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**Datasheet for the decision
of 9 November 2006**

Case Number: T 0968/05 - 3.3.02

Application Number: 98956348.1

Publication Number: 1124581

IPC: A61K 47/10

Language of the proceedings: EN

Title of invention:

Transdermal delivery of medications using a combination of penetration enhancers

Applicant:

Trans-Pharma Corporation

Opponent:

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Headword:

Re-establishment of rights

Relevant legal provisions:

EPC Art. 108, 122

EPC R. 65(1), 78(2)

Keyword:

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Decisions cited:

J 0005/80

Catchword:

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Case Number: T 0968/05 - 3.3.02

D E C I S I O N
of the Technical Board of Appeal 3.3.02
of 9 November 2006

Appellant: Trans-Pharma Corporation
2503 Terella Place
Escondido, CA 92025 (US)

Representative: Otten, Hajo
Witte, Weller & Partner
Patentanwälte
Fürststraße 13
D-72072 Tübingen (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 3 March 2005
refusing European application No. 98956348.1
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: U. Oswald
Members: G. Rampold
P. Mühlens

Summary of Facts and Submissions

I. The appeal lies against the decision of the examining division to refuse European patent application No. 98 956 348.1 dated 3 March 2005 and posted on the same date. The decision was sent to the then European representatives of the applicant (assignee) Withers & Rogers in London.

II. With letter dated 14 March 2005, Dr David Elsy of Withers & Rogers sent the decision to the then US-representative of the appellant James W. McClain of Gordon & Rees LLP in San Diego, CA. The relevant passages in Dr Elsy's letter read as follows (with emphasis from the attorney):

"Please find enclosed a Decision from the European patent office dated 3 March 2005. The application has been rejected. Please note that this Decision is open to Appeal. An Appeal fee would need to be filed by **3 May 2005**. This deadline is not extendible. Additionally, Grounds for Appeal would need to be filed by **3 July 2005**. Again, this deadline is not extendible. In the absence of your instructions to the contrary, I will not file an Appeal".

This letter arrived at the office of Mr McClain on 18 March 2005. The Chairman of the applicant, Mr Dubrulle, had already instructed Mr McClain not to abandon the application.

III. By letter dated 23 April 2005, appellant's Chairman Mr Dubrulle instructed Gordon & Rees to transfer the file to the law firm Wilson Sonsini in San Diego, CA.

The file reached Wilson Sonsini on 5 May 2005 and was together with other files of the applicant inventoried, reviewed and processed by Wilson Sonsini secretary. On 19 May 2005, Wilson Sonsini's attorney Peter Munson wrote to Dr David Elsy asking whether an appeal would be still possible.

- IV. By letters dated 7 and 8 July 2005, which arrived at the EPO on 8 July 2005, the applicant filed an Appeal, paid the appeal fee, requested re-establishment of rights under Article 122 EPC into the deadline for filing a Notice of Appeal against the decision of 3 March 2005 and paid the respective fee.
- V. In support of its request for re-establishment of rights, the applicant submitted that the time limit had been missed as a result of several adverse circumstances, although all procedures the file had to undergo in the respective attorney's offices had functioned properly.
- Among these adverse circumstances were the retirement of the former representative McClain who left Gordon & Rees in March 2005, the conversion of the IP files to a new docketing system at Gordon & Rees and the transfer of the applicant's IP files to Wilson Sonsini on instruction of the applicant. In any event, the time limit for filing the appeal - 3 May 2005 according to Dr Elsy's letter was not docketed in the registers of Gordon & Rees. On the other hand, the registers contain the time limit for filing the Grounds of Appeal (3 July 2005), again according to Dr Elsy's letter. The responsible docketing clerk Patricia Newton cannot give an explanation of how this could happen.

The applicant further submits that Patricia Newton was a very attentive and well educated clerk with considerable experience in docketing matters. There had never been docketing problems caused by her although she had docketed in the order of 10.000 various docketing events in the preceding five years. In addition to that, there had been no docketing problems caused by the conversion of the files to a new docketing system either. As a consequence, all due care had been taken at the office of Gordon & Rees in handling the file.

