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D E C I S I O N
of 17 December 1993

Case Number: J 0023/92 - 3.1.1
Application Number: 86830224.1
Publication Number: 0253043
IPC: B28B 1/08

Language of the proceedings: EN

Title of invention:

A system for the strip-production of pit-panels of pre-compressed or partially pre-compressed reinforced concrete or with slow reinforcement, being extended to the lower and upper surfaces and to the ribs, and end product thereof

Applicant:

Ing. A. Russo & C. S.a.s.

Opponent:

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Headword:

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Relevant legal norms:

EPC Art. 122

Keyword:

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Decisions cited:

-

Headnote/Catchword:

-



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Boards of Appeal

Chambres de recours

Case Number: J 0023/92 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 17 December 1993

Appellant: Ing. A. Russo & C. S.a.s.
Via Santacroce, 64 A
I - 80129 Napoli (IT)

Representative: Mascioli, Alessandro, Prof.Dr.
c/o A.N.D.I.
Associazione Nazionale degli Inventori
Via Urbana, 20
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Decision under appeal: **Decision of the Formalities Section of the
European Patent Office dated 30 March 1992
refusing the application for re-establishment of
rights in respect of European patent application
No. 86 830 224.1.**

Composition of the Board:

Chairman: R.L.J. Schulte
Members: G. Davies
J.-P.B. Seitz

Summary of Facts and Submissions

I. On 29 July 1986, the Appellant filed European application No. 86 830 224.1. The fifth year renewal fee fell due on 31 July 1990 and on the previous day, 30 July 1993, the Appellant paid an amount of ITL 469.000.- This amount was insufficient, the renewal fee for the fifth year being ITL. 592.000.-

On 28 August 1990, a notice drawing attention to Article 86(2) EPC and Article 2(5) of the Rules relating to Fees was issued by the Office. However, no fee was paid within the six month period provided for in Article 86(2) EPC. On 8 March 1991 the EPO faxed a communication pursuant to Rule 69(1) EPC to the Applicant's representative informing him that the application was deemed to have been withdrawn for non-payment of the fifth year renewal fee.

On 18 April 1991, the Applicant's representative filed a request for re-establishment of rights under Article 122 EPC with respect to the loss of rights resulting from the non-payment of the renewal fee. The respective fee had already been paid on 20 March 1991, together with the outstanding amount of the renewal fee and the additional fee for belated payment thereof.

In support of the request for re-establishment of rights, the Applicant's representative stated that his assistant, Miss R., had by mistake paid a fourth year renewal fee instead of the required renewal fee for the fifth year. On receipt of the communication from the EPO dated 28 August 1990, she had verified that the renewal fee had been paid in due time but had failed to check whether the correct amount had been paid and, for this reason, did not reply to the communication. It was

suggested that this was because the EPO frequently sent communications requesting payment of renewal fees, when these had in fact already been paid. When the mistake came to light following contacts with the EPO in early March 1991, the Applicant's representative had given Miss R. precise instructions regarding the steps to be taken by her under the EPC to rectify the matter but, before she had taken these steps, she had fallen ill and had been absent from the office from 13 March 1991 to 27 April 1991. Miss. R.'s work had been taken over by another employee who had then paid the outstanding fees on 20 March 1991 and filed the request for re-establishment of rights on 18 April 1991.

- II. In a decision dated 30 March 1992, the Examining Division refused the application for re-establishment of rights on the grounds that the Applicant's representative had not taken all the due care required by the circumstances himself. No evidence had been presented to show that the representative had properly instructed his assistant or exercised reasonable supervision over her work (cf. J 05/80, EPO 0J 1981, 343). It could have been expected of a careful representative that he would have supervised the action taken in reply to the notice of 28 August 1990 in order to establish whether or not a mistake had been made. An EPO reminder regarding the non-payment of fees, which can lead to a loss of rights, should always result in a careful check by the representative in charge of the file as it is his responsibility to avoid loss of rights. Moreover, no evidence had been supplied to demonstrate that the representative had established in his office a normally effective system for monitoring time limits prescribed by the EPC (cf. J 02/86, J 03/86, 0J EPO 1987, 362).

III. By letter dated 22 May 1992, received by the EPO by facsimile the same day, the Appellant's representative filed a notice of appeal against this decision, the appeal fee having been paid the previous day. A written Statement of Grounds of Appeal was filed on 28 May 1992. Subsequently, in response to a communication of the Legal Board of Appeal dated 29 January 1993, the Appellant provided further details regarding the organisation of work in his office in a letter dated 10 March 1993.

