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Datasheet for the decision of 2 December 2009

Case Number: T 0520/09 - 3.2.02

Application Number: 00917730.4

Publication Number: 1161186

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Language of the proceedings: EN

Title of invention:
Occlusion apparatus

Applicant:
Board of Regents, The University of Texas System

Opponent:
-

Headword:
Occlusion apparatus/BOARD OF REGENTS UNIVERSITY OF TEXAS SYSTEM

Relevant legal provisions:
-

Relevant legal provisions (EPC 1973):
EPC Art. 121, 122

Keyword:
"Re-establishment - all due care (no)"

Decisions cited:
J 0010/07, J 0005/80, J 0007/99, J 0002/98

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0520/09 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 2 December 2009

Appellant: Board of Regents,
The University of Texas System
201 West 7th Street
Austin
Texas 78701 (US)

Representative: Bublak, Wolfgang
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 16 September 2008 rejecting the request for re-establishment into the time-limit for further processing of the European patent application No. 00917730.4.**

Composition of the Board:

Chairman: A. Pignatelli
Members: S. Chowdhury
D. Valle
P. L. P. Weber
J. Geschwind

Summary of Facts and Submissions

I. The appeal lies from the decision of the Examining division dated 16 September 2008 to reject the request of the appellant (applicant) for re-establishment of rights into the time-limit to file a request for further processing, and to declare the Euro-PCT application No. 00917730.4 (deemed to be withdrawn as of 23 November 2004) pending and to refund the fees paid to the EPO after 23 November 2004, with the exception of the fee for re-establishment of rights.

II. The notice of appeal was filed on 26 November 2008, the appeal fee was paid on the same day. The statement setting out the grounds of appeal was filed on 26 January 2009.

III. The decision of the Examining division was based on the following facts:

On 10 May 2004, the Examining division sent a communication under Article 96(2) EPC with a four months time-limit to reply.

On 27 September 2004, extensions to the deadline were allowed at the request of the applicant amounting to a total of six months. Thus, the time-limit elapsed on the 20 November 2004.

On 22 November 2004, a further request for extension of the time-limit was filed for the same reasons as before, i.e. need for clarification with the client.

On 26 November 2004, the request was refused, because on this occasion the reasons were considered to be insufficient. The applicant did not react.

On 27 December 2004, a notice of loss of rights was issued under Rule 69(1) EPC, with which the applicant was informed that the application was deemed to be withdrawn under Article 96(3) EPC because no answer to the communication under Article 96(2) EPC had been filed. The applicant was informed that he had either the possibility to ask for a decision under Rule 69(2) EPC or to file a request for further processing under Article 121 EPC. As no reaction came from the applicant, the proceedings were closed on 6 April 2005 and a notice of refund of fees was sent on 20 April 2005.

On 16 January 2006 a request for re-establishment of rights into the time-limit to file a request for further processing under Article 121 EPC 1973 was filed, the fee paid, the reasons filed and the omitted act completed.

In its decision, the Examining Division held that Article 122 EPC 1973 was applicable in the present case and therefore a request for re-establishment of the right to file a request for further processing was possible. It held the request under Article 122 EPC 1973 admissible but not allowable because the monitoring system in the office of the representative was not normally satisfactory since the same mistake happened more than once and in more than one file. Furthermore, the Examining Division found that the representative should have checked the file earlier, at

the latest when the assistant asked for a second extension of time-limit.

The Examining Division held that the decisions cited by the applicant were not applicable in the present case because in those cases the representative and not the assistant was affected by mental health problems.

IV. The appellant requests that the decision under appeal be set aside and that the time-limit for further processing be re-established.

He requested oral proceedings.

V. On 16 June 2009, the Board summoned the appellant to oral proceedings and sent a communication containing its provisional opinion.

VI. The appellant essentially submitted that the loss of right was due to an isolated mistake in a normally satisfactory monitoring system and that therefore re-establishment of rights should be allowed.

He described the monitoring system in his office as follows:

Every mail, e-mail or fax from external parties or offices arrives at the central mail receiving department of the office. Here a stamp with a time-limit indication is put on the front page of the printed mail and registered in a central register. The appellant did not explain how the central register actually works.

From the mail department, all mail goes to his desk or to another attorney's desk according to the availability of either one of them for a first checking.

After that the letter and the file are sent together to the department responsible for the file concerned. The assistant of the department presents the incoming mail, e-mail or fax together with the file to the responsible attorney. The attorney decides what needs to be done and gives the file back to the assistant with the corresponding instructions. If a request for extension of time-limit has been sent, the client is informed and the new deadline is communicated to him.

There is a strict rule in the office that for each and every signature the file must be presented to the signatory. But under some circumstances it can happen that a letter is signed without the file. This can happen if somebody stores the file in the wrong place or if the file is in the annuity or accounting departments which are in another building. Under such circumstances, it is checked whether the letters have been sent to the right addressee and whether an answer has been received by checking the database of the office containing the letter sent and the correspondence received.

