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I N T E R L O C U T O R Y
D E C I S I O N
of 10 March 1994

Case Number: T 0667/92 - 3.3.2

Application Number: 82301996.3

Publication Number: 0063491

IPC: A23K 1/17

Language of the proceedings: EN

Title of invention:
Ruminant lactation improvement

Patentee:
Eli Lilly and Company

Opponent:
SmithKline Beecham Corporation

Headword:
Re-establishment/ELI LILLY

Relevant legal norms:
EPC Art. 122

Keyword:
"Statement of Grounds"
"Due care"
"Exceptional circumstances"

Decisions cited:
-

Catchword:
-

Case Number: T 0667/92 - 3.3.2

**I N T E R L O C U T O R Y
D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 10 March 1994**

Appellant: Eli Lilly and Company
(Proprietor of the patent) 307, East McCarty Street
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Indiana 46285 (US)

Representative: Tapping, Kenneth George
Erl Wood Manor
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Surrey GU20 6PH (GB)

Respondent: SmithKline Beecham Corporation
(Opponent) One Franklin Plaza
PO Box 7929
Philadelphia, Pennsylvania 19101 (US)

Representative: Waters, David Martin, Dr.
Smith Kline & French Laboratories Ltd.
Patent Department
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office dated 22 May 1992 revoking
European patent No. 0 063 491 pursuant to
Article 102(1) EPC.

Composition of the Board:

Chairman: P.A.M. Lançon
Members: E.M.C. Holtz
U.M. Kinkeldey

Summary of Facts and Submissions

- I. The Appellant/Patentee on 21 July 1992 lodged a notice of appeal against the decision of 22 May 1992 by the Opposition Division to revoke European patent No. 82 301 996.3 and paid the appeal fee on the same date.
- II. On 2 October 1992, one day after expiry of the prescribed time period, the Appellant submitted a Statement of Grounds. After the Registrar of the Boards of Appeal had informed the Appellant that it appeared that a Statement of Grounds had not been filed within the time limit laid down in Article 108, the Appellant on 20 November 1992 submitted a request for re-establishment of rights under Article 122 EPC.
- III. The Appellant submitted as grounds for the request that delivery of the Statement of Grounds had been late for reasons beyond their control and that all reasonable care had been taken to meet the deadline.
- IV. The Appellant's arguments as submitted by their representative may be summarised as follows.

The date of the despatch of the Statement of Grounds, 29 September 1992, allowed two days for it to reach the European Patent Office in Munich by the set deadline. The package was sent by the special express delivery service by the Royal Mail, namely the Parcel Force's International Datapost service. Their brochure showed that they offer a guaranteed delivery time which, in case of all former West German addresses is two days. The

Appellants have used this service for several years and always found them reliable. Usually the packages have reached the addressee within one day, well within the guarantee. Out of some 360 packages sent since June of 1992 through this service, only one apart from the case now in question was late, and that was one without a proper addressee to a P.O. box number in Saudi Arabia.

The reason for the late delivery, as explained by the Parcel Force service, was that although the package arrived in Germany on 30 September, it was held up by customs.

The data checking system of the representative for the Appellant does not add any time for the "10 day" rule. A dated reminder slip is attached to all files requiring action having to meet a deadline. The responsible representative therefore would prepare responses well in advance of the final deadline. The system is backed up by an independently-maintained computerised system which issues monthly reminders to each representative.

The reason the grounds of appeal were not sent earlier was that a meeting had to be arranged on 22 September - the date when the representative had actually planned to send off the Statement of Grounds - to discuss the details of a change of arguments that would strengthen the appeal according to an expert, whose affidavit to this effect was to be annexed to the Statement of Grounds. After the amendments had been made,

approval from the Appellant in the US had to be sought. Everything, except the affidavit, was completed by Friday, 25 September. On 28 September, the representative arranged for a telefaxed delivery of this item.

Although theoretically the Statement of Grounds could have been telefaxed, it was thought to be too cumbersome since it consisted of 91 pages. The representative, however, was confident that the express postal service would meet the delivery requirements, otherwise he would have had the document telefaxed in spite of its length. He had never before failed to meet a deadline.

According to a submitted copy of a letter from an enquiries officer at Parcel Force, dated 29 October 1992 and addressed to the Appellant, the item in question arrived in Germany on 30 September 1992 and passed to customs, which only released it to the Express Mail Service in Munich on 1 October 1992 at 15:30 hrs, which was too late for delivery that day. The item was finally delivered on 2 October 1992 at 09:45 hrs to an employee at the European Patent Office.

- V. In response to a communication by the Board, requesting further information regarding the Statement of Grounds, which as submitted had consisted of 19 pages, and on the fact that the package had already been released from customs on the afternoon of 1 October, the last day of the time period for filing the Statement of Grounds, the Appellant, on 26 January 1993, submitted essentially the following:

The originally intended Statement of Grounds would have contained 91 pages, but it was decided not to file the affidavits until the sworn copies had arrived, as a result of which the actually filed statement contained only 19 pages. However, at the time of planning the best route to get the documents to the EPO in due time, there was still the possibility that the signed affidavits would be available and therefore telefaxing was not a realistic option.

As to the question by the Board regarding the possibility for Parcel Force to have delivered the package the same day it was released from the German customs, this was beyond the control of the Appellant once they had engaged them to deliver it. Although it may seem as if the carrier would have had ample time to deliver it on time, this was still outside the control of the Appellant. Among other factors, Parcel Force would have had to sort out the relevant package from a batch of around 1000 or more mail items, as well as to bring it to the EPO before closing time, 1¼ hours after the release from customs. Parcel Force would not make use of the round-the-clock mail box at the EPO, since they needed a signed receipt in order to meet the condition under the guarantee that they deliver the package to the proper destination.

