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## **DECISIONS OF THE BOARDS OF APPEAL**

**Decision of Technical Board of Appeal 3.3.5 dated 23 February 2001**

**T 428/98 - 3.3.5**

(Translation)

Composition of the board:

Chairman: R. K. Spangenberg

Members: M. B. Günzel

G. J. Wassenaar

**Patent proprietor/Respondent: Klima, Hans-Horst**

**Opponent/Appellant: Rudolf Messner**

**Headword: Re-establishment/KLIMA**

**Article: 108, third sentence, 122(1), (2) and (3) EPC**

**Rule: 65(1), 78(2) and (3), 83(4), 85 EPC**

**Keyword: "Re-establishment of rights in respect of time limit for filing grounds of appeal" - "Application filed in time (yes)" - "Reliance on information justified" - "Satisfactory evidence of all due care (no)" - "Insufficient proof of normally satisfactory time-limit monitoring system" - "Failure to submit evidence despite board's request to do so" - "Sign that veracity may be doubted"**

## Headnote

*I. Where a communication from the Office notifies an applicant that he has missed a time limit, the cause of failure to complete the omitted act within the meaning of Article 122(2), first sentence, EPC is as a rule removed on the date when the applicant actually receives the communication, provided that failure to complete the act was purely due to previous unawareness that the act had not been completed. The legal fiction of deemed notification under Rule 78(3) EPC (in the version in force until 31 December 1998) has no effect on the date of removal of the cause of non-compliance, even if this works against the applicant because the actual date of receipt of the communication precedes the date calculated according to Rule 78(3) EPC (2.2).*

*II. An appellant may rely on information which the board's registrar can be proved to have provided by telephone concerning the method for calculating a time limit the appellant has to observe before the board if the point of law on which that information is based has at that time not yet been clarified in the case law of the boards of appeal (2.2).*

*III. Generally speaking, to satisfy the requirement of all due care, a system for monitoring time limits must not leave time-limit monitoring in the hands of just one person, but must incorporate at least one effective cross-check (confirmation of established case law, 3.5).*

*IV. Failure to submit evidence despite being requested to do so by the board may be viewed as a sign that the evidence would perhaps not confirm what has been claimed (3.6).*

## Summary of facts and submissions

I. The appeal lies from the opposition division's decision of 9 March 1998 maintaining European patent No. 0 563 508, application No. 92 890 079.4, in amended form.

II. The appellant is the opponent. On 23 April 1998 he filed an appeal against the opposition division's decision and paid the appeal fee.

III. In a letter dated 21 August 1998, the board's registry notified the appellant that he had not stated the grounds for his appeal against the opposition division's decision and that the appeal was therefore likely to be rejected as inadmissible under Article 108 and Rule 65(1) EPC. The letter referred to Article 122 EPC (Restitutio in integrum). According to the appeal dossier, this letter was delivered to the appellant's representatives on 24 August 1998.

IV. In a communication dated 27 October 1998, received at the EPO on 28 October 1998, the appellant sought re-establishment of his rights in respect of the time limit for filing the statement of grounds of appeal, paid the fee for re-establishment of rights, and filed the required statement of grounds and his application for re-establishment of rights. He cited Rule 78(3) EPC (in the version in force until 31 December 1998) as proof that he had filed the latter application in time.

V. In an initial communication the board expressed its provisional opinion that the start of the two-month period after removal of the cause of non-compliance, within which the application for re-establishment had to be filed under Article 122(2), first sentence, EPC, depended on the date until which the applicant or proprietor had actually been unable to complete the omitted act. The legal fiction of deemed notification under Rule 78(3) EPC did not apply to the present situation. In cases where an opponent could have his rights re-established in accordance with G 1/86, OJ EPO 1987, 447, the principles for the interpretation of Article 122 EPC developed for applicants and proprietors were to be applied. Hence the cause of non-compliance with the time limit in the present case had been removed on the day on which the appellant's representative had been made aware of the missed time limit. That was 24 August 1998, the date of receipt of the registry's communication of 21 August 1998.

VI. The appellant contested this legal opinion, referring to J 29/94, OJ EPO 1998, 147. He further pointed out that a patent agent in the law office representing him in the present appeal proceedings had phoned the board's registrar on behalf of his professional representatives on 13 October 1998. Even without the legal fiction of Rule 78(3) EPC, that had been before expiry of the time limit for filing the application for re-establishment. The board's registrar had confirmed that Rule 78(3) EPC was to be applied for purposes of calculating the two-month period under Article 122(2) EPC. An affidavit sworn by the patent agent and confirming this was submitted.

