

Publication in the Official Journal Yes / No

File Number: T 324/90 - 3.3.3
Application No.: 83 109 035.2
Publication No.: 0 103 300
Title of invention: Encapsulation of electronic components with
calcium silicate-containing poly(arylene
sulfide) compositions
Classification: C08L 81/02

D E C I S I O N
of 13 March 1991

Proprietor of the patent: Phillips Petroleum Company

Opponent: Hoechst AG

Headword: Re-establishment/HOECHST

EPC Article 108, 122

Keyword: "Re-establishment of rights" - "prima facie
evidence" - "all due care" (no) -
"unsatisfactory system"

Headnote

In order to comply with the two-months' time limit laid down in Article 122(2) EPC, it is not necessary that the application for re-establishment of rights provide any prima facie evidence for the facts set out in it, nor is it necessary that it indicate the means by which those facts are supported (e.g. medical certificates, sworn statements and the like). Such evidence may be submitted after the time limit, if so required.



Case Number : T 324/90 - 3.3.3

DECISION
of the Technical Board of Appeal 3.3.3
of 13 March 1991

Appellant :
(Opponent)

Hoechst AG
- Zentrale Patentabteilung -
Postfach 80 03 20
D - 6230 Frankfurt am Main 80

Respondent :
(Proprietor of the patent)

Phillips Petroleum Company
5th and Keeler
Bartlesville
Oklahoma 74004
US

Representative :

Dost, Wolfgang, Dr.rer.nat., Dipl.-Chem.
Patent- und Rechtsanwälte
Pagenberg-Dost-Altenburg & Partner
Galileiplatz 1
D - 8000 München 80

Decision under appeal :

Interlocutory decision of Opposition Division of
the European Patent Office dated 12 February 1990
concerning maintenance of European patent
No. 0 103 300 in amended form.

Composition of the Board :

Chairman : F. Antony
Members : M. Aúz Castro
H. Fessel

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EPC Article 108, 122
Keyword: "Re-establishment of rights" - "prima facie
evidence" - "all due care" (no) -
"unsatisfactory system"

Headnote

Headnote follows

Summary of Facts and Submissions

- I. By interlocutory decision of 12 February 1990, the Opposition Division found that in view of the amendments made by the proprietor, patent No. 103300 and the invention to which it related met the requirements of the European Patent Convention.
- II. The Opponent lodged an appeal against this decision on 19 April 1990 and paid the appeal fee.
- III. The written statement setting out the grounds of appeal was not filed until 25 June 1990.
- IV. On that same day, an application for re-establishment of rights was filed and the appropriate fee was paid. Oral proceedings were requested in the event that the Board could not allow the application on the basis of the written submissions.

As grounds for the application the Appellant submitted that non-compliance with the time limit has been due to a series of unfortunate coincidences which could be summarised as follows:

The patent specialist in charge of this particular case had dictated the statement of grounds on 15 June 1990 and then locked up the cassette in a cupboard together with the file and a note saying "T. 22.6.90 b. einhalten!" ("please keep the deadline of 22 June 1990").

From Monday, 18 June to Friday, 22 June 1990 he was away in Switzerland. Normally his assistant would have removed the work from the cupboard on the following working day and passed it on to the central typing pool. But it so happened that his assistant was also absent on 18 June and the following days. Normally there were four assistants

available, but during the week in question only two of them were present to deal with all the work and neither of them had apparently realised the significance of the note. The statement was finally typed on 21 June 1990 and was then - owing to misinterpretation of the meaning of the deadline - placed on the desk of the specialist in charge of the case, who found it on his return from Switzerland.

The application for re-instatement was not accompanied by any prima facie evidence.

- V. In a letter dated 27 November 1990, the Appellant provided further details regarding organisation of work in the central patent department of his firm:

The specialist responsible for preparing a statement for a case pending would normally dictate it and then pass the file to an assistant, indicating the time limit. As a rule one assistant worked for at least three people. The four assistants on the office floor concerned here deputised for each other in the event of absence.

In the present instance the specialist preparing the statement had not been able to pass the cassette to his assistant because he did not finish dictation until after working hours on Friday. His assistant would have understood the note attached to the file, but as she was ill on the following Monday the file had been sent to the typing pool by another assistant who normally worked for a different person. In the typing pool the deadline in the note had been taken to mean the deadline for completion of the typing.

