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**Datasheet for the decision
of 3 July 2015**

Case Number: T 1022/14 - 3.5.05
Application Number: 07767804.3
Publication Number: 2036550
IPC: G06F19/00, A61K41/00,
A61P35/00, A61P15/10
Language of the proceedings: EN
Title of invention:
DRUG, DRUG INDUCTION DEVICE, MAGNETIC DETECTOR AND METHOD OF
DESIGNING DRUG
Applicant:
IHI Corporation
Ishikawa, Yoshihiro
Headword:
Re-establishment of rights/IHI
Relevant legal provisions:
EPC Art. 122
Keyword:
Re-establishment of rights - time limit for requesting further
processing - due care on the part of the professional
representative (no)
Decisions cited:
J 0005/80, J 0016/82, J 0025/96, T 0439/06, T 0473/07,
T 1465/07
Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 1022/14 - 3.5.05

**D E C I S I O N
of Technical Board of Appeal 3.5.05
of 3 July 2015**

Appellant: IHI Corporation
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Koto-ku
Tokyo 135-8710 (JP)

Appellant: Ishikawa, Yoshihiro
(Applicant 2) 1-19-8 Shinjuku
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Tokyo 160-0022 (JP)

Representative: Lamb, Martin John Carstairs
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 9 December 2013
refusing the request for re-establishment of
rights.**

Composition of the Board:

Chair A. Ritzka
Members: P. Cretaine
D. Prietzel-Funk
K. Bengi-Akyuerek
G. Weiss

Summary of Facts and Submissions

- I. This is an appeal against the decision of the Examining Division dated 9 December 2013 to reject the appellant's request for re-establishment of rights in respect of the time limit to request further processing, to reject the request for further processing, and to declare that the application was deemed to be withdrawn. The underlying facts were as follows.

- II. European patent application 07 767 804.3 was filed by the applicant's European representative who is instructed by the applicant's Japanese representative. The Examining Division sent a communication under Article 94(3) EPC on 9 December 2009 setting a time limit of four months which was later extended until 19 June 2010 at the request of the European representative. On 27 July 2010 the EPO issued a notice of loss of rights pursuant to Rule 112(1) EPC informing the applicant that the application was deemed to be withdrawn under Article 94(4) EPC because the invitation to file observations on the communication from the Examining Division had not been complied with. No request for further processing was filed before the lapse of the respective time limit on 6 October 2010.

- III. On 14 January 2011 the appellant filed a request for re-establishment of rights and for the grant of further processing. As to the reasons for failing to request further processing in due time, it was submitted that due to an unusual and isolated mistake the formalities clerk at the European representative's office had marked the present application as "ABANDONED", and the due date for filing a response had been deleted and removed from the electronic monitoring system in June

2010. This misunderstanding had been caused by an ambiguous instruction from the Japanese representative in its letters dated 3 and 4 June 2010. Later, when the notice of loss of rights dated 27 July 2010 was received, the European representative in charge again mistakenly thought that the case was abandoned and did not report the official letter to the applicant. These were isolated and excusable mistakes in a normally reliable time limit monitoring system.

- IV. In the decision under appeal the Examining Division found that the European representative had failed to act with due care and to follow the instructions to request further processing given by the applicant's Japanese patent attorney with the letters dated 3 and 4 June 2010. The European representative had admitted that he had not read through the correspondence with the applicant and had failed to observe the applicant's request to file a request for further processing, and thus had not verified that there was indeed no instruction to abandon the case. The failure to request further processing had been caused by his failure to check thoroughly the letters from the Japanese representative. The Examining Division also established that a second series of errors by the formalities clerk and the representative had occurred later when the notice of loss of rights was received in the European representative's office. As the file was considered abandoned, the correspondence with the applicant's instructions was not thoroughly checked, the notice of loss of rights was not reported to the applicant and no time limit for requesting further processing was set. Thus, there was also insufficient supervision of the assistants and the members of the formalities department. The Examining Division held that this series of mistakes could not be considered a single,

exceptional and isolated error in a normally satisfactory system. Moreover, the internal system of file processing in the European representative's office had proved faulty at all stages, as each of the persons involved had failed to act with due diligence.

- V. Notice of appeal was received at the EPO on 13 February 2014 with the appropriate fee being paid on 14 February 2014. A statement setting out the grounds of appeal was received at the EPO on 17 April 2014.
- VI. The appellant argued that the European representative and his office had observed all due care. There had been a single error on the part of the European attorney when the file had been closed in the mistaken belief that it was to be abandoned and sent to storage. This mistake was excusable in a normally satisfactory system. The system in the office was designed to check the decisions of the European attorney. In normal cases, upon receipt of a notice of loss of rights, the procedure at the European representative's firm was for the file to be checked again by a member of the formalities department and then to be sent to the responsible attorney to confirm that the case was indeed to be abandoned. According to the appellant, in this case the system exceptionally failed. On receiving the notice of loss of rights a formalities clerk had failed to realise that the abandoned file was in fact alive, that the applicant had decided to request further processing and thus that the file should be handed over to the representative. But at this point in time the file did not appear to have been handed over to the European representative to check. Hence, the European representative had no opportunity to rectify the error made in the first place. In this respect, the appellant filed new evidence, in particular a further

witness statement from Mr Lamb, the European representative, relating to the investigation since carried out into the electronic records of the location of the relevant file during the time of processing in July 2010.

