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**Datasheet for the decision
of 28 February 2013**

Case Number: T 2336/10 - 3.2.08

Application Number: 02749297.4

Publication Number: 1499814

IPC: F16D 65/092, F16D 55/226,
F16D 65/84

Language of the proceedings: EN

Title of invention:
Disc brake pad

Patent Proprietor:
Freni Brembo S.p.A.

Opponent:
VRI-Verband der Reibbelagindustrie e.V.

Headword:
-

Relevant legal provisions:
EPC Art. 108, 122(1)
EPC R. 101(1), 126(2), 103(1)(b)

Keyword:
"Missing statement of grounds"
"Re-establishment of rights"
"Proof of all due care (no)"

Decisions cited:
G 0001/86, J 0003/93, J 0005/80

Catchword:
-



Case Number: T 2336/10 - 3.2.08

D E C I S I O N
of the Technical Board of Appeal 3.2.08
of 28 February 2013

Appellant: VRI-Verband der Reibbelagindustrie e.V.
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Representative: von Kreisler Selting Werner
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Respondent: Freni Brembo S.p.A.
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
15 September 2010 concerning maintenance of the
European patent No. 1499814 in amended form.

Composition of the Board:

Chairman: T. Kriner
Members: M. Alvazzi Delfrate
D. T. Keeling

Summary of Facts and Submissions

I. A decision of the Opposition Division of the EPO maintaining European patent No. 1 499 814 in an amended form was despatched to the parties on 15 September 2010. Notification of the decision to the parties is deemed to have been effected on 25 September 2010 (Rule 126(2) EPC).

II. By a letter dated 23 November 2010, which was transmitted to the EPO by fax on the same date, the appellant (opponent) filed a notice of appeal against the decision of the Opposition Division, the appeal fee being paid the same day. In the notice of appeal the appellant requested the Board of Appeal to set aside the decision of the Opposition Division and to revoke the patent in its entirety. The notice of appeal concluded with the following sentence:

"The written statements setting out the reasons for the appeal will be submitted within the legal term."

III. On 1 March 2011 the registrar of the Board of Appeal sent the appellant a communication pointing out that no statement setting out the grounds of appeal had been filed and that the appeal was therefore likely to be rejected as inadmissible pursuant to Article 108, third sentence, and Rule 101(1) EPC.

IV. By letter filed at the EPO on 29 April 2011, the appellant submitted an application for re-establishment of rights under Article 122 EPC, paid the respective

fee and filed the missing statement of grounds of appeal.

- V. Oral proceedings were held on 28 February 2013.
- VI. The appellant requested that the application for re-establishment of rights under Article 122 EPC be granted, that the decision under appeal be set aside and that European Patent No. 1 499 814 be revoked.
- VII. The respondent requested that the application for re-establishment of rights under Article 122 EPC and the appeal be rejected.
- VIII. The appellant's arguments in support of the application for re-establishment of rights may be summarised as follows:

The opponent is a registered association of several German manufacturers in the brake-lining industry. Responsibility for co-ordinating opposition proceedings within the association lies with Mr Z. Communications between the association and its representatives are normally handled by Mr Z. via e-mail.

The opponent's representatives received the decision under appeal on 17 September 2010. The Chief Clerk's Office (*Bürovorstehung*) of the opponent's representatives noted the time limit for filing the notice of appeal (25 November 2010) and the time limit for filing the statement of grounds of appeal (25 January 2011). The practice is to record time limits in the computer-operated system for monitoring

time limits and to note them on the documents in question.

The time limits for filing the notice of appeal and statement of grounds of appeal are worked out by computer. The person responsible for noting time limits checks the time limits generated by the computer. The firm's patent attorneys go through the post together and check the time limits recorded on the documents.

A cross-check then takes place. Another employee from the Chief Clerk's Office, different from the person who noted the time limit, checks the time limits noted on the documents and in the computerized system. The assistants receive a weekly listing of the time limits that are due to expire in the coming three weeks. They sort the cases out and discuss the files with the competent patent attorneys. Someone in the Chief Clerk's Office also monitors the time limits as a cross-check and issues a reminder to the assistant or other person working on each case.