IV. The arguments of the Appellant in support of the appeal may be summarised as follows: the representative had always exercised the necessary supervision over his assistant, who had suffered from a nervous breakdown at the relevant time. Because of her mental condition, the representative submitted that she had deliberately acted against his professional interests. He submitted that he personally had done all that was required and had even checked the contents of the envelope to be sent to the EPO. He had charged his assistant only with payment and mailing. He had been misled by the assistant into believing she had carried out these tasks because she had showed him receipts and documents concerning similar cases, so deceiving the representative's trust and good faith.

As regards the system for monitoring time limits prescribed by the EPC in operation in his office, the representative supplied the EPO with two floppy discs containing the program developed to provide reminders with respect to pending applications for European patents. The program *inter alia* reviewed the files and sorted them monthly in groups according to their expiry date.

Reasons for the Decision

1. The appeal is admissible.
2. The application for re-establishment of rights fulfils the conditions laid down in paragraphs (2) and (3) of Article 122 EPC and is admissible.
3. 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 reestablished upon application subject to the conditions referred to in paragraph 1, above, being met. It is the established case law of the Boards of Appeal that a request for re-establishment of rights cannot be acceded to unless the representative himself can show that the due care required of the Applicant or proprietor by Article 122(1) EPC has been taken. It is incumbent on the representative to properly instruct and to exercise reasonable supervision over the work of any assistant to whom the performance of routine tasks has been entrusted (J 05/80, EPO OJ 1981, 343). Moreover, Article 122 is intended to ensure that loss of rights does not result from an isolated mistake in an otherwise satisfactory system; thus, an Appellant or its representative must be able to demonstrate that a normally effective system for monitoring time limits prescribed by the EPC was established at the relevant time in the office in question (J 02/86, J 03/86, OJ EPO 1987, 362).
4. The Board, having duly considered the evidence submitted in support of the application for re-establishment and of this appeal, finds that the Appellant's representative has not shown that he exercised all the

due care required by the circumstances. As stated by the Examining Division in its decision, the representative should have supervised an investigation by his assistant into the action to be taken in response to the notice dated 28 August 1990. There is nothing in the evidence to suggest that the representative himself took any action to investigate the matter or to inform himself of the result of the check carried out by Miss R. The representative has asserted that he always exercised due supervision over the work of Miss R., but the evidence in this connection is inconsistent and does not bear this out. The representative refers to the fact that, at an unspecified date and in relation to an unspecified matter, he checked the contents of an envelope to be sent to the EPO prepared by Miss R., charging her only with payment and mailing. However, there is no evidence that the incident in question was related to a response to the EPO notice of 28 August 1990, no such response having made thereto until 20 March 1991, when Miss R. was away ill. The representative has laid much emphasis on the fact that Miss R. was away ill from 13 March until late April 1991 but nowhere is it suggested that Miss R. was ill already in August 1990 or indeed in January 1991 prior to the expiry of the period of grace for payment of the renewal fee. If such had been the case, the duty of the representative to supervise her work would have been all the greater.

5. The evidence submitted concerning the system for monitoring time limits in the representative's office does not satisfy the Board that the system was normally effective at the time in question. The evidence was presented in the form of two floppy discs containing the program used to monitor EPO time limits, accompanied by a brief written description of the program and the computer system used. The written evidence did not, as required, provide an adequate description of the

monitoring system or explain how the system was applied to the present case. The Board nevertheless carefully examined the program and files contained in the floppy discs submitted in evidence, but the contents thereof did not add to the written evidence provided. Thus there is nothing in the evidence to show that the failure to pay the correct renewal fee was likely to have been an isolated mistake in an otherwise satisfactory system. The representative has submitted that he is now confident that the system will exclude the possibility of faults due to negligence or bad faith because every step of patent procedure is checked by him, his new assistant and the computer analyst of the office. However, in relation to the facts of the present case, no evidence has been presented to indicate that the system described was in force at the relevant time, or, assuming it was, to explain how it was that the system failed and why the representative neglected to check every step of the patent procedure in this case.

6. In view of the foregoing, the Board is bound to conclude that the evidence submitted in support of the application for re-establishment of rights is insufficient to show that all the due care required by the circumstances had been taken by the Appellant's representative. Consequently, re-establishment of rights in respect of the time limit for paying the fifth year renewal fee is refused.

Order

For these reasons, it is decided that:

The appeal is dismissed.

The Registrar:



M. Beer

The Chairman:



R. Schulte

W. Daniels
17.12.
2397.D JPS.