VII. At the request of the board, its registrar made an official statement regarding the alleged event.

VIII. To substantiate his application for re-establishment of his rights, the appellant argued as follows:

After notification of the opposition division's decision, the senior clerk responsible for maintaining the law office's time-limit calendar had recorded the time limit for appeal and the time limit for filing the statement of grounds, noting 9 July 1998 as the date when the latter expired. It was no longer possible to reconstruct exactly what had happened on 2 July 1998; but the clerk, for reasons she herself could not explain and without any direct or indirect instruction to do so, had crossed out the time limit for filing the statement of grounds as if it had been met, even though no statement had been filed. That whole week, and especially on that day, the clerk had been suffering from severe headaches. She could only imagine she had crossed out the time limit because of her poor health combined with a possible mix-up with an appeal case before the Federal Patents Court, where it was not essential to state the grounds for an appeal. The clerk had worked in the appellant's representatives' law office for 33 years, was an extremely reliable specialist and had never missed a time limit before. The office's patent agents held regular meetings, which the clerk too attended, stressing the need for careful work and the specific requirements of work which was linked to time limits, and emphasising the legal consequences. The

appellant submitted affidavits to that effect from the clerk and the appellant's representatives in the present case.

IX. In a further communication, the board said the applicability of the legal fiction of deemed notification in Rule 78(3) EPC to the calculation of the time of removal of the cause of non-compliance was an issue which had not been explicitly resolved in board of appeal case law. Its provisional view therefore was that the appellant had rightly relied on the information the board's registrar had provided by telephone with regard to the time by which he had to file his application for re-establishment of rights, and that in the present case that application had to be considered as having been filed on time.

On the issue of whether the appellant's arguments justified the conclusion that he had been unable to comply with the relevant time limit despite taking all due care required by the circumstances, the communication had the following to say:

The erroneous crossing out of a time limit by a normally reliable clerk, attributable to her temporary health problems, might be held to constitute an isolated mistake which could justify re-establishment of rights. Yet in such a case it also had to be demonstrated that a normally satisfactory system for monitoring time limits had been in place in the law office and had failed purely on account of the specific circumstances of the case. Generally speaking, under existing board of appeal case law, to satisfy the requirement of all due care a system for monitoring time limits must not leave monitoring in the hands of just one person, but must incorporate at least one effective cross-check. On that issue the appellant had so far been silent. The law office's patent agents may, as argued by the appellant and substantiated by an affidavit from the patent agents Dr Hafner and Dr Stippl, have held regular meetings, which the clerk too had attended, referring in general terms to the requirements of work which was linked to time limits and to the importance of careful work; but that said nothing about the actual nature of cross-checks on time-limit monitoring and on correct working practice, if indeed any were conducted. The board also considered it normal and reasonable to expect all available associated evidence

to be submitted in support of the claimed sequence of events, which in this case meant not just affidavits from the employee in question but, for example, the appropriate extract from the time-limit calendar of the appellant's representatives to which the appellant had referred.

X. The appellant replied as follows:

The staff of his representatives' law office currently comprised two patent agents, two lawyers, a partly qualified patent lawyer (Patentassessorin) and a law graduate, plus a senior clerk and at any given time at least two paralegals. Thus the employees responsible for monitoring time limits were specially qualified and highly experienced.

Mandatory time limits were not only recorded in the main calendar, but were always noted on a time-limit flag on the file, in duplicate and clearly visible, so even the external appearance of the file made it clear that a time limit had been recorded and needed to be observed. Shortly after the time limit had first been recorded, the file was forwarded to the person responsible for it, who then had to cross-check the time limit recorded on it. Moreover, the office's entire staff were under strict instructions to check for compliance with the time limit at each significant movement of the file, and were repeatedly alerted by patent agents, at daily meetings and with reference to specific cases, to the care that had to be taken over monitoring time limits and applying the cross-checking mechanisms.

No other evidence was submitted.

