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D E C I S I O N
of 24 February 2005

Case Number: T 0541/04 - 3.2.2

Application Number: 97919931.2

Publication Number: 0921781

IPC: A61G 17/06

Language of the proceedings: EN

Title of invention:

Odor-proof sealable container for bodily remains

Applicant:

McWilliams, Edward L.

Opponent:

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Headword:

-

Relevant legal provisions:

EPC Art. 122

Keyword:

"Restitutio in integrum - all due care (no)"

Decisions cited:

J 0002/86, J 0003/86, J 0003/88, J 0027/88, J 0005/94,
J 0025/96

Catchword:

-



Case Number: T 0541/04 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 24 February 2005

Appellant: McWilliams, Edward L.
7931 Canary Way
San Diego, CA 92 123 (US)

Representative: Gray, James
Withers & Rogers
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London SE1 2HW (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 26 November 2003
refusing European application No. 97919931.2
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: T. K. H. Kriner
Members: D. Valle
U. J. Tronser
M. G. Noel
E. J. Dufrasne

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division, dated 26 November 2003, to refuse the European patent application 97 919 931.2 because the examining division held that the appellant's request for re-establishment of rights under Article 122 EPC was to be rejected.

- II. With communication pursuant to Rule 69(1) EPC dated 17 September 2001 the appellant was informed that the European patent application was deemed to be withdrawn under Article 96(3) EPC because the invitation to file observations on the communication from the examining division dated 29 March 2001 had not been complied with.

- III. In reply to this the appellant's European representative faxed a request for re-establishment of rights on 11 March 2002 together with a response to the points raised in the examining division's communication dated 29 March 2001 and paid the fee prescribed by Article 122(3) EPC. The request was substantiated as follows: Upon receipt of the official letter dated 29 March 2001 by the European patent attorney, this was reported to the US patent attorney representing the (US American) applicant. At this time there also existed a co-pending US patent application for the same invention. At about the same time as the issuance of the examining division's official letter, the US patent office issued an official letter on the US patent application. Both official letters were reported to the applicant by the US patent attorney and his instructions sought. The applicant subsequently

instructed the US patent attorney that he no longer wished to proceed with the US patent application. The US patent attorney misinterpreted these instructions and believed that the applicant wished to discontinue with both the US patent application and the European patent application. For this reason the European patent attorney did not receive instructions from the US patent attorney to respond to the examining division's communication dated 29 March 2001.

IV. With communication dated 14 August 2002 the examining division informed the appellant that it intended to refuse the request, the prescribed time limit of two months (Article 122(2) first sentence EPC) for answering the communication not having been observed. The noting of loss of rights under Rule 69(1) EPC, dated 17 September 2001, had been faxed on 11 March 2002.

V. On 17 December 2002 the European patent attorney filed a reply including further arguments and a sworn statement made by the appellant himself.

His arguments were as follows: As could be seen from the statement of the appellant, he instructed the US patent attorney in June 2001 by letter that he wished to proceed with his European patent application. During a subsequent telephone conference shortly thereafter, a misinterpretation of the appellant's instructions occurred whereby the US patent attorney understood that the appellant did not wish to proceed further with his European patent application. When the Rule 69(1) EPC communication dated 17 September 2001 was forwarded to the US patent attorney, he could not have realised that

a time limit had been missed, as he was under the impression at that time that the application was to be abandoned. That the European patent application had lapsed because a time limit had been missed contrary to the appellant's instructions did not come to light until the end of February 2002 when the appellant contacted the US patent attorney and enquired as to the status of the European patent application. Thus the request under Article 122 EPC was admissible.

VI. On 13 January 2003 the European patent attorney filed a further statement made by the US patent attorney supplementing the facts submitted in the statement made by the appellant.

VII. The appealed decision of the examining division, enlarged by the addition of a legally qualified member, is based on the finding, that though the request for re-establishment of rights is admissible, because the cause of non-compliance with the time limit was removed in February 2002, it could not be allowed because the US patent attorney, as the person responsible for the application did not act with all due care required by the circumstances. Since the appellant had sent a letter to the US patent attorney prior to the telephone conference unequivocally indicating that he did indeed wish to proceed with the European patent application, the US patent attorney should have taken all necessary measures to ascertain what his client's wishes were instead of assuming that the telephoned instructions were meant to supersede the previous instructions sent by letter. The examining division held that due care would have required that the US patent attorney had tried to clarify the contradictory situation, be it by

asking the client during the telephone conversation for written confirmation, by subsequent letter or by taking some other measure to obtain clear instructions. In view of the appellant's sworn statement, the examining division considered it to be highly implausible that the appellant's instructions could have been misunderstood, bearing in mind that he observed that when he heard about the lapse of the European patent application he was extremely surprised and expressed his concern calling attention to his letter of June 2001.

