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**Datasheet for the decision
of 7 May 2008**

Case Number: T 1095/06 - 3.3.07

Application Number: 00974679.3

Publication Number: 1230020

IPC: B01J 20/10

Language of the proceedings: EN

Title of invention:
Silicate/aluminate materials

Applicants:
University of Greenwich

Opponent:
-

Headword:
Re-establishment/GREENWICH

Relevant legal provisions (EPC 1973):
EPC Art. 23, 122, 122(1)(2)(3)(4)
Revision Act 2000, Art. 7
Decision of Administrative Council of 28 June 2001, Art. 1(5)

Keyword:
"Isolated mistake by representative - all due care (no)"
"Special circumstances (no)"
"Re-establishment (no)"

Decisions cited:
J 0005/80, J 0002/86, T 0869/90, T 0473/91, T 0111/92,
T 0971/99

Catchword:
(1) The case law on "an isolated mistake in an otherwise satisfactory system" cannot be relied on to ignore a failure to act by the professional representative himself, unless

there are special circumstances which make the failure to act compatible with taking all due care (see points 5 and 6).

(2) A belief that an action has been performed for which there is no objective basis cannot be given any weight as a circumstance to be taken into account under Article 122(1) EPC (see point 8).

(3) Neither the importance of an application to an applicant, nor the technical merit of the invention concerned, are circumstances that can be taken into account in favour of allowing re-establishment (see point 17).



Case Number: T 1095/06 - 3.3.07

D E C I S I O N
of the Technical Board of Appeal 3.3.07
of 7 May 2008

Appellant: University of Greenwich
30 Park Row
Greenwich
London SE10 9LD (GB)

Representative: Blake, John Henry Francis
Brookes Batchellor
102-108 Clerkenwell Road
London EC1M 5SA (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 10 May 2005
refusing European application No. 00974679.3
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: S. Perryman
Members: B. ter Laan
F. Rousseau

Summary of Facts and Submissions

- I. European patent application 00 974 679.3 of the applicants (hereinafter "requesters") was refused by the Examining Division, the written decision being posted on 10 May 2005.
- II. On 19 September 2005 there were filed a notice of appeal, an accompanying fee voucher for the appeal fee, and a separate letter stating that a request for re-establishment of rights into the period for filing the notice of appeal and payment of the appeal fee would be filed within two months from 16 September 2005, indicated as the date when the patent attorney (hereinafter "the representative") who had been instructed to file an appeal had become aware that the notice of appeal had not been filed within the set time limit. A statement of grounds of appeal was filed on 20 September 2005, accompanied by an experimental report.
- III. The fee for a request for re-establishment was paid on 7 November 2005, and a request under Article 122 EPC for re-establishment of rights into the period for filing the notice of appeal and payment of the appeal fee were filed on 13 November 2005, accompanied by a statement by the representative setting out and explaining the circumstances in which the non-compliance with the time limit occurred.
- IV. In a communication issued 23 August 2006 the Board indicated issues that seemed to require further consideration.

V. The evidence and explanatory statements filed in writing on 13 November 2005, 1 November 2006 and 7 April 2008 or given at the oral proceedings held on 7 May 2008, insofar as relevant to the lines of argument then still maintained, can be summarized as follows:

Background on reminder system used

- The representative's firm operated centrally a primary, computer-based, reminder system in which due dates were recorded, and sent electronically to both the representative and his secretary in the form of two lists, a daily "B list" of all dates due the next working day and a weekly "C list" of all due dates in the next two months.
- Due dates entered in these central records were reckoned from the date of the EPO notification rather than the deemed day of receipt to avoid any risk of miscalculating the "10 day period" by records staff. The representative could ask that a further due date be entered into the central system, calculated to allow for the "10 day period".
- The copy of the weekly "C list" received by the representative's secretary was printed out by her and used as a check list for actions taken or needing to be taken. Items that were completed were crossed through and items that were uncompleted were brought to the representative's attention. The "C list" was placed on the top of his secretary's desk (not in a drawer) throughout

the week for inspection and comment by the representative, if needed, or for her to draw issues to his attention. Each new weekly "C list" was checked against the previous week's "C list" so that information could be transferred if necessary. The previous week's "C list" was then discarded.

