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Title of invention:

Titre de l'invention :

ENTSCHEIDUNG / DECISION

vom / of / du 20 December 1983

Appellant:

Stichwort / Headword / Référence : Art.1(f),2(a)(c) Code of professional Conduct (CPC)
Art.12 Regulation on Discipline for professional
EPÜ / EPC / CBE representatives (RDR)

Advertising - offer of unsolicited services - taking evidence -
procedural questions

Leitsatz / Headnote / Sommaire

Europäisches
Patentamt

Beschwerdekammer in
Disziplinarangelegenheiten

European Patent
Office

Disciplinary Board
of Appeal

Office européen
des brevets

Chambre de recours statuant
en matière disciplinaire



Case No: D 04/83

DECISION

dated 20 December 1983

Decision under appeal: Decision of the Disciplinary
Committee of the Institute of
Professional Representatives before
the European Patent Office dated 31
March 1983

Composition of the Board:

L. Gotti Porcinari, Chairman
P. Ford, Member
O. Bossung, Member
E. Bokelmann, Member
H. Brühwiler, Member

Summary of facts and submissions

- I. The Appellant, as a European professional representative, is a Member of the Institute of Professional Representatives before the European Patent Office. On 5 May 1982, the Complainant, a public body established under national law to represent the interests of patent practitioners in a Contracting State, lodged a complaint with the Institute alleging that the Appellant had contravened Article 1 of the Regulation on Discipline for Professional Representatives (OJ EPO 1978, 91) by advertising professional services and soliciting work through a document distributed in the United States of America by a U.S. Patent Attorney. It was alleged, in particular, that the Appellant had not followed the recommendations of paragraphs 1(f), 2(a) and 2(c) of the Code of Professional Conduct established by the Council of the Institute (OJ EPO 1980, 213) and had attempted to solicit work by comparison of services and to attract clients through advertising and to offer unsolicited services. The document complained of, headed "E.P.O. Prosecution for U.S. Attorneys", referred to the Appellant by name as "our authorised E.P.O. representative" and gave as the Appellant's address, that of a non-existent firm, the name of which consisted of the joint surnames of the U.S. Patent Attorney and of the Appellant, at the same postal address as the Munich office of the Appellant. The document suggested inter alia that the U.S. Patent Attorney could provide the Appellant's services at relatively low cost.
- II. The document was dated 1 November 1981 but the Appellant was not aware of the contents of the document or the fact that it had been distributed until these matters were drawn to the Appellant's attention by another Mem-

ber of the Institute, who was also a Member of the Complainant body, at the end of September 1982. On 27 September 1982, the firm of European representatives of which the Appellant is a Member sent a telex message to the U.S. Patent Attorney, asking him to ensure that the names of members of that firm of European representatives would no longer appear in circular solicitation letters sent out by him.

- III. The U.S. Patent Attorney replied by telex, on the same day, that his document was not a circular solicitation letter but an instruction sheet sent to clients of his firm. Nevertheless, he offered to remove the Appellant's name from his document if instructed to do so. By letter dated 4 October 1982, the Appellant's firm again requested that he should refrain from mentioning in any such papers the name of any Member of that firm. He complied with the request.
- IV. On 18 October 1982, the Chairman of the Disciplinary Committee of the Institute wrote to the Appellant in order to communicate the complaint which had been lodged with the Institute on 5 May 1982.
- V. In replying to the Chairman's letter on 3 November 1982, the Appellant pointed out that the subject matter of the complaint had only become known to the Appellant at the end of September 1982 and that immediate action had already been taken to prevent the U.S. Patent Attorney from continuing to use the Appellant's name. Furthermore, the situation had been explained in a letter to the Member of the Institute who had raised the matter with the Appellant. The accusations of the Complainant were denied.

- VI. The case was considered by a Chamber of the Disciplinary Committee which, in the Decision under appeal, dated 28 March 1983, found the Appellant guilty of not complying with the Rules of Professional Conduct and decided to give a warning. In its Decision, the Chamber expressly accepted that the documents complained of had been sent out without the previous knowledge or consent of the Appellant and that the Appellant's firm had promptly taken steps to prevent any further mentioning of the Appellant's name in such documents. Nevertheless, the Committee was of the opinion that if the Appellant had "observed greater caution" in professional relations with the U.S. Patent Attorney, the mentioning of the Appellant's name "might not have occurred". Furthermore, the Chamber felt that it was "extremely unlikely" that the U.S. Patent Attorney would and could have developed and advertised his scheme without the knowledge and consent of the European representatives concerned. The appellant had admitted that there had been professional cooperation between the U.S. Patent Attorney and the Appellant's firm for many years. In the view of the Chamber, the exchanges of letters and telex messages "strongly" pointed to the existence of an agreement to allow the Appellant's name to be entered on EPO Request for Grant forms, without the Appellant even being required to look at the cases concerned. In the opinion of the Chamber, even if the Appellant did not know in full detail how the U.S. Patent Attorney would use the names of European representatives in his project, there had been insufficient discretion on the part of the Appellant.
- VII. By letter received by the EPO on 2 May 1983, the Appellant appealed to the Disciplinary Board of Appeal. The letter set out the Grounds of the Appeal. The Appellant