The opponent's representative informed the opponent of the notification of the decision under appeal. Mr Z. then informed the other members of the opponent association, in an e-mail dated 27 October 2010, a copy of which was sent to the representatives. In that e-mail he indicated that unless instructions to the contrary were issued by 15 November 2010 it was to be assumed that no appeal should be filed. The representative responsible for the case instructed his assistant, Mrs R., that no action should be taken in the absence of instructions from Mr Z. Mrs R. entered a

corresponding annotation into the computerized time limit monitoring system.

On 11 November 2010 the opponent's representative received an e-mail from an employee of one of the members of the opponent association containing relevant technical information about the case. The representative informed the opponent by e-mail of 15 November 2010 that the information received was technically relevant and stated that unless instructions to the contrary were received from the opponent an appeal should be filed. Mrs R. then amended the annotation concerning the time limit for filing the notice of appeal so that it provided for the filing of an appeal on 23 November 2010 unless instructions to the contrary were received from Mr Z. However, she failed to alter the annotation concerning the time limit for filing the statement of grounds of appeal.

On 23 November 2010 the notice of appeal was filed and the appeal fee paid. The corresponding time limit was cancelled by Mr S., who works in the Chief Clerk's Office of the representatives.

Later, when sorting through the time limits, Mrs R. relied on the annotation concerning the time limit for filing the statement of grounds of appeal and assumed that if the case was to be proceeded with there would be an e-mail to that effect from Mr Z. She therefore searched for such an e-mail from Mr Z. but could not find any e-mail with instructions to file a statement of grounds of appeal. She did not find the e-mail of 11 November 2010 because it is not normal for individual members of the opponent association to have

direct contact with the opponent's representatives. She therefore assumed that in accordance with the instructions contained in Mr Z.'s e-mail of 27 October 2010 the opponent did not wish to pursue the proceedings any further.

On 24 January 2011, when Mr S. asked Mrs R. about the time limit that was due to expire the following day, she again went through all e-mails from Mr Z. and informed Mr S. that there were no e-mails with the corresponding instructions from Mr Z. Mr S. then checked the representative's central register of e-mails and likewise failed to find an e-mail from Mr Z. with the corresponding instructions. On 25 January 2011 he therefore deleted the time limit for filing the statement of grounds of appeal.

The opponent filed the appeal on time and wished to proceed with the appeal. The representative was prevented from filing the statement of grounds of appeal as a result of a concatenation of unfortunate circumstances. The origin of the problem lay in the fact that Mrs R. had, when altering the annotation concerning the time limit for filing the notice of appeal, failed to alter the annotation concerning the time limit for filing the statement of grounds of appeal. The problem was compounded because one of the members of the opponent association had sent an e-mail directly to the representative implicitly instructing him to file a notice of appeal and statement of grounds of appeal, whereas communications were normally channelled through Mr Z. The result was that Mrs R., when searching for an e-mail with instructions to file

a statement of grounds of appeal, had failed to find any.

The time limit was missed as a result of an isolated mistake in an otherwise satisfactory system for monitoring time limits.

Mrs R. is a legal executive who has been employed by the opponent's representatives since 1 October 2002. She has worked for patent attorneys for several years and is familiar with all the details of proceedings before the EPO, in particular with the monitoring of time limits. She is an extremely reliable and experienced assistant of a European patent attorney.

Mr S. has worked in the Chief Clerk's Office of the opponent's firm of representatives for 19 years is likewise an extremely reliable employee used to recording and monitoring time limits.

Mrs R. and Mr S. are subject to constant supervision and training. At the end of 2010 they attended a three-day seminar in which they received training from staff of the EPO. As evidence the opponent produced copies of e-mails and an affidavit by Mrs R.

IX. The respondent's arguments concerning the application for re-establishment of rights may be summarised as follows:

The representative is himself responsible for ensuring that a time limit is observed. He cannot simply delegate responsibility for verifying time limits to an assistant.

