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**D E C I S I O N**  
**of 17 May 2000**

**Case Number:** J 0007/99 - 3.1.1

**Application Number:** 96305183.4

**Publication Number:** 0918173

**IPC:** F16G 5/16

**Language of the proceedings:** EN

**Title of invention:**  
Heavy-duty power transmission V-belt

**Applicant:**  
BANDO CHEMICAL INDUSTRIES, LIMITED

**Opponent:**  
-

**Headword:**  
Heavy-duty power/BANDO CHEMICAL

**Relevant legal provisions:**  
EPC Art. 60(3), 91(5), 122  
PCT Art. 4(1)(v)  
EPC R. 69(1), 90(1)(c)

**Keyword:**  
"Article 91(5) EPC disproportionate legal consequence (no)"  
"Legal incapacity (no) cause of non-compliance"

**Decisions cited:**  
J xx/xx (OJ 1985, 159), J 0002/86, J 0003/86, J 0009/86, J  
0027/88, J 0027/90, J 0022/97, T 0191/82, T 0287/84, T  
0223/88, T 0026/92, T 0828/94

**Catchword:**  
-



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Boards of Appeal

Chambres de recours

Case Number: J 0007/99 - 3.1.1

**D E C I S I O N**  
**of the Legal Board of Appeal 3.1.1**  
**of 17 May 2000**

**Appellant:** BANDO CHEMICAL INDUSTRIES, LIMITED  
2-15, Meiwa-dori 3-chome  
Hyogo-ku  
Kobe-shi (JP)

**Representative:** Blatchford, Michael  
Withers & Rogers  
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2 Hays Lane  
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**Decision under appeal:** Decision of the Receiving Section of the European  
Patent Office dated 5 October 1998 concerning  
European patent application No. 96 305 183.4  
rejecting a request for re-establishment.

**Composition of the Board:**

**Chairman:** J.-C. Saisset  
**Members:** M. J. Vogel  
B. J. Schachenmann

## Summary of Facts and Submissions

- I. By a communication dated 27 August 1996 the appellant, the proprietor of patent application No. 96 305 183.4 (which claims a priority date of 13 July 1995), was invited by the Receiving Section of the EPO to file the missing designation of inventor within 16 months of the priority date, i.e. by 13 November 1996 at the latest, failing which the application would be deemed withdrawn. On 27 December 1996 the applicant was informed that the application was deemed withdrawn because no designation of inventor had been filed by the due date.
- II. On 15 January 1997 the professional representative of the applicant filed both a request for re-establishment pursuant to Article 122 EPC and the designation of inventor (in fact, there were four co-inventors). He also explained that the reasons for the late filing of the designation would be provided shortly. The fee for re-establishment was paid on 10 January 1997. The statement of the grounds of appeal, however, was not filed until 18 March 1997. On 9 September 1997 the Receiving Section informed the applicant's representative that the request for re-establishment appeared to be inadmissible since the statement of the grounds had been filed too late, i.e. after expiry of the two month time limit under Article 122(2) EPC which had begun on 6 January 1997 when the notification of the communication was, pursuant to Rule 69(1) EPC, deemed to be received. The representative did not comment on this within the two month time limit set by the Receiving Section. On 5 October 1998 the Receiving Section decided, for the reasons given in its communication of 9 September 1997, that the request under Article 122 EPC was inadmissible.

III. On 8 December 1998 the applicant lodged an appeal, paid the appeal fee and requested that the decision of the Receiving Section be set aside and that the request for re-establishment be found admissible and the matter be remitted to the Receiving Section.

In the grounds of appeal, filed on 15 February 1999, the new representative dealing with the case submitted a statutory declaration by the former representative, his partner Mr. X, who was responsible for the case at the material time, and pointed out with reference to this declaration that the proceedings were deemed to have been interrupted under Rule 90(1)(c) EPC in the early months of 1997 as a result of the legal incapacity of his partner and that therefore the application for re-establishment of rights under Article 122 EPC was deemed to have been completed in due time. Mr. X was suffering at the material time from stress caused by bereavement after the unexpected death of his mother. His reactions included lack of energy and loss of both concentration and memory. He did not seek medical help because it would have been wholly out of character for him to do so. Therefore no evidence from a medical practitioner as to his state of mind at the time was available. He referred to the decision of the Legal Board of Appeal dated 1 March 1985 (OJ 1985, 159).

IV. On 16 June 1999 the board issued a preliminary non-binding opinion pointing out in particular that the submissions on the mental reactions to bereavement cannot be considered as reliable evidence as to whether and to what extent Mr. X actually suffered therefrom. Lack of concentration on more complex issues than those indicated in the statutory declaration submitted would not amount to legal incapacity in the sense of Rule 90(1)(c) EPC. Furthermore the declaration left several questions unanswered. Nothing was said about

the period during which Mr. X suffered from depression; obviously he was not completely unable to do his work. Nor did it explain why the statement of grounds was not lodged by one of his colleagues, nor what happened to other cases, nor whether there were other cases of failure to observe time limits in the material period.

