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File Number: J 31/90 - 3.1.1

Application No.: 89 900 647.2

Publication No.: WO 8906086

Title of invention: Thin-film conductive circuit and process for its
production

Classification: H05K 1/09

D E C I S I O N
of 10 July 1992

Applicant: Mitsui Mining & Smelting Co., Ltd., et al

Headword:

EPC Articles 122, 158(2)

Keyword: "Missed time limit for supply of translation of international
application in official language of EPO" - "All due care (yes)" -
"Re-establishment (yes)"



Case Number : J 31/90 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 10 July 1992

Appellant : Mitsui Mining & Smelting Co. Ltd., et al
2-1-1, Nihonbashi-Muromachi
Chuo-ku
Tokyo-to 103 (JP)

Representative : Simon Thorley Q.C.
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Decision under appeal : Decision of the Receiving Section of the European
Patent Office dated 19 July 1990 refusing the
application for re-establishment of rights in
respect of European patent application
No. 89 900 647.2.

Composition of the Board :

Chairman : R. Schulte
Members : G. Davies
J-C. De Preter

Summary of Facts and Submissions

- I. On 15 December 1988, the appellant filed international application PCT/JP88/01275, claiming the priority of two national patent applications filed in Japan on 18 December 1987 and 8 March 1988, respectively. This application was given the European patent application number 89 900 647.2. The appellant's representative subsequently filed EPO Form 1200 upon entering the European regional phase; the form was dated 3 August 1989 and was received at the EPO on 8 August. An authorisation (Rule 101 EPC) was filed at the same time and the relevant fees, including the national fee, paid. On 1 September 1989, translations of the Japanese priority documents were filed.

The time limit prescribed in Article 22(1) PCT with respect to furnishing a translation of the international application and the payment of the national fee to the designated office expired on 18 August 1989 (20 months from the priority date).

The appellant's representatives were advised by communication of 12 October 1989, pursuant to Rule 69(1) EPC, that the application was deemed withdrawn because a translation of the international application into one of the official languages of the EPO had not been furnished in accordance with Article 158(2) EPC within the period specified under Article 22(1) PCT.

This case is one of three cases where the identical mistake was made within a period of five weeks.

- II. By letter received by the EPO on 7 December 1989, the appellant filed an application for re-establishment of rights under Article 122 EPC, with respect to the missed

time limit for filing the English translation of the international application.

By a Decision dated 19 July 1990, the Receiving Section rejected the application for re-establishment of rights. The Receiving Section was of the opinion that the appellant's representative had not taken all the due care required by the circumstances, finding inter alia that the representative had delegated to her secretary the complete preparation of the documentation required for the entry into the European national phase for the international application in question and had limited herself to signing the documents presented to her. This implied that the secretary had had to interpret relevant provisions of both the PCT and the EPC, in particular Article 22(1) PCT and Article 158 (2) EPC. Such delegation exceeded the scope of routine tasks which might properly be entrusted to a secretary. The Receiving Section considered also that the professional representative had not been aware of the requirement to file a translation of the international application.

- III. On 20 August 1990, the appellant's representatives filed a notice of appeal against this decision, paying the appeal fee on the same day. The statement of grounds of appeal was filed on 14 November 1990. By separate letter received by the EPO the same day, the appellant's representative requested oral proceedings in the event that the Board envisaged the possibility of an adverse finding.

- IV. The evidence submitted by the appellant in support of the application for re-establishment of rights in the grounds of appeal, in response to a communication of the Board dated 7 October 1991 and in the course of oral proceedings held on 10 July 1992, is summarised below.

At all relevant times the representative concerned carried on business from a small, branch office of her firm at Ascot, U.K., where she was the only qualified practitioner. As sole partner in the office, she relied on the competence and assistance of her personal secretary (A.D), who had worked with her for ten years, for the performance of routine clerical tasks including the preparation of forms and papers for filing with the EPO according to her specific instructions and subject to checking by her. During the ten years the two had worked together, the representative had instructed A.D. in the various procedures and documentation required in connection with filing European patent applications at the EPO as well as entering the European national phase of international applications. Based on the performance of A.D. over the years, the representative regarded her as a reliable person, having the qualifications and experience required of a patent agent's personal secretary. The two ladies had also built up a particularly close, working relationship due to the small size of the office. The representative submitted that, once she had satisfied herself that A.D. was properly instructed, fully informed and carrying out her duties without error, she had felt it was proper to rely on her. In particular, for at least eight years prior to 1989, it was the practice of the firm to use Form 1200 for the purpose of supplying the required information and documents to the EPO in the European regional phase of international applications. However, the representative did not expect A.D. to assess which documents should be filed or the date on which they should be filed. The representative would instruct A.D. which documents to send either orally or by a written indication on the document itself, and was fully satisfied by long experience that A.D. was meticulous in carrying out those instructions both in filling in the forms and dispatching the documents.