The representative at no point called or contacted by any means the appellant in order to obtain further explicit instructions. He did no more than passively check incoming e-mails. He therefore failed to observe all due care required by the circumstances. The time limit was missed because there was a lack of communication between the representative and his client. It was not missed because of an isolated mistake but as a result of the representative's conscious decision to disregard the time limit in the absence of explicit instructions from the client.

Reasons for the decision

1. The decision under appeal was despatched to the parties on 15 September 2010. By virtue of Rule 126(2) EPC, it is deemed to have been received by the appellant on 25 September 2010. The two-month time limit for filing the notice of appeal therefore expired on 25 November 2010 (Article 108, first sentence, EPC) and a statement setting out the grounds of appeal had to be filed by 25 January 2011 (Article 108, third sentence, EPC). The appellant filed the notice of appeal on 23 November 2010 (i.e. within the relevant time limit) but failed to file a statement setting out the grounds of appeal by 25 January 2011. The appeal must therefore be rejected as inadmissible under Rule 101(1) EPC, unless the appellant's application for re-establishment of rights under Article 122 EPC is granted.

2. Article 122 (1) EPC provides as follows:

"An applicant for or proprietor of a European patent who, in spite of all due care required by the circumstances having been taken, was unable to observe a time limit vis-à-vis the European Patent Office shall have his rights re-established upon request if the non-observance of this time limit has the direct consequence of causing the refusal of the European patent application or of a request, or the deeming of the application to have been withdrawn, or the revocation of the European patent, or the loss of any other right or means of redress."

3. The wording of Article 122 (1) EPC implies that re-establishment of rights is available only to patent applicants and patent proprietors. However, the case law has established that an opponent who files a notice of appeal within the two-month time limit laid down in the first sentence of Article 108 EPC but who fails to file a statement setting out the grounds of appeal within the four-month time limit laid down in the third sentence of Article 108 EPC may apply for re-establishment of rights in respect of that failure: see G1/86 (OJ 1987, 447).

4. An applicant for re-establishment of rights must, according to the wording of Article 122(1) EPC, demonstrate that "all due care required by the circumstances" was taken. The duty to exercise all due care applies first and foremost to the applicant for re-establishment and then, by virtue of the delegation implicit in his appointment, to the professional

representative authorized to represent the applicant before the EPO: J3/93, at paragraph 2.1.

5. Where a loss of rights results from some error in a party's failure to implement its intention to comply with a time limit, it is sufficient to show that the failure is due to exceptional circumstances or that it results from an isolated mistake within a normally satisfactory monitoring system: see Case Law of the Boards of Appeal of the European Patent Office, 6th edition, 2010, section VI. E.7.3.1, final paragraph.
6. The appellant's representative has sought to demonstrate that his firm operates a normally satisfactory system for monitoring time limits and that the failure to file a statement of grounds of appeal by 25 January 2011 in the present case was due to an isolated mistake.
7. The explanations provided by the appellant's representative are not, however, convincing. The failure to file a statement of grounds of appeal does not seem to have been due to an isolated mistake but rather to a basic error in the system used by the appellant's representative for monitoring time limits; that error lies in the failure to distinguish between, and treat differently, the two time limits referred to in Article 108 EPC. The difference between those two time limits is, however, obvious and of great significance. The two-month time limit laid down in the first sentence of Article 108 concerns the filing of a notice of appeal. The decision as to whether to file a notice of appeal normally calls for a certain amount of reflection. The potential appellant and his

representative, if he has one, will have to weigh up the prospects of success, the likely expense and the possible availability of alternative strategies. The four-month time limit laid down in the third sentence of Article 108 concerns the filing of a statement of grounds of appeal, which is an entirely different matter. Once a notice of appeal has been filed, and the appeal fee paid, within the two-month time limit, the necessity of filing a statement of grounds of appeal within the four-month time limit is self-evident. Neither the appellant nor his representative need agonize or reflect deeply about whether to go through with that procedural step. It is something that in the normal course of events has to be done. In exceptional circumstances the appellant may of course decide to withdraw the appeal without filing a statement of grounds of appeal and before the time limit for doing so has expired, thus qualifying for the reimbursement of the appeal fee under Rule 103(1)(b) EPC. However, simply allowing the four-month time limit to go by without either filing a statement of grounds or withdrawing the appeal is not a rational choice; it is something to be avoided without exception since it renders the appeal inadmissible and deprives the appellant of the possibility of recovering the appeal fee.

