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**D E C I S I O N**  
of 4 November 1998

**Case Number:** T 0764/97 - 3.5.2

**Application Number:** 90912566.8

**Publication Number:** 0484447

**IPC:** H01B 1/06

**Language of the proceedings:** EN

**Title of invention:**  
Composites and Methods for making the same

**Applicant:**  
Hyperion Catalysis International, Inc.

**Opponent:**

-

**Headword:**  
Restitutio/HYPERION CATALYSIS INT.

**Relevant legal provisions:**  
EPC Art. 122

**Keyword:**  
"Restitutio - all due care - assistant"  
"Notice of appeal - deemed not to have been filed"

**Decisions cited:**  
J 0005/80, J 0003/88, T 0715/91

**Catchword:**

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Europäisches  
Patentamt

European  
Patent Office

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Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number: T 0764/97 - 3.5.2

D E C I S I O N  
of the Technical Board of Appeal 3.5.2  
of 4 November 1998

Appellant: Hyperion Catalysis International, Inc.  
128 Spring Street  
Lexington, MA02173 (US)

Representative: Hoffmann, Eitle  
Patent- und Rechtsanwälte  
Arabellastrasse 4  
81925 München (DE)

Decision under appeal: Decision of the Examining Division of the  
European Patent Office posted 17 February 1997  
refusing the European patent application  
No. 90 912 566.8 according to Article 97(1) EPC.

Composition of the Board:

Chairman: W. J. L. Wheeler  
Members: B. J. Schachenmann  
M. R. J. Villemin

## Summary of Facts and Submissions

- I. European patent application No. 90 912 566.8 was refused by a decision of the Examining Division posted on 17 February 1997. The applicants (appellants) are a company having its place of business in the USA which was represented by US patent attorneys instructing the then responsible European professional representatives.
- II. By letter dated 28 March 1997, the European representatives sent a reminder to the US patent attorneys informing them that the filing of notice of appeal against refusal of the application and payment of the appeal fee was due on 17 April 1997 and that a written statement of grounds was due on 17 June 1997.
- III. By letter dated 16 April 1997 the US patent attorneys informed the European representatives that they were unable to locate the decision of refusal "with a response due on June 17, 1997". Accordingly, they asked for a copy of the document. At the same time, they instructed the European representatives to file the notice of appeal and to pay the appeal fee "before the June 17, 1997 due date in order to maintain the pendency of this application".
- IV. In reply, by facsimile letter of 23 April 1997, the European representatives referred to previous correspondence concerning "new working conditions" and pointed out that "without advanced payment from you, we are not in a position to proceed further with your cases". The letter went on to state that "if we do not receive BY FAX ON APRIL 24, 1997, copy of the payment corresponding to the Appeal fee for the EP-90 912 566.8, (...) we will be obliged to immediately resign our representation for the above patent with the E.P.O. and the patent may be rejected".

- V. On the same day, i.e. on the 23 April 1997, the US patent attorney in charge of the case reacted by preparing and signing a cheque for the appeal fee. He instructed his secretary to immediately fax a copy of that cheque and to forward the original to the European representatives. However, neither the fax message nor the original ever reached the European representatives.
- VI. On 25 April 1997, the European representatives informed the European Patent Office by facsimile that they were no longer representatives for the European patent application No. 90 912 566.8. A copy of that letter was transmitted by facsimile to the US patent attorneys and was received there at noon on the same day. However, the responsible US patent attorney did not become aware of that letter until 29 April 1997 when the file was returned to him, at his request, for further action in this connection. At that time he noted that the file contained no record of the transmission of the cheque to the European representatives.
- VII. On 17 June 1997 newly appointed European representatives filed a notice of appeal against the decision of the Examining Division of 17 February 1997 and paid the appeal fee. At the same time they filed an application for restitutio in integrum under Article 122 EPC with respect to the period for filing the notice of appeal which had expired on Monday, 28 April 1997.
- VIII. In support of the application for restitutio in integrum it was submitted that for reasons which were still not clear the secretary of the US patent attorney had not faxed the copy of the cheque to the former European representatives as requested by them as a precondition for their filing the appeal. Apparently, the letter and the cheque had been lost or misplaced somewhere in the offices of the US patent attorneys. In

