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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 12 August 1994

Case Number: T 0381/93 - 3.5.1

Application Number: 86302176.2

Publication Number: 0196857

IPC: H04N 3/195

Language of the proceedings: EN

Title of invention:
Transformer winding arrangement especially for video display

Applicant:
RCA Thomson Licensing Corporation

Opponent:
-

Headword:
Re-establishment/RCA Thomson

Relevant legal norms:
EPC Art. 108, 122

Keyword:
"Late-filed Statement of Grounds";
"All Due Care (yes)";
"Re-establishment (yes)"

Decisions cited:
J 0005/80; J 0007/82; J 0002/86; J 0003/86; J 0027/88;
T 0191/82; T 0667/92

Catchword:
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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0381/93 - 3.5.1

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 3.5.1
of 12 August 1994

Appellant: RCA Thomson Licensing Corporation
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Representative: Pratt, Richard Wilson
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Decision under appeal: **Decision of the Examining Division of the European Patent Office dated 20 November 1992 refusing European patent application No. 86 302 176.2 pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: P. K. J. van den Berg
Members: G. Davies
R. Randes

Summary of Facts and Submissions

I. Appellant's European patent application No. 86 302 176.2, filed on 25 March 1986 and claiming priority from US patent application No. 717 805 dated 29 March 1985, was refused by a decision of the Examining Division of the EPO dated 20 November 1992. Notification of the decision to the Appellant is deemed to have been effected on 30 November 1992 (Rule 78(3) EPC).

II. By letter filed on 14 January 1993, the Appellant's representative filed a notice of appeal against this decision, paying the appeal fee on the same day. On 7 June 1993, the Registrar of the Boards of Appeal sent the Appellant's representative a communication pursuant to Article 108 and Rule 65(1) EPC pointing out that the written statement setting out the grounds of appeal had not been filed within the prescribed time limit (which had expired on 30 March 1993,) and drawing his attention to the possibility of filing a request for re-establishment of rights under Article 122 EPC.

III. By letter dated 24 June 1993, received by the EPO by facsimile on 25 June 1993, the Appellant's representative filed the missing Statement of Grounds of Appeal and an application for re-establishment of rights under Article 122 EPC. Oral proceedings were requested should the Board be minded to refuse the application for re-establishment.

IV. The arguments of the Appellant's representative in support of the application for re-establishment of rights may be summarised as follows:

The Appellant's patent administration was controlled by GE and RCA Licensing Management Operation, Inc. (hereinafter referred to as "GERLMO"), in the USA. GERLMO had an administrative section known as IS&S and used the services of the London patent operation of its parent company, the General Electric Company (hereinafter referred to as "LPO"), for proceedings before the EPO. Thus, the Appellant's representative, the manager of LPO, was instructed in this case by GERLMO.

Routine tasks such as noting time limits and reminding representatives of due dates, were delegated by the Appellant's representative to the office manager, Mr King, who had over 30 years experience in the administration of patents and, at the time of the incident giving rise to the present case, had worked for LPO for 16 years. Mr King had handled the administration of European patent applications since the start of the EPO's operations. He operated a computerised record system for administering the patents and patent applications for which LPO was responsible.

LPO's staff also included four secretaries, whose duties included sending communications to the EPO, one of whom, Mrs Hurst, was involved in the present case.

In the present case, the Appellant's representative received instructions regarding the filing of the Statement of Grounds of Appeal from GERLMO by facsimile on 11 March 1993. He responded thereto, suggesting amendments on 16 March 1993 and, thereafter, the grounds of appeal were finalized on 18 March 1993 (a Thursday). In accordance with normal practice, the grounds of appeal were prepared for despatch to the EPO by DHL courier on Friday, 19 March 1993, in good time to meet the deadline of 30 March 1993. At the same time as the

package to the EPO was prepared, a second package enclosing **inter alia** a copy of the grounds of appeal was prepared for despatch to GERLMO. One air-bill (No. 691 379 570) was used for the package to be sent to the EPO, Munich, and another (No. 691 379 603) was used for the package to GERLMO. The packages were duly collected on 19 March 1993 by DHL. According to LPO's experience, it could be confidently expected that the package would be delivered to the EPO on the next working day, Monday, 22 March 1993.