V. In response to that communication the appellant's present representative filed a medical opinion from Dr. Y, a consultant psychiatrist, based on a lengthy interview with Mr. X and a certificate confirming the mother's death on 22 December 1996. Answering the questions raised by the board, the appellant pointed out with reference to the medical opinion that not only was Mr. X's ability to concentrate on complex issues affected but also his short term memory and recall. He had therefore become preoccupied to the extent of functioning "automatically" at the material time. That no other deadline had been missed was explained by the fact that "automatic" functioning would apparently have been sufficient to keep most deadlines under control. The fact that no other deadlines were missed did not mean that Mr. X had been in a fit mental state to do the work required of him nor that he necessarily had the capacity to make rational decisions. The psychiatrist's opinion indicated that the opposite was the case for a period of about six months. It was also observed that Mr. X's depressed mental condition would not have been evident to his colleagues, particularly because professional people do not, as a result of their training, show their emotions.

VI. In a further statutory declaration dated 27 April 2000 with three exhibits Mr. X explained how it could happen that his secretary missed the deadline for filing the designation of inventor and that he was emotionally unable at that time to complete the application for restitutio within due time because it was a matter he

associated with a strong personal feeling of guilt as a result of his secretary's error. With the same submission the appellant filed a statutory declaration from one of Mr. X's partners who confirmed the personal circumstances of his colleague when his mother died and said that, due to the architecture of the old building housing the firm's offices, everyone worked behind closed fire doors separated from the others so that they were not necessarily aware if one partner was experiencing personal or mental problems.

VII. Oral proceedings were held on 17 May 2000, in the course of which the appellant submitted the following requests:

- as main request, that the proceedings in European patent application No 96305183.4 be interrupted under Rule 90(1)(c) EPC from 22 December 1996 up to 18 March 1997 and consequently that the appellant's request for re-establishment of rights under Article 122 EPC be held admissible and allowable;
- as auxiliary request (I), that the applicant's request for re-establishment of rights under Article 122 EPC be held admissible and allowable in any event independent of Rule 90(1)(c) EPC;
- as auxiliary request (II), that the filing of the certified copy of Japanese Application No. 7-176963 of 13 July 1995 from which priority was claimed for European patent application No. 96 305 183.4 be treated as a designation of the inventors for purposes of Article 81 and Rule 17(1) EPC.

VIII. In addition to the written submissions the appellant's representative raised as a preliminary issue the question of proportionality of the legal consequences foreseen by the EPC if inventors have not been designated in time, submitting that the designation of inventors does not form one of the most important parts of a European patent application.

With respect to the main request he explained in detail the circumstances of Mr. X's mother's death, of his bereavement and depression and of his double feelings of guilt over not having been present when his mother died and over the mistake of his secretary. These emotions caused a complete block preventing him from dealing with the particular matter of the request for restitutio in this case when he returned to the office after Christmas 1996.

With regard to the first auxiliary request the appellant's representative pointed out by reference to the case law of the Boards of Appeal that, while in many cases the date of removal of non-compliance under Article 122(2) EPC may be the receipt of the notification this is not always the case. The Rule 69 EPC notification would only prima facie be the date of removal, i.e. in the absence of circumstances to the contrary. Consequently consideration of individual circumstances was not excluded. In the present case it would be impossible not to consider the individual circumstances of Mr. X's failure to meet the deadline. The date of removal under Article 122(2) EPC should be taken as 18 March 1997, when Mr. X overcame his mental block and filed the statement of grounds of the request for restitutio.

Concerning the allowability of the request he referred to the earlier submissions and Mr. X's statutory declaration, stating that the failure to file the

designation of inventors represented an isolated procedural mistake by his secretary who had worked for him reliably for 15 years and that the computerised monitoring back-up systems worked satisfactorily. With respect to the second auxiliary request for restitutio, the appellant's representative argued that the inventors had been already designated in the priority document. This could be considered as the designation of inventors under the EPC.

### **Reasons for the Decision**

1. The appeal is admissible.
2. The board does not agree with the appellant's opinion that loss of rights under Article 91(5) EPC as a result of the omission to designate the inventor would be a disproportionate legal consequence. On the contrary the severe legal consequence of Article 91(5) EPC is justified by the fact that the right to be designated as the inventor in accordance with Article 81 EPC is an important moral right of the inventor as the natural person who has performed the creative act of invention (as opposed to the company or legal person which is usually the applicant).