XI. The respondent's view was that the appeal should be rejected as inadmissible for late filing of the statement of grounds. The appellant had failed to demonstrate that his representatives had taken all due care required by the circumstances. Simply telling employees what their duties were was not enough. It was up to a representative to ensure that these duties were actually performed and were not grossly neglected merely because one employee had a headache.

XII. The appellant requests

that his rights be re-established in respect of the time limit for filing the statement of grounds of appeal and that the patent be revoked.

The respondent requests

that the appeal be rejected as inadmissible, and auxiliarily that the appeal be dismissed.

### **Reasons for the decision**

1. Under Article 108, third sentence, and Rules 78(3) (in the version in force until 31 December 1998), 83(4) and 85(1) EPC, the time limit for filing the statement of grounds for the appeal against the opposition division's decision of 9 March 1998 expired on 20 July 1998. The statement of grounds was filed on 28 October 1998 and was therefore late. Under Rule 65(1) EPC, an appeal for which no statement of grounds is filed within the time limit laid down in Article 108, third sentence, EPC is to be rejected as inadmissible.

#### *Admissibility of the application for re-establishment of rights*

2. In his submission of 27 October 1998, received at the EPO on 28 October 1998, the appellant, who had been the opponent in proceedings before the opposition division, applied for re-establishment of his rights in respect of the time limit for filing the statement of grounds of appeal.

2.1 According to the Enlarged Board decision in G 1/86, OJ EPO 1987, 447, an appellant as opponent may 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. The principles for the interpretation of Article 122 EPC established in respect of applicants and proprietors apply here too.

2.2 Under Article 122(2), first sentence, EPC, the application for re-establishment of rights must be filed within two months of the removal of the cause of non-compliance with the time limit.

According to the appellant, his representatives were unable to observe the time limit for filing the statement of grounds because their office's senior clerk on 2 July 1998 had by mistake crossed out the 9 July time limit as if it had been met. As the board understands it, the appellant means by this that, because of this mistake, his representatives had been unaware that no statement of grounds had been filed.

Yet they were aware of this omission no later than 24 August 1998, when they received a communication to that effect from the registry. Re-establishment of rights in respect of the above time limit was applied for in the communication received at the EPO on 28 October 1998, which is over two months after 24 August.

The appellant's claim that the application for re-establishment of rights was filed in time is based on Rule 78(3) EPC in the version in force until 31 December 1998, under which a notification - in this case the registry's communication of 21 August 1998 - effected by registered letter is deemed to be delivered to the addressee on the tenth day following its posting.

In the board's view, as already stated in its first communication to the parties, this legal fiction of deemed notification in Rule 78(3) EPC is not applicable to the question of when the cause of non-compliance with a time limit was removed within the meaning of Article 122(2), first sentence, EPC. The boards have consistently ruled that the time when the cause of non-compliance is removed is a matter of fact. It depends on the time until which the applicant was actually unable to complete the omitted act. Hence the legal fictions of Rule 78 EPC cannot be applied in determining this time in connection with a communication from the Office. In fact, the cause of failure to complete an omitted act is as a rule removed when the notification informing the applicant of his omission is actually received, where this omission was due solely to unawareness that the act had not been completed (established case

law pursuant to J 7/82, OJ EPO 1982, 391, Reasons 3 and 4; see in particular J 27/90, OJ EPO 1993, 422, Summary III and Reasons 2.3, 2.4 and 2.5, first paragraph of each).

That has been recognised in board of appeal decisions relating both to Rule 78(2), first sentence, and to Rule 78(3) EPC in the version in force until 31 December 1998, in cases where non-application of the legal fictions was to the parties' advantage because they had indeed received a notification from the Office later than the time calculated in accordance with Rule 78 EPC or because there was no evidence that the notification had ever been delivered (re Rule 78(2) EPC see J 7/82 *loc. cit.* and Headnote I and, for example, J 22/92 of 15 December 1994, Reasons 3.3.2; re Rule 78(3) EPC see J 15/84 of 4 June 1985, Reasons 2 ff).

In principle, the time of removal of the cause of non-compliance within the meaning of Article 122(2) EPC depends on the actual time at which the applicant or his representative became or must have become aware of the missed time limit. In the board's view, this principle can only be applied uniformly, and must therefore apply even if in specific instances it works to the applicant's disadvantage. That, too, has already been recognised in case law in a different context. Thus the applicant cannot cite the date of receipt of an Office notification about a missed time limit as the time of removal of the cause of non-compliance if it is clear for other reasons that he or his representative was aware of the omission beforehand (J 17/89 of 9 January 1990, Reasons 4 and 5; T 900/90 of 9 January 1990, Reasons 2.2).