It was LPO's practice to send all EPO mail by courier and, if urgent, first by facsimile with confirmation by courier. The secretaries normally prepared a DHL courier package containing communications to the EPO twice weekly, on Wednesdays and Fridays, and also prepared DHL courier packages for other destinations, including GERLMO, on the same days. There was an established procedure for labelling these packages and allocating the required DHL air-bills to the corresponding envelopes. These envelopes were collected by a DHL courier, who put LPO's packages into DHL's own plastic envelopes and the completed air-bills into the transparent pockets of DHL's envelopes.

LPO had used DHL's services for at least five years prior to the incident giving rise to this case, without mishap. The particular system of despatch referred to above had operated for at least three years. During that time, LPO had changed its practice from sending only urgent mail to the EPO by courier to sending all mail by that means.

On 25 March 1993, LPO received back from the EPO with a compliments slip the package containing the documents which had been addressed to GERLMO on 19 March 1993. The package was redirected that day to GERLMO with an

explanatory letter. It was also assumed at the time by Mr King that the package intended for Munich had been sent in error to GERLMO. Enquiries were made, therefore, by telephone of IS&S at GERLMO and DHL to check the situation. According to IS&S, they had received nothing so far from LPO. DHL confirmed that a package with air-bill No. 691 379 570 had been delivered to Munich. At that stage, Mr King concluded that both packages must have been delivered to Munich.

DHL's tracing department were also contacted by Mrs Hurst. On 1 April 1993, DHL informed Mrs Hurst that the envelope delivered to the USA with air-bill No. 691 379 603 had been empty when delivered to GERLMO on 22 March 1993 and signed for and gave LPO a free air-bill.

Mr King and Mrs Hurst then concluded that: both packages had been delivered to the EPO in Munich under air-bill 691 379 570; that air-bill 691 379 603 had been delivered with an empty plastic envelope to GERLMO; and that the EPO had returned the documents intended for GERLMO to LPO. There was no evidence at that time that the package intended for the EPO had not arrived in Munich. They consequently informed the Appellant's representative that DHL had made an error but that it had been corrected.

The fact that the package intended for the EPO had never arrived came to light in late May 1993. Mr King regularly obtained a due date report of all applications on which procedural steps were outstanding from LPO 's computerised records system. When a procedural step was taken, the date was entered as an "action taken" date. Such dates remained on the list until a "completion date" was entered following acknowledgement of the step taken from the recipient, e.g. the EPO. Mr King noticed

that the "action taken" date remained on the due date report in respect of the present application but was not unduly concerned at first because it seemed clear from the information he had about the DHL incident that the EPO had received the package; moreover, he knew that EPO Forms 1037 were usually but not always promptly returned and that his secretary had a backlog of work; it was possible, therefore, that she had not entered the "completion date" after receiving the returned Form 1037. However, he was sufficiently concerned by 25 May 1993 to telephone the EPO to check the situation and he then learnt from the Registrar of the Boards of Appeal that the Statement of Grounds of Appeal had never been received.

On 1 June 1993, Mrs Hurst contacted DHL again. They then provided, by facsimile, evidence of delivery of air-bills No. 691 379 570 and 691 379 603 to the correct addresses on 22 March 1993. The evidence of delivery indicated that the packages had been signed for by the recipients, and the package delivered to Munich had indeed been signed for. However, the package delivered to GERLMO had been marked "SOF", which means "signature on file" and that the package had not actually been signed for on delivery. Meanwhile, on 25 May 1993, Mr King set in train further investigations by GERLMO as a result of which the original Statement of Grounds of Appeal destined for the EPO was found on file, date-stamped 22 March 1993 IS&S.