The usual practice of the representative, on receipt of instructions from foreign associates, was to review the instructions and consider the formal requirements to determine due dates for lodging documents and the documents required and then to pass the file with the necessary instructions to A.D. to prepare the necessary documentation. Such instructions would primarily comprise an instruction to complete the necessary form(s) according to the usual, well-established, practice. Upon presentation of the completed form, the representative would compare the details contained on the form with the information in the file and, if she believed the form to be correct, she would sign it and return it to A.D. for the preparation and attachment of the necessary enclosures in accordance with her previous instructions.

In the case in question, on receipt of instructions, the representative had opened a case file and obtained an internal reference number from her Head Office as well as the relevant European application number from the EPO. She had then written such details on the file and on the top of the English translation of the international application and passed the file to A.D. with the oral instruction to complete a EPO Form 1200 in accordance with the instructions received from the client and to attach the English translation of the PCT application.

Once A.D. had completed Form 1200, she presented it to the representative for checking and signature; on checking the form the latter did not notice that item 5 of the form referring to the supply of a translation of the international application was not ticked. Thereafter, the representative returned the form to A.D. for attachment of the enclosures which she assumed would include the necessary English translation of the international

application. The representative did not then check the assembled documents, her experience of the competence of A.D making this in her opinion unnecessary.

The representative provided evidence that she was aware of the requirement to file the English translation in the form of a letter dated 4 September 1989 (in respect of one of the other two applications where the identical mistake was made), written well before the communication of October 12 referred to in paragraph I, above, was received, requesting corrections to be made to a translation of the international specification.

It was submitted that the failure of the representative to fill in item 5 of Form 1200 should not be regarded as evidence of lack of due care. There was no obligation to use Form 1200; it was used in the representative's system as a useful tool with which to collate the essential information and documents to be filed within the 20-month period in Euro-PCT cases; however, the representative's system did not depend only on the correct completion of the form. The system relied primarily on the written instructions given by the representative to her secretary by way of notations on the file and on the oral instructions given to the latter case by case.

In conclusion, the representative submitted that it had been her clear intention that the necessary translation of the text in an official language of the EPO should be enclosed and that failure to correct a minor error in the completion of Form 1200 should not be regarded as proving a lack of due care on her part. She had exercised all the due care required by the circumstances in providing adequate training and instruction to A.D. The failure to file the translation in this case was due to circumstances beyond her control.

- V. Evidence was also put forward by A.D. to confirm that the representative had instructed her in this case to file the appropriate documentation but that having prepared the Form 1200 she had omitted to include the English translation of the international application, even though it was on file and had been annotated by the representative. She had never previously omitted to file any appropriate documents at the EPO although she had been dealing with such matters on a routine basis for many years. She attributed the error to the unusual amount of personal stress she was undergoing at the time, due to the fact that her husband had suffered a heart attack; as a result of the stress she, herself, had had to be treated for high blood pressure and in September 1989 had been obliged to resign from her job.

Reasons for the Decision

1. The application for re-establishment of rights fulfils the conditions laid down in paragraphs (2) and (3) of Article 122 EPC and is admissible.

2. Article 122 EPC provides for an applicant who, in spite of all the due care required by the circumstances having been taken, was unable to observe a time limit vis-à-vis the EPO, thereby losing a right or other redress, to have his rights re-established upon application subject to the conditions referred to in paragraph 1, above, being met. It is the established jurisprudence of the Boards of Appeal that Article 122 EPC is intended to ensure that, in appropriate cases, the loss of substantive rights does not result from an isolated procedural mistake within a normally satisfactory system (J 2 and 3/86, OJ EPO 1987, 362).

3. Whether or not a request for re-establishment of rights may be allowed, however, depends on whether or not the appellant can show that all the due care required by the circumstances of the particular case was in fact taken to comply with the time limit. With respect to due care, the following principles relevant to the present case were laid down by the Board in J 5/80 (OJ 1981 343):

- (1) When an applicant is represented by a professional representative, a request for re-establishment of rights cannot be acceded to unless the representative himself or herself can show that he or she has taken the due care required of an applicant or proprietor by Article 122(1) EPC.
- (2) If the representative has entrusted to an assistant the performance of routine tasks, the same strict standards of care are not expected of the assistant as are expected of the applicant or his representative.
- (3) A culpable error on the part of an assistant made in the course of carrying out routine tasks is not to be imputed to the representative if the latter has shown that the necessary due care was exercised in dealing with the assistant. In this respect, it is incumbent on the representative to choose for the work a suitable person, properly instructed in the tasks to be performed and to exercise reasonable supervision over the work.

That decision also made it clear that a representative cannot relieve himself of responsibility for carrying out tasks which, by reason of his qualification, fall upon him personally, such as, for example, the interpretation of laws and treaties.

4. In the present case, therefore, for re-establishment of rights to be allowed the Board must be satisfied that the representative took all the due care required by the circumstances, and, in particular, took such care in relation to setting up the system for observing the time limit in question and in the choice, instruction and supervision of her assistant. In considering these issues, the Board has had available to it additional evidence in support of the appellant's case for re-establishment of rights which was not before the Receiving Section.