first complained that Article 5(b) of the Code of Professional Conduct had not been complied with, as the grievance complained of had not been taken up privately before being made the subject of a formal complaint. Secondly, the Appellant complained that the Decision under appeal rested on assumptions of lack of caution when in fact (as could be proved by an affidavit of the U.S. Patent Attorney) neither the Appellant nor the Appellant's firm had any prior knowledge of the project of the U.S. Patent Attorney, let alone any agreement with him in the matter. The Chamber had based its Decision on assumptions which were simply not true. It was requested that the Decision under appeal should be reversed and the complaint dismissed. It was also requested that the Decision of the Chamber should not be communicated to the Members of the Institute.

VIII. At the request of the Disciplinary Board of Appeal, the Appellant duly filed the affidavit made on 22 April 1983 of the U.S. Patent Attorney concerned. This affidavit states inter alia that the Attorney had never made any agreement as to mentioning the names of members of the Appellant's firm in any of the papers which he sends to clients in the U.S.A. The instruction paper complained of had not been shown to members of the Appellant's firm at any time, nor had its contents been discussed in any way with them. The instruction paper did not violate the code of conduct of the U.S. Patent and Trademark Office or the Rules of the American Bar Association. The Attorney asserts that he believed that his action was not contrary to the European Patent Convention and thus he had not consulted any of his European associates before issuing his instruction paper. He specifically denied establishing any link with the Appellant and he confirmed that he had deleted the name of the Appellant from his papers.

Reasons for the Decision

1. This appeal complies with the provisions of the Additional Rules of Procedure of the Disciplinary Board of Appeal (OJ EPO 1980, 188) and is, therefore, admissible.

2. The document complained of contains several references to the Appellant and to the services of the non-existent firm in which the Appellant was supposed to be a partner. It was not unreasonable for the Complainant and the Disciplinary Committee to assume, from these references, that the Appellant had at least been consulted in some way before such a document was issued. However, it is now clear that this assumption was not justified. Not only does the Appellant deny that there was any prior consultation or agreement but the U.S. Patent Attorney has declared on oath that he never consulted the Appellant or any other European associates, because he assumed that his scheme was not in conflict with the European Patent Convention and he thought that the situation resembled that relating to prosecution of national patent applications throughout the world, for which purpose patent attorneys often asked their clients to execute powers of attorney in favour of other patent attorneys in individual countries, without notifying the latter that this was being done.

3. Neither the Disciplinary Committee nor the Disciplinary Board of Appeal is called upon to judge the conduct of the U.S. Patent Attorney and, therefore, we express no view as to the propriety of his actions. In particular, it is not necessary to decide whether he was justified in considering that his scheme did not conflict with the European Patent Convention and the professional obliga-

tions of the European patent attorneys whose names he added to his document. It is clear that he used the Appellant's name without any permission, express or implied, and that, accordingly, the Appellant has done nothing in breach of the Rules of Professional Conduct.

4. The Appellant's conviction will therefore, be set aside for this reason but it is necessary to say that there was a procedural defect in the handling of the case by the Disciplinary Committee which it is essential to avoid: the Appellant was not given an opportunity to comment on the specific allegations of indiscretion and of prior agreement with the U.S. Patent Attorney, before the Decision under appeal was given. This was contrary to Article 12, Regulations on Discipline for Professional Representatives ("the right to be heard"), which expresses a principle of justice which is of particular importance in disciplinary cases.

In the present case, the Disciplinary Board of Appeal considers that the filing of the evidence of the U.S. Patent Attorney with the appeal, which has enabled this Board to consider the whole case, constitutes a special reason for not remitting the case to the Disciplinary Committee, despite the fundamental deficiency in the proceedings before the Committee (cf. Article 12, Additional Rules of Procedure of the Disciplinary Board of Appeal).

5. It should be added that the Disciplinary Board of Appeal considers, contrary to the view of the Appellant, that the Complainant, as a public body established by law, is fully entitled to make a disciplinary complaint to the Institute, in the public interest. It is not properly to

be regarded as merely a cover for anonymous European professional representatives who also belong to it.

6. The Appellant's complaint that the grievance was not taken up privately before proceedings were started, in compliance with Article 5(b) of the Code of Professional Conduct, is a matter which should be considered by the Institute. The Disciplinary Board of Appeal expresses no opinion on the matter in these proceedings.

Order

For these reasons,

it is decided that:

The Decision of the Disciplinary Committee dated 28 March 1983 is set aside.