- As a secondary reminder system, the representative maintained a personal back-up system in a loose leaf file held by his secretary, in which were placed copy letters or other documents, for historical reasons known as "blues", referring to deadlines and marked with a date on which the file was to be reviewed. On the relevant day, this back-up file was to be brought to the representative, and the marked copy either destroyed or marked with a fresh reminder date and returned to the file. It was normal practice to destroy the "blue" after the deadline had passed - its only purpose was as a reminder; it was not an actual record of anything, so there was no need to keep it. The actual records were maintained centrally.
- The representative's secretary had been working as a patent attorney's secretary for over sixteen years, and as the representative's personal secretary for ten years, and so was fully familiar with his working practices and with the importance of deadlines in filing documents at the EPO.
- The practice of the representative and his secretary at holiday times was that during the

preceding week they reviewed the "blues" and tried to complete matters that fell due during her holiday, or where possible re-date them to be pulled out for inspection at a date after her return. For matters due for completion during the holiday but not completed before, the blues were removed and given to the representative to place on his desk as a visible reminder of matters requiring action.

- It was not unusual for the representative to prepare a short document for the EPO and file it himself by fax, because his secretary was not a full time employee, being present only part of each day. So sometimes the representative himself would finalize a letter, or other document, and fax it to the EPO, usually after his secretary had left the office but sometimes also during the day.

Actions relating to specific appeal

- The professional representative dealing with the application had reported to the applicants by e-mail of 24 June 2005 that any appeal against the written decision of 10 May 2005 of the examination division refusing the application had to be filed by 20 July 2005. The e-mail log of communications between the representative and the applicants on this and other cases showed that he was in touch with the applicants instructions on Monday 11 July 2005 and obtained to file an appeal.

- The representative intended himself to prepare and file the notice of appeal and fee voucher for the appeal fee.

- During his secretary's absence prior to 11 July 2005, he had prepared a notice of appeal ready for filing when needed, by adapting one of a small collection of accepted notices of appeal that he kept stored on his office computer, to ensure that the statutory content was present when submitting an appeal. This draft was used when the error was noticed, but re-dated to the actual date of filing, and was stored on his computer under this new date, so the draft as such could not be produced.

- In the present case, the "blue" for filing the notice of appeal would not have been a copy of a letter to the client reporting the deadline because this was done by e-mail. Most probably the "blue" was another copy of the EPO communication of 10 May 2005 notifying the decision refusing the application. This "blue" was probably marked up with a date a week ahead of a two month term reckoned from the date of issue of the communication, then with the two month date itself, and finally with the deadline based on the 10 days allowed by Rule 78. Since the "two month from issue" deadline expired on the Sunday before his secretary's return from holiday, then the representative would have re-dated it to Monday 11 July, the notional "last day" and the date of her return, to be produced to him on the day of her return.

- Because of being on holiday his secretary did not see the latest "B list" and "C list" until Monday 11 July. At some time during the day she would have drawn the "C list" and "blue" to his attention. The "blue" prepared for the deadline could not be produced because in accordance with normal practice it would have been destroyed after the deadline had passed.

- It seemed to the representative that he must have mistakenly told his secretary that the matter was in hand or completed. So the reminder would have been destroyed and there would have been no need to make a "10 day" adjustment to the due date.

- The representative and his secretary had worked together long enough that his statement that the matter was in hand or completed would not have been accepted by his secretary unless she was convinced that he was correct; their relationship was such that his secretary would not have been deterred from questioning his comments. Equally the representative was not in the habit of stating that things had been one which had not been done. He was sufficiently aware of the seriousness of not lodging an appeal in good time i.e. the lack of any opportunity for extension or "further processing", that if there had been any thought in his mind that the necessary action had not been taken when this was raised with him, he would have immediately inspected his file while there was time to submit the appeal.

- The representative had arranged to visit and did so visit the requesters on 22 July 2005 to discuss with them the contents of the statement of grounds of appeal, and possible experimental evidence to be submitted. At this time he had the firm belief that the notice of appeal had been duly filed.

- The representative's erroneous belief that the notice of appeal had been filed persisted until 16 September 2005, when the representative in making preparations to file the statement of grounds noted from his own file, confirmed by on-line file inspection at the EPO, that no notice of appeal had been lodged, and the appeal fee not been paid.

- In the course of his professional life the representative calculated that he had met over eight thousand time limits, including those related to fifty-eight EPO opposition proceedings, most of which had gone to appeal, and a lesser number of appeals on examining division issues. The request for re-establishment in this case was the first he had made.