VI. The same applies after the transfer of the file to Wilson Sonsini. There, the secretary Misty Elam reviewed all transferred files after arrival on 5 May 2005 and came to the conclusion that the time limit for filing an appeal had been missed anyway. Seeing no reasons to depart from standard procedure at Wilson Sonsini, the file was sent to the docketing desk in the Palo Alto office of Wilson Sonsini and brought to the attention of attorney Peter Munson only after that occurrence. Peter Munson took immediate action and wrote to Dr Elsy (letter of 19 May 2005, see III above) Thus, the file had again be handled with all due care.

VII. On 19 January 2006, the Board issued a communication where it expressed its doubts whether re-establishment could be granted.

Oral proceedings before the Board were held on 9 November 2006.

VIII. At the oral proceedings the representative of the applicant pointed out that the Wilson Sonsini secretary

Misty Elam was not responsible for docketing events, as this was the task of the Palo Alto Office. When reviewing the files transferred from Gordon Rees, she reviewed only the file wrappers and not, as it might appear from her declaration dated 5 July 2005, the files. Contrary to that declaration, she had not noticed the correspondence indicating the due date of 3 May 2005 when Wilson Sonsini received the file but only when preparing the earlier declaration, i.e. in July 2005.

To support its submissions, the representative of the appellant filed at the oral proceedings a new declaration of Misty Elam dated 8 November 2006. It offered further submissions in that respect, if necessary.

- IX. The appellant requested re-establishment into the time limit for filing the appeal and, as an auxiliary request, that the proceedings be continued in writing.

Reasons for the Decision

1. The appealed decision was posted on 3 March 2005. According to Rule 78(2) EPC, the two-months time limit for filing an appeal (Article 108 EPC) started on the tenth day following the posting, i.e. 13 March 2005, and ended on 13 May 2005. Consequently, when the file reached the Wilson Sonsini office on 5 May 2005, there were still 8 days left to file an appeal in due time. The appeal was however only filed on 8 July 2005.

2. The appellant requests re-establishment into the time limit for filing the appeal. All formal requirements under Article 122(2) and (3) EPC are met. The request for re-establishment is therefore admissible.

3. Under Article 122(1) EPC, an applicant shall have its rights re-established if it was, in spite of all due care having been taken, unable to observe a time limit. In the present case, in the absence of any other explanation, one or several mistakes in the attorney's offices must have led to the late filing of the appeal. This follows from the fact that the state of the case was clear as well as the state of the file, and that, according to the appellant's submissions, no technical problems had occurred. The Board has therefore to analyse whether the all-due-care requirement has been respected.

4. In the office of Gordon & Rees, when docketing the time limits, the alleged due date of 3 May 2005 was not entered into the registers. Under the circumstances, the reason seems to be a mistake by the competent docketing clerk Patty Newton, who cannot, according to her declaration dated 16 May 2006, explain how this could happen.
 - 4.1 There is a body of case law of the Boards of Appeal concerning due care in dealing with assistants of professional representatives (cp. Case Law of the Boards of Appeal of the European Patent Office, "White book", 4th edition 2001, VI. E 5.3.5, starting with J 5/80 (OJ 1981,343). The key ruling of this case law is that if a suitable person is chosen to carry out the task, and if this person is properly instructed and

supervised, he/she can be entrusted with routine tasks, such as docketing time limits. In such a case, the standard of care expected is less strict than it is demanded of the representative himself.

4.2 It follows i. a. from the declaration of the former representative Mr McClain dated 9 October 2006 that the docketing clerk Patty Newton was experienced and well trained, and that in many years of her docketing practice no problems had occurred. The Board therefore holds, in favour of the appellant, that the alleged mistake made by Mrs Newton may not be imputed to the representative, and hence not to the appellant.

5. As the time limit for filing the appeal had not yet expired when the file reached the office of Wilson Sonsini, the all - due - care requirement must be investigated again.

5.1 When a case is transferred to a new professional representative, it is a paramount task to review the file thoroughly and with great care. Otherwise, in merely relying on information given by the former representative, the new representative could not decide on its own what to, and what to do next. Thus, special care has to be given in particular to the monitoring of time limits. Only after having carried out this is the representative able to decide whether normal procedure can be followed, or whether other action is required.

