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Bezeichnung der Erfindung: Shaped products of polypropylene
Title of invention:
Titre de l'invention :

Klassifikation / Classification / Classement : C08L 23/12

ENTSCHEIDUNG / DECISION

vom / of / du 19 November 1990

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

SUMITOMO CHEMICAL COMPANY; LIMITED

Einsprechender / Opponent / Opposant :

- 1) Hoechst AG
- 2) Naamloze Vennootschap DSM

Stichwort / Headword / Référence :

EPÜ / EPC / CBE Art. 122

Schlagwort / Keyword / Mot clé :

"Re-establishment of rights (refused)

- Leitsatz / Headnote / Sommaire



Case Number : T 491/89 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 19 November 1990

Appellant : SUMITOMO CHEMICAL COMPANY, LIMITED
(Proprietor of the patent) Kitahama 4-chome 5-33
Chuo-Ku
Osaka 541 (JP)

Representative : Dixon, Donald Cossar
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Chancery Lane
London WC2A 1QU (GB)

Respondent : Hoechst Aktiengesellschaft, Frankfurt (Main)
(Opponent 01) c/o Kalle Niederlassung der Hoechst AG
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D-6200 Wiesbaden 1 (DE)

Representative :

Respondent : Naamloze Vennootschap DSM
(Opponent 02) Het Overloon 1
NL-6411 Heerlen/NL

Representative : Hoogstraten, Willem Cornelis, Roeland
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Decision under appeal : Decision of the Opposition Division of the European
Patent Office of 23 November 1988, issued
30 May 1989 revoking European patent No. 0 012 605
pursuant to Article 102(1) EPC.

Composition of the Board :

Chairman : F. Antony

Members : J.A. Stephens-Ofner
S.G. Schödel

Summary of Facts and Submissions

- I. European patent No. 12 605 was granted on 30 January 1985 to Sumitomo Chemical Company Limited of Osaka, Japan.
- II. Timely opposition to the said patent was entered by (a) Hoechst AG, Frankfurt, Germany and (b) DSM, Geleen, The Netherlands.
- III. A decision of revocation was delivered orally on 23 November 1988 and issued in writing by the Opposition Division on 30 May 1989, with the valid notice of appeal against it being filed on 1 August 1989. The notice of appeal was "particularly but not exclusively" directed against the adverse findings on the allowability of the amendments sought by the Appellant (Patentee).
- IV. By a letter dated 6 October 1989, received on 11 October 1989, that is to say two days after the expiry of the notional time limit for the filing of the statement of grounds of appeal pursuant to Article 108 and Rule 78(3) EPC, the Appellant sought an extension of two months for lodging his statement of grounds of appeal. The official response to this request was a communication dated 27 October 1989, said to have been received by the Appellant on 30 October 1989, informing him that the EPC did not permit extensions of time limits for the filing of statements of grounds of appeal, so that the only remedy open to the Appellant was re-establishment of rights under Article 122 EPC.
- V. The Appellant did file his statement of grounds of appeal on 7 November 1989, followed by an application for re-establishment of rights under Article 122 EPC, filed on 21 December 1989. The Appellant (Applicant for re-establishment of rights) also requested oral proceedings

in the event of the likelihood of an unfavourable decision being made by the Board of Appeal.

VI. The grounds and facts relied upon by the Appellant in his application for restoration were essentially that his professional representative was at all relevant times labouring under the misapprehension that the time limit for the filing of a statement of grounds of appeal, as provided for in Article 108 EPC, was extensible. This misapprehension constituted, so the Appellant argued, an isolated procedural mistake in an otherwise satisfactory system operated in the offices of his professional representative. These facts were, so he argued, fully analogous to those on which the decisions in cases J 02/86 and J 03/86: "Motorola/Isolated mistake" (OJ EPO 1987, 362) to grant restoration of rights were based. The Appellant also strongly relied upon a telephone conversation he alleged took place on or before 19 September 1989 with an unnamed official of the EPO who, according to Appellant, had advised him that extensions of time for the filing of statements of grounds of appeal were indeed available. The application for restoration of rights was supported by evidence in the form of a comprehensive statement by the partner responsible in the Appellant's firm of professional representatives, who was at all relevant times in charge of the matter. Details of this evidence, as well as of the evidence given by the above-mentioned professional representative in the course of oral proceedings, will be dealt with in the Reasons for this decision.