However, the boards of appeal have not yet expressly ruled on whether Rule 78(3) EPC is still inapplicable to the date of removal of the cause of non-compliance within the meaning of Article 122(2) EPC even if this works to the applicant's disadvantage, although some decisions, such as that cited by the appellant in support of his conflicting opinion (J 29/94, OJ EPO 1998, 147), may seem to suggest that what matters in this case too is the actual date of receipt of the notification. The cited decision states (Reasons 3) that the appellant was aware of his omission at the latest when he actually received the communication from the EPO, and in the

appellant's favour it was merely assumed that he did not receive the communication before the tenth day following its posting (Rule 78(3) EPC). Yet as far as can be established, the view expressed here has not hitherto played a deciding role in any board of appeal ruling.

In these circumstances, in determining the date by which they had to file their application for re-establishment, the appellant's representatives were in the board's view entitled to rely on the information supplied on the phone by the board's registrar, which indicated that Rule 78(3) EPC was to be applied in calculating when the time limit for filing the application for re-establishment expired. In the light of the board registrar's official statement, the board considers it proven that the appellant's representatives were given this information, even if the registrar could no longer remember the exact date of the phone call, merely that it had taken place in October 1998. At the same time, however, the registrar testified that she had been asked a question of that nature only once since joining the Office on 1 March 1998, and a representative would normally request such information at a time when he could if necessary still take the required steps even if he received a negative answer. So the board believes the affidavit of the patent agent in the office of the appellant's representatives testifying that he had conducted this phone call with the registry on 13 October 1998 and had therefore acted in time before expiry of the time limit for filing the application for re-establishment, even assuming 24 August 1998 was the date of removal of the cause of non-compliance. The respondent did not contest this view, provisionally declared in the board's second communication.

The application for re-establishment of rights is therefore deemed to have been filed in time.

2.3 As the fee for re-establishment was paid at the same time as the application for it was filed, and as the grounds for both application and appeal have been stated, the requirements of Article 122(2), second sentence, and (3) EPC have likewise been met. The application for re-establishment of rights is admissible.

*Allowability of the application for re-establishment of rights*

3. The appellant has however failed to provide satisfactory evidence that he was unable to comply with the time limit for filing the statement of grounds of appeal despite taking all due care required by the circumstances in accordance with Article 122(1) EPC.

3.1 The appellant argued that the time limit had been missed because of an isolated mistake made by a highly reliable and experienced clerk in the law office of his representatives. This clerk, who was responsible for maintaining the office's time-limit calendar, had on 2 July 1998 mistakenly crossed out in that calendar the 9 July time limit for filing the statement of grounds, as if it had been met.

3.2 According to established board of appeal case law pursuant to J 5/80, OJ EPO 1981, 343, when an applicant is represented by a professional representative, a request for restitutio in integrum cannot be acceded to unless the representative himself can show that he has taken the due care required of the applicant by Article 122(1) EPC. The representative may entrust assistants with routine tasks, which generally include the recording and monitoring of time limits. Case law has also held that assistants cannot be expected to meet the same rigorous requirements of care as the applicant or his representative (J 5/80, loc. cit., Reasons 6).

3.3 Under established board of appeal case law, restitutio in integrum is intended to ensure that an isolated mistake within a normally satisfactory system does not result in an irrevocable loss of rights. (See the case law references in: Case Law of the Boards of Appeal of the European Patent Office (Case Law), 3rd edition 1998, VI-E, 9.2.2.)

3.4 The erroneous crossing out of a time limit for filing grounds by a normally reliable employee, where attributable to temporary health problems of that employee, may constitute an isolated mistake.

3.5 However, case law rules that in such a case it must also be demonstrated that the law office operated a normally efficient time-limit monitoring system (see case law references in: Case Law, loc. cit.) which had failed only for very specific reasons. Under case law, one of the requirements of care applicable to a time-limit monitoring system is generally that monitoring should not be left in the hands of just one person; the chosen monitoring system should incorporate at least one effective cross-check (Case Law, VI-E, 9.2.3; see for example T 828/94 of 18 October 1996, Reasons 2 ff, with other case law references).