It was further submitted that it was not the duty of those in charge of cases to see that time limits were adhered to. That was the job of other employees who were also

responsible for keeping the files and sending correspondence. The employee responsible in this particular instance had talked to the specialist in charge of the case about the time limit on 15 June 1990 and then went on leave on 20 June 1990. His substitute was on leave for half a day on Thursday 21 June and was ill on Friday 22 June.

- VI. Oral proceedings were held on 13 March 1991 and the specialist attending the hearing on behalf of the Appellant summarised his arguments and showed the Board the note - a piece of pink paper with the time limit written in red ink. He further produced a yellow card usually attached to the file indicating the deadline for the typing pool. He also presented the Board with a list of the various cases and the time limits applying to them. The list did not indicate the varying degree of importance of those time limits.

The Appellant requested re-establishment of rights in respect of the unobserved time limit for filing the statement of grounds of appeal.

The Board rejected the request.

- VII. In a letter dated 19 March 1991 the Appellant requested reimbursement of the appeal fee.

Reasons for the Decision

1. Under Article 108, third sentence EPC, a written statement setting out the grounds of appeal must be filed within four months after the date of notification of the decision. In the present case, this period elapsed on 22 June 1990 (Rules 78(3), 83(1), (2) and (4) EPC).

2. The appeal's admissibility, therefore, depends on whether re-establishment of rights in respect of the time limit for filing the statement of grounds is allowed or not.
3. According to the wording of Article 122(1) EPC, only the applicant for or proprietor of a European patent who was unable to observe a time limit vis-à-vis the European Patent Office shall, upon application, have his rights re-established. The Enlarged Board of Appeal, however, held in its decision G 01/86, dated 24 June 1987 (OJ EPO 1987, 447) that an appellant as opponent may also have his rights re-established under Article 122 EPC if he has failed to observe the time limit for filing the statement of grounds of appeal. Therefore, Article 122 EPC is applicable in the present case.
4. The application for re-establishment complies with the formal requirements of Article 122(2) EPC. The cause of non-compliance with the time limit was removed when the Appellant's employee in charge of the case returned from Switzerland on 25 June 1990 and found the file on his desk, and the application was filed within two months from that date, namely on the same day (25 June). The omitted act, i.e. failure to file the statement of grounds of appeal, was also completed on that day.
5. According to Article 122(3), first sentence, EPC the "application must state the grounds on which it is based and must set out the facts on which it relies." This English version, and the French version too (in French: "la requête doit être motivée et indiquer les faits et les justifications invoqués a son appui") differ to some extent from the German version, which contains an additional requirement: "Der Antrag ist zu begründen, wobei die zur Begründung dienenden Tatsachen glaubhaft zu machen sind." (the facts on which the application relies must be

substantiated by producing prima facie evidence). The difference became noticeable because the Appellant used the German language, and since the Respondent did not appear the oral proceedings too were held in German. In the German version, the way in which the application, the statement of grounds and the requirement that the facts be substantiated are grammatically linked seems to imply that the facts relied on must be substantiated within the two-month time limit, whereas in the other two versions there is no such provision. Article 177(1) EPC lays down that the three texts of the Convention in English, French and German are equally authentic, so it could not have been intended to have stricter requirements for the admissibility of a request for reinstatement in one version than in the other two. Therefore, it can be considered as established case-law of the Boards of Appeal of the European Patent Office that only the grounds and the facts must be filed within the two-month period, whereas evidence, if needed, may be filed later. (J 16/82 in OJ EPO 1983, 262; T 13/82 in OJ EPO 1983, 411; T 191/82 in OJ EPO 1985, 189; T 287/84 in OJ EPO 1985, 222; J 2/86 and J 3/86 in OJ EPO 1987, 362; J 22/88 in OJ EPO 1990, 244).

Nor is it necessary to indicate in an application for re-establishment the means (e.g. medical certificates, sworn statements and the like) by which the facts relied on are supported, as is suggested in Singer's commentary on the European Patent Convention on page 579. Such a requirement would not be in line with the English and French versions.

Since it is admissible to file prima facie evidence after expiry of the two-month time limit, it seems, therefore, that in the case of T 14/89 (OJ EPO 1990, 432) there was no need to refer to the principle of good faith as far as lack of substantiation ("Glaubhaftmachung" within the meaning of the German text) was concerned.