8. In the light of the observations made in the previous paragraph it is clear that the system for monitoring time limits operated by the appellant's representative was inadequate inasmuch as it entailed a danger that, having filed a notice of appeal and paid the appeal fee within the two-month time limit, he might omit to file the statement of grounds of appeal within the four-

month time limit or to take advantage of the possibility of a reimbursement of the appeal fee under Rule 103(1) (b) EPC. The appellant's representative was content to operate a system under which an assistant - admittedly a well-trained, experienced and competent assistant - was allowed to record time limits and make annotations without making the necessary distinction between the two time limits laid down in Article 108 EPC.

9. Following notification of the decision under appeal, a colleague of the appellant's representative recorded the relevant time limits (25 November 2010 and 25 January 2011) in the computer-operated system for monitoring time limits. Initially an annotation was entered into the system to the effect that no action should be taken in the absence of instructions from Mr Z. The same annotation was made for both the time limits. At a later stage "technically relevant information" was received and the representative decided that an appeal should be filed unless his client issued instructions to the contrary. His assistant amended the annotation concerning the two-month time limit for filing the notice of appeal but did not amend the annotation concerning the four-month time limit for filing the statement of grounds of appeal. That was clearly not the best way to proceed and in a well organized firm of professional representatives one would not expect matters to be arranged in such a way.
10. Once the representative had reached the conclusion that an appeal should be filed unless instructions to the contrary were to be received, it was necessary to

import into the computer-operated system for monitoring time limits some means of ensuring that the notice of appeal would be filed and the appeal fee paid by 25 November 2010 and that the statement of grounds of appeal would be filed by 25 January 2011.

11. It is in any event necessary to operate a system which ensures that, once a notice of appeal has been filed, a statement of grounds of appeal will in the normal course of events be prepared and filed within the relevant time limit (unless, exceptionally, a decision is taken to abandon the appeal and obtain a reimbursement of the appeal fee). It makes no sense to have, in a computer-operated (or manual) system for monitoring time limits, an annotation to the effect that a statement of grounds of appeal should only be filed if specific instructions are received from the client. The only logical annotation, regarding the four-month time limit laid down in the third sentence of Article 108 EPC, is an annotation to the effect that, in the event of the notice of appeal having been filed and the fee paid, a statement of grounds of appeal must be filed before the period expires, unless instructions to withdraw the appeal are received.

12. Notwithstanding the unfortunate annotation that was entered in the computer-operated system, and the failure to amend it after it became apparent that an appeal was likely to be filed, it should still have been possible to avoid missing the time limit for filing the statement of grounds of appeal if due care had been exercised in the days and weeks preceding the expiry of the time limit on 25 January 2011. The explanations provided by the appellant's representative

- about the checks performed in January 2011 do not lead the Board to believe that all due care required by the circumstances was exercised.
13. Clearly the people within the representative's firm who were responsible for monitoring time limits were aware that the time limit was about to expire but they did not take certain steps, the necessity of which ought to have been apparent to experienced staff familiar with EPO procedures. The crucial error was to focus on searching for an email from a specific individual (Mr Z.) and to persist in the mistaken belief that nothing needed to be done in the absence of explicit instructions to file a statement of grounds of appeal. For reasons explained above, the first and most obvious step to be taken, when it is clear that the time limit for filing a statement of grounds of appeal is about to expire, is to ascertain whether the corresponding notice of appeal was filed and the appeal fee paid. If that had been done in the present case it would have been obvious to properly trained and experienced staff that a statement of grounds of appeal had to be prepared and filed by 25 January 2011 in the absence of a clear instruction to the contrary.
14. Simply to delete the time limit from the monitoring system without taking the necessary action was not an option, because that entailed losing not only the right to pursue the appeal but also the possibility of recovering the appeal fee. Searching for explicit instructions to file a statement of grounds of appeal is misconceived, since it involves reversing what ought to be the normal rule of sound practice (i.e. to file such a statement in the absence of instructions to the