On this issue, however, the appellant's representatives were silent, even after the board's express reference to this legal situation. In reply to the communication they merely said that, in their office, time limits were recorded not only in the time-limit calendar but on a time-limit flag on the file, in duplicate and clearly visible, and that shortly afterwards the file was forwarded to the person responsible for it, who then had to cross-check the recorded time limit. But no further indication was given of steps taken to ensure that the recorded time limit was actually met. For an effective time-limit monitoring system it is not enough merely to note down a time limit. There must also be a reminder mechanism which ensures that the file is processed in time before the time limit expires. Yet the appellant's representatives have said absolutely nothing about how office procedures and file handling are organised. In particular, they have not demonstrated the existence of any kind of cross-checking mechanism, in the form either of time-limit counter-checking by someone else or of other measures such as a computer-assisted reminder system. The fact that, as the appellant's representatives have argued, the office's entire staff are under strict instructions to check for compliance with the time limit at each "significant movement" of the file is not sufficient, as it is a matter of chance whether files subject to time limits are "significantly moved", before the time limit expires, for other reasons such as an enquiry or instructions from the client. Thus general orders of this kind are not suited to ensuring that, in normal circumstances, a file subject to a time limit is brought to the attention of the person responsible for it before the time limit expires in spite of a mistake on the part of the person responsible for time-limit monitoring; to say nothing of the fact that the notion of "significant file movement" is

anything but clear. In the present case the file was evidently not "significantly moved", as the appellant's representatives were not alerted to the failure to observe the time limit for filing the statement of grounds until the registrar notified them of the loss of rights.

Thus, on the basis of the appellant's representatives' submission, it may be assumed as far as the present case is concerned that the clerk's erroneous crossing out of the time limit for filing the statement of grounds resulted in non-compliance with that time limit and that, given the failure to demonstrate any other systematic monitoring or cross-checking mechanisms despite the board's indication of the need to do so, a mistake on the part of the clerk was certain to cause the time limit to be missed unless some other member of the office's staff chanced in time to notice the file and the fact that the time limit had been crossed out as met in the time-limit calendar but not in the file itself.

In very special circumstances, the boards of appeal have been prepared to consider a representative to have exercised all due care even though there was no all-purpose cross-checking mechanism independent of the person responsible for time-limit monitoring; but that was only in cases where the representative's office was a small unit in which he essentially bore sole responsibility for substantive processing of the files and the demand for time-limit monitoring was accordingly limited, and where time-limit monitoring also involved intensive personal co-operation between the representative and his assistant (see for example J 31/90 of 10 July 1992, Reasons 4 ff, and T 166/87 of 16 May 1988, Reasons 2). The exceptional nature of this ruling has been stressed, and the present situation is not comparable. According to the appellant's submission, his representatives' office is staffed by two patent agents, two lawyers, a partly qualified patent lawyer (Patentassessorin) and a law graduate, ie six people dealing in their main professional capacity with cases relating to intellectual property rights. Such cases are commonly subject to time limits, with immediate negative legal consequences for the client if a time limit is missed. Thus in such an office time-limit monitoring is a major undertaking in terms of both significance and scale.

3.6 Moreover, even allowing for the clerk's affidavit, given the conduct of the appellant's representatives in the present case the board sees fit to doubt that the appellant's description of how the time limit was recorded and crossed out in his representatives' office actually reflects what happened. It should have been easy for his representatives to provide written evidence, eg a copy of the entries in the time-limit calendar and the time-limit flag on the file, to substantiate what the clerk said in her affidavit; how the latter came to be made, moreover, the board cannot imagine. The appellant's representatives were even expressly requested in the board's second communication to submit all written evidence available in connection with the alleged events, especially an extract from the time-limit calendar referred to by the appellant. Failure to submit any of the written evidence which ought to exist according to the appellant's submission, or to give any reason for not doing so, is seen by the board as a sign that these documents might not have confirmed what had been claimed.

4. The application for re-establishment of rights in respect of the filing of the statement of grounds of appeal is therefore to be refused, and the appeal is to be rejected as inadmissible under Article 108, third sentence, and Rule 65(1) EPC.

## **Order**

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

1. The appellant's application for re-establishment of rights in respect of the time limit for filing the statement of grounds of appeal is refused.
2. The appeal is rejected as inadmissible.