rules and practice of the EPO. According to the Legal Advice of the EPO No. 6/80 (OJ EPO 1981, 303-305) it is possible to make payments through independent renewal fee agencies and according to Article 7(2) of the Rules relating to Fees the Office may directly contact any party making a payment where the purpose of the payment is unknown.

- The receipt by the professional representative of the communication by the EPO dated 6 March 1989 concerning the declaratory decision regarding the loss of rights did not constitute the removal of the cause of non-compliance, because neither he nor the US patent attorney was in a position to check whether the communication was well founded, as they kept no records of renewal fee payments. Other than the payment agency itself, only the Appellants were in a position to check that payment had been made.

- The cause of non-compliance consisted in the erroneous belief that the case had been properly transferred from one computer system to another, which cause was only removed when the Applicants themselves realised on 18 May 1989 that a mistake had been made in the computer transfer. Accordingly their unawareness or inadvertance could not be removed by a notification under Rule 69(1) EPC.

- The oversight by the Appellant's patent department in not realising that the file had not been properly transferred constituted an isolated mistake in an otherwise satisfactory system.

XI. A summons to oral proceedings, scheduled for 19 June 1991, was sent to the Appellants on 24 April 1991. By telecopy dated 5 June 1991 the Appellants informed the Board that they did not propose to attend and that they therefore looked forward to receiving the Decision of the Board of Appeal. The Board of Appeal cancelled the oral proceedings by Order of 12 June 1991.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. Admissibility of the application for re-establishment of rights
 - 2.1 In accordance with Article 122(2) EPC, an application for re-establishment of rights must be filed within two months of the date of removal of the cause of non-compliance with the missed time limit.
 - 2.2 In the present case the application for re-establishment was filed on 5 June 1989. This means that this application was admissible only if the Board is able to find that the cause of non-compliance had been removed less than two months before that date.
 - 2.3 According to the established case law of the Boards of Appeal, the removal of the cause of non-compliance occurs on the date on which the person responsible for the

application (i.e. the patent applicant or his authorised agent) is made aware of the fact that a time-limit has not been observed (J 27/88 of 5 July 1988, Reasons 2.3, not published; T 191/82, OJ EPO 1985, 189; T 287/84 OJ EPO 1985, 333).

Principally the person or persons entitled to a patent application are responsible for the patent application. However in accordance with Article 134 EPC the Applicants may appoint a professional representative. Furthermore Article 133(2) EPC requires any applicant not having either a residence or their principal place of business within the territory of one of the Contracting States to be represented by a professional representative and to "act through him in all proceedings established by this Convention". The professional representative takes responsibility for the patent application towards the Applicants on the basis of their (internal) agency agreement. And he may be considered by the EPO to bear this responsibility on the basis of his authorization and on the basis of his professional capacity as a professional representative appearing on the list maintained by the EPO (Article 134(1) EPC) in that he is to be considered entitled to undertake procedural steps in the interests of the Applicants.

The Applicants, a US Company having their principal place of business in the United States, and acting as a principal, properly appointed the professional representative as their agent by referring to a general authorisation (see: Rule 101(2) EPC). This constitutes an express authorisation. In accordance with Rule 101(3) EPC the President of the European Patent Office has determined the form and content of such a general authorisation. It is laid down in EPO Form 1003 07.81 and refers to "all

proceedings established by the European Patent Convention concerning the European patent application or patent".

Therefore the professional representative was empowered to act in the name of the Appellants. He was also capable of doing so. Under Article 133(2) he was the only one authorized to file a request for re-establishment. Due to his qualification as a professional representative under the EPC he knew the steps to be taken in such a situation. Pursuant to Rule 81 EPC he received the communications from the EPO. He was therefore the one who notified the Appellants via their national patent attorney by a letter dated 6 October 1988 of the unpaid fee and he even expressed his doubts as to the suitability of the renewal fee agency recently appointed.

With the exception of the filing of the application itself, only one act may be performed by any person, namely the payment of fees (see: Art. 133(2) EPC and Legal Advice of the EPO No. 6/80, OJ EPO 1980, 149) and this therefore constitutes an exception to the principle laid down in Article 133(2) EPC. However the above mentioned Legal Advice of the EPO does not contain any element which could lead to the conclusion that this exception extends beyond the mere act of executing payments. Point 5 of the said Legal Advice reads as follows:

"The fact that a fee is paid by a third party does not make that person a party to the proceedings to which the payment relates. Provided that the procedure to which the fee relates can be identified, any correspondence relating to the payment will therefore be conducted with the party concerned or with his representative and not with the person who made the payment."