- VII. In the communication accompanying the summons to oral proceedings to be held on 3 July 2015 the board gave its preliminary opinion that the appellant's request for re-establishment of rights was not allowable. Apparently the decisive failure had already happened when the file was abandoned by the European representative in June 2010 though he had indeed received an instruction from the Japanese representative to request further processing later. All subsequent events had been caused by this particular action alone, regardless of whether further failures on part of the office employees had taken place later.
- VIII. With the appellant's letter of reply dated 2 June 2015 it was admitted that the European representative as well as his staff had made mistakes in this case. However, it was submitted that they were excusable. The letters dated 3 and 4 June 2010 (submitted with the letter dated 2 June 2015 as exhibit A) from the Japanese representative gave clear instructions to file a divisional application from the application at hand but did not clearly and prominently indicate the applicant's intention to use further processing for the parent application in order to respond belatedly to the examination report. The letter of 3 June 2010 was ambiguous and, like the letter of 4 June 2010, did not prominently instruct further processing. The concerned instruction was "somewhat hidden". The unusual strategy of filing a divisional application - which had been done - and the deliberate use of further processing of

the parent application had led to the failure of the European representative and his support staff. It would have taken exceptional diligence on the part of the formalities staff to examine the letters of the Japanese representative in sufficient depth to notice the intention of using further processing. Also further evidence (exhibits B1, B2 and C) was submitted relating to the reliability of the office's monitoring system, including the training and supervision of formalities staff.

- IX. Oral proceedings were held as scheduled on 3 July 2015. At the oral proceedings the appellant's representative presented his case on the basis of the written submissions. Furthermore he pointed out *inter alia* that the principle of proportionality should be taken into consideration, in particular in view of the exceptional circumstances of the present case, e.g. that unclear instructions had been given and that a divisional application had been filed. In support of this argument T 1465/07 was cited. The appellant requested that the decision under appeal be set aside and that re-establishment in respect of the time limit for requesting further processing of the application be granted.

Reasons for the Decision

1. The appeal complies with the provisions of Articles 106 to 108 EPC. Therefore it is admissible.
2. Pursuant to Article 122(1) EPC, an applicant for a European patent shall have his rights re-established upon request who, in spite of all due care required by the circumstances having been taken, was unable to

observe the time limit vis-à-vis the EPO which has the direct consequence of causing inter alia the deeming of the application to have been withdrawn. The party (as well as its representative, if any) is expected to be diligent and careful and the non-observance of the time limit must have been caused by unforeseeable circumstances.

Regarding the responsibility for the failure to observe the time limit it has to be established whether the applicant (patent proprietor) or the representative acting on its behalf personally failed to apply all due care with respect to the time limit. Only if all due care was taken, a second point needs to be examined, that is whether the representative while not being responsible for a personal particular failure, may nevertheless be responsible for mistakes that happened in a system set up in the law firm to safeguard the observance of time limits because the system was faulty itself or the assistants operating within the system were not properly selected or monitored (in this respect see decisions J 5/80, OJ EPO 1981, 343, headnote III and J 16/82, OJ 1983, 262, point 7 of the reasons).

3. Irrespective of any other mistake that may have been made, the board sees the primary and decisive reason why the request for further processing as instructed by the Japanese representative was not filed in due time as being that the European representative abandoned the file in June 2010, contrary to the instructions from the appellant.
4. In the letter dated 3 June 2010 the instruction by the appellant's Japanese representative reads as follows:

"... Please be informed that we will not respond to the recent examination report and request Further Processing for further prosecution of the present application. We also request to file a divisional application to pursue claims to iron salen compounds. ..."

Further, the Japanese representative gave the following instruction with its letter dated 4 June 2010:

"... Please be informed that it is not necessary holding this application by some kind of credible response to current Official Letter, and we will file further processing. ..."