A cross-check or another supervision system has not been described.

The representative in this case submitted that in general after he has given instructions to the assistant he does not check the file any further but

waits until a reaction on his action is given by the client or a third party. The system is based on trusting the assistants and the staff, assuming that they will do their job properly. The attorney assumes that the assistant will show him the incoming mail, e-mail, fax or put through the phone calls, execute his instructions properly and present him the file when necessary. On the other hand he claims to have a personal electronic reminder-system that reminds him of the files that have to be checked on a particular day or for specific reasons. Furthermore, so called "hot files" are put on a table in the department and the assistant and the attorney check them from time to time. "Hot files" are files in which a further extension of time-limits is no longer possible. A more detailed description of the monitoring system has not been submitted.

In the present case, the assistant presented a request for extension of the time-limit to the representative two times without the paper file, giving restructuring in the office as the reason. She informed the representative that the time-limit extension was necessary because no instructions had been given by the client although the client was reminded that instructions are required. In all cases the representative signed the requests.

The attorney submits that he could not check the paper file because it could not to be found, but he checked the electronic mail on the assistant's computer on which he could see the e-mail reminding the client about the time-limit. Of course, no acknowledgment of receipt of the e-mail was in the file, but he submits

that he had no reasons to assume that the assistant could have lied. On the other hand, he submits that it is very unlikely that he signed two requests for extension of time-limit without seeing the file. Although he does not remember when he checked the file, he considers that the central mail receiving department or the department to which the file was assigned would have discovered if requests for extension of time-limits were signed without checking the paper file and would have undertaken counter-measures. Therefore, it has to be assumed that he checked the file.

He assumes that the assistant presented to him a "constructed file" in which the instructions from the client and the communications of the office were not present. In fact, the assistant had taken out of the file all the enquiries from the US agent and all communications of the Office including the notice of loss of rights and the notice on the refund of the renewal fee and hidden them between other papers. The assistant also intercepted all calls from the US representative. When the notice of loss of rights was received the assistant did not inform the attorney either and did not put the notice in the file. The time-limit for filing a request for further processing was registered by the central mail receiving department but, upon expiry of the time-limit, the assistant informed that department that the client had not given instructions and that the time-limit was to be deleted from the register. The attorney was not informed of all these actions. The central mail receiving department abandoned the application without requiring a confirmation from the attorney. This is possible in the office because it is not unusual that clients do not

give instructions on the file or do not pay and in these cases the applications are abandoned.

The representative submits that he had no reasons to think that the file he saw was not the real file, that he also had no reasons to call the client and ask for instructions because it is usual that clients do not give instructions even after having received reminders, that he also had no reasons to check the file in the electronic database of the EPO because often it takes months before the EPO answers requests for extensions of time-limits. After having filed the second request for extension of the time-limit he was aware of the fact that this request was very likely to be refused and the file was put on the table dedicated to "hot files" and this was a sufficient measure to monitor the file because this meant that the file would be checked from time to time. He could not say how often the "hot files" had been checked. In any case, since the assistant had taken out of the file all communications from the EPO, it was impossible for him to recognise what happened. Even if he had seen that the fee was reimbursed, he had considered that this was not unusual because clients often pay fees twice. He did not ask the US representative to have a copy of the lost or misplaced file because this would be embarrassing for himself or his office.

The representative was informed of the loss of rights only on 14 November 2005 when the US representative of the applicant called him late in the evening. This call to enquire why the application was deemed to be withdrawn according to the EPO online register was not intercepted by the assistant because she had gone home.

At this moment the representative started an intensive search for the paper file, found the hidden papers and discovered what had happened. At that moment he also realised that the assistant was probably having mental problems and dismissed her immediately.

The assistant responsible for the file had been working in the representative's office since 1 June 2002 and was a responsible person, who had never made a mistake before. The attorney had no reason not to trust her. He never recognized any negligence concerning her duties while she was working with him. He cannot explain why she acted as she did. He assumes that she had mental health problems.

He considered that he applied all due care required by the circumstances because it is not possible to implement a monitoring system that enables someone to discover such unusual behaviour. An attorney has to trust his assistant and cannot check everything himself. Since one and the same person was acting all the time and in both cases in which the problems arose, it has to be considered that it was an isolated mistake in a normally satisfactory monitoring system.

The representative compared the present case with the case decided in J 7/99, in which the representative gave up prosecuting the application due to a mental block and with the case decided in J 2/98, in which the representative had mental health problems.

Reasons for the decision

The admissible appeal is not allowable, because the request for re-establishment of rights was correctly refused by the Examining division. The application is therefore deemed to have been withdrawn because the request for re-establishment of right is admissible but not allowable.