VII. In addition to seeking re-establishment of rights under Article 122 EPC, the Appellant also submitted the alternative request that his notice of appeal, filed on 1 August 1989, should be deemed to constitute an

admissible statement of grounds of appeal. In support of this submission he relied upon the fact that the notice of appeal went well beyond the requirements of Rule 64 EPC in that it specified the primary ground of appeal, namely, that the Opposition Division erred in finding that certain amendments suggested by the patentee were inadmissible.

VIII. Since Articles 111 and 116 EPC, which inter alia permit the refusal of requests for oral proceedings in certain cases, did not apply to this appeal, oral proceedings, strictly limited to deciding the allowability of the application for restoration under Article 122 EPC, were held on 19 November 1990. At these proceedings both Opponents, being themselves parties to the originating appeal proceedings, were represented.

Reasons for the Decision

1. The application for re-establishment of rights satisfies the procedural requirements of Article 122 EPC and is, therefore, admissible.
2. Turning first to the Appellant's subsidiary request that his notice of appeal be deemed to constitute an admissible statement of grounds of appeal, the Board accepts that the notice of appeal does indeed go somewhat beyond the list of matters set out in Rule 64 EPC, which states:

"The notice of appeal shall contain: (a) the name and address of the Appellant in accordance with the provisions of Rule 26, paragraph 2c; (b) a statement identifying the decision which is impugned and the extent to which amendment or cancellation of the decision is requested."

The matter that is additional to the above listed ones is the statement that "the appeal being particularly but not exclusively directed against the adverse findings on the allowability of the amendment sought ...". The presence of such additional matter however, does not in itself suffice to convert the notice of appeal into a statement of grounds of appeal which, in order to satisfy the requirement of Rule 55(c) EPC read in the light of Rule 66 EPC, must contain an indication of the facts, evidence and arguments presented in support of the grounds on which the Appellant relies. As in the case of opposition proceedings per se, to which Rule 55(c) EPC is in terms directed and the operation of which is extended to appeals by Rule 66 EPC, the principle to which Appellants and Respondents alike must adhere is that they should present their case fully and in good time, so as to enable their adversaries in the proceedings to see precisely the case they will need to answer. That is indeed the function of notices of opposition:

cf. "Opposition Procedure in the EPO" (OJ EPO 1989, 417 paragraphs 2 and 13) as well as decisions in cases such as T 117/86 OJ EPO 1989, 401, T 295/87 (to be published) and T 182/89 (to be published; Headnote published OJ 8/1990). The notice of appeal in this case is quite plainly insufficient to reveal to the Respondents the nature of the case being put against the first instance's finding as to the allowability of the amendments, and indeed one of the Respondents, in an answer to a question by the Board, clearly stated this to be the case, whilst the second Respondent agreed that he was in the same position.

Accordingly, the Board does not accept the Appellant's request to treat the notice of appeal filed on 1 August 1989 as an admissible statement of grounds of appeal.

3. Turning to the main issue in the case, namely the allowability of the application for restoration of rights, the Board indicated at the very outset of the oral proceedings, that whilst an adverse finding on this application would lead to the rejection of the appeal on the ground of its inadmissibility, a favourable one would result in continuation of the proceedings in writing and possibly the appointment of further oral proceedings to decide the substantive issues in the appeal.

4. The Appellant contended that the "central issue" in the case was the confirmation by the EPO of his professional representative's mistaken assumption that the time limit for the filing of the statement of grounds of appeal pursuant to Article 108 EPC was extensible. This mistaken assumption or misapprehension stemmed, in part, from the professional representative's inference that the specific legal requirement for the payment of a fee for notices of appeal (Article 108 EPC) rendered that document more important than the statement of grounds of appeal, so that one could reasonably expect that these grounds could be filed outside the time limit specified in Article 108 EPC, in line with the alleged practice of the Opposition Division of being liberal in granting extensions of time for the filing of documents. The professional representative, in his written evidence, freely admitted that "having not previously conducted an appeal, I was unfamiliar with procedures peculiar thereto."

