



Beschwerdekammer in Disziplinarangelegenheiten

Disciplinary Board of Appeal

Chambre de recours statuant en matière disciplinaire

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-3014

Case Number: D 0001/22

D E C I S I O N
of the Disciplinary Board of Appeal
of 26 August 2024

Appellant: N.N.

Decision under appeal: Decision of the Disciplinary Committee of the
Institute of Professional Representatives before
the European Patent Office dated 8 April 2022

Composition of the Board:

Chairman: I. Beckedorf
Members: G. Decker
A. Bacchin
C. Rebbereh
S. Arkan

Summary of Facts and Submissions

- I. The appeal filed by the President of the Council of the Institute of Professional Representatives before the EPO ("appellant") concerns the decision of the Disciplinary Committee of the Institute ("Disciplinary Committee") summarily dismissing complaint No. CD 04/2021.

- II. The complaint was filed by an email dated 17 August 2021. The two complainants alleged that the defendant, a Dutch professional representative and member of the Institute of Professional Representatives before the EPO ("epi"), had failed to transfer a Belgian patent from a company owned by the complainants to them as individuals, resulting in the lapse of the patent. Nevertheless, the defendant had continued to charge the complainants renewal fees for the patent as well as processing fees via the defendant's former company and his current place of business. The complainants further pointed to several other "*financial malpractices*" by the defendant via the defendant's places of business, including not informing the complainants about the increase in fees when the defendant's company was sold to the defendant's current place of business.

- III. The Disciplinary Committee forwarded the complaint to both the appellant and the President of the EPO to give them an opportunity to comment under Article 12 of the Regulation on discipline for professional representatives ("RDR"). By letter dated 1 January 2022, the appellant informed the Disciplinary Committee that he would only comment on the complaint once he had received the defence letter.

IV. Upon examination of the facts of its own motion, the Disciplinary Committee concluded in its decision dated 8 April 2022 that the complaint did not disclose any facts upon which an allegation of a breach of the Rules of Professional Conduct could be made against the defendant. It therefore decided "*unanimously to summarily dismiss the complaint*". In view of this result, the Disciplinary Committee deemed it unnecessary to call upon the defendant to present a defence. Consequently, the defendant was not notified of the complaint before the decision was issued.

V. The Disciplinary Committee reasoned its decision as follows.

(a) Dealing with matters beyond representation before the EPO was not within the Disciplinary Committee's purview. The transfer of a Belgian patent was unrelated to representation before the EPO.

(b) The purpose of disciplinary proceedings was to serve the public interest in the orderly and proper exercise of professional representation before the EPO. The Disciplinary Committee's purview did not cover relationships between epi members derived from facts outside activities related to the EPC. A lack of information given by an epi member was unrelated to the orderly and proper exercise of professional representation before the EPO.

(c) Complaints before the Disciplinary Committee could only be filed against epi members and against companies. Disputes relating to contracts should be handled by the competent national authorities.

VI. By letter dated 9 June 2022, the appellant filed notice and grounds of appeal against the Disciplinary Committee's decision. The appellant stated that the decision under appeal had been notified to him on 7 June 2022. The file contains no evidence as to the notification date.

VII. The appellant requests that:

- the Disciplinary Committee's decision be set aside
- the case be remitted to the Disciplinary Board of the EPO under Article 12 of the Additional Rules of Procedure of the Disciplinary Board of Appeal ("RPDBA") due to fundamental deficiencies in the proceedings.

VIII. The appellant's arguments may be summarised as follows.

- (a) The nine-month period under Article 6(3) RDR had expired before the Committee had taken a decision. Only the chair of the Disciplinary Board of the EPO could extend that period. Therefore, the case should be remitted to the Disciplinary Board for further prosecution.
- (b) While the complaint related to a national patent and partly to acts by the defendant's companies, it concerned the behaviour of an epi member which fell within the scope of the RDR. A professional representative should not be able to avoid obligations under the European Rules of Professional Conduct by setting up a company and acting through it. Hence, the Committee had been wrong to summarily dismiss the complaint on the grounds that the alleged facts fell outside the

scope of application of the RDR. The decisive consideration for the application of the RDR was whether professional representatives might prejudice the necessary confidence in their profession with their behaviour.

