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Aktenzeichen / Case Number / N^o du recours : T 287/84

Anmeldenummer / Filing No / N^o de la demande : 81 304 608.3

Veröffentlichungs-Nr. / Publication No / N^o de la publication : 0 056 512

Bezeichnung der Erfindung: Reverse osmosis membrane and process for making
Title of invention: the same
Titre de l'invention :

Klassifikation / Classification / Classement B01D13/04

ENTSCHEIDUNG / DECISION

vom / of / du 11 June 1985

Anmelder / Applicant / Demandeur : BRUNSWICK CORPORATION

~~Patentanwalt / Proprietor of the patent /
Titulaire du brevet~~

~~Finanzhilfer / Opponent / Opposant~~

Stichwort / Headword / Référence : Re-establishment / BRUNSWICK

EPÜ / EPC / CBE Article 122

Re-establishment of rights - all due care

Leitsatz / Headnote / Sommaire

1. An application for re-establishment of rights may be considered as complying with the requirement that it must set out the facts on which it relies (Article 122(3)EPC) if the initially filed application in writing, which does not contain such facts, can be read together with a further document, which contains them and is filed before the expiry of the period within which the application has to be filed.
2. In considering whether "all due care required by the circumstances" has been taken, the word "all" is important and, for the purposes of Article 122(1) EPC, the circumstances of each case must be considered as a whole.

Europäisches
Patentamt
Beschwerdekammern

European Patent
Office
Boards of Appeal

Office européen
des brevets
Chambres de recours



Case Number: T 287 / 84

DECISION
of the Technical Board of Appeal 3.4.1
of 11 June 1985

Appellant: BRUNSWICK CORPORATION
One Brunswick Plaza
Skokie
Illinois 60077 (US)

Representative: ALLDEN, Stanley et al.
A.A. THORNTON & Co.
Northumberland House
303/306 High Holborn
London WC1V 7LE (GB)

Decision under appeal: Decision of Examining Division 031 of the European Patent
Office dated 19 July 1984 refusing European patent
application No 81 304 608.3 pursuant to Article 97(1)
EPC

Composition of the Board:

Chairman: O. Huber
Member: P. Ford
Member: J. Roscoe

Summary of facts and submissions

- I. European patent application No. 81 304 608.3 (published under No. 0 056 512) was refused by a Decision of the Examining Division of the European Patent Office dated 19 July 1984.
- II. By telex dated 17 September 1984, duly confirmed by letter, one of the professional representatives appointed to act for the applicants filed a notice of appeal against the Decision of the Examining Division. Neither the telex nor the letter made any reference to payment of the fee for appeal and the fee was not paid at the time.
- III. By a telex of 16 November 1984, duly confirmed by letter, it was stated that it was not wished to pursue the appeal lodged by telex on 17 September 1984 but to offer amended claims which were not open to the objections set out in the Decision of the Examining Division. New claims and other amendments were set out in the telex.
- IV. By a second telex dated 16 November 1984, also duly confirmed by letter, the representative requested "restoration of the application", stating that he had just become aware that the appeal fee was not paid by "the due date for appealing, i.e. 19 September 1984" and that the fee was not paid "due to an unfortunate misunderstanding in this office". No information was given about the alleged misunderstanding. The fee for re-establishment of rights was duly paid but the appeal fee was still not paid.
- V. The appeal fee was not in fact paid until a Registrar of the Boards of Appeal, acting on the instructions of the Board, telephoned the representative concerned, on 19 December 1984, to draw his attention to the requirements of Article 122 EPC that the "omitted act" - in this case payment of the

appeal fee - must be completed within the period of two months from the removal of the cause of non-compliance with the time limit (Article 122(2) EPC, second sentence) and that an application for re-establishment of rights must set out the facts on which it relies (Article 122(3) EPC, first sentence).

- VI. As a result of the telephone call, the representative then caused the appeal fee to be paid and he wrote a letter to the European Patent Office on the same day saying that he had paid the appeal fee but requesting that the appeal fee be refunded later, as the applicants were not prosecuting an appeal. He also gave information about circumstances surrounding the non-payment of the appeal fee "due on 19 September 1984".
- VII. According to his letter, telex instructions to file an appeal had been received by his office on 13 September 1984. He was absent from his office on business at the time and did not return until Monday 17 September 1984. On his return he instructed his secretary to telex the European Patent Office to lodge an appeal and to arrange the payment of the appeal fee with the accounts department of his firm. His secretary, however, had understood him to say that he would give the necessary instructions directly to the accounts department. On the same day, the representative was informed by telephone that his father had died in hospital. In consequence, he was immediately involved in family matters and did not properly check the action taken on the case. Both he and his secretary thought that the other had given the necessary instructions to the accounts department and the fact that the fee had not been paid did not come to light until two months later.

