



Beschwerdekammer in Disziplinarangelegenheiten

Disciplinary Board of Appeal

Chambre de recours statuant en matière disciplinaire

Boards of Appeal of the
European Patent Office
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Case Number: D 0001/21

D E C I S I O N
of the Disciplinary Board of Appeal
of 14 February 2022

Appellant: N.N.

Decision under appeal: **Decision of the Disciplinary Board of the
European Patent Office in case DB 04/19 dated
31 March 2021**

Composition of the Board:

Chairman: W. Sekretaruk
Members: C. Brandt
I. Beckedorf
D. Korper Žemva
A. Hooiveld

Summary of Facts and Submissions

- I. The appeal is against the decision of the Disciplinary Board of the European Patent Office, hereinafter "Disciplinary Board", of 31 March 2021 concerning case DB 04/19, holding that the representative concerned committed a breach of duties, in particular according to Article 1 Regulation on discipline for professional Representatives (RDR) and Article 1(d) Code of Conduct of the Institute of Professional Representatives before the European Patent Office (CoC of epi), following a complaint of a client of the accused representative. The case was referred to the Disciplinary Board by the Disciplinary Committee according to Article 6(2)(c) RDR.

- II. The appellant is the President of the Institute of Professional Representatives before the European Patent Office (appellant).

- III. As regards "**I. Summary of facts and submissions**" and "**II. Reasons for the decision**" the decision of the Disciplinary Board can be summarised as follows:
 - (a) The Disciplinary Board pointed to the obligation of the professional representative to take adequate preventive measures to safeguard the client's / complainant's interests in the event that he should be prevented from exercising his profession due to illness or other unforeseen circumstances according to Article 1(4) CoC of epi. As further explained in the appealed decision the representative failed to provide any explanation why their health problems obviously allowed them to take certain organisational measures as pre-payment requests

(points 5. to 7. of the decision under appeal) and the organisation of meetings, as the meeting with the representative and the client on 14 August 2018, but made it impossible to exercise and realise these duties and tasks for the protection of their client, which is the complainant, in particular, why the advanced payments of annual fees by the client to the representative in respect of three European patent applications (see points 5. to 7. of the decision under appeal) were not processed to the EPO.

- (b) The Disciplinary Board furthermore stated a violation of Article 1(1) RDR, according to which the professional representative shall exercise their profession conscientiously and in a manner appropriate to their dignity and in particular, shall not knowingly make any false or misleading statement. During the meeting on 14 August 2018 the representative intentionally gave the impression that they were in full control of the processing of the patent applications EP 14830743 and EP 15828890, for which renewal fees and respective surcharges had not been paid in due time (see points 5. and 6. of the decision under appeal), and that there was no reason to worry. However, the representative in this regard knowingly made false and misleading statements and put the client's rights at risk.
- (c) Concerning the non-payment of the renewal fees regarding the EP- applications EP 14830743 and EP 15828890 (see points 5. and 6. of the decision under appeal) the examining division allowed the request for re-establishment of rights submitted by another representative appointed by the client.

Regarding a third EP-application EP 13461533 (see point 7. of the appealed decision) the client/complainant itself managed to avoid a loss of rights by transferring the amount including the surcharge to the EPO.

IV. **Part III.** of the decision contains the following **Order:**

"For these reasons, the Disciplinary Board has decided to delete the Professional Representative from the list of professional representatives for a period of nine (9) months (Article 4(1)(e) RoD). At the end of this period, the Professional Representative will be re-entered on the list of professional representatives on request, accompanied by a medical certificate confirming that their health condition allows them to exercise their profession."

V. The decision of the Disciplinary Board was notified to the appellant on 8 April 2021. The notice of appeal was filed with letter dated 10 May 2021 and the statement of grounds of appeal with letter dated 17 June 2021.

(a) According to the statement of grounds of appeal the appeal is particularly directed against part III. "Order" of the Disciplinary Board's decision, which is found not to be in compliance with Article 4 RDR, since a period of nine months was neither "for not more than six months" (Article 4(d) RDR), nor "for an indefinite period" (Article 4(e) RDR). Regarding Article 4(e) RDR the appellant referred to D 11/91. A first question, which was to be answered in the affirmative with regard to Rule 154(3) EPC, was whether a condition for

reinstatement in the list of professional representatives could be imposed.

The second question would be whether the condition selected ("medical certificate confirming that their health condition allows them to exercise their profession") would be appropriate, which was to be denied according to the appellant.

- (b) The **appellant requested** in principle that the decision of the Disciplinary Board be set aside with regard to the imposed condition for re-entry on the list of professional representatives. This condition should be replaced by a verifiable condition which ensures that the clients' interests will not be jeopardised in the future. In addition, reasoning should be provided for the particular period of deletion.

VI. By letter dated 26 November 2021 the President of the European Patent Office (EPO) was given the opportunity to comment on the appeal pursuant to Article 12, second sentence, RDR. With letter dated 28 January 2022 the President of the EPO informed the Disciplinary Board of Appeal (hereinafter "Board") that he did not intend to provide any comments on the appeal.

VII. Since oral proceedings have not been requested and in the absence of any written statement or request of the representative concerned in the file the decision could be taken in written proceedings without holding oral proceedings.