any case, a search had failed to uncover the letter and the cheque. However, the misplacement of the cheque and letter represented an isolated event in the time-tested, reliable system employed by the US patent attorneys to monitor terms set by the EPO and to inform the responsible European representatives of actions to be taken. Moreover, the secretary was an experienced, extremely trustworthy and reliable person held in very highest regard by the attorneys and the law firm administration. She was therefore routinely entrusted with difficult and time sensitive matter.

- IX. On 18 August 1997 the Board issued a first communication indicating that most of the appellants' submissions were not supported by evidence. In particular, the appellants were asked to establish that, during the critical period, the US patent attorney in charge had indeed exercised reasonable supervision over the work of the secretary and to explain for which reason he had not immediately reacted to the facsimile of 25 April 1997 with which the European representatives resigned from representation in respect of the patent application in question.
- X. In response to that communication the appellants filed respective affidavits signed by the US patent attorneys involved and by the secretary. In the event that restitutio was not granted based on the filed written submissions, oral proceedings were requested.
- XI. In the annex to the summons for oral proceedings issued on 30 March 1998 the Board pointed to some discrepancies in the argumentation supporting the application for restitutio. Furthermore, it indicated that, considering the then imminent expiry of the appeal period and the impending resignation of the European representatives, the handling of the case during the critical period appeared to go far beyond

mere routine work which could be delegated to a secretary. In this context reference was made to an earlier decision T 715/91. In addition, it seemed that the secretary was not properly advised as to the impending resignation of the European patent attorneys nor the urgency of the case. Otherwise, when reviewing the facsimile letter received from the European representatives on 25 April 1997, she would immediately have recognized that the responsible patent attorney had to be alerted. For these reasons it appeared that not all due care required by the circumstances had been taken.

- XII. At oral proceedings held on 4 November 1998, the appellants repeatedly insisted that faxing the copy of the cheque for the appeal fee with the accompanying letter *per se* had to be considered as a routine task which, under any circumstances, would fall on the secretary as a result of her professional qualifications. In that context they referred to decisions J 5/80 and J 3/88 of the Legal Board. Furthermore, they maintained that the secretary was properly instructed and reasonably supervised. Even if she had received the facsimile copy of the letter dated 25 April 1997 of the European representatives in time, she would have had no reason whatsoever to attend to the matter since the letter was neither marked 'URGENT' nor addressed directly to the responsible US patent attorney.

## Reasons for the Decision

1. According to Article 108 EPC notice of appeal must be filed in writing at the European Patent Office within two months after the date of notification of the decision appealed from. Taking Rule 78(3) EPC into account, the decision under appeal dated 17 February 1997 is deemed to have been notified on 27 February 1997. The period for filing the notice of appeal therefore ended on Monday, 28 April 1997. However, the notice of appeal was not filed until 17 June 1997 together with the application for restitutio in integrum under Article 122 EPC. In these circumstances the notice of appeal is deemed not to have been filed unless restitutio in integrum can be granted.
2. The appellants' application for restitutio in integrum complies with the formal requirements provided for in Article 122(2) EPC and is therefore admissible. Thus, the issue at stake is whether or not, according to Article 122(1) EPC, all due care required by the circumstances of the particular case was taken to comply with the time limit for filing the notice of appeal.
3. During the critical period the European professional representatives cooperated with the US patent attorneys from which they received the instructions on how to proceed with the present European patent application. The due care requirement therefore not only applies to the European representatives but also to the US patent attorneys acting on behalf of the appellants (see J 3/88, point 3 of the reasons).

