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**D E C I S I O N**  
of 1 Oktober 2002

**Case Number:** J 0018/99 - 3.1.1

**Application Number:** -

**Publication Number:** -

**IPC:** -

**Language of the proceedings:** EN

**Title of invention:**

-

**Appellant:**

Garcia Cabrerizo, Pedro

**Opponent:**

-

**Headword:**

Representation under Article 134(7) EPC

**Relevant legal provisions:**

EPC Art. 131, 134, 177(1)

EPC R. 97(1)

**Keyword:**

"Entitlement to undertake representation"

"Legal practitioner qualified in a contracting State (Spain)"

**Decisions cited:**

J 0027/95, T 0019/90, T 0302/93

**Catchword:**

-



Europäisches  
Patentamt

European  
Patent Office

Office européen  
des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number: J 0018/99

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.1  
of 1 October 2002

**Appellant:** Carcia Cabrerizo, Pedro

**Representative:** -

**Decision under appeal:** Decision of the Legal Division of the European Patent Office dated 16 April 1999 refusing the request to be registered as a legal practitioner entitled to undertake representation before the European Patent Office in accordance with Article 134(7) EPC.

**Composition of the Board:**

**Chairman:** J.-C. Saisset  
**Members:** B. Schachenmann  
V. Di Cerbo

## Summary of Facts and Submissions

- I. This is an appeal from the decision of the Legal Division of the European Patent Office of 16 April 1999 rejecting the appellant's request to be registered as a legal practitioner entitled to undertake representation before the European Patent Office in accordance with Article 134(7) EPC.
- II. In the proceedings before the Legal Division the appellant maintained that he was a member of the Bar Association in Madrid (i.e. a Spanish *abogado*) and was also admitted to act as *Agente de la Propiedad Industrial* before the Spanish Patent and Trademark Office. In his opinion these qualifications fulfilled the requirements of Article 134(7) EPC with the consequence that he was entitled, as a legal practitioner in Spain, to undertake representation in proceedings before the European Patent Office.
- III. In the decision under appeal the Legal Division confirmed its constant practice according to which Article 134(7) EPC only applied to legal practitioners entitled to act as representatives before their national patent offices by virtue of the exercise of the profession of legal practitioner "as such" without any other qualification. However, since in Spain legal practitioners (*abogados*) were not entitled "as such" to act as representatives in patent matters, Article 134(7) EPC did not apply to them.
- IV. In the statement setting out the grounds of appeal the appellant contested the restrictive interpretation of Article 134(7) EPC by the Legal Division. In his view this provision only required that a legal practitioner qualified and having his place of business in a

Contracting State was entitled to act as a professional representative in patent matters in that State as a pre-condition for his entitlement to undertake representation in proceedings before the EPO.

In addition, the appellant pointed to Title III of the Spanish Law 30/1992 of 26 November, on Administrative Procedure (Ley de Régimen Jurídico de las Administraciones Públicas y del Procedimiento Administrativo Común - LRJ-PAC) which entered into force on 28 April 1994. According to Article 32 LRJ-PAC referring to "representation" any person with legal capacity was entitled to act as another person's representative before the Public Administrations in Spain including the Spanish Patent and Trademark Office. Since these provisions had come into force, legal practitioners in Spain were entitled to act in patent matters before the Spanish Patent and Trademark Office as any other person with legal capacity. For this reason legal practitioners qualified in Spain complied with the requirements of Article 134(7) EPC.

- V. With letter dated 11 October 2001 the Legal Board of Appeal, based on Article 131(1) and Rule 97(1) EPC, asked the Spanish Patent and Trademark Office (*Oficina Española de Patentes y Marcas*) for information on the provisions concerning representation before it, in particular the Law on Administrative Procedure referred to by the appellant.
- VI. The comments of the Director General of the Spanish Patent and Trademark Office in reply to this request may be summarized as follows:
- According to Article 155 of the Spanish Law on Patents in combination with Article 32 of Law 30/1992 of 26 November, on Administrative Procedure (LRJ-PAC) interested parties may act

before the Spanish Patent and Trademark Office on their own behalf or through any person (including Spanish *abogados*) who only needs to be authorised by the represented party.

- If an application is filed at the Spanish Patent and Trademark Office by a person acting as representative of an interested party, an explicit authorisation enabling this person to act on behalf of the party making authorisation is required. If such authorisation is not filed in due time, the application will be rejected.
- Albeit any person authorized by an interested party may represent this party before the Spanish Patent and Trademark Office, not anybody can undertake professional representation as an *Agente de la Propriedad Industrial* unless he or she appears on a special Register of Industrial Property Agents.
- In order to be entered on the special Register of Industrial Property Agents a qualifying examination has to be passed in accordance with Article 157 of the Spanish Law on Patents as amended by Law 21/1992 of 16 July, of Industry.
- Hence, Spanish *abogados* may act before the Spanish Patent and Trademark Office on behalf of their clients as simple representatives but may not as such undertake professional representation as *Agentes de la Propriedad Industrial*.