5.2 The first inspection of a new file is therefore a special task and not a routine one. Hence, not all assistants can be entrusted with that kind of work. The representative has to choose a suitable person among

the most experienced clerks with the best skills, who are generally entrusted with tasks beyond mere routine work. As a further consequence of the fact that the first processing of newly transferred files cannot be regarded as a routine work, no lower threshold of care applies if an attorney entrusts this task to an assistant.

5.3 Even if a representative has chosen a suitable person in the above sense for the first review of a transferred file, it is appropriate that this person be closely supervised. Above all, it has to be made perfectly clear to the assistant that he/she has to alert the attorney immediately whenever he/she notes any irregularity in the file, such as an expired time limit. It is then up to the attorney to determine whether the time limit has been actually missed, whether that has any importance for the case and, as the case may be, what remedies are available. All this cannot be decided upon by an assistant. Hence, the assistant's work has to be supervised promptly, at least before sending the file away for several days, by presenting the reviewed file to the attorney.

6.1 In the present case, it was clear from the file that the application had been refused by the European Patent Office, that the applicant had given instruction not to abandon the application, that there were time limits to be observed, and that one of the time limits allegedly had already been missed, as follows from Dr Elsy's letter. This letter could have been easily found in the file - even without checking its content "in depth". In this context, the Board notes that a mere review of the wrappers of the file or of lists with information

coming from the former representative was not sufficient. The fact that the file was nevertheless sent to the docketing office following routine procedures and was only presented to the attorney after having been sent back several days later demonstrates that it had not been handled with "all due care required by the circumstances", be it that the instructions how to handle such cases were not appropriate, or that the clerk acted against normal procedures.

- 6.2 If the file had been reviewed properly, attorney Mr Munson would have had the opportunity to contact immediately his colleague in London in order to find out what could be done after the (alleged) time limit of 3 May 2005 had expired - as he did later by his letter of 19 May 2005. In that case, he would have learned that the due term was actually 13 May 2005 and that it was thus still possible to file an appeal.
7. As the case is clear from the file as it stands and the outcome of the oral proceedings of 9 November 2006, there is no need to continue the proceedings in writing.
8. In summary, the Board finds that the requirements of Article 122 EPC are not met and that the applicant cannot be re-established into the time limit for filing an appeal against the decision dated 3 March 2005. The appeal being late filed, it has to be rejected as inadmissible (Article 108 EPC, Rule 65(1) EPC).

The Registrar:

The Chairman:

A. Townend

U. Oswald

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(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

**Datasheet for the decision
of 23 March 2007**

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Application Number: 98956348.1

Publication Number: 1124581

IPC: A61K 47/10

Language of the proceedings: EN

Title of invention:

Transdermal delivery of medications using a combination of penetration enhancer

Applicant:

Trans-Pharma Corporation

Opponent:

-

Headword:

Correcting errors in decision of 9 November 2006

Relevant legal provisions:

EPC R. 89

Keyword:

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Decisions cited:

-

Catchword:

-



Case Number: T 0968/05 - 3.3.02

D E C I S I O N
of 23 March 2007
correcting errors in the decision
of the Technical Board of Appeal 3.3.02
of 9 November 2006

Appellant: Trans-Pharma Corporation
2503 Terella Place
Escondido
CA 92025 (US)

Representative: Otten, Hajo
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Fürststraße 13
D-72072 Tübingen (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 3 March 2005
refusing European application No. 98956348.1
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: U. Oswald
Members: M. C. Ortega-Plaza
P. Mühlens

Pursuant to Rule 89 EPC, obvious mistakes in the written decision dated 9 November 2006 in appeal case T 0968/05 are hereby corrected.

Following the last paragraph

"In summary, the Board finds that the requirements of Article 122 EPC are not met and that the applicant cannot be re-established into the time limit for filing an appeal against the decision dated 3 March 2005. The appeal being late filed, it has to be rejected as inadmissible",

the decision is complemented as follows:

"Order

For these reasons it is decided that:

1. The request for re-establishment into the time limit for filing an appeal against the decision of the Examining Division dated 3 March 2005 is refused.
2. The appeal is rejected as inadmissible."

The Registrar:

The Chairman:

A. Townend

U. Oswald