- Because the representative (mistakenly) thought the action had been completed without invoking the "10 days", there would have been no difference in outcome if the 10 day period had been diarised, because as far as the representative was concerned the action was complete, and the "10 day" date would have been deleted.

Special circumstances

- The application concerned prize-winning technology to be exploited by a spin-off company, on which a US patent had been granted, and was of importance to the requesters.

- While the representative was not directly affected by the bombings which occurred in London on 7 July 2005, nevertheless the atmosphere in the London commuter belt, in which his office was situated, was very tense in the days following the bombings because of the possibility of further such attacks, and the representative was concerned about the safety of his daughter who used one of the underground lines affected. This might well have been a contributory factor in leading to the inexplicable oversight.

VI. The lines of argument put forward in writing by the representative (insofar as they were still maintained at oral proceedings), and in oral submissions by Mr. Douglas Campbell of counsel at the oral proceedings on 7 May 2008 were as follows:

- There was no lack of care by the applicants, nor by the representative. The latter's firm had an efficient computer operated system of primary reminders, and an efficient secondary back-up system of reminders operated by the representative and his secretary, namely the marked-up paper copy of the central diary maintained by representative's secretary, and a separate system of "blues" as described.

- The representative was highly efficient with a failure rate on time limits of only one in eight thousand. The sort of error that occurred might happen to any responsible person.

- The representative firmly believed that he had taken the necessary action. When such a highly experienced representative stated that he had performed a certain action his secretary would accept this at face value. Further checks would probably have failed, and double and triple checks were not a necessary feature for a system to be considered satisfactory. It was always possible to be wise after the event, but such a hindsight view should not be taken.

- So even a layman would appreciate that what happened here was an isolated error in an otherwise satisfactory system, and the present case fell squarely within the facts of case J 2/86 (OJ 1987, 362).

- There was no reason to discriminate between professional representatives and other persons. Professional representatives should be allowed to make the occasional human error without adverse consequences for their clients.

- Allowing re-establishment despite a human error by the representative would not harm anyone or create an unfortunate precedent.

- In response to a comment in the Board's communication, that it would normally regard a satisfactory system as one that allowed for and compensated for some degree of human error also of the professional representative himself, it was submitted that it was not practicable in a small firm to provide a level of staffing such that every activity is reviewed by another person, at least not if a service to clients is to be provided at a reasonable cost. Providing extra layers of bureaucracy did not necessarily solve the problem, because there still remained the risk of human error: "*quis custodiet ipsos custodes?*"

- In the case of an experienced representative it should be sufficient for all due care to be recognized that a system existed under which a required act was brought directly to the professional representative's attention in more than one way, which was the case here.

- There was no reason to discriminate under the principle of proportionality between cases where an isolated error occurred and was noticed and corrected within one or two days, and cases where the error did not come to light until more than a month later when the next action fell due, as was the case here.

- The application concerned prize-winning technology and was of importance to the requesters. This should be taken into account under the principle of proportionality to allow re-establishment, as

loss of the application was far too harsh a penalty for any human error that had occurred here.

- There were exceptional circumstances in this case, namely the London bombings of July 2005, and these should be taken into account to allow re-establishment.

VII. The requesters requested re-establishment into the period for filing the notice of appeal and for payment of the appeal fee, and that the appeal be deemed duly filed.

Reasons for the Decision

1. In accordance with Article 1(5) of the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000 ("Revision Act"), Article 122 EPC 1973 remains applicable to considering the request for re-establishment of rights in this case, since the time limit for making such request had expired before the Revision Act entered into force.
2. It is established case law that for the purposes of Article 122(4) EPC 1973 the relevant Board of Appeal has exclusive jurisdiction to decide on a request for re-establishment of rights in respect of the time limit for filing a notice of appeal (see T 473/91 (OJ EPO 1993, 630)).

3. In relation to the formal requirements of Article 122(2)(3) EPC 1973 for an application for re-establishment to be admissible, the evidence shows that the professional representative responsible held the belief, albeit erroneous, that the notice of appeal had been filed and the due fee paid. This belief persisted until 16 September 2005, when the representative noted from his own file, confirmed by on-line file inspection at the EPO, that no notice of appeal had been lodged, and no appeal fee had been paid. For the purpose of considering admissibility, this erroneous belief of the representative can be accepted as the cause of non-compliance with the time limit. The omitted acts were completed on 19 September 2005. The application for re-establishment was filed in writing on 13 November 2005, within two months from the removal of this cause of non-compliance, and the necessary fee was paid on 7 November 2005. The application for re-establishment stated the grounds on which it was based and set out the facts on which it relied. Thus the formal requirements of Article 122(2)(3) EPC 1973 for the application for re-establishment to be admissible are regarded as met.