6. In the present case, since the fee for re-establishment had been paid within the prescribed time limit, the application also complies with Article 122(3) EPC and is therefore admissible.

7. However, Article 122(1) EPC makes it a condition for re-establishment of rights that the person applying for re-establishment show that "all due care required by the circumstances" was taken.

The Appellant pleads a series of unfortunate circumstances that prevented him from observing the time limit. But from the facts set out in detail the question arises as to whether the way in which the Appellant's firm organised handling of correspondence and its system for observing time limits were satisfactory in general.

The question as to whether a particular system used in a particular firm to ensure that procedural acts such as the filing of statements of grounds of appeal are completed in due time fulfils the requirement of "all due care" depends upon the individual circumstances of each case.

In a large firm, where a considerable number of deadlines have to be monitored at any given time, it must normally be expected that at least an effective system of staff-substitution in the case of illness and for absences in general is in operation in order to ensure that official documents such as decisions by the European Patent Office, which start periods within which procedural steps have to be carried out, are properly complied with.

From the facts submitted in this case it must be concluded that no appropriate precautions had been taken in the event of unexpected absences on the part of staff responsible for monitoring time limits.

The Appellant affirms that the employee who was responsible for monitoring the time limit and attending to the file went on leave on 20 June 1990. No mention is made of any measures taken by that employee to ensure punctual mailing of the statement of grounds of appeal during his absence. Moreover, no information was provided as to what steps, if any, were taken by his substitute regarding observance of the time limit.

Also, there is no indication as to whether or not arrangements were made to have someone replace the substitute in question when he reported sick on Friday 22 June 1990.

The Board further observes that in addition the list containing various time limits for the cases to be dealt with by the specialist did not in any way highlight the most important, i.e. inextensible, time limits.

The Board notices certain inconsistencies in the Appellant's submissions. On the one hand it is submitted that the pink paper with the time limit went to the particular assistant concerned, while on the other hand the Board is informed that it was the duty of other staff to monitor the time limit. It therefore seems that there was really no need for the said note.

Furthermore, it is submitted that the four assistants working on the same floor replace each other if required. However, the replacement for the assistant who normally worked for the specialist in charge of the case did not realise what the note referred to, whereas the assistant normally responsible according to the submissions would have understood. The question as to whether the assistants all had the same instructions remains open.

To conclude: the facts submitted in support of the application do not indicate that all due care had been taken to ensure the prompt mailing of the statement of grounds of appeal. On the contrary, the system for monitoring time limits in the Appellant's firm shows considerable deficiencies and obvious absence of clear instructions regarding assignment of responsibilities.

Apparently it was only the specialist in charge of the case who took some precautions with the object of ensuring observance of the time limit, even though, according to the submissions, it was not his responsibility to do this.

8. It follows that the Appellant's rights cannot be restored in respect of the failure to meet the time limit for filing the statement of grounds of appeal. Consequently, the appeal has to be rejected as inadmissible (Rule 65(1) EPC).

9. The following observations have to be made concerning the request for refund of the appeal fee:

Article 108, second sentence, EPC stipulates that the notice of appeal shall not be deemed to have been filed until after the fee for appeal has been paid. Consequently, in a case where an appeal is not deemed to have been filed because the appeal fee was not paid in time, the appeal did not come into existence; hence the appeal fee was paid without reason and therefore cannot be retained.

It follows that in such a case the appeal fee must be reimbursed (J 16/82 in OJ EPO 1983, 262).

But the situation is different in the present case, in which the appeal is inadmissible because a statement of grounds was not filed in due time. In this case the appeal already exists, even though it is inadmissible. In a case of inadmissibility of an appeal no reimbursement of the appeal fee is provided for in the Convention. Reimbursement of the fee may only be ordered in the circumstances set out in Rule 67 EPC. The appeal fee cannot be refunded for the reason that a statement of grounds was not filed, or was filed too late (T 13/82 in OJ EPO 1983, 411; T 41/82 in OJ EPO 1982, 256).


Order

For these reasons, it is decided that:

1. The application for re-establishment of rights is rejected.
2. The appeal is rejected as inadmissible.
3. The application for reimbursement of the appeal fee is rejected.

The Registrar:

The Chairman:


E. Görgmaier


F. Antony