VII. The comments of the President of the Spanish Patent Office referred to above were communicated to the appellant with an invitation to file observations. In his reply of 15 March 2002, the appellant underlined that these comments confirmed his position according to

which Spanish lawyers could, as anybody else, act as representatives of their clients before the Spanish Patent and Trademark Office without being registered as *Agente de la Propriedad Industrial*, if they did not undertake such representation in the capacity of Industrial Property Agents. Only if somebody intended to undertake representation in Spain as an *Agente de la Propriedad Industrial*, he or she would have to be entered on the special Register of Industrial Property Agents.

### **Reasons for the Decision**

#### 1. *Admissibility of the appeal*

The main issue at stake is whether or not the appellant, a legal practitioner (*abogado*) qualified in Spain and having his place of business in Spain, is entitled under Article 134(7) EPC to undertake professional representation of third parties in proceedings before the European Patent Office. A further issue concerns the registration of the appellant as a legal practitioner under Article 134(7) EPC.

As far as the finding of the first instance concerns the rejection of the appellant's request for registration as legal practitioner in accordance with Article 134(7) EPC, it is questionable whether the appellant was adversely affected (see point 5.3, below). However, the decision under appeal is not limited to this formal issue but denies the right of the appellant to act as a representative under

Article 134(7) EPC in general. For this reason the appellant is adversely affected by the decision under appeal. The appeal therefore complies with Articles 106 to 108 and Rules 1(1) and 64b) EPC and is admissible.

2. *Interpretation of Article 134(7) EPC*

2.1 Article 134(7) EPC, in its English version, refers to "professional representation" that may be undertaken by any legal practitioner to the extent that he is entitled "to act as professional representative in patent matters" within his State (emphasis added). This raises the question whether, in Article 134(7) EPC, it is an additional requirement that legal practitioners must be entitled under their national law to act as representatives in patent matters on a professional basis.

2.2 For the understanding of Article 134(7) EPC it is important to note that the term "professional" is not used in the German and French texts. Since according to Article 177(1) EPC the English, French and German texts of the Convention are equally authentic, a common meaning has therefore to be found through interpretation (T 19/90, OJ EPO 1990, 476, point 4.3 of the reasons; T 302/93 of 7 May 1995).

2.3 The English version of Article 134 EPC uses the term "professional representative" in several contexts.

In paragraphs 1 to 5 of Article 134 EPC, it corresponds to the German and French term "zugelassener Vertreter" and "mandataire agréé", respectively, referring to those persons whose names appear on the list pursuant to Article 134(1) EPC. Whereas in earlier drafts of the Convention the German and French texts also contained the terms "berufsmässiger Vertreter" and "mandataire

professionel", the final texts use the expressions "zugelassener Vertreter" and "mandataire agréé". The reason for that was the agreement of the Contracting States that reference should only be made to the qualifications required for the exercise of the function in question, without suggesting that these functions had to be exercised on a "professional", i.e. continuous and permanent basis (see *travaux préparatoires*, doc. BR/219/72, N. 133, p. 18; *Bernecker*, *Münchener Gemeinschaftskommentar*, Art.163, N.24).

In a different way the term "professional representative" is used in the expression "to act as a professional representative in patent matters" at the end of Article 134(7) EPC. The German and French equivalents read: "die Vertretung auf dem Gebiet des Patentwesens ausüben" and "agir ... en qualité de mandataire en matière de brevets d'invention", respectively. Reference is made here to the entitlement of legal practitioners to represent clients in patent matters within their national legal systems. However, also in this context the term "professional" was deliberately avoided in the German and French versions. No requirement can therefore be derived from Article 134(7) EPC that legal practitioners need to be entitled within their State to exercise representation in patent matters on a "professional", i.e. continuous and permanent basis.

- 2.4 From the above the Board concludes that it is only significant for the application of Article 134(7) EPC that a legal practitioner qualified in a Contracting State is - as such - entitled, within that State, to act as representative in patent matters. The EPC does not distinguish for this purpose between entitlement to act as "simple" representative or to act as "professional" representative of clients.



3. *National provisions concerning representation before the Spanish Patent and Trademark Office*

The appellant, a person qualified as an *abogado* having his place of business in Spain, invoked the national provisions governing representation of interested parties before the Spanish Patent and Trademark Office, in particular Article 32 of Law 30/1992 of 26 November, on Administrative Procedure (LRJ-PAC) according to which any person with legal capacity is entitled to act as another person's representative before the Public Administrations in Spain. In the proceedings before the first instance the appellant had not referred to this provision which therefore was not considered by the Legal Division.

- 3.1 In order to be able to assess the legal consequences of the national provisions referred to above for the present case the Legal Board of Appeal has asked the Spanish Patent and Trademark Office for information (point V., supra). The observations of the Director General of the Spanish Patent and Trademark Office (point VI., supra) appear to confirm the appellant's submissions insofar as Article 32 of Law 30/1992 of 26 November, on Administrative Procedure (LRJ-PAC) is indeed applicable in the proceedings before the Spanish Patent and Trademark Office with the consequence that any person, including Spanish *abogados*, authorized by a party is entitled represent this party before the Spanish Patent and Trademark Office. Only for undertaking professional representation as an *Agente de la Propriedad Industrial*, it would be necessary to appear on the special Register of Industrial Property Agents.