4. In providing for re-establishment under Article 122 EPC 1973, the legislator did not intend to provide a remedy for all cases in which there was an intention to perform an act due by a certain time limit, but an unintentional failure to observe that time limit. Rather the legislator provided for re-establishment only for those cases where the applicant, in spite of all due care required by the circumstances having been taken, had been unable to observe the time limit.

5. In the established case law this is considered as requiring that the applicant himself has taken all due care, and also that any professional representative entrusted with taking the necessary action has also taken all due care. The professional representative may entrust work to an assistant and re-establishment may be possible even in the event of a culpable error on the part of the assistant, if the professional representative is able to show that he has chosen for the work a suitable person properly instructed in the tasks to be performed, and that he has himself exercised reasonable supervision over the work (see J 5/80 (OJ 1981, 343). The professional representative cannot be required to double-check every action by an assistant. If the professional representative fails to act because he has not received a reminder due to some error of a properly chosen, properly instructed, and reasonably supervised assistant this can be regarded as "an isolated error in an otherwise satisfactory system" which would still allow re-establishment to be granted.
6. This view of the case law cannot, however, be extended to everything that can be described as an "isolated mistake". A failure to act by a professional representative leading to non-observance of a time limit must be judged simply on the requirement of Article 122(1) EPC, namely whether it occurred in spite of all due care required by the circumstances having been taken. A professional representative must be presumed to be supervising his own work continuously. Thus the case law on "an isolated mistake in an otherwise satisfactory system" cannot be relied on to ignore a failure to act by the professional representative himself, unless there are special

circumstances which make the failure to act compatible with taking all due care.

7. All due care also requires that all the steps necessary to meet the time limit have been taken with due care. On the facts put forward, the requesters themselves acted with due care in giving instructions to file the appeal, and the professional representative acted with due care in reporting the decision under appeal, and in obtaining instructions to file the appeal on 11 July 2005. The professional representative intended to prepare the notice of appeal and fee voucher for the appeal fee himself, and took some preparatory steps to do so. As the representative fairly stated at the oral proceedings he had no actual memory of the events, so that he could only make conjectures as to why the notice of appeal was not actually filed.

8. The evidence is that the firm's file on the case contained no indication of any filing of a notice of appeal on 16 September 2005, so the Board can only assume that a check of the file at any time before the due date of 20 July 2005 for filing of the appeal would have brought to light that the notice of appeal had not been filed. Thus though the evidence is that at some time the professional representative acquired the erroneous belief that the notice of appeal had been filed at the EPO, there are no objective facts which would justify such a belief. The Board is unable to give such an erroneous belief, for which there is no objective reason, any weight as a circumstance to be taken into account under Article 122(1) EPC 1973.

9. On the representative's conjectural reconstruction of events, he received a reminder, but no-one checked the file. On this evidence the systems in place functioned, but their function was to give reminders to the professional representative. They appear neither to have been intended nor did they serve to compensate for any failure by the professional representative himself to take the necessary action.

10. From the above, *prima facie* the Board is not satisfied that a case for re-establishment under Article 122(1) EPC 1973 has been made out. Certain further arguments on behalf of the appellants however need to be considered, before reaching a definite conclusion.

11. Case J 2/86 (OJ EPO 1987, 362), heavily relied on by the appellants, concerned a patent coordinator (not a professional representative) employed by the applicants in that case themselves. The patent coordinator, who was considered a suitable person to fill her position, nevertheless failed to pay annual renewal fees on divisionals in very special circumstances which made the mistake by the patent coordinator understandable in that case. She erroneously believed that the professional representative who had filed the divisionals would also be responsible for the payment of the renewal fees, contrary to the actual agreement between the applicants in that case and their professional representative. It is in this context that the Board concerned commented that it "recognizes 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".

12. Accepting that all due care had been exercised by such a patent coordinator in the very special circumstances of case J 2/86, cannot imply that in the present case the professional representative, who had no doubt that he was responsible for filing the appeal, was exercising all due care when failing to file the notice of appeal and failing to check the file.