The evidence concerning the alleged confirmation by the EPO of the professional representative's mistaken assumption consists of the statement accompanying the application for re-establishment, and exhibit "Document K" to the above statement, which is a copy of a sticker on which the professional representative had noted down the points he intended to cover in the course of his telephone

conversation with the European Patent Office. Document K, which is in the professional representative's handwriting, and which is transcribed in his statement, reads as follows:

"Ring EPO

Check format

Covering letter. Focus. Correct. Comments.

The meaning of these entries, with the exception of the entry "Ring EPO", is clearly explained in the above statement. Thus, "check format" was a note to the effect that the professional representative would have to check as to how precisely the statement of grounds was to be presented: by letter or by formal statement. An enquiry as to such a matter is clearly consistent with the professional representative's stated inexperience in appeal proceedings. The terms "covering letter; focus; correct; and comments" were stated by the professional representative to denote particular matters which he would have to refer to in his reporting letter to his client, and these matters are indeed reflected in his letter of 19 September 1989 to the Appellant and shown as exhibit "Document J". In an answer to a question put by the Board concerning the meaning of the term "Ring EPO", the professional representative stated that that term was intended to remind him to check the extensibility of the time limits applying under Article 108 EPC to the filing of statements of grounds of appeal.

The statement then goes on to relate the circumstances and the outcome of the telephone conversation that was alleged to have taken place on or about 19 September 1989.

Paragraph 13, page 4 of this document states "my normal practice when telephoning the EPO is to look up the number of the Formalities Officer appearing on the last

communication; I have no reason to believe that I departed from this practice when telephoning on 19 September. In the present case the name is that of R. Kammerer (EPO Form 2042 30 May 1989, document M). However, my recollection is that she was not available on the cited telephone when I rang (I say 'she' since I knew from the handling of other opposition cases when I had spoken to her that she was a lady), and that instead I was eventually put through to another officer who confirmed (as I understood it) my previous belief as to the availability of the extension". In paragraph 14 of his statement the professional representative goes on to say "I took no note of the name of the other officer; nor am I otherwise able to identify the officer. I can only assume that some misunderstanding must have arisen between us in the course of our conversation - something might have been misheard. I would have spoken in English, since I lack verbal fluency in the other two official languages (French and German). My impression was that English was not the native language of the officer with whom I spoke." In answer to a question by the Board, the professional representative conceded, however, that the officer's English was good enough to be understood for the purpose of the conversation. In an answer to a further question, he stated that his question as to the extensibility of time limits was specifically directed to time limits for the filing of statements of grounds of appeal and was not, therefore, a purely general enquiry about time limits in the EPO procedure.

Having considered the evidence as a whole, including statements made in the course of oral proceedings, the Board accepts, on the balance of probability, that the professional representative did indeed contact the EPO on or about 19 September. Although the enquiry was directed to the first instance and not, as it should have been, to the Registry at the Boards of Appeal, this mistake can be

readily understood in the light of the professional representative's inexperience in appeal matters. Had it been possible more closely to identify the officer who dealt with the enquiry on behalf of R. Kammerer (the Formalities Officer whose name appeared on EPO Form 2042 of 30 May 1989), the Board would have been in the position to shed further light on what matters were discussed at the relevant date, by calling the officer concerned as a witness cf. Article 117(1)(d) EPC. In the absence of such evidence, however, the Board is unable to come to a firm conclusion on what may or may not have been discussed on or about the 19 September 1989. For the reasons set out below, this lack of conclusive information is not, contrary to the Appellant's submission, the key to deciding the allowability of the application for re-establishment.

