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File Number: T 30/90 - 3.3.3
Application No.: 79 300 552.1
Publication No.: 0 004 774
Title of invention: Preparation of a cationic starch paste

Classification: C08B 31/12

DECISION
of 13 June 1991

Proprietor of the patent: Grain Processing Corporation

Opponent: CPC Europe Ltd.

Headword: Re-establishment of rights by Appellant/GRAIN PROCESSING CORP.

EPC Article 108, 122

Keyword: "Re-establishment of rights by Appellant into time limit for filing
Notice of Appeal: denied"
"Appeal consequently inadmissible"

Headnote



Case Number : T 30/90 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal
of 13 June 1991

Appellant :
(Proprietor of the patent)

Grain Processing Corporation
1600 Oregon Street
Muscatine
Iowa 52761 (US)

Representative :

Skailes, Humphrey John
Frank B. Dehn & Co.
Imperial House
15-19 Kingsway
London WC2B 6UZ (GB)

Respondent :
(Opponent)

CPC Europe Ltd.
Internation Plaza
Anglewood Cliffs, New Jersey 07632 (US)

Representative :

Wilkinson, Stephen John
c/o Stevens, Hewlett & Perkins
5 Quality Court
Chancery Lane
London WC2A 1HZ (GB)

Decision under appeal :

Decision of Opposition Division of the European
Patent Office dated 20 September 1989 revoking
European patent No. 0 004 774 pursuant to Article
102(1) EPC.

Composition of the Board :

Chairman : F. Antony
Members : C. Gérardin
J. Stephens-Ofner

Summary of Facts and Submissions

- I. European patent No. 0 004 774 was granted on 18 July 1984 to Grain Processing Corporation, USA.
- II. Admissible opposition to the aforesaid patent was entered by CPC Europe Limited.
- III. A decision was duly issued by the Opposition Division on 20 September 1989, revoking the patent.
- IV. A Notice of Appeal against the above decision of the Opposition Division was not filed until 8 January 1990, that is to say well after the expiry of the notional time limit (30 November 1989) pursuant to Article 108 and Rule 78(3) EPC. In conjunction with his Notice of Appeal, the patentee also applied for re-establishment of rights in respect of the missed time limit (Article 122 EPC).
- V. The grounds and facts relied upon by the Appellant in his application for restoration were, essentially, that the chain of communication between the patentee and his US and UK representatives had, owing to an inadvertent mistransmission in the USA by a telecopier operator of a relevant instruction, broken down, and that the mistake only became apparent after the deadline for the filing of the Notice of Appeal had expired. In his sworn affidavit, filed with the application for re-establishment, the patentee's US representative stated that "upon receiving instructions from my client on November 29, 1989 I telecopied instructions to our associate counsel ...". He then went on to say that the telecopy, intended to be sent to his UK associate counsel, had been inadvertently misdirected to his client company.

The patentee's UK representative also gave evidence to the effect that, in view of the technical issues raised by the Opposition Division's decision, he did not expect to receive final instructions to proceed with the appeal until very shortly before 30 November 1989. He went on to state that he only became aware of the mistransmission of the USA-originating telefax instructions (dated 29 November 1989), on 5 December 1989, i.e. five days after the expiry of the notional time limit under Rule 78(3) EPC. He also went on to state that in view of the six-hour time difference between London and Chicago there was no point in his attempting to contact the patentee's US attorney on the last day for the filing of the Notice of Appeal, namely, 30 November 1989.

VI. Accordingly, the Appellant submitted that the system of communication set up between the patentee and his UK and US representatives was a satisfactory one, and that the mistransmission of the telefax instructions (dated 29 November 1989) constituted an isolated procedural mistake in this system, as operated by the offices of the patentee's representatives. He therefore argued that the jurisprudence laid down in cases such as J 5/80, J 02/86, J 03/86, T 179/87 and J 03/88 applied to the present case, with the result that re-establishment of rights into the time limit for filing the Notice of Appeal should be granted.

VII. In a letter dated 11 April 1990 the Opponent (Respondent) to the appeal commented on the grounds and evidence supplied by the patentee in support of his application for re-establishment. His two principal points of criticism were, firstly, that 29 November 1989 was, in all the circumstances, far too late for the patentee to give instructions to his US attorney in this matter, so that

this tardiness in itself constituted, in the absence of a satisfactory explanation, lack of all due care within the meaning of Article 122 EPC. Secondly, he took issue with the assertion made by the patentee's UK representative that there was no point in his attempting to contact the patentee's US attorneys on 30 November 1989 because of the six-hour time difference between London and Chicago. The Opponent urges that there was in fact ample time for the patentee's UK representative to contact his US associate at the start of business in Chicago, and subsequently to fax a Notice of Appeal to the EPO on the same day. In the alternative, he urges that the patentee's UK representative should, in any case, have contacted his US associate before the expiry of the time limit, in order to seek instructions as to how to proceed in the matter.

By letter received 9 May 1990, the Appellant's UK representative took issue with the Opponent's above submissions and asked for an opportunity to reply to them, which he was, in any event, formally invited to do by a communication from the Board dated 15 June 1990.