VIII. In a communication dated 14 January 1985, the Board drew the attention of the representative to several matters :

- 1) the last date for filing the appeal and paying the appeal fee in accordance with Article 108 EPC, was, by application of the "10 day rule" (Rule 78(3) EPC), 29 September 1984, not 19 September 1984.
- 2) the application for re-establishment of rights could not succeed unless the requirements of Article 122 EPC were met. In particular, the representative had to satisfy the Board that he was unable to observe the time limit in spite of all due care required by the circumstances having been taken. In the present case instructions for paying the appeal fee had apparently been given hastily and orally and it seemed that there was no system in the representative's firm for detecting oversights in arranging for payment of fees. It was not apparent why the alleged misunderstanding had not been detected and corrective action taken before the normal period for payment of the fee had expired. Nor was there any explanation of how the error came to be discovered two months later.
- 3) the original application for re-establishment of rights had merely stated that there had been a "misunderstanding". This did not appear to be a sufficient statement of the facts on which the application relied, within the meaning of Article 122(3) EPC.
- 4) the amendments to the European patent application which had been submitted on 16 November 1984 could not be considered unless both the rights lost were re-established and the appeal was held to be admissible.

- 5) as there was no appeal in existence, the appeal fee would be refunded if the application for re-establishment of rights were refused. Otherwise, the appeal fee would not be reimbursed unless the requirements of Rule 67 EPC were satisfied.

IX. The representative responded to the communication by letter dated 11 February 1985.

- 1) On the matter of "due care" he stated that, in a case such as the present one, in his firm it was the responsibility of the representative or his assistant to give the accounts department the necessary instructions to make out a fee sheet and that a stamped copy of the fee sheet returned to his firm by the EPO's bankers was placed in the relevant file to show that the fee had been paid. The system worked well. The representative's firm had handled some 830 European patent applications since April 1979 and, so far as could be ascertained, this was the first time that any representative in the firm had had to seek re-establishment of rights due to a fault or error in the firm. It was submitted that this was evidence of "due care" being exercised and that human error by the representative could be excused.
- 2) The error in the present case had not been detected for two months because the representative had had no occasion to look at the file until he received instructions as to the substance of the appeal.
- 3) As to compliance with Article 122(3) EPC, his letter of 19 December 1984 could properly be read together with his original telex of 16 November 1984, since it was dated within the period in which re-establishment of rights could be applied for.

4) Re-establishment of rights had been permitted by the Branch of the EPO at The Hague in an unpublished case of which the representative had knowledge, in which US attorneys had apparently made many procedural mistakes concerning a European patent application. As re-establishment had been allowed in that case, it ought to be allowed in the present case.

Finally, the representative requested oral proceedings before an adverse decision was reached on the present application.

- X. The Board issued a summons to oral proceedings. In an accompanying communication, the Board indicated that it might be possible to decide that Article 122(3) EPC was sufficiently complied with by reading together the letter of 19 December 1984 and the telexed application for re-establishment of rights but the Board was still far from satisfied that "all due care required by the circumstances" had been taken. The unpublished case referred to did not appear to provide any basis for admitting the present application for re-establishment of rights.
- XI. Oral proceedings were held on 11 June 1985. At these proceedings the applicant requested re-establishment of rights in respect of the time limit for paying the appeal fee. Certain additional facts were established. From a written statement by the secretary concerned, which the Board allowed to be filed, it was clear that the secretary was only involved in the process of paying fees to the extent that she took files to the accounts department when asked to do so by the representative. In the present case, she cannot now remember whether she was asked to do this but she did not do so. Furthermore, from oral statements made by the representative concerned during the proceedings, it became clear that, although he had personally handled some

60 European patent applications, he had never previously lodged an appeal to the Boards of Appeal. In addition, he explained that he was not aware of the critical condition of his father's health at the time when he instructed his secretary to send the telex lodging the appeal and to prepare the letter confirming it. He had visited his father in hospital two days before and, at that time, although seriously ill, his father was expected to live for several weeks more. It had, therefore, been a great shock to him to be told on 17 September 1984 that his father had died. It was also made clear in the course of the oral proceedings that no assistant was helping the representative with the present case.

It was submitted that there had been no unnecessarily hasty action on the representative's part. It was admitted that he had subsequently acted in a somewhat confused way in handling procedural matters concerning the appeal, the application for re-establishment of rights and the request for new claims to be considered, but it was submitted that this confusion, being subsequent, had no bearing on the question whether the failure to pay the appeal fee had occurred despite "all due care required by circumstances" being exercised to see that it was paid in due time. It was submitted that it would not be in any way an abuse of the European Patent Convention or contrary to the public interest to allow re-establishment of rights in the present case.

Reasons for the Decision

1. After due consideration, the Board can confirm its previously expressed view that the present application for re-establishment of rights complies with the requirements of Article 122(2) and (3) EPC. The cause of non-compliance with the time limit for payment of the appeal fee was removed on

16 November 1984, when the representative concerned first appreciated that the appeal fee had not been paid. The letter of 19 December 1984 and the appeal fee having been received within two months of the removal of cause of non-compliance, and the fee for re-establishment of rights having been duly paid, the formal requirements of Article 122 EPC are satisfied.