This is recognised not only by the laws of all EPC Contracting States but the European Patent Convention itself states in Article 60(1) that the right to a European patent shall belong to the inventor or his successor in title. This provision makes it clear that the European patent belongs primarily to the first to invent. Only for the purposes of proceedings before the EPO is the applicant deemed to be entitled to exercise the right to the European patent (Article 60(3) EPC). Even in this case, however, the applicant is not



assumed to be the inventor but only to be entitled to the European patent, whereas the inventor himself retains the right to be designated as such.

Thus, having regard to this underlying principle of the EPC, and moreover of the PCT (Article 4(1)(v)), the board cannot share the view of the appellant that Article 91(5) EPC imposes a disproportionate legal consequence in the event of an omission to file the designation of inventor.

3. Moreover the board is not convinced that, as submitted by the appellant, in this case the proceedings have been interrupted because of legal incapacity of the former representative pursuant to Rule 90(1)(c) EPC (main request). In its grounds of appeal the appellant refers to the decision of the Legal Board of 1 March 1985 (OJ 185, 159) where it held that legal incapacity in the sense of Rule 90(1)(c) EPC does not strictly cover what is to be understood as legal incapacity under various national laws. On the contrary, since there is a unified European profession of representatives before the European Patent Office it would be justified, as the board pointed out, to consider that there should be a uniform standard for judging legal incapacity, in order to avoid differences in the application of Rule 90(1)(c) EPC depending on the nationality or domicile of the representative (OJ 1985, 163). This uniform standard of legal incapacity has been determined by the board for the purpose of Rule 90(1)(c) EPC taking into consideration the principles recognised in the national laws of the Contracting States. The basic consideration is whether the representative concerned was either in a fit mental state to do the work required of him at the material time or whether he lacked the capacity to make rational decisions.

- 3.1 For the purpose of Rule 90(1)(c) EPC the question can be left open whether, at the material time, the appellant's former representative was or was not completely incapable of making rational decisions in this particular case. As he explained at great length in writing and during the oral proceedings, his mental block was restricted to just this single case in which his secretary failed to observe the time limit pursuant to Article 91(5) EPC and, as a consequence, he himself failed to file the grounds of the request for restitutio in integrum within due time (Article 122(2) EPC). In other cases he worked, as he pointed out, "automatically" so that no other failure to meet time limits or other mistakes occurred.
- 3.2 This is, however, not "legal incapacity" as it is understood for the purpose of Rule 90(1)(c) EPC. Legal incapacity pursuant to this rule means a mental state in which the representative is so totally or nearly totally unable to take rational decisions that all his professional duties, and not just one isolated case, are affected by his mental state. It would be highly unreliable to assess a representative's legal capacity or incapacity by reference to only one case. Furthermore that approach would beg the question whether legal incapacity as regards one single case could or did affect other cases dealt with by the representative in question.
- 3.3 Thus the board cannot find that the appellant's former representative was legally incapable of dealing with the application at the material time and holds that the main request must be refused.

4. *Admissibility of the request for restitutio in integrum in accordance with Article 122 EPC*

4.1 Date of removal of cause of non-compliance (Article 122(2) EPC)

The second instance heard in greater detail than the Receiving Section of the circumstances under which the former representative of the appellant failed to file the grounds of the request for re-establishment before 18 March 1997. On the basis of these new facts and submissions, the board finds that the date of removal of the cause of non-compliance pursuant to Article 122(2) EPC was 18 March 1997 when the representative Mr. X overcame his mental block in dealing with the present case.

4.1.1 In general the cause of non-compliance is considered to be removed when the person responsible for the application is made aware of the fact that a time limit has not been observed (J 27/88; T 191/82, OJ EPO 1985, 189; T 287/84, OJ EPO 1985, 333; J 27/90, OJ EPO 1993, 422). This - as the Receiving Section pointed out correctly in the contested decision - is usually the date on which the appellant or his representative received the "Noting of loss of rights" communication pursuant to Rule 69(1) EPC (Form 1095), in this case 27 December 1996.

4.1.2 However, this is not always the case. As the Boards of Appeal held in the decisions cited to it, this only applies "in the absence of circumstances to the contrary" (see J 27/90 OJ EPO 1993, 422). Such circumstances to the contrary can be recognised in this case having regard to the new facts submitted at second instance. The facts submitted with the grounds of appeal and additional evidence draw a convincing and credible picture of a disastrous combination of

personal and professional circumstances which, as regards this case only but in this case totally, caused in Mr. X an extraordinary state of mental block and depression which prevented him from registering the non-compliance with the time limit notified on 27 December 1996.

4.1.3 The circumstances were such that in this period the secretary of Mr. X had noted the wrong time limit for the designation of inventor, the consequence of which was that the application would be deemed to be withdrawn. This occurrence, for which Mr. X was responsible, gave rise to a very strong feeling of guilt. The omission to meet the time limit pursuant to Article 91(5) EPC and the subsequent feeling of guilt would not alone mean that the cause of non-compliance continued beyond the notification. However, immediately before he received the notification of loss of rights, his mother died unexpectedly just two days before Christmas.