contrary). That error was compounded by searching exclusively for an incoming e-mail from a single individual (Mr Z.) within the opponent association. In fact if the search had been widened so as to include outgoing e-mails to that single individual the time limit would probably not have been missed. Annex 5 to the application for re-establishment of rights reproduces an e-mail of 15 November 2010 in which the opponent's representative informed Mr Z. that, having checked the documents (presumably the documents supplied in an e-mail of 11 November 2010 by an unnamed person within the opponent association other than Mr Z.), he had formed the view that a large part of the arguments used by the Opposition Division in the decision under appeal could be overcome and that he would be filing an appeal unless instructions to the contrary were received by 20 November 2010. It is difficult to understand why that e-mail did not come to light when the persons responsible for monitoring time limits within the representative's firm carried out various checks and searches in January 2011 before deleting the time limit from the computer-operated system. Moreover, that e-mail was sent in reply to an e-mail of 12 November 2010 in which Mr Z. had expressly answered "yes" to the question whether an appeal should be filed but had asked the representative to check the relevant documents once more. Thus, even if only incoming e-mails from Mr Z. were being searched for in January 2011, it should have been clear that a statement of grounds of appeal had to be filed.

15. It is well established that a professional representative may entrust routine tasks such as noting time limits to an assistant, provided that (i) a

suitable person is chosen for that purpose, (ii) he or she is given proper instructions and (iii) the representative exercises reasonable supervision over the work of the assistant: J5/80 (OJ 1981, 343, paragraph 7). In the present case it is questionable whether proper instructions were given to the assistants entrusted with monitoring time limits or whether a reasonable amount of supervision was exercised. In particular, the representative does not appear to have issued proper instructions as regards the correct way to deal with the time limit for filing a statement of grounds of appeal. An assistant to whom that task is entrusted must be instructed to work on the assumption that, once the notice of appeal has been filed and the appeal fee paid, a statement of grounds of appeal will in principle have to be filed within the four-month time limit laid down in Article 108 EPC. It is not logical to allow the assistant to proceed on the assumption that a statement of grounds of appeal should be filed only if specific instructions to do so are received. It is also important to ensure that the assistant is aware of the need to take positive action - such as checking with the representative or contacting the client directly - before deciding that no statement of grounds of appeal need be filed and deleting the relevant time limit from the system; a properly instructed assistant would be aware that purely passive steps, such as searching incoming e-mails, are not sufficient.

16. Nor is there any evidence that the representative exercised reasonable supervision over the work of the assistant to whom the monitoring of time limits had been delegated. The representative has argued that the

two members of staff in question (Mrs S. and Mr R.) are subject to constant supervision and training and that one of them cross-checked the work of the other in the present case. However, few details are given about specific measures of supervision and there is nothing to suggest that the supervisory action taken in this case could have prevented the missing of the time limit or made it less likely. The supervisor and the person being supervised both started from the incorrect premises that no statement of grounds of appeal needed to be filed in the absence of explicit instructions to that effect and that the purely passive step of searching for an e-mail from a single individual with the necessary instructions was sufficient. In the circumstances it would not be unreasonable to conclude that a little more direct involvement of the representative in person was called for.

17. In conclusion, the facts and evidence submitted in support of the application for re-establishment of rights do not indicate that all the due care required by the circumstances was taken either by the appellant or by the appellant's representative.

18. It follows that the appellant's rights cannot be re-established in respect of the failure to meet the time limit for filing the statement of grounds of appeal. Consequently, the appeal must be dismissed as inadmissible.

Order

For these reasons it is decided that:

1. The application for re-establishment of rights is refused.
2. The appeal is rejected as inadmissible.

The Registrar:

The Chairman:

V. Commare

T. Kriner