5. In this case, a first consideration is whether the system for observing the time limit can be shown by the party to be normally satisfactory. The representative provided evidence that the system she had established and operated in close cooperation with her secretary for the preparation of the documentation required for the entry into the European national phase of PCT applications had worked satisfactorily for a period of ten years in relation to a substantial number of such applications. The system combined the giving of specific oral instructions to the secretary on a case by case basis regarding the information to be included in the EPO Form 1200 with notations on the file to indicate which documents should be filed with the EPO. Such notations had as a matter of fact been made in the present case on the missing document. The respective file would then be given to the secretary for the completion of Form 1200 in accordance with the instructions received. The file and the completed Form 1200 would then be returned to the representative for checking and signature. Thereafter, the secretary as instructed would assemble the documents required to be filed at the EPO with the Form 1200 and dispatch them.

This case, where the secretary failed to file a translation of the PCT application, was the first time in ten years that she had made such an error. The Board takes the view that this system, while far from perfect, may be considered in the special circumstances of the case to be normally satisfactory. The Board wishes to emphasise, however, that the system could only be so considered because of the particular conditions in which the representative and her secretary worked. Over a period of ten years, working together alone in a small office they had built up an excellent working relationship and mutual trust and the Board is satisfied that the system had worked well over a considerable period of time. The fact that this system operated efficiently for many years is evidence that it was normally satisfactory (T 309/88 of 28 February 1990, unpublished). Therefore, there was no compelling reason for the representative to change the system. With the benefit of hindsight, it is clear that the system was not ideal and, in particular, it would have been preferable for the representative to check not only that the Form 1200 had been correctly completed but also that the correct documents had been assembled for dispatch to the EPO. The absence of any such check in circumstances similar to the present case might well lead to a finding of lack of due care in future cases.

6. For re-establishment of rights to be allowed in the present case, the representative must be shown also to have exercised all the due care required by the circumstances. The same strict standards of care are not expected of an assistant. According to the jurisprudence of the Boards of Appeal (see paragraph 3, above), routine tasks may be entrusted to an assistant provided that the necessary due care on the part of the representative has been exercised in dealing with the assistant. In this respect, it is incumbent upon a representative to choose

for the performance of routine tasks a suitable person, properly instructed in the tasks to be performed, and to exercise reasonable supervision over their work. The Board is satisfied from the evidence that the secretary in question was a suitable person for the work; she had shown herself competent and reliable over many years. It is also clear from the evidence that she had been properly instructed by the representative and had acquired considerable experience in her work. The question arises whether the representative had exercised reasonable supervision over her work. The representative has submitted that it was reasonable to leave the assembling of documents for dispatch to the EPO in accordance with her instructions to her secretary in the circumstances of the case since, after ten years' experience of the work, the secretary was properly instructed, fully informed and had been carrying out her duties without error. The Board considers that, because of the close and long-standing working relationship between the representative and her secretary, it was reasonable to leave this routine task to the secretary. The Board is satisfied on the evidence that the representative had properly instructed her secretary as to the documents to be filed with the EPO in this case and specifically to file the English translation of the international application and that the failure to file the document was due to an error on the part of the secretary and not to a lack of due care on the part of the representative.

7. As mentioned in paragraph 4, above, the Board has had the benefit of evidence which was not before the Receiving Section. This has made it clear that the representative had not entirely delegated the preparation of the documentation to be filed with the EPO in this case to her secretary but had exercised proper supervision. There was also no question of the secretary being required to

interpret the relevant provisions of the PCT and EPC. There is also no doubt that the representative at all times was fully aware of the requirement to file a translation of the international application.

8. The same rigorous standard of care as is demanded of an applicant or his professional representative is not expected of an assistant (J 5/80 cited above). According to the evidence, the representative's secretary erred in failing to file the missing document; she had never previously made such a mistake. At the time the mistake was made, there is evidence that she was suffering from severe stress as a result of her husband's illness and was herself suffering from ill-health. The Board is satisfied, therefore, that this was an isolated mistake in a normally satisfactory system. The Board has taken account of the fact that the same mistake was made in three similar cases within a period of five weeks. It takes the view that this does not mean that the mistake cannot be considered an isolated mistake. Once the representative's secretary had failed to carry out her instructions in the first case without it coming to the notice of the representative, and since her instructions in the second and third cases included the instruction to follow the same procedure as in the first case, it was to be expected that she made the same mistake each time. The Board considers the mistake in the three cases to be one mistake.

9. The Board is satisfied therefore that, in spite of all due care required by the circumstances having been taken by the appellant's representative, she was unable to observe the time limit for filing the required translation into an official language of the EPO of the international application in this case.

10. The application for re-establishment of rights is allowed and the English translation of the international application shall be deemed, therefore, to have been filed in time.

Order

For these reasons, it is decided that:


1. The Decision of the Receiving Section of the European Patent Office dated 19 July 1990 is set aside.
2. The rights of the appellant are re-established in relation to the filing of the English translation of the international application within the time limit prescribed by Article 22(1) PCT.

The Registrar



J. Rückerl

The Chairman



R. Schulte



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