4.1.4 The present case is not one of a single more or less expected event which a well organised office should be able to accomodate but an unexpected accumulation of unfortunate incidents (the omission of the designation of inventor, his secretary's uncharacteristic lapse, his mother's unexpected death and his absence thereat) which taken together led Mr. X to suffer from a complicated major depressive disorder with cognitive impairment caused by bereavement, guilt feelings and mental overload. As Dr. Y, a highly experienced psychiatric consultant, pointed out in his medical opinion based on a lengthy interview with Mr. X, the depression not only affected his ability to concentrate on more complex issues but also affected his short term memory. He had been able to function "automatically", keep most cases under control, and do routine work. But the emotionally stressful matter concerning the

application for restitutio was embarrassing for him and caused anxiety and feelings of guilt. While this opinion is based on facts reported to Dr. Y by Mr. X two years after the period of depression, the board has no doubt that Mr. X gave him credible information and that an experienced consultant psychiatrist like Dr. Y is in a position to give a reliable opinion on Mr. X's illness at the material time.

4.1.5 This illness had not been obvious to his colleagues and office staff so they had no reason to intervene in the present case. As the psychiatrist Dr. Y and Mr. X both pointed out in their letter and statutory declarations respectively, it was purely internal illness with no external manifestations of distress. The board accepts that professional people, lawyers in particular, are generally well trained not to show their emotions. Moreover Mr. X's partner confirmed in his statutory declaration that he did not notice any sign of abnormal behaviour which might suggest incapacity when his mother died and added that the office arrangements were such that the other partners would not necessarily be aware if one partner was experiencing problems.

4.1.6 Consequently the board holds that the cause of non-compliance pursuant to Article 122(2) EPC was only removed when Mr. X was sufficiently recovered to file the grounds on which the application for restitution is based. That was on 18 March 1997. Thus the request for restitutio in integrum is admissible.

4.2 All due care under Article 122(1) EPC

4.2.1 The established case law of the Boards of Appeal shows 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 2/86 and J 3/86 OJ 1987, 362). Whether or not a request for restitutio in integrum can be allowed, however, depends on whether or not an appellant can show that all due care required in the circumstances of a particular case has in fact been taken to comply with the time limit.

In the case law of the Boards of Appeal relating to the concept of "all due care" it has been accepted that secretaries and patent assistants, and even patent attorneys, are not perfect and that human errors can occur. As a counterbalance, however, the case law requires that office systems should also make appropriate provision for the occurrence of human errors and provide sufficient checks for their detection (J 22/97, 2.1).

- 4.2.2 In the office of Mr. X a normally effective computerised monitoring system was in use in which all time limits were entered, as was explained during the oral proceedings. This computerised system produced a diary sheet for the secretary a month in advance showing all the representative's pending deadlines. These were additionally entered by hand on the front of each file. Such a double reminder system incorporates an effective cross-check mechanism of both the computerised and manual system and can therefore be considered as normally satisfactory as other such systems considered by the Boards of Appeal in several decisions in this area (J 9/86; T 223/88; T 26/92; T 828/94). The board is of the opinion that the office systems in this case were as satisfactory as the systems in those earlier cases.

4.2.3 Further the board finds that in the present case the omission of the designation of the inventor was an isolated mistake within a normally satisfactory system. As Mr. X pointed out in his written evidence and during the oral proceedings, his secretary Ms. S. had been employed in his office as his personal assistant for more than 15 years, and was a very reliable person and trusted employee. During the long period she worked for him no mistake similar to the present one had occurred. Her work did not involve any foreseeable risk, but concerned routine work which could usually be safely delegated to her. There was no reason not to rely on her in her normal work consisting inter alia in the monitoring of time limits. This is why Mr. X could not give any explanation why she omitted to submit the designation of inventor in due time. It was only afterwards that he found Ms. S. had erroneously marked on the front of the file that the term for filing the statement of inventorship would expire on 13 January 1997, instead of 13 November 1996 as had been entered correctly in the computerised monitoring system. He was unable to explain why Ms. S. did not notice that one of the time limits was differently noted in the computer system and on the front of the file. In the view of the board these are typical circumstances justifying, in the case of an isolated mistake a finding that the requirement of "all due care" pursuant to Article 122(1) EPC has been satisfied.

5. Since the time limit was missed in spite of all due care required in the circumstances being taken and the omitted act was completed within the time limit, the appealed decision is to be set aside and restitutio in integrum under Article 122 EPC is to be granted according auxiliary request (I).

## **Order**

### **For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The appellant is re-established in his rights.

The Registrar:

The Chairman:

M. Beer

J.-C. Saisset