A different conclusion cannot be drawn either from Article 7 of the Rules relating to Fees, which allows the Office to contact those making payments only where the purpose of a payment is unknown. No duty to communicate with such a person regarding the outcome of the application itself arises out of the said Rule. The professional representative thus remained fully in charge regarding all other acts, such as the handling of the application in all respects, including the receipt on behalf of the Appellants of any correspondence, communication and decision from the EPO (Rule 81(1) EPC). The Appellants themselves point out in their letter to the EPO dated 3 April 1991 that it was the responsibility of the professional representative to deal with all technical and procedural matters and to "prosecute the Application".

Therefore there can be no question of two lines of communication between the Applicants and the EPO. The professional representative remained responsible for the application notwithstanding the fact that the Applicants used an independent service firm for the payment of renewal fees. Due to the powers conferred on him through the authorisation by the Applicant and his professional capacity his awareness may be considered to be sufficient to remove the cause of non-compliance (see also: T 287/84, OJ 1985, 333; T 191/82, OJ 1985, 189).

- 2.4 The removal of the cause of non-compliance is a matter of fact which has to be determined in the individual circumstances of each case (J 07/82, OJ 1982, 391). Here it is conceivable as the Appellants allege, that the cause of non-compliance consisted in "the erroneous belief that the case had been properly transferred from one computer system to another", which lead to the unawareness that due dates for payments had been missed. In the case of an error of facts the removal occurs on the date on which any person

responsible for a patent application should have discovered the error made. This is not necessarily the date of receipt of the communication under Rule 69(1) EPC (see: T 315/90 of 18 March 1991, not published). If, however, such a communication has duly been served, it may, in the absence of circumstances to the contrary, be assumed that the removal was effected by this communication (see also: J 07/82, OJ 1982, 391).

The communication from the EPO dated 6 March 1989 to the professional Representative stated that the application was deemed to be withdrawn. His attention had already been drawn to this danger by the communication under Article 86(2) EPC dated 6 September 1988. The Appellants do not put forward any convincing argument which could lead to the conclusion that the representative was not aware of the need to check in good time with the Applicants the circumstances leading to the failure to pay. Nor are there convincing arguments explaining why he failed to file a request for re-establishment of rights or a precautionary request to be completed with the necessary details later but still in time. Finally there are no convincing arguments that he was entitled to ignore the content of the said communication. The fact that neither he nor the Appellant's national patent attorney kept records of the renewal fee payments made by an external renewal fee payment agency does not constitute a ground for failing to act on an EPO communication, particularly one dealing with the loss of rights. On the contrary, such a communication must prompt the authorized representative to take action with his client in the manner referred to.

The allegation that it was believed that the payment had been made and that the communication from the EPO was unfounded is no compelling reason for inactivity either but

rather a strong incentive to file a request for re-establishment and/or to contest the communication by a request for a decision under Rule 69(2) EPC together with filing the details of the payment, had such payment been made. Yet this was not undertaken either.

It is not necessary therefore to establish in this case whether the Applicants themselves or their national patent attorney were unaware payment had not been made and whether they were made aware (see also: T 30/90 of 13 June 1991, not published).

- 2.5 Consequently it must be assumed that the Applicant's professional representative was made aware, by the communication under Rule 69(1) EPC, that an important fee had not been paid in time and that a loss of rights had occurred. This constitutes the removal of the cause of non compliance. This assumption is even confirmed in this case by the letter dated 15 March 1989 to the Applicant's national patent attorney in which the professional representative referred to the loss of rights. As the request for re-establishment dated 5 June 1989 was filed more than two months after the removal of the cause of non compliance, it is therefore not admissible according to Article 122(2) EPC.
3. As the request is inadmissible, the question of whether "due care" within the meaning of Article 122(1) was taken need not be dealt with.

Order

For these reasons, it is decided that:

The appeal is dismissed.

The Registrar




M. Beer

The Chairman



O. Bossung



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