The Appellant's representative was in the USA at the time and returned to the office on 1 June 1993. He became aware of the failure to file the grounds of appeal on 3 June 1993, when Mr King made a full report to him on the case.

It was submitted that the Appellant's representative had taken all the due care required by the circumstances: in particular, all due care had been taken in preparing the Statement of Grounds of Appeal for despatch to the EPO in due time on 19 March 1993 via DHL. LPO had an established procedure for preparing documents for despatch via DHL, which was reliable. LPO submitted that the evidence showed that in this case the package to GERLMO had been correctly addressed by LPO. They believed that the package addressed to the EPO had also been correctly addressed, although they had no copy thereof to prove it. The evidence also showed that two separate air-bills had been addressed to Princeton and Munich respectively. It was LPO's experience that DHL could be relied upon to allocate the correct packages to the correct air-bills on placing the former into DHL's own plastic envelopes with pockets for the latter, on collection. It was also their experience that DHL could also be relied upon to deliver packages to the EPO in Munich within twenty-four hours of despatch, or by the next working day if a week-end or official holiday intervened. LPO's use of DHL to despatch communications to the EPO thus represented a normally satisfactory system and the failure of the system in this case was an isolated procedural mistake.

As soon as LPO had been made aware that something had gone wrong when the package intended for GERLMO was returned to them on 25 March by the EPO, they had checked with DHL and GERLMO to ascertain what had been delivered and where. These checks led them to believe that the EPO had received the package intended for them. The fact that the Statement of Grounds had not been delivered to the EPO came to light as a result of the due care shown by Mr King in regularly checking the computer records.

It was therefore submitted that all the conditions for re-establishment of rights laid down in Article 122 EPC and in the case law of the Boards of Appeal were met in this case.

Reasons for the Decision

1. The application for re-establishment of rights fulfils the conditions laid down in paragraphs (2) and (3) of Article 122 EPC and is admissible. In particular, the Board finds that the date of the removal of the cause of non-compliance with the time limit was the date that the representative personally became aware of the fact that the time limit had not been observed, that is 3 June 1993 (cf. J 07/82 (OJ EPO 1982, 391), J 27/88 of 5 July 1989 (unpublished), and T 191/82 (OJ EPO 1985, 189).

2. Article 122 EPC provides for an applicant who, in spite of all the due care required by the circumstances having been taken, was unable to observe a time limit vis-à-vis the EPO, thereby losing a right or other redress, to have his rights re-established upon application subject to the conditions referred to in paragraph 1, above, being met. It is the established case law of the Boards of Appeal that, when an applicant is represented by a professional representative, a request for re-establishment of rights cannot be acceded to unless the representative himself can show that the due care required of the applicant or proprietor by Article 122(1) EPC has been taken. It is incumbent on the representative properly to instruct and to exercise reasonable supervision over the work of any assistant to whom the performance of routine tasks has been entrusted (J 05/80, OJ EPO 1981, 343). Moreover, Article 122 EPC is intended to ensure that loss of rights does not

result from an isolated mistake in an otherwise satisfactory system; thus an Appellant or its representative must be able to demonstrate that a normally effective system for monitoring time limits prescribed by the EPC was established at the relevant time in the office in question (J 02/86, J 03/86 (OJ EPO 1987, 362)).

3. The requirement of due care must be judged in view of the situation existing before the time limit expired . Having duly considered the evidence submitted in support of the present application for re-establishment of rights, the Board is satisfied that the Appellant's representative exercised all the due care required by the circumstances in this case. He has satisfactorily demonstrated that he has established in his office a normally effective system for monitoring the various time limits prescribed by the EPC in relation to European patents and patent applications handled by his office (cf. J 02/86 and J 03/86, **supra**). He has also demonstrated that all due care was taken to prepare the Statement of Grounds of Appeal in due time and to make arrangements for its despatch to the EPO by courier on 19 March 1993, well before the due date of 30 March 1993. Moreover, the Board is satisfied that the representative also took such care in the choice, instruction and supervision of his assistants, Mr King and Mrs Hurst, who were highly experienced and capable colleagues entrusted with routine tasks connected with the case (cf. J 5/80, **supra**).