(c) There had been a breach of the confidentiality of deliberations as per Article 20 RDR because the decision under appeal stated that the "*Chamber decide[d] unanimously to summarily dismiss the complaint*" (emphasis added by the appellant).

IX. In a communication under Article 14 RPDBA, the Disciplinary Board of Appeal (hereinafter: Board or Disciplinary Board) set out its preliminary opinion on this case. It gave the appellant and the President of the EPO the opportunity to comment on that opinion. Neither submitted a response on the merits of the case. In his response letter dated 27 May 2024, the appellant merely pointed to changes to the preamble of the EPC Code of Conduct in its current version.

Reasons for the Decision

1. *Admissibility of the appeal*

1.1 The decision under appeal, which was taken pursuant to Article 6(2)(a) RDR, is a final decision for the purposes of Article 8(1) RDR and hence open to appeal (see D 18/19, Reasons 13; D 19/19, Reasons 2.2; D 1/18, Reasons 6.23 and 6.24; D 2/18, Reasons 1).

1.2 The appellant, who is entitled to file an appeal under Article 8(2) RDR, filed notice of appeal and a

statement setting out the grounds of appeal within the time limits under Article 22(1) RDR and in compliance with Article 6 RPDBA. The formal requirements for an admissible appeal are therefore met.

1.3 According to decision D 55/21 (Reasons 9), for an appeal of the epi President to be admissible, it is sufficient to indicate why the decision under appeal is wrong in substance. Depending on the circumstances, it may not be necessary to specifically request what the expected substantive outcome should be; a request for remittal on the merits may suffice (see also D 2/20, Reasons 24).

1.4 In the case in hand, the complaint was dismissed by the Disciplinary Committee. To the extent that the appellant invoked a breach of Article 6(3) RDR allegedly amounting to a substantial procedural violation, the Board regards a request for remittal as sufficient. As regards substance, the appellant considered that the Disciplinary Committee should not have dismissed the matter. Since the issue is about jurisdiction and the defendant was not called upon to present a defence, the request for remittal on the merits is sufficient as well. Lastly, as regards the alleged breach of the confidentiality of deliberations as per Article 20 RDR, the appellant appears to request remittal in view of a further substantial procedural violation. The situation is thus the same as regards the alleged breach of Article 6(3) RDR. The Board therefore concludes that the substantive requirements for an admissible appeal are also met.

2. *Allowability of the appeal*

2.1 *Substantial procedural violation - observation of the time limit under Article 6(3) RDR*

2.1.1 The appellant appears to be of the opinion that final decisions taken by the Disciplinary Committee after expiry of the time limit under Article 6(3) RDR should be considered a substantial procedural deficiency because the Disciplinary Committee no longer has the competence to rule after that time.

2.1.2 Article 6(3) RDR stipulates that if the Disciplinary Committee does not take a final decision within nine months of an alleged breach of the Rules of Professional Conduct being brought to its notice, it should within that time limit submit a report on the state of the proceedings to the chair of the Disciplinary Board of the EPO. Under Article 6(4) RDR, the chair of the Disciplinary Board, on receiving the report or on expiry of the time limit referred to in paragraph 3, should either (a) extend the time limit for consideration of the matter by the Disciplinary Committee, or (b) transfer the matter to the Disciplinary Board. Article 6(5) RDR sets forth that the chair may grant no more than two extensions, totalling not more than six months, under paragraph 4(a).