5. In view of this wording the board is unable to follow the European representative's submission that the instruction to file further prosecution for the parent application was ambiguous or that he needed to apply exceptional diligence to understand what was said. Also, the instruction to file further processing of the parent application was not "somewhat hidden". Both letters explicitly stated that no response to the examination report was to be made other than to request further processing. From this it is undoubtedly clear that the application was not to be abandoned but to be further pursued later on and - as a second point - a divisional application was to be filed in due time. This kind of strategy is not particularly unusual and, even if, it was clearly and understandably set out in the letters of 3 and 4 June 2010. So no room for interpretation was available.
6. Nevertheless, according to his submissions the European representative started the normal internal procedure to abandon the file, to delete the time limit for

responding to the examination report and to send it to storage by signing the stamp "ABANDONED" on the file's cover. According to the representative's "witness statement" of 14 January 2011, the file had been stamped "ABANDONED" by a formalities officer when it arrived at the representative's desk and he signed it with his normal internal signature on 18 June 2010. Normally, as was explained and discussed in the oral proceedings before the board, incoming letters were added to the file on top of all previous letters. As this also may have been the case in this file, the European representative, according to his own submissions, used an internal form (Exhibit C) presented on top of the file referring to "Responding to Deadline" and ticked the box saying "Remove due Date (no response to be filed)". The board understands that he mistakenly had in mind that no response at all was to be filed, the application was to be allowed to lapse passively and only a divisional application was to be filed in due time. Consequently, he triggered the abandonment of the parent application by then signing the stamp indicating "ABANDONED".

7. This error is not of the kind to be excused, because it could have been prevented if all due care had been taken. As the appellant rightly set out in its letter dated 20 September 2012, abandonment is a final action with serious consequences if misapplied. Thus for a decision to close a file and to abandon an application the utmost care must be taken to establish whether the appellant has without any doubt issued instructions to that effect. In the board's judgement this duty was not duly performed by the European representative. He could have understood the true instruction if he had read it with the necessary standard of care.

8. No other result is justified on the basis of the fact that the word "ABANDONED" had already been stamped on the file's cover. The board understands that it was applied by a formalities officer in order to be signed by the representative. Even if this may have been misleading, the decision to abandon an application must be taken by the representative himself, on the basis of his own observations and knowledge. He personally is responsible for it. This responsibility cannot be delegated to employees, as decisions of this kind require the special knowledge of the representative for which he must assume personal responsibility as a professional. The impugned decision rightly points out that the representative retains personal and final responsibility in matters involving a possible irrevocable loss of rights (see established case law of the boards of appeal, such as T 473/07 of 30 November 2007, point 3.2 of the reasons; T 439/06, OJ EPO 2007, 491, point 7 of the reasons; J 25/96 of 11 April 2000, point 3.1 of the reasons). Since he did not read the letters thoroughly, the representative did not apply the necessary standard of care. A possibility to exculpate the representative on the basis that someone else may have made a mistake as well, is not given, even if the representative's mistake happened for the first time or was a singular error.

9. The further argumentation of the appellant regarding the actions in the office when the notice of loss of rights was received in July 2010 is understood to dispute nevertheless the responsibility of its representative, as the system implemented in the representative's office was allegedly "designed to check the decision of the attorney", but failed exceptionally. Instead of handing over the file to the representative, as normally foreseen in such a case,

the file was - for unknown reasons - sent back to storage. As a consequence, the representative had no chance to rectify at this point in time his failure that had taken place in June 2010.

10. This argument cannot be considered a valid excuse since these events do not form an independent second series of mistakes but occurred only as subsequent errors based on the first error to abandon the case. In addition, the board holds that the necessary office systems are not for the assistants to check the decisions of the attorney, but vice versa. Otherwise, the assistants would be supervising the attorney, which would place the necessary supervision with the wrong persons.
11. Already for these reasons the request for re-establishment is unallowable. Another question was whether a reliable time limit monitoring system was properly set up in the representative's office, or whether the training and supervision of the office's employees were sufficient. In this regard, the decision under appeal indicated that the mistakes that took place gave a serious indication that the internal monitoring system was faulty. These points do not have to be examined further, as primarily the representative himself - and not his staff - is responsible for the failure and thus the further points are irrelevant.
12. Moreover, the appellant argued with reference to T 1465/07 of 9 May 2008 that the principle of proportionality had to be applied. In the present case an isolated error in a satisfactorily working system had led to the severe loss of rights. Under the particular circumstances this isolated error should be held to be excusable according to the principle of

proportionality, as a reinstatement of rights had no implications for the public, given that a divisional application had been filed. The board is not convinced by this argument. The existence of the divisional application provides the appellant with the possibility to pursue the application regardless of the outcome of these proceedings. These findings are based on the case law of the boards of appeal which, according to T 1465/07, has been considered to comply with the principle of proportionality. On the other hand, and more generally, the severe consequence of a loss of a patent application in this case cannot be considered in isolation but must also be assessed against the values of legal certainty and proper administration of justice that are embodied by the time limits appropriate to Article 122 EPC. The principle of proportionality cannot be applied to the effect that the provisions in Article 122 EPC were obviously undermined and the application of this article was rendered uncertain.

13. Consequently, the requested re-establishment of rights cannot be granted. The appeal is not allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

Decision electronically authenticated

The Registrar:

The Chair:



K. Götz-Wein

A. Ritzka