4. It was submitted in evidence that the packages were correctly addressed to the EPO and GERLMO, respectively, by LPO and it appears from the evidence that air-bills with the numbers corresponding to the correct addresses were attached by DHL to two separate packages addressed to the EPO and GERLMO and recorded on DHL's shipping

bills. There is also proof that the package addressed to GERLMO was correctly addressed by LPO. Thus, the problem in this case arose from the failure of the courier service, DHL, to deliver the package to the EPO as instructed. A party who has missed a time limit must also show due care in their choice of method of delivery (T 667/92 of 10 March 1994, unpublished). The Board is satisfied that the choice of the courier service, DHL, was acceptable in view of the fact that LPO had made regular use of its services, without mishap, for a period of five years. In the Board's view, once a reliable carrier has been chosen and commissioned for the delivery, a party is entitled to rely on them provided that the party has given all the necessary and proper instructions to the carrier. In this connection, the Board finds that LPO's established procedure for preparing documents for despatch via DHL was reliable and that LPO's twice-weekly use of DHL's services to despatch communications to the EPO represented a normally satisfactory system and the failure of the system in this case was an isolated procedural mistake.

5. The question remains whether all the due care required by the circumstances was taken by LPO once they became aware on 25 March 1993 (five days before the expiry of the time limit) that the package for GERLMO had been delivered to the EPO in error. In this respect, the Board is also satisfied that Mr King and Mrs Hurst took considerable trouble to ascertain what had happened. In the light of the fact that the same day, 25 March 1993, DHL confirmed to LPO that the package with air-bill No. 691 379 570 had been delivered to Munich on 22 March 1993, it was not unreasonable in the circumstances to conclude from the information available to them at the time that the Statement of Grounds of Appeal addressed to the EPO had been duly delivered within the time limit.

6. Finally, it is the established case law of the Boards of Appeal that the duty of care in cases of re-establishment of rights applies not only to the applicant's representative but also to the applicant. An applicant is entitled to rely on its duly authorised professional representative to deal with the EPO. However, to the extent that it is on notice that a time limit has not yet been met and/or that instructions are required in order to meet it, an applicant has a duty to take all the due care in the circumstances to meet the time limit. According to the evidence, the delivery to IS&S of documents concerning this case on 22 March 1993 and the filing thereof appear not to have been properly recorded by IS&S, so that LPO was mistakenly informed that no documents had been delivered. It is necessary to consider, therefore, whether this constitutes a lack of care. Had the applicant had actual notice from LPO on 25 March 1993 that DHL had failed to deliver the Statement of Grounds of Appeal to the EPO, but had taken no action to remedy the situation, it may be that in such circumstances a finding of absence of due care would be justified. However, that is not the situation on the present facts as LPO had concluded at the time, on the basis of information received from DHL, that the package addressed to the EPO had been delivered and at that stage there was therefore no reason for the applicant to institute a search at the premises of IS&S and GERLMO. The Board is therefore satisfied that the applicant as well as his representative exercised all the due care required by the circumstances.

7. The Board is satisfied that all the due care required by Article 122(1) EPC was taken in this case. The application for re-establishment of rights is allowed and the Statement of Grounds of Appeal shall be deemed, therefore, to have been filed in time.

Order

For these reasons it is decided that:

The rights of the Appellant are re-established in relation to the filing of the Statement of Grounds of Appeal within the time limit prescribed by Article 108 and Rule 65(1) EPC.

The Registrar: The Chairman:

M. Kiehl P. K. J. van den Berg