2.1.3 The Board doubts that the appellant has a legitimate interest to invoke a breach of Article 6(3) to (5) RDR.

(a) In decision D 1/20 it was held that the President of the Council of epi and the President of the EPO ("the Presidents") were not parties to the first-instance disciplinary proceedings but that

they enjoyed certain participation rights which gave them a status similar to a party to those proceedings. The case concerned specifically the Presidents' right to comment. The board held that this right did not substantially differ from a party's right to be heard. Consequently, an infringement of the Presidents' right to comment under Article 12, second sentence, RDR amounted to an infringement of the right to be heard and at the same time constituted a fundamental deficiency under Article 12 RPDBA (D 1/20, Reasons 1.3 and 1.4) which may be invoked by the Presidents with an appeal.

- (b) In the case in hand, however, the situation is different as the appellant has not invoked a violation of his right to be heard, instead alleging a violation of Article 6(3) RDR. The appellant had indeed been invited to comment on the complaint, but he informed the Disciplinary Committee that he would only comment once he had received the defence. Since the defendant was not notified of the complaint and was not asked to file a written defence, there was no written defence to be communicated to the Presidents.

- (c) The appellant has not given any reason why and under which circumstances a final decision taken by the Disciplinary Committee after expiry of the time limit under Article 6(3) RDR should be considered a substantial procedural deficiency. Moreover, the appellant has not provided any indication whether and to what extent Article 6(3) to (5) RDR aims at protecting the Presidents' right to participate in proceedings under the RDR concerning an alleged breach of the Rules of Professional Conduct. In

light of the above, the Board doubts that the appellant has a legitimate interest to invoke a breach of Article 6(3) to (5) RDR.

2.1.4 Yet even if it were accepted that the Presidents may rely on a breach of procedural provisions in their appeal, the Board cannot agree with the appellant's narrow reading of Article 6(3) RDR.

(a) Article 6(3) RDR, which should be read together with Article 6(4) and (5) RDR, addresses the case where the Disciplinary Committee does not take a final decision within nine months of being notified of an alleged breach of the Rules of Professional Conduct. The purpose of Article 6(4) and (5) RDR is to determine whether the time limit for the Disciplinary Committee to take a final decision within the meaning of Article 6(2)(a) and (b) RDR should be extended or whether the file should be transferred to the Disciplinary Board without awaiting a referral under Article 6(2)(c) RDR. The procedural decision about whether to extend the time limit for consideration of the matter by the Disciplinary Committee or to transfer the matter to the Disciplinary Board - which is a discretionary decision - must be taken by the chair of the Disciplinary Board.

(b) It is to be noted that under Article 6(4) RDR, the chair of the Disciplinary Board has the power to decide on this matter upon expiry of the nine-month time limit under Article 6(3) RDR, without being presented a report by the Disciplinary Committee on the state of the proceedings.

(c) Nevertheless, in view of the possibility of extending the time limit for consideration of the matter by the Disciplinary Committee, the question is whether Article 6(3) and (4) RDR provides for a devolutive effect which would prevent the Disciplinary Committee from deciding on the complaint after expiry of the nine-month time limit under Article 6(3) RDR but before the chair of the Disciplinary Board has taken a decision on the extension of that time limit.

(d) In the Board's view, there is no devolutive effect upon expiry of the time limit pursuant to Article 6(3) RDR; the Disciplinary Committee remains competent to deal with the case. However, the Disciplinary Board can assume responsibility for the case by a decision of its chair transferring the case to the Disciplinary Board. As a consequence of this, the Disciplinary Committee would no longer be able to rule on the case. Therefore, the possibility of the Disciplinary Committee taking a decision more than nine months after being notified of an alleged breach of the Rules of Professional Conduct is not ruled out *per se*; it is only ruled out if the matter is transferred to the Disciplinary Board under Article 6(4)(b) RDR.