2. However, the Board is not satisfied that it has been established that the failure to pay the appeal fee in due time occurred in spite of "all due care required by the circumstances" having been taken. In the present context the word "all" is important and, for the purposes of Article 122(1) EPC, the circumstances of each case must be considered as a whole.

3. On the morning of Monday 17 September 1984, the representative concerned, who had been absent from his office for some days, arrived to find the filing of the appeal awaiting his attention. From his remarks about the "due" date it is clear that he proceeded on the assumption that the appeal had to be filed by 19 September 1984. If he was aware of the benefits to the applicant of the "10 day rule" resulting from the operation of Rule 78(3) EPC, he chose to make no use of them. It is also evident that he made no careful study of the procedural requirements for filing an appeal to the Boards of Appeal, although he had never previously filed one. In this connection, it may be observed, in passing, that the notice of appeal filed did not fully comply with the requirements of Rule 64 EPC, in that it omitted to give the address of the appellant in accordance with Rule 26(2)(c) EPC and failed to state the extent to which amendment or cancellation of the decision was requested. Such deficiencies could be remedied but their existence denotes prima facie a lack of attention to the rule.

4. There is, in fact, strong direct evidence of haste in the handling of the whole matter, included in the written statement by the secretary, which was handed to the Board at the oral proceedings. She states that the representative gave her the file with instructions to send the telex and the confirming letter "early in the morning shortly after his arrival in the office". By then, evidently, he had already dealt with the matter as completely as he intended to on that day, except for signing the documents when they had been typed. The secretary states that having sent the telex and then the letter, she simply returned the file to him. By the time she did so, she was told by him of the death of his father.

5. Neither the secretary's recollection nor her actions at the time as stated by her, therefore, appear to support the representative's allegation that there was a misunderstanding between them as to which of them was to give instructions to the accounts department. Although the representative obviously sincerely believes that he said something to his secretary at the time about payment of the appeal fee, it seems to the Board at least as probable that he simply omitted to say anything about it. He accepts, with commendable honesty, that the cause of the non-payment was human error on his part and he does not seek to blame his secretary. At any rate, the Board is not satisfied on the evidence available that the cause of the non-payment of the appeal fee was the originally alleged misunderstanding. This alone would justify rejection of the application for re-establishment.

6. However, having regard to the seriousness of the case both for the applicant and for the representative concerned, the Board has carefully considered whether there are any other circumstances which could lead the Board to a conclusion favourable to the present application. The Board is entitled to examine the facts of its own motion (cf. Article 114(1) EPC) and in the present case it has done so.
7. The Board is prepared to accept the submission that the representative's firm has a very good record of procedural efficiency in general and that, in the past, the absence of any system for systematically checking that fees had been paid had not given rise to significant problems. However, it is apparent that the failure in the present case stemmed from the lack of a methodical observation of procedural requirements, not by the firm in general but by a single individual, called upon suddenly to operate a procedure which was unfamiliar to him.
8. Despite the arguments of the representative who presented the case at the oral proceedings (a different representative from the one whose conduct is in question) that such matters, being after the event, should be disregarded, the Board is satisfied that it is right and proper to consider the conduct of the representative concerned, not only on 17 September 1984 but also subsequently. If evidence of his subsequent conduct demonstrated that he was, on other occasions, consistently methodical and punctilious in studying and carrying out procedural requirements, the Board would have been disposed to take this into account in his favour.
9. Unfortunately, such evidence is not available. As the Board pointed out during the oral proceedings, the representative never appears to have appreciated the importance of complying with the requirements for an admissible appeal,

so that the amendments to the European patent application which he wished to put forward could be considered under Article 109 EPC (interlocutory revision) by the first instance, or, within the formal framework of an appeal proceeding, by the Board of Appeal. He only paid the appeal fee when expressly told that he must do so and even then he asked that it should be refunded because he was not, in his view, prosecuting an appeal.

He ran the danger of having the present application for re-establishment of rights rejected on the grounds of non-compliance with two mandatory requirements of Article 122 EPC and was only saved from this by the intervention of the Registrar, at the request of the Board, which was under no legal obligation to warn the representative of the risks he was running.

10. The Board is not satisfied that it would be justified to take account of the result of the unpublished case relied upon by the appellant's representative, which was not decided by a Board of Appeal and was not a reasoned decision. Furthermore, on its facts, that case appears to be very different from the present one.
11. In all the circumstances, the present application for re-establishment of rights must be refused. As there is no appeal in existence, the appeal fee paid on 19 December 1984 may be refunded without an order of the Board.

Order

For these reasons,
it is ordered that :
The application for re-establishment of rights is refused.

The Registrar



The Chairman