Reasons for the Decision

1. The request for re-establishment was submitted on 20 November 1992 and the corresponding fee was paid on the same date. The Statement of Grounds having been submitted already on 2 October 1992, all acts required under Article 122 have been carried out. As the date of removal of the cause of non-compliance with regard to the filing of the Statement of Grounds has to be calculated at 19 October 1992, starting from the communication of 9 October 1992 and adding ten days in accordance with Rule 78(3) EPC, the request meets all formal requirements and is therefore admissible.

2. The time limits given for appeals serve the object of legal security, i.e. the parties as well as the public will know immediately when the decision takes on full force, i.e. is no longer appealable. It also makes for economy of procedure. Re-establishment as an exception from this principle is therefore only open to a party who can show that the time limit was missed "in spite of all due care required by the circumstances having been taken" (Article 122(1) EPC).

3. It should first be made clear that the requirement of due care must be judged in view of the situation existing **before** the time limit expired. This means that the measures taken by the party to meet the time limit must only be judged with regard to the circumstances as they were at that time.

What must be considered in the present case is whether the choice of waiting until two days of the time limit were left and the further choice of a special carrier for the delivery are in keeping with the due care

requirement under the circumstances existing when the two choices were made.

4. The question thus first arises whether the Appellant could be said to have taken all due care required by the circumstances when allowing only two days for the delivery from the United Kingdom to Munich, Germany. As explained by the Appellant, the reason for the delay in sending off the Statement of Grounds was a last minute change of argumentation, which according to the Appellant required affidavits from experts in the United States.

According to the jurisprudence of the Boards of Appeal, a party wishing to file evidence in support of arguments and facts does not need to do so within the time limit given for the Statement of Grounds (or a notice of opposition as the case may be), but can do so at an appropriate later time. To have waited only for such evidence therefore is no excuse for having missed the time limit (see e.g. T 324/90, point 5, OJ EPO 1993, 33). A Statement of Grounds is sufficient for the purposes of Article 108 EPC, and thus admissible, if the legal and factual grounds are given in such a way and to such an extent that the appeal can be readily understood by any counterparty and the Board of Appeal.

To wait only for further affidavits would therefore not have been justified in the present case. However, after careful consideration of the arguments submitted in this regard by the Appellant, the Board has arrived at the conclusion that the delay also was caused by a change of reasoning, i.e. that the legal grounds of appeal had been shifted. Given this assumption, the

Board would be prepared to accept that the delay until two days before expiry of the time limit in question did not show lack of due care.

5. Given that the representative was entitled to wait for instructions in spite of the short time left, the Board finds reason to point out that the method of telefaxing immediately would spring into mind as an appropriate means of keeping the time limit. In this respect the Appellant explained that they thought a submission of more than 90 pages to be rather too cumbersome to telefax. The Board would on this point observe that, with the above jurisprudence in mind, only a summary of the legal arguments would have sufficed and no affidavits would have had to be included, and that in the end only 19 pages were in fact submitted.

In parallel situations for future cases, telefaxing should preferably be used. However, given that this is the first case in which the method of telefaxing appears to have been raised as an independent means of communicating submissions to the EPO, the Board accepts the explanation of the Appellant why this means was not used in this particular case.

6. A party who has missed a time limit must also show due care in their choice of method of delivery. The Board is satisfied that the choice of a special carrier was acceptable in view of the fact that they had earlier made use of such a delivery service without mishaps.
7. Another question related to the use of outside agents is whether or not, once a reliable carrier has been chosen and commissioned for the delivery, the party is

entitled to rely on them without having to instruct them further, for example with regard to the availability of a 24 hour receiving system (the EPO mail-box-system) or to request immediate reporting if there was a risk that the package could not be delivered on time.

The Appellant argued that they no longer had any control of the package once they had transferred it to Parcel Force, and that what happened thereafter was beyond their control, implying that they could not be held liable for the delay whatever happened after this transfer had taken place.

There is established jurisprudence within the Boards of Appeal of the EPO insofar as assistants are concerned. In such situations, it has been held that due care has been exercised also when **assistants** perform duties which are routine in character and do not require any particular professional knowledge normally expected in patent attorneys, **provided** that such assistants have been chosen, instructed and are being supervised with all due care (J 5/80, OJ EPO 1981, 343). No such corresponding jurisprudence has as yet been established with regard to **outside agents**.

The possible objection that there is no legal connection between an outside agent and the party does not seem correct. Such a legal tie exists in the sense that the contract with the agent is entered into by the representative on behalf of that party. If the agent (here the carrier) cannot accept conditions requested by the representative, the latter must consider whether he can enter into the delivery contract at all, knowing

that a lack of proper safeguards may be held against him under Article 122 EPC with regard to the due care requirement.

However, since the facts of the present case are exceptional in that the package was held in customs for 36 hours, an incident which could not reasonably be foreseen either by the postal service or by the professional representative - the Board accepts the argument that the package would have been delivered on time had it not been for this incident.

8. The Board is well aware that in the present case the very extraordinary circumstances regarding the withholding of the package by the customs office in Munich for 36 hours and a necessary sorting out of the relevant package from a batch of around 1000 or more mail items must also be given weight.

On balance, therefore, the Board is of the opinion that for this specific case the facts and arguments offered by the Appellant are sufficient to show due care, as required by Article 122(1) EPC. The request for re-establishment is therefore to be allowed.

Order

For these reasons it is decided that:

1. The request for re-establishment is allowed.
2. The appeal is admissible.

The Registrar:

The Chairman:

P. Martorana

P. Lançon