VIII. He gave this reply on 18 August 1990. In it he explained the nature of the system of reminders and acknowledgements of faxes installed and operated in his offices. In dealing with one of the Opponent's main points, namely that the UK representative should have taken timely steps before the expiry of the time limit in order to elicit, via his US associate, instructions for the further conduct of the proceedings, he stated: "... As regards 30 November 1989, the last day for appeal, I was aware from my firm's reminder system that we had not received instructions, but the possibility of a failure in communications did not unfortunately occur to me. I, therefore, had no reason to believe that anything was wrong. However, as stated in paragraph 7 of my earlier statement, I thought it would

have been to no avail to have attempted to contact Mr. Cavanaugh on 30 November, in view of the time difference between London and Chicago, 6 hours. Even assuming it would have been possible to contact Mr. Cavanaugh at 9.00 a.m. (Chicago time), it would have already been 3.00 p.m. London time, which would have made it impossible to pay the appeal fee by normal methods.

The method that is normally used in my firm to pay EPO fees is by sending a check by post to the EPO in Munich, but this method could obviously not be used in these circumstances. The normal procedure we use in urgent cases is to take a check by hand with a covering letter to the EPO's bank in London, but as banks shut at 3.30 p.m. and the EPO bank is several miles away, this would again have been impossible. My firm also has a debit account with the EPO in Munich, but this is primarily used for relatively minor matters, for example obtaining copies of documents. At the time in question I had only used the card on one occasion over the whole period of existence of the account.

... The other possibility suggested of paying the fee via an associate in Munich is far removed from the normal practice, and in any event offices in Munich are likely to be shut by 4.00 p.m. London time." As regards the second principal point concerning tardiness by the Appellant himself in giving instructions regarding the conduct of the appeal, he stressed the complex nature of communications between the Appellant and his US attorneys, and went on to state that the US attorney did in fact inform the Appellant of the decision of the Opposition Division in a letter dated 9 October 1989, and that after reviewing that decision the Appellant asked, on 23 October 1989, for an estimate of the costs of an appeal, which advice was duly supplied on 1 November 1989

- following which he started to evaluate the interests of his European companies in the technology in question. The filing of the appeal was, so it was stated, authorised at 9.00 a.m. on 29 November 1989, showing that the Appellant had the question of the appeal under constant review.

IX. The above submissions were sent to the Opponent, who, on 19 October 1990, made a number of further observations concerning the system of acknowledgements of telefaxes and like matters, as used in the offices of the Appellant's representatives, and also took issue with the Appellant's assertion that 30 November 1989 was, for all practical purposes, too late to arrange for timely payment of the appeal fee.

Reasons for the Decision

1. The application for re-establishment satisfies the procedural requirements of Article 122 EPC and is, therefore, admissible.
2. Article 122 EPC provides, as a pre-requisite for the restoration of rights, the exercise of "all due care required by the circumstances", by the applicant for, or proprietor of, a European patent. This requirement extends to his representatives and, in particular, to his professional representatives (in the sense defined in Articles 133 and 134 EPC), cf. J 05/80, OJ EPO 1981, 343 and T 715/89 (unpublished). It follows that lack of such care, either by the Appellant himself or by his representative, and in particular his professional representative, will preclude re-establishment of rights.
3. Most of the written submissions and evidence in the present case concern the system of communications in

general, and the transmission and acknowledgements of telefaxes in particular, as operated by the Appellant's representatives in their respective offices in the UK and the USA.

Having examined that evidence and those submissions, the Board is satisfied that the mistransmission of the telefax instruction by the Appellant's UK representative constituted an isolated mistake in an otherwise satisfactory system. This event, however, took place on 29 November 1989, only one day before the expiry of the notional time limit (30 November 1989) pursuant to Article 108 and Rule 78(3) EPC. The crucial question for deciding upon the allowability of this application for restoration is whether or not the conduct of the Appellant himself and/or of his representatives throughout the whole period following the issuance of the decision under appeal amounted to the exercise of "all due care required by the circumstances". By "all due care" in this context is meant all reasonable care, that is to say, the standard of care that the notional reasonably competent patentee/applicant/representative would employ in all the relevant circumstances.

4. As far as the Appellant is concerned, he had been informed of the decision under appeal on 9 October 1989, and of the likely costs of an appeal on 1 November 1989.

It is, of course, to be expected, and is quite normal, for parties to weigh the costs of appeal proceedings against their relevant commercial interests, as the patentee has had to do in this case. The Board fully accepts that this process does indeed take a fairly considerable amount of time so that a final decision will, as was stated in the above letter by the Appellant's representative, be made later rather than at an early stage in the proceedings.

The decision was in fact made, and the appeal authorised, at 9.00 a.m. on 29 November 1989, but this was, in the Board's finding, too late, in all the circumstances of the case, to expect with reasonable certainty that timely action would still be taken by the representatives.

5. As far as the conduct of the professional representative is concerned, it may or may not be true that by 30 November 1989 it was too late for him to take effective action by contacting his US instructing agent to seek relevant instructions, and thereafter to carry out those instructions. What is decisive, however, is that he took no action whatsoever some time before that date. His stated expectation of not receiving final instructions until very shortly before 30 November 1989 does not, in the Board's finding, justify his failure to seek those instructions at least a few days before the expiry of the time limit which was known to him, particularly in view of the difficulties (upon which he expressly relies), of last minute communications with his US instructing agent, and of the problems of making urgent payments to the EPO.

6. This failure on the part of the professional representative to seek timely instructions either exacerbated the consequences of the Appellant's (patentee's) own tardy decision-making, or was a contributory cause of it. In consequence, the Board finds that neither the Appellant nor his professional representative had exercised the degree of care prescribed by Article 122(1) EPC and, accordingly, refuses the application for restoration.

As a direct consequence of this refusal, the Board also finds that the appeal filed on 8 January 1990 against the decision of the Opposition Division dated 20 September 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:

The Chairman:


E. Görgmaier


F. Antony