Reasons for the Decision

1. The appeal against the decision of the Disciplinary Board is admissible (Articles 8 and 22(1) RDR) and allowable.

2. The order concluded by the Disciplinary Board (III. of the contested decision) lacks a basis in Article 4 RDR, which is the only legal basis for disciplinary measures for a professional representative who fails to comply with the Rules of professional conduct. Article 4(1)(d) RDR provides a deletion from the list of professional representatives for not more than six months, whereas Article 4(1)(e) RDR explicitly allows a deletion from the list of professional representatives for an indefinite period. Therefore, it is evident that the decision of the Disciplinary Board "to delete the Professional Representative from the list of professional representatives for a period of nine (9) months (Article 4(1)(e) RoD)" is wrong as such, because it is not foreseen as disciplinary measure for a professional representative who fails to comply with the Rules of professional conduct.

Since any penalty and sanction in the broader sense, thus any disciplinary measure as statutory in Article 4 RDR, must have a proper legal basis, this part of the order alone constitutes a fundamental procedural violation, justifying that the decision is set aside and the case is remitted to the Disciplinary Board.

3. The Board agrees with the appellant that the condition for the re-entry into the list of professional representatives in the contested decision (order), namely the submission of a medical certificate

confirming that their health condition allows them to exercise their profession does not qualify as the appropriate and suitable measure considering that the reason for the deletion of the Professional Representative from the list of professional representatives for a period of nine (9) months was the violation of Article 1(1) RDR in making false and misleading statements during the meeting of 14 August 2018, but not the failure to take adequate preventive measures to safeguard the complainant's interests in the event that they should be prevented from exercising their profession due to illness or other unforeseen circumstances (Article 1(d) CoC of epi). It is not comprehensible how a "medical certificate confirming that their health condition allows them to exercise their profession" could serve as an appropriate condition and kind of evidence that the reasons responsible for the violation of the obligations under Article 1(1) RDR as correctly stated in the decision of the Disciplinary Board under point 15. of the Reasons are removed and that all due care has been taken that they will not occur in the future again.

4. The fact that the provision of a medical certificate is held not to be an appropriate measure in the present case does not imply that a condition for a re-entry into the list for professional representatives can not be imposed at all.

4.1 The entry of a professional representative from the list for professional representatives can be deleted, i.a., according to Rule 154(2) EPC, Article 134(1) (c) EPC and Article 4 RDR in case of disciplinary measures. According to Rule 154(3) EPC a representative shall, upon request, be re-entered into the list of

professional representatives "if the conditions for deletion no longer exists". Consequently, the professional representative concerned requesting the re-entry into the list has to provide any suitable verification that the conditions for deletion no longer exists, which has to be defined, examined and accepted by the competent disciplinary body.

- 4.2 In case of a decision according to Article 4(1)(e) RDR the term "indefinite period" has to be defined. The Disciplinary Board in decision D 11/91 (OJ 1995, 721) has established that, if pursuant to Article 4(1)(d) RDR a penalty is imposed for a period of time which is fixed in the decision, reinstatement is automatic and unconditional once that period of time has expired. If a penalty according to Article 4(1)(e) RDR is intended the term "indefinite period" should be understood as "a period not defined by the text", that is for a discretionary period to be decided by the competent disciplinary body, which, in its decision, should fix the said period and give reasons for its choice (D 11/91, point 7.8.3 of the Reasons). Although the Disciplinary Board had indicated a period of nine months in the decision under appeal, it failed to provide any reason why that period was regarded as a necessary and appropriate as well as a sufficient penalty for the established failure to comply with the Rules of professional conduct.
5. As regards the particular conditions which have to be complied with for a re-entry into the list and to be fixed in such a decision of the competent disciplinary body the appellant already provided some suggestions in its statement of grounds of appeal.

- 5.1 With regard to the obligation of the professional representative to take adequate preventive measures to safeguard the client's interests in the event that he should be prevented from exercising his profession due to illness or other unforeseen circumstances (III.(a) above) suitable evidence should be provided that measures have been taken to safeguard the client's interests in case the representative is prevented from exercising their profession (Article 1(d) CoC of epi). The Board agrees with the appellant that no medical certificate is required for entry on the list of professional representatives. A health condition allowing the exercise of the profession is neither a condition for entry on the list nor a condition for staying on the list; further, a certificate issued by any medical doctor without a definition of the health condition required for the exercise of the profession, and without a possibility for a counter-examination by an medical doctor appointed by the EPO, does not appear appropriate.
- 5.2 The Disciplinary Board also stated in the decision under appeal a violation of Article 1(1) RDR, according to which the professional representative shall exercise his profession conscientiously and in a manner appropriate to its dignity. In particular, he shall not knowingly make any false or misleading statement, as done in the meeting on 14 August 2018 (III.(b) above). In this regard it appears to be a possible reasonable and feasible condition for a re-entry that the representative submits evidence that he has indemnified the complainant from any damages and financial losses caused by the representative's misconduct and violation of his obligations according to Article 1(1) RDR, e.g., either according to a possible final decision of a

court or based on an amicable settlement between the representative and the complainant.

6. In consideration of the fundamental procedural violation committed by the Disciplinary Board by ordering a penalty which has no legal basis in the pertinent provision of Article 4 RDR the Disciplinary Board of Appeal has decided to remit the case to the Disciplinary Board for further prosecution. The Disciplinary Board in particular will have to take care that the order of the decision to be taken after the remittal complies with Article 4 RDR, and also, in case of a penalty according to Article 4(e) RDR, determine conditions for a re-entry into the list of professional representatives considering the findings of the Board under points 4. and 5. of the present decision.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Disciplinary Board for further prosecution.

The Registrar:

The Chairman:



N. Michaleczek

W. Sekretaruk

Decision electronically authenticated