VIII. In its statement of grounds of appeal the appellant added to its submissions before the first instance essentially as follows: The general "due care" standard of the professional was that a practitioner may reasonably rely on regular instructions given by a client when those instructions are consistent with normal practice and prosecution of patent matters and with past procedures with the particular client, as was the case with that client. The "due care" standard required the practitioner to act on instructions without delay. An instruction in writing could be and often was subsequently reversed by a contrary oral instruction. There is no hierarchy in the form in which instructions take. During the telephone conversation between the appellant and its US patent attorney, it was the attorney's recollection that the appellant did not wish to spend more money on patent applications. It was the US patent attorney's belief that the appellant did not differentiate between the two applications during the telephone conference. One of the most prevalent reasons not to proceed with a particular patent matter was the magnitude of the costs involved.

Therefore the US patent attorney found no contradiction in his client's instructions sent by letter in June 2001 and mentioned during the telephone conversation. Furthermore there was no indication that the instruction was in an unclear form which called for further clarification.

IX. Oral proceedings were held on 24 February 2005.

X. The appellant requested essentially:

The decision under appeal be set aside.

The request for re-establishment of the right to file observations to the communication dated 29 March 2001 be allowed with the consequence of reinstatement of the application.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. The request for re-establishment of the right to file observations to the communication of the examining division pursuant Article 96(2) EPC dated 29 March 2001 is admissible too, since the requirements of Article 122(2) and (3) EPC are complied with.
 - 2.1 In particular the examining division in its decision under appeal correctly found that the two months time limit under Article 122(2) first sentence EPC was met. Though the request for re-establishment was filed on

11 March 2002, i.e. about half a year after receipt of the communication under Rule 69(1) EPC dated 17 September 2001, this communication could not lead to removal of the cause of non-compliance with the time limit under Article 96(1) EPC, since this information concerning a loss of rights was fully consistent with the misunderstanding that occurred during the telephone conversation between the US patent attorney and the appellant. The error with respect to the appellant's instructions pertaining to its European patent application did not come to light until the end of February 2002 when he contacted the US patent attorney in order to ask about the status of this application. In consequence the appellant could not recover its failure to comply with the time limit under Article 96(1) EPC until that time.

- 2.2 Furthermore the grounds on which the request for re-establishment is based have been filed within the two months time limit under Article 122(2) first sentence EPC too.

Although the appellant in its request faxed on 11 March 2002 only submitted that the US patent attorney had misinterpreted the instructions as to the European patent application without specifying this submission with any additional facts it was admissible to complete the original submission later by adding facts contained in the letter dated 17 December 2002, i.e. after expiry of the two months time limit. These facts substantiating the instructions sent with the appellant's letter of June 2001 and the circumstances during the subsequent telephone conversation with its US patent attorney were only for completeness and did

not change the basis of the original submissions (see J 5/94 point 2.3, not published).

3. The Board is however not convinced that the US patent attorney, whose conduct is relevant for a consideration of the case (see J 3/88; J 27/88; J 25/96; not published), acted with all due care required by the circumstances.

3.1 The cause of non-compliance with the time limit for filing observations on the examining division's communication dated 29 March 2001 was based on a misunderstanding on the part of this attorney concerning the appellant's instructions during the telephone conversation subsequent to the letter of instruction dated June 2001. A crucial point for deciding on the merits of this appeal is assessing whether this misinterpretation amounted to not exercising all due care required by the circumstances.

3.2 The examining division's argumentation in the decision under appeal is not accurate when considering whether or not the conduct of the US patent attorney following this misunderstanding amounted to the exercise of "all due care". Once such a misunderstanding occurred the US patent attorney was prevented from realising that there was a contradiction between the instructions received in the letter of June 2001 and those received during the telephone conversation. Furthermore a hierarchy between written instructions and oral instructions cannot be justified in this case. The European Patent Office has to accept particularly that it was a usual practice between the US patent attorney and the appellant that an instruction in

writing could be and often was subsequently reversed by a contrary oral instruction. The Board cannot see any reason to doubt the representative's submissions in this respect.

3.3 The consequence of the misinterpretation at issue was that the US patent attorney believed that the appellant did not want to proceed with both its US patent application and the European patent application, whilst in fact the appellant actually did not wish to abandon the latter.

3.4 With regard to the contents of the telephone conversation the US patent attorney submitted that the appellant told him that he did not wish to spend any more money on patent applications and the attorney added during the oral proceedings before the Board, that his client made a complaint that the "foreign" cases cost him too much money and thus should be abandoned. In the Board's opinion the US patent attorney however should with normal caution have asked for detailed instructions with regard to the several patent applications at stake. Even if US patent applications are very easy to get re-instated - as the US patent attorney submitted during the oral proceedings - in the Board's view it was not appropriate to act in the same manner with regard to cases in other countries where the US patent attorney's firm was acting. The US patent attorney should have had taken into consideration that foreign patent offices may make higher demands concerning re-instatement than the US patent office.

- 3.5 Thus the misinterpretation surrounding the US patent attorney's belief that his client did not wish to respond to the examining division's communication, leading to missing the time limit for filing observations, was not the result of exceptional circumstances (See for instance J 2/86 and J 3/86, OJ 1987, 362).
4. It follows that the appeal must be dismissed. As a consequence the proceedings were closed with legal effect as of 10 August 2001 and any renewal fees paid thereafter must be refunded.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

V. Commare

T. Kriner