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Aktenzeichen / Case Number / N<sup>o</sup> du recours : T 112/89 - 3.2.4

Anmeldenummer / Filing No / N<sup>o</sup> de la demande : 86 306 034.9

Veröffentlichungs-Nr. / Publication No / N<sup>o</sup> de la publication : 0 216 475

Bezeichnung der Erfindung: Dual-pass continuously variable transmission  
Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : F16H 37/02

### ENTSCHEIDUNG / DECISION

vom / of / du 4 October 1990

Anmelder / Applicant / Demandeur : Borg Warner Corporation

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPU / EPC / CBE Article 122

Schlagwort / Keyword / Mot clé : "Restitutio in integrum (refused) -  
Due care not substantiated"

Leitsatz / Headnote / Sommaire

Europäisches  
Patentamt

Beschwerdekammern

European Patent  
Office

Boards of Appeal

Office européen  
des brevets

Chambres de recours



Case Number : T 112/89 - 3.2.4

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.4  
of 4 October 1990

**Appellant :** Borg Warner Corporation  
200 South Michigan Avenue  
Chicago  
Illinois 60 604 (US)

**Representative :** Alden, Thomas Stanley et al  
A.A. Thornton & Co.  
Northumberland House  
303-306 High Holborn  
London W1V 7LE (GB)

**Decision under appeal :** Decision of Examining Division 117  
of the European Patent Office dated  
11 August 1988 and dispatched on  
28 September 1988 refusing European  
patent application No. 86 306 034.9  
pursuant to Article 97(1) EPC

**Composition of the Board :**

**Chairman :** C. Andries

**Members :** J.-C. Saisset

M.H.M. Liscourt

### Summary of Facts and Submissions

- I. In this case, the notice of appeal contests the decision of the Examining Division of the European Patent Office refusing application No. 86 306 034.9 and dispatched on 28 September 1988 to the Applicant. The Applicant filed the notice of appeal by letter dated 24 November 1988, received on 30 November 1988, and paid the fee for appeal on 24 November 1988. The notice of appeal contains nothing that could be regarded as a Statement of Grounds but simply indicates that "a written statement setting out the grounds of appeal will follow".
  
- II. The Statement of Grounds was only filed by facsimile on 17 August 1989 after the Appellant's attention had been drawn to the consequences of its absence in a communication pursuant to Article 108 and Rule 65(1) EPC dated 11 May 1989.
  
- III. On 6 July 1989 the Appellant requested by facsimile, confirmed by letter on 7 July 1989, re-establishment of rights under Article 122 EPC and paid the corresponding fee on 4 July 1989.
  
- IV. In support of the application for restitutio in integrum, the representative of the Appellant pointed out that, in his view, although all due care required by the circumstances had been taken by the Appellant, he had been unable to observe the time limit for filing a written Statement of Grounds due to the fact that the correspondence relating to the present appeal had been misfiled during the transfer of the file from the Chicago to the Troy patent department of its subsidiary company, Borg Warner Automotive, Inc. He underlined that due to the great number of files transferred at this time, such misfiling was beyond the control of the Appellant.

- V. In a communication dated 11 July 1990, the Board drew the Appellant's attention to the fact that when an Applicant or Appellant is represented by a professional representative, a request for restitutio in integrum cannot be granted unless the representative himself can establish that also he has taken the due care required from the Applicant by Article 122(1) EPC.
- VI. By facsimile received on 11 September 1990 and confirmed by letter on 13 September 1990, the representative points out that the duty incumbent on the representative to take "all due care required by the circumstances" depends on the relationship which exists between the representative and his client. According to this opinion, when, as in the present instance, a representative has as a client the patent department of a firm like the Borg Warner Corporation which employs numerous patent lawyers backed up by a team of clerical and secretarial staff having at its disposal a sophisticated reminder system and needing a professional representative only in order to satisfy the requirements of Article 133(2) EPC, the duty of the representative is discharged when he has clearly notified the client that a time limit is to be observed and is satisfied that the client has received that information. It is then the client's duty to instruct the representative to take action by the time limit in question.
- VII. Moreover, the representative explains that the time limit had not been met because the necessary action to be taken, which was admitted by the joint responsibility of the representative and the Applicant, involved communication between them. He points out that this complication, with its attendant possible misunderstandings is imposed by Article 133(2) which disadvantages an Applicant who has neither his residence nor his principal place of business

in a Contracting State as compared with an Applicant meeting the residential qualification and not needing the intervention of a professional representative.

- VIII. Finally, he submits that any doubt that the Board might have on the present issue should equitably be resolved by the Board exercising its discretion in favour of the Appellant because in his opinion the decision of the Examining Division was overly hasty.