2.1.5 Lastly, the Board notes that in the case in hand, the Disciplinary Committee did not actually exceed the nine-month time limit under Article 6(3) RDR. The complaint (in English) was received by the epi Secretariat on 17 August 2021 by email and forwarded to the Registrar of the Disciplinary Committee on the same day. Hence, the complaint was brought to the Disciplinary Committee's attention in accordance with

Article 7(3) of the Additional Rules of Procedure of the Disciplinary Committee of the epi on 17 August 2021 (see D 55/21, Reasons 28). The time limit under Article 6(3) RDR expired on 17 May 2022. The decision of 8 April 2022 was therefore taken in due time, i.e. before the expiry of the time limit pursuant to Article 6(3) RDR.

2.2 *Substantial procedural violation - breach of the confidentiality of deliberations as per Article 20, second sentence, RDR*

2.2.1 The appellant appears to regard the Disciplinary Committee's decision to "*unanimously [...] dismiss the complaint*" as a violation of Article 20 RDR amounting to a substantial procedural deficiency, justifying the remittal of the case to the department of first instance for further prosecution.

2.2.2 Under Article 20, second sentence, RDR the deliberations of the disciplinary bodies "*shall be confidential*".

2.2.3 The appellant has not given any reason why and under which circumstances a breach of the confidentiality of deliberations as per Article 20, second sentence, RDR should be considered a substantial procedural deficiency. Besides not properly substantiating the alleged procedural deficiency, the appellant has also failed to provide any indication whether and to what extent Article 20, second sentence, RDR aims at protecting the Presidents' right to participate in proceedings under the RDR concerning an alleged breach of the Rules of Professional Conduct. Again, the Board doubts that the appellant has a legitimate interest to invoke a breach of Article 20, second sentence, RDR.

2.2.4 In any case, the Board is of the opinion that the Disciplinary Committee did not violate the confidentiality of deliberations and that there is no substantial procedural violation.

- (a) In the Board's view, one purpose of the confidentiality of deliberations under Article 20, second sentence, RDR is so that the existence of and grounds for any dissenting vote within the disciplinary body are not announced, since all its members are responsible for a decision even if one of them is voted down by majority.
- (b) Furthermore, the principle of confidentiality of deliberations is also there to safeguard the deliberation process and thus to ensure the freedom of decision by guaranteeing the serenity and independence of the individual judge's judgement.
- (c) However, the indication in the contested decision that it was taken by unanimity merely rules out any disagreement among the members and does not convey any further information on the deliberations among the members. This is acceptable.
- (d) In any case, the Board fails to see any causal link between that announcement and the decision itself. Therefore, if there is any procedural violation at all, it is not a substantial violation that would justify setting aside the contested decision and remitting the case for further prosecution.

2.3 *Applicability of the RDR*

2.3.1 The appellant submitted that the Disciplinary Committee had wrongly denied the applicability of the RDR to the facts alleged in the complaint. The appellant acknowledged that the complaint concerned a dispute relating to a national patent (omission of a transfer as instructed by the complainants). Nevertheless, the appellant was of the opinion that the Rules of Professional Conduct applied, mainly for the following reasons.

- The applicability of the disciplinary rules was not restricted to professional representation in proceedings before the EPO or other professional activities under the EPC.
- The alleged omission by a professional representative in relation to the transfer of a national patent also fell within the scope of the RDR and the jurisdiction of the disciplinary bodies of epi and the EPO.
- While the complaint was directed against the company of a European professional representative, the behaviour of said representative was at issue. A professional representative should not be able to avoid obligations under the European Rules of Professional Conduct by setting up a company and acting through it.

2.3.2 The Board agrees with the appellant that a professional representative cannot hide behind the veil of a company to avoid the application of European disciplinary rules.

2.3.3 However, the jurisdiction of the disciplinary bodies of epi and the EPO as established by the RDR does not cover any and all conduct or activities of a professional representative.