13. It has been submitted that this is the first time limit the representative has failed to meet in a professional life involving meeting over eight thousand time limits. The enquiry as to the circumstances of the case required for the purposes of Article 122(1) EPC 1973 is not regarded by the Board as extending to or permitting an enquiry as to the record of the person concerned for meeting time limits in general. The enquiry is to be confined to the facts of the particular case (other than for cases where the same circumstances caused a time limit to be missed in several cases).

14. The Board realizes that a professional representative is likely to have to meet many hundreds of time limits a year, and that the sheer numbers involved make it not improbable an error will occasionally occur due to insufficient care being taken. But the Board cannot see that the requirements of Article 122 EPC as to all due care can be reinterpreted to mean that a lapse from this standard can be ignored in general as a mere "isolated mistake". This can only be done in cases where there are special circumstances which can be said to have caused the mistake. In this case the Board can see no such circumstances.

15. The Board accepts that professional representatives are human, and liable, as are others, to make the occasional mistake. It is for this reason that in numerous decisions (see for example decision T 869/90 of 15 March 1991, Reasons, point 2) the Boards of Appeals have recommended that for time limits where Article 122 EPC provides the only possible remedy if the time limit should not be observed, it is advisable that there be a system independent of the professional representative concerned which gives warning that the action necessary to meet the time limit has not been taken. This independent system may also not be perfect, but the number of cases where both the professional representative and the independent system both fail should be less than if the independent system is not in place. Importantly, in any case where both fail, the possibility then would exist that the immediate cause for non-observance of the time limit is the unforeseeable failure of the independent system, and not lack of due care by the professional representative, so that re-establishment under Article 122 EPC is possible.

16. The principle of proportionality, namely that a sanction in administrative law should be no more than to achieve a given end, has been invoked on behalf of the requesters, on the basis that for an application important to the applicant the sanction of the appeal being deemed not filed, and thus the application being lost, is too severe for a failure to observe a time limit. In the case law, the principle of proportionality (see for example decisions T 869/90 (*supra*) and T 111/92 of 3 August 1992, and the Case Law of the Boards of Appeal, 5th edition 2006, Section VI.E.10) has been invoked in cases where a time limit has been missed by a

day or so, and even its application in this situation has been denied (see for example T 971/99 of 19 April 2000). Given that the legislator has provided only the remedy of re-establishment under Article 122 EPC 1973 for the case of a failure to meet the time limit for filing a notice of appeal, and has laid down onerous conditions for this, it can only be assumed that the legislator considered the importance of filing an appeal on time to justify severe consequences if the time limit was not met and all due care could not be shown, including the severe consequence of an application for an important invention being lost. The principle of proportionality might suggest that a sanction less than loss of the application would be sufficient, but this is a criticism of the law as it stands, and by Article 23 EPC the Boards of Appeal are bound by the EPC as it stands.

17. The importance of an application to the applicant, or the merit of the invention concerned, have not been taken into account as circumstances in the case law. If the importance of an application to the applicant, or its technical merit, were to be taken into account, the wording of Article 122 EPC 1973 would seem, if anything, to call for even more care than for meeting time limits in other cases less important. This would not make it easier to allow re-establishment. This Board thus cannot see its way to accepting the importance of the application, or the technical merit of the invention, as circumstances to be taken into account in favour of allowing re-establishment.

18. The Board has also been asked to take into account as a special circumstance, the bombings that took place in

London starting 7 July 2005, and the increased anxiety that this caused. Given that instructions to file the appeal were actively being obtained by the representative on 11 July 2005, and apparently seven working days remained for filing the notice of appeal and paying the fee due by the set date of 20 July 2005, any causal connection between the bombings, or the anxiety they caused, and the failure to file the notice of appeal, and the failure to pay the fee, appears too hypothetical and remote, for the bombing to be taken into account as a special circumstance excusing the failure that occurred here.

19. The Board thus concludes that no case for re-establishment under Article 122(1) EPC 1973 has been made out, and the request for re-establishment must be refused.

Order

For these reasons it is decided that:

1. The request for re-establishment under Article 122 EPC into the period for filing the notice of appeal and for payment of the appeal fee is refused.
2. The appeal is deemed not to have been filed.

The Registrar:

The Chairman:

C. Eickhoff

S. Perryman