5. Applicants for re-establishment of rights under Article 122 EPC need to prove, on the balance of probability, that a failure to observe a time limit vis-à-vis the EPO took place despite the exercise by them, or by their professional representatives (doctrine of vicarious liability) of "all due care required by the circumstances". In the present case the Appellant urges that an isolated mistake made by his professional representative in the context of an otherwise satisfactory reminder system is insufficient to establish a lack of such care, particularly since, as he alleges, the misapprehension was confirmed by an officer of the EPO. It follows that in order to succeed in his plea, he must establish, first of all, that a normally satisfactory reminder system covering all procedural aspects of the prosecution of patent applications, including oppositions to granted patents, as well as the judicial procedure in appeals, was in full operation at all relevant times. The Board observes that it was on the basis of the existence

of such a normally satisfactory system that the decisions in cases J 02/86 and J 03/86, referred to previously, were arrived at.

6. In an answer to a question put to him by the Board, the Applicant's representative stated that the clerical staff in his firm relied on him as the ultimate arbiter on issues such as the one that gave rise to this application for re-establishment. It was not therefore surprising, having regard to the professional representative's freely admitted inexperience in appeals procedure, that this system failed to differentiate between flexible and rigid time limits. A normally satisfactory reminder system would quite obviously have been able to detect and subsequently correct the professional representative's mistake of procedural law concerning the operation of Article 108 EPC, insofar as it concerns time limits for the filing of statements of grounds of appeal. It follows that real cause of the mistake of law was not really the information received from the EPO, but the absence of a satisfactory reminder system, coupled with the professional representative's inexperience in appeals. For this reason, none of the cases on which the Appellant relied in the course of oral proceedings, and a common feature of which was that the procedural errors were actually caused by information received from the EPO, can help the Board in deciding the central issue before it. In this connection, the Board would observe that cases cited for the first time by either party - as was the case here by both the Appellant and by both of the Respondents (Opponents) in the appeal proper, constitute "matter" that may be disregarded under Article 114(2) EPC, despite the fact that that Article does not expressly mention matters other than facts and evidence. As was pointed out to both parties by the Board, it is imperative in the interests of fair and speedy procedure that all parties as well as the

Boards of Appeal, should be apprised in good time of the legal arguments, including the cases to be cited in their support, that are going to be put forward in the oral proceedings. It is not, therefore, sufficient for parties to assume that a particular Board is fully conversant with all of the large number of cases decided by all Boards of Appeal during the last ten years or so.

The lack of existence of a normally satisfactory system of operation clearly explains the language used in letters written by the professional representative to the Appellant and to counsel representing him in these proceedings, on 16 June and 2 August 1989. Thus in the letter of 16 June 1989 he states "... the grounds of appeal does not have to be filed until 30 September 1989, which period is no doubt extensible"; whilst in the letter of 2 August 1989 to counsel he states "I should be grateful if you would prepare a written statement of the grounds of appeal after you have returned from holiday. The notional due date is 30 September 1989."

The failure to install and to operate a satisfactory reminder system capable of differentiating between rigid and flexible time limits in all procedures before the EPO, including judicial proceedings before the Boards of Appeal, does not, in the Board's view, satisfy the requirements in Article 122 EPC of "all due care required by the circumstances", the relevant circumstance in this case being the intention to appeal against the decision of the Opposition Division of 30 May 1989. The direct cause of the failure to observe the time limit in question was not so much the understandable mistake made by the professional representative who had never conducted an appeal before, but rather the inefficiency in the reminder system as such that operated at the relevant time.

Had it been possible for the Board to establish, on the balance of probability, that information emanating from the EPO was a significant contributory cause to the failure to file the statement of grounds in due time, the Board's decision upon the allowability of the application for restoration of rights could, and probably would, have been different as a result of the application of the principle of fair treatment of parties by all organs of the EPO, including the judicial organ, i.e. the Boards of Appeal; however, on the basis of the limited information which the Appellant's representative was in a position to provide, such a contributory cause could not be established to the Board's satisfaction.

The Board therefore finds that the requirement of exercising all due care in the circumstances has not been met, and accordingly it rejects the application for reinstatement. As a direct consequence of this rejection it also finds that the appeal against the decision of the Opposition Division dated 30 May 1989 has to be rejected as inadmissible.

Order

For these reasons, it is decided that:


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

The Registrar:



E. Gorgmaier

The Chairman:



F. Antony