1. For the following reasons the Examining division correctly stated that the request for re-establishment is admissible.

1.1 A request for re-establishment can only be admissible if the law allows re-establishment of rights into the missed time-limit.

In the present case, the missed time-limit is related to the request for further processing according to the then applicable Article 121 EPC 1973. The request for re-establishment of rights into this time-limit was filed on 16 January 2006, the day on which the time-limit for filing the request elapsed. The requirements for admissibility must be sustained throughout the duration of the proceedings i.e. until the end of the appeal proceedings concerning this request. In the meantime the EPC has been modified and a re-establishment of rights into the time-limit for further processing which was not excluded by Article 122 EPC 1973 is no longer possible under the EPC in the version of 2000. However, a change in the legal position occurring after the expiry of the time-limit for fulfilling the admissibility requirements can have no impact, either to the appellant's advantage or to his

detriment, on the assessment of admissibility. The purpose of setting time-limits for complying with the admissibility requirements specified in these provisions is to ensure the possibility of determining, when the relevant time-limits expire, whether the request is admissible so that the examination whether it is allowable can be carried out. Therefore, the decision as to whether a request can be considered admissible according to the relevant provisions, geared to the fulfilment of the requirements for admissibility within a certain legally defined period, depends entirely on the substantive and legal position at the time of expiry of the time-limits (see also J 10/07, OJ EPO 2008,567).

Since the EPC 2000 was not in force at the time the request for re-establishment was filed, and the time-limit for doing so had expired, Article 122 EPC 1973 is applicable to the present case.

1.2 The time-limit of two months provided for in Article 122(2)(3) EPC 1973 for filing the request for re-establishment, paying the fee, filing reasons and completing the omitted act has been complied with because the Board has no reasons to deviate from the decision of the first instance in which it has been established that the date of removal of the cause of non-compliance is the date on which the representative was made aware of the noting of loss of rights by the US representative, i.e. 14 November 2005. All other formal requirements provided for in Article 122 EPC 1973 are fulfilled.

2. The request for re-establishment of rights into the time-limit to request further processing is not allowable because it was not shown that the time-limit was missed despite all due care required by the circumstances has been applied (Article 122 EPC 1973).

2.1 Primarily it is up to the applicant to show due care. If third parties act for him by virtue of the delegation implicit in the appointment of the professional representative, the applicant who has delegated the duty to exercise all due care has to accept their actions on his behalf (see J 5/80, OJ EPO 1981, 343).

The representative in his turn can delegate routine tasks to assistants. In this case, it is incumbent upon the representative to choose for the work a suitable person, properly instructed in the tasks to be performed, and to exercise reasonable supervision over the work. If the representative is able to prove that he did so, he can succeed in re-reestablishment (see J 5/80). The jurisprudence considers that the representative has discharged his burden of proof, when it is proven that the time-limit was missed due to an isolated mistake in a normally satisfactory system for monitoring time-limits.

2.2 It results from the submissions of the representative that the system in its office was principally based on the assumption that staff would follow the rules of the office and the instructions given by the attorney, but it has not been shown to the Board, considering the so implemented system, how possible failures could be detected and remedied in due time.

Even considering in favour of the appellant that all delegated tasks were routine tasks and assuming that all submissions were proven, it results from the submissions that, in the present case, it was possible for the assistant to act several times on her own motion in an inappropriate and detrimental way, over a period of time of almost one year and even to give instructions to other employees or departments which led to the abandonment of the application without any warning being activated by the system or counter-measures adopted by staff. In particular, it was apparently possible in at least two cases (the present one and the case concerning the Euro-PCT application No. 00914800.8) that the assistant ordered, and the central mail receiving department responsible for time-limits deleted the time-limits for further processing after the issue of a notice of loss of rights - an action which has fatal consequences for the applications - without the responsible representative and the client being informed and their approval being requested. It was not submitted that a cross-check system or other measures have been implemented in order to avoid such critical situations.

Even if it was one and the same person acting, it cannot be said that the time-limit was missed due to an isolated mistake. The time-limit has been missed due to a series of measures taken by the assistant on her own motion which were not detected because, according to the submissions in the present case, neither cross-check nor other supervisory mechanisms was present in order to avoid wrong behaviour of employees or failures

in the proper execution of their duties, particularly when the employees are acting on their own motion.

Even if it is assumed in favour of the appellant that the assistant had mental health problems, the decisions cited are not relevant because in those cases it was the representative himself who could not exercise his functions properly due to mental health problems. In the present case it is not submitted that any physical or mental health problem would have prevented the appellant's representative from monitoring a file or supervising an employee's work.

The Board holds therefore, that it was not shown that the supervision of the work of the assisting staff was sufficient to avoid repeated failures. It has therefore not been proved that all due care required by the circumstances has been applied.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

D. Sauter A. Pignatelli