3.2 The same conclusion was drawn by the Office for Harmonization in the Internal Market (OHIM) for the purposes of the application of Article 89(1)(a) of the Council Regulation (EC) No 40/94 on the Community Trademark which provision substantially corresponds to Article 134(7) EPC. In point 1 of his Communication No 2/96 of 22 March 1996 the President of the OHIM stated that the Spanish authorities had informed the OHIM "that, under strict interpretation of the Spanish law, lawyers are entitled to represent their clients professionally before the Oficina Española de Patentes y Marcas. Consequently, Spanish lawyers ('abogados') are now also entitled to represent natural and legal persons before this Office".

3.3 From the information referred to above the Board concludes that under the present Spanish law any legal practitioner qualified in Spain and having his place of business in Spain is entitled (as anybody else) to represent clients before the Spanish Patent and Trademark Office in patent matters if he presents an authorisation from the party.

4. *Conclusions concerning the applicability of Article 134(7) EPC to Spanish legal practitioners*

According to the conclusions of the Board in point 3, supra, legal practitioners qualified in Spain and having a place of business in Spain are - as such and as anybody else with legal capacity - entitled within Spain to undertake representation of clients in patent matters as simple representatives. The only requirement for them is the filing of an authorisation of the represented party. Since for the purposes of Article 134(7) EPC no distinction is to be made between entitlement to act as "simple" representative and entitlement to act as "professional" representative (see point 2.4, supra), Spanish legal practitioners

appear to meet the conditions of Article 134(7) EPC and are therefore entitled to undertake representation in proceedings established by the EPC to the same extent as before the Spanish Patent and Trademark Office.

5. *Registration under Article 134(7) EPC*

5.1 The appellant requested to be registered as a legal practitioner entitled to act in proceedings established by the EPC in accordance with Article 134(7) EPC. This request was rejected by the Legal Division of the EPO on the ground that he did not comply with all requirements of Article 134(7) EPC. For the reasons set out above the Legal Board of Appeal disagrees with that conclusion (see point 4, supra). The decision under appeal is therefore to be set aside.

5.2 The requested registration under Article 134(7) EPC has to be distinguished from the entering of a person on the list of professional representatives under Article 134(1) EPC. Whereas the latter is constitutive for the right to undertake representation in proceedings established by the EPC, registration under Article 134(7) EPC merely serves the administrative purpose of avoiding repeated examination of the requirements to be met by legal practitioners under this provision. A legal basis for such registration can be seen in point 1.1(c) of the decision of the President of the EPO dated 10 March 1989 concerning the responsibilities of the Legal Division (OJ EPO 1989, 177) according to which the latter is responsible for registration and deletion of legal practitioners under Article 134(7) EPC.

According to the practice of the Legal Division of the EPO (as described in decision J 27/95 of the Legal Board of Appeal) legal practitioners are registered under Article 134(7) EPC only if they have filed a signed authorisation by a party. This practice appears to be justified since legal practitioners entitled to act as representatives under Article 134(7) EPC must file, according Article 2 of the decision of the President of the EPO dated 19 July 1991 (OJ EPO 1991, 489), a signed authorisation or a reference to a general authorisation already on file. Thus, there is neither a right nor a legal interest for a legal practitioner to be registered under Article 134(7) EPC without filing a signed authorisation.

- 5.3 The appellant generally requested registration as a legal practitioner entitled to act in proceedings established by the EPC in accordance with Article 134(7) EPC without filing a signed authorisation of a party to this effect. In these circumstances the Board, following the practice of the Legal Division, needs not decide on the requested registration. Thereby the appellant is not adversely affected since, for the reasons set out above, the requested registration does not confer any right on him and he can renew his request as soon as he is authorised by a party to undertake representation before the EPO. In such case the Legal Division is ordered to decide along the lines indicated above.

**Order**

**For this reason it is decided:**

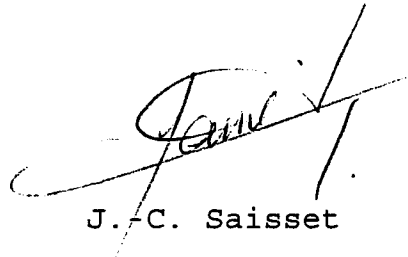
1. The decision under appeal is set aside.
  
2. The case is remitted to the Legal Division with the order to register the appellant as legal practitioner entitled to act as representative in proceedings before the EPO under Article 134(7) EPC subject to the proviso that:
  - he files a signed authorisation enabling him to act for the party making authorisation in proceedings before the EPO.

The Registrar:



S. Fabiani

The Chairman:



J.-C. Saisset

B&Ch.