4. As submitted by the appellants the principal reason for the failure to comply with the time limit for filing the notice of appeal was an error of the secretary of the US patent attorney (see point VIII, supra). In this context, they referred to the jurisprudence of the Boards (J 5/80) according to which a request for re-establishment of rights can be acceded to in the event of a culpable error on the part of an assistant, if the professional representative is able to show that he has chosen for the work a suitable person properly instructed in the tasks to be performed, and that he has himself exercised reasonable supervision over the work. According to the appellants' submissions all these conditions were complied with in the present case.
  
5. However, decision J 5/80 also points out that a representative cannot relieve himself of responsibility for carrying out tasks which, by reason of his qualification, fall upon him personally. This is especially true for tasks which exceed the scope of mere routine tasks. If he delegates such tasks to an employee and if the latter makes an error in the course of that work which results in the failure to observe a time limit, the representative cannot establish that he took all due care required by the circumstances (J 5/80, points 8 and 9 of the reasons).
  
6. Though, under normal conditions, the faxing of the copy of a cheque for the appeal fee with an accompanying letter is indeed a task falling within the meaning of a routine task of a secretary, this is no longer true for an emergency situation such as clearly existed after receipt of the letter of the European representatives dated 23 April 1997 (see point IV, supra). At that time the imminent expiry of the appeal period together with the impending resignation of the European representatives created a situation which required



extra care and did not allow the US patent attorney to merely delegate the further handling of the case to a secretary. Considering the particular circumstances of the case, the patent attorney should have ascertained that, in order to avoid a loss of the application, the facsimile transmission of 23 April 1997 was successful and had reached the European representatives on or before the deadline of 24 April 1997 (see point IV, supra). However, it was not submitted by the appellants that any such supervision had taken place.

7. Moreover, the appellants were not able to displace the Board's doubts as to whether the secretary was properly instructed by the responsible patent attorney in view of the impending resignation of the European representatives and the urgency of the case (see point XI, supra). The appellants' argument that the mail room and the secretary had no reason whatsoever to treat the facsimile letter of 25 April 1997 from the European representatives with any expediency rather seems to indicate that the instruction was insufficient. Had the secretary been informed on the particulars of the case, i.e. on the impending resignation of the European representatives, she would immediately have recognized the importance of the facsimile letter of 25 April 1997 and treated it accordingly. The fact that it arrived on the desk of the responsible patent attorney only three working days after receipt, does not, in any case, support the appellants' submission that the secretary was sufficiently aware of the circumstances of the case. In addition, the fact that, according to her affidavit of December 1997, she had no recollection of the facts and circumstances surrounding the events in April 1997, tends to weaken, rather than support, the appellants' submission.

8. In conclusion, the Board holds that the responsible US patent attorneys were not able to establish that all due care required by the particular circumstances of the present case had been taken to comply with the time limit for filing a notice of appeal. For this reason the application for re-establishment of rights with respect to the appeal period is refused.

It is therefore not necessary for the Board to further consider whether all due care required by the circumstances was taken on the side of the European representatives when they withdrew their services shortly before the end of the appeal period.

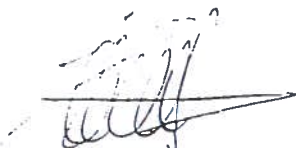
9. Thus, as set out in point 1, supra, the appeal is to be deemed not to have been filed. Since the purpose of the appeal fee cannot be achieved, it shall be repaid.

### Order

**For these reasons it is decided that:**

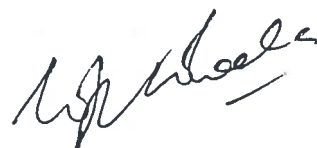
1. The application for re-establishment of rights is refused.
2. The appeal is deemed not to have been filed.
3. The appeal fee shall be reimbursed.

The Registrar:



M. Kiehl

The Chairman:



W. J. L. Wheeler