- (a) The Board agrees with decision D 19/99 (Reasons 5.1) that the former preamble of the epi Code of Conduct (see the version as last amended on 8 May 2001, OJ EPO 2003, 523: "*This Code is to govern the conduct and other activities of the members in so far as such activities are related to the Convention on the Grant of European Patents (European Patent Convention) [...]*") excluded the possibility of European disciplinary rules being applied to acts performed by a European professional representative solely in relation to national patents, without any connection with a European patent and the EPC.

- (b) It is true that the preamble of the current version of the epi Code of Conduct (last amended on 11 November 2023, OJ EPO 2024, A35) no longer refers to activities related to the EPC ("*This Code, adopted under Articles 4(c) and 9(3) of the Founding Regulation, contains the recommendations of Council as to the conduct and activities of Members in so far as related to Members' profession*"). However, this does not alter the conclusion set out in the previous point. The Board agrees with the further reasons given in decision D 19/99 (Reasons 5.1) as to why the application of the European disciplinary rules (pursuant to Article 134(8) EPC 1973, corresponding to current Article 134a(1)(c) EPC) is restricted to acts by a European professional representative connected with a European patent and the EPC, as follows.

- It follows from Article 134(1) and (5) EPC that professional representatives are, in principle, the only ones entitled to act in all proceedings instituted by the EPC. Therefore, the disciplinary power delegated by the contracting states in Article 134a(1)(c) EPC must necessarily be understood as relating to their activity as such.

- It is a settled principle of law in the jurisdiction of the same contracting states that provisions enacting disciplinary sanctions that restrict the free exercise of a profession are, like those of criminal law, to be interpreted strictly, and therefore narrowly. Such an interpretation is also necessary to avoid conflicts of jurisdiction between the EPO and national disciplinary bodies. As a consequence of the narrow interpretation of the texts imposing disciplinary sanctions, it is not possible to have these same texts govern, by analogy, other ancillary activities that a professional representative might also engage in.

- Thus, the disciplinary powers of the bodies set up under Article 134a(1)(c) EPC clearly apply only to the activities of professional representatives in relation to their privilege of representation, i.e. those relating to the grant of a European patent.

- Lastly, Article 1(1) RDR itself requires such an interpretation in that it stipulates that "*[a] professional representative shall exercise his profession ...*" (emphasis added; see also the

French version "*Tout mandataire agréé doit, dans l'exercice de ses fonctions, faire preuve ...*").

- (c) The same limited interpretation applies to Article 1(2) RDR, which recites that "[a] *professional representative shall conduct himself in such a manner as not to prejudice the necessary confidence in his profession*" (emphasis added). Therefore, the appellant's argument that the decisive point is whether the professional representative's behaviour might prejudice the necessary confidence in their profession cannot actually be understood independently of a direct link to representation before the EPO or activities under the EPC.
- (d) Accordingly, while stressing that the power of the disciplinary bodies of epi and the EPO was not solely restricted to activities as a professional representative in proceedings before the EPO, decision D 25/05 (Reasons 4) confirmed that this power did not encompass conduct or activities which were not related to a European patent. D 25/05, as well as D 16/95 referred to in D 25/05, concerned the filing of a translation and/or the payment of fees under the EPC for the national parts of a granted European patent as required by the EPC.

2.3.4 The case in hand is, however, exclusively concerned with a national patent. While this national patent served as a priority application for a European patent, the complaint is only about the omission of a transfer of said national patent under the applicable national law. The national parts of the European patent, which claim priority of the national application, are not at issue. The complaint is not related to any provision of

the EPC either. The defendant's activities on which the complaint is based thus have no connection with a European patent and provisions of the EPC applicable to the national parts of any such patent (e.g. Articles 65 and 141 EPC). The fact that the defendant is a professional representative does not as such establish the link between the facts of the complaint and the EPC as required by the above case law.

2.3.5 Therefore, the Disciplinary Committee rightly denied its jurisdiction and dismissed the complaint.

2.4 Since the admissible appeal is not allowable, it must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. Schalow

I. Beckedorf

Decision electronically authenticated