#### Reasons for the Decision

1. Since the decision of the Examining Division was dispatched to the Appellant on 28 September 1988, the Statement of Grounds was filed beyond the time limit of Article 108, third sentence, EPC. The Notice of Appeal contains nothing that could be regarded as a Statement of Grounds. Therefore the admissibility of the appeal depends on whether the application for re-establishment of rights in respect of the time limit for filing the Statement of Grounds is allowed.
2. Although the request for restitutio in integrum and the corresponding fee were filed and paid in due time, the Board considers that it has not been established that the failure to file the Statement of Grounds 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 purpose of Article 122(1) EPC, the circumstances of this case must be considered as a whole (see decision T 287/84 OJ EPO, 1985, 333).
3. The Board accepts the representative's arguments that regarding the due care required by Article 122(1) EPC, the

obligations of the Applicant and those of his representative are clearly distinct and that the due care to be exercised by the representative may depend on the relationship which exists between him and his client. This is obviously the meaning of decision J 5/80 OJ EPO, 1981, 343.

4. However, it is also clear that both the representative and the Applicant must exercise all due care in order to observe all the time limits during patent granting procedures, contrary to the opinion expressed by the representative of the Appellant. The Board is therefore not convinced that the duty of the representative is fully discharged when he has notified his client that a time limit is to be observed and is satisfied that the client has received the notification.
  
5. On the contrary, the Board is of the opinion that when a representative has been instructed to lodge an appeal and does not receive in due time from his client the necessary additional instructions he needs to discharge his duty, he should take all necessary measures to try to obtain from his client these instructions, e.g. instructions concerning the Statement of Grounds. In the present case, the Board remarks that the representative acted in this way when, having received no instruction to lodge the notice of appeal in answer to the first letter he sent on 13 October 1988, he sent a telex reminder on 23 November 1988 asking the client to telex back to authorise him to take action before the expiry of the time limit. This attitude, which was the right one, contradicts the representative's affirmation that, due to the circumstances concerning the long history of the representative's dealings with his client, sending a reminder could have been legitimately considered by him as superfluous.

6. On the other hand, the Board considers that when a firm like the Borg Warner Corporation has a substantial patent department, this department has to take all due care when it transfers files to its firm's subsidiary company which has its place of business in another town in order to avoid loss of documents or misfiling of correspondence. It is obvious that a risk of misfiling exists whenever files are transferred. Therefore, the Board is of the opinion that in such circumstances, the Borg Warner Corporation itself would only have exercised all due care during the reorganisation of its patent department, if it had given to its representatives special instructions for cases like the present one in which a time limit had to be met. However, such special instructions were not given to the representative.
  
7. Therefore the Board concludes that neither the representative nor the Applicant have taken all due care required to observe the time limit as defined in Article 108, third sentence, EPC.
  
8. Concerning the conditions of the application of Article 133(2) EPC, the Board is not convinced that the non-observance of the time limit is, for the Borg Warner Corporation which has neither a residence nor its principal place of business within the territory of one of the Contracting States, the result of the obligation to have a representative. Actually, if both the representative and the Appellant had taken the due care specified by the Board in points 5 and 6 of its present decision, the time limit could have been met.
  
9. Finally, there is no provision in the European Convention authorising the Boards of Appeal to examine the merits of an appeal when the requirements of Article 122(1) EPC are not fulfilled.

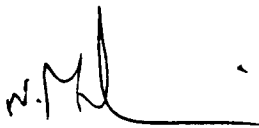
10. Since for the above reasons the request for restitutio in integrum cannot be accepted by the Board and the Statement of Grounds filed on 17 August 1989 cannot be regarded as being filed within the time limit as defined in Article 108, third sentence, EPC. Therefore, the appeal has to be rejected as inadmissible.

**Order**

**For these reasons, it is decided that:**

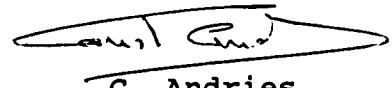
1. The request for restitutio in integrum is rejected.
2. The appeal is rejected as inadmissible.

**The Registrar:**

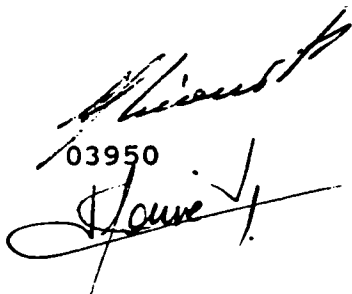


N. Maslin

**The Chairman:**



C. Andries



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