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Datasheet for the decision of 27 February 2019

Case Number: J 0005/18 - 3.1.01

Application Number: 12152933.3

Publication Number: 2478918

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Language of the proceedings: EN

Title of invention:

Compositions and methods for the treatment of addiction and other neuropsychiatric disorders

Applicant:

Board OF SUPERVISORS OF LOUISIANA STATE UNIVERSITY AND AGRICULTURAL AND MECHANICAL COLLEGE

Headword:

Re-establishment of rights in the time limit for further processing - no

Relevant legal provisions:

EPC Art. 122, 121, 111(1)
EPC R. 136, 135, 113(1)
RPBA Art. 11

Keyword:

Decisions cited:
J 0012/92, J 0029/94, J 0005/94, J 0015/10, J 0003/08, T 2274/11, J 0009/16, J 0003/88, J 0025/96, R 0018/13, T 0439/06, T 1561/05, J 0001/07, T 0198/16, J 0016/17

Catchword:

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European Patent Office
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Juristische Beschwerdekammer

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Case Number: J 0005/18 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 27 February 2019

Appellant: (Patent Proprietor)	Board OF SUPERVISORS OF LOUISIANA STATE UNIVERSITY AND AGRICULTURAL AND MECHANICAL COLLEGE c/o Louisiana State University System P.O. Box 16070 Baton Rouge, LA 70893 (US)
Representative:	Williams, Gareth Owen Marks & Clerk LLP 62-68 Hills Road Cambridge CB2 1LA (GB)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 11 December 2017 concerning the European patent application No. 12152933.3.**

Composition of the Board:

Chairman	W. Sekretaruk
Members:	J. Hoppe
	R. Cramer

Summary of Facts and Submissions

I. The appeal of the applicant (appellant) lies against the decision of the examining division posted on 11 December 2017 wherein the request for re-establishment of rights was rejected and the application deemed withdrawn. The background of the appealed decision is as follows:

II. With a communication posted on 26 August 2013, the examining division set a time limit of four months for a reply to its communication pursuant to Article 94(3) EPC and later granted a two-month extension following a request by the applicant. The applicant did not reply within the extended time limit, so on 1 April 2014, a notice of loss of rights pursuant to Rule 112(1) EPC was dispatched which informed the applicant that further processing or a decision on the matter could be requested within two months after notification.

III. On 29 September 2014, the applicant requested further processing, replied to the communication dated 26 August 2013, and filed a request for re-establishment of rights with respect to the period for filing the request for further processing. The fees for re-establishment and further processing were paid at the same time.

IV. The request for re-establishment of rights stated that the applicant and its US attorneys first became aware of the loss of rights on 28 July 2014 and explained the

circumstances in which the non-compliance with the time limit for further processing had occurred.

V.

The applicant alleged that, within an otherwise well-functioning system, the time limit was missed due to a single error, namely the belief that instructions relating to the further processing notice had already been sent to the EP representatives. The evidence submitted (Annexes 1 to 7) and explanatory statements filed in writing on 29 September 2014 can be summarised as follows:

- The applicant was represented by European professional representatives (in the following: EP representative), Marks & Clerk, who received instructions from a US attorney firm, Duane Morris (in the following US representative).

- In both attorney firms, electronic reminder systems were operating which generated reminders which were brought to the attention of an attorney.

- On 2 September 2013, the responsible EP representative, Mr Williams, sent an email (Annex 1) to the responsible US representative, Ms Crews, reporting the communication of 26 August 2013 and the necessary steps to be taken.

- By letter dated 19 December 2013 (Annex 2) the EP representative requested a two month extension of time at the EPO and reported this to the US representative.

- On 25 February 2014, the EP representative received an email from the US representative indicating that the applicant was interested in using further processing (Annex 3) with the following wording:

"Our client has decided not to file a response to the First Examination Report dated August 26, 2013, ... However we are interested in further processing. I cannot recall whether you must take action at the deadline for response or only after the EPO sets a further deadline. Can you please let me know the time at which costs and fees would be incurred for further processing and provide an estimate of the amounts due?..."

- The EP representative replied on the same day via email informing the US representative about the requirements for further processing as regards the time limits and fees (Annex 4).

- On 2 April 2014, the EP representative reported the notice of loss of rights via email to the US representative and informed it of the necessary steps to be taken before the deadline of 1 June 2014 as regards a request for further processing (Annexes 5, 6). This letter was not saved in the US representative's document management system, nor was it reported electronically to the applicant. Nevertheless, the deadline for further processing was docketed in the system.

- On 4 May 2014, the US representative, Ms Crews, left the law firm and her cases were allocated to other attorneys in the US-law firm.

- On 26 May 2014, 28 May 2014 and 28 June 2014, the docketing department of the US law firm sent reminders regarding the deadline for requesting further processing to the responsible US representative (Annex 7). The attorneys within the US law firm discussed the deadline and believed that instructions for further processing had been given in the letter dated 25

February 2014 (Annex 3). Therefore, instructions were not sent to the EP representative, nor were instructions sought from the applicant.

- After the deadline for requesting further processing had passed, the EP representative merely updated the file status in its record department.

- The applicant and its US representative became aware of the closing of the application on 28 July 2014 via a routine check of the European Patent Register.

VI. By letter dated 13 April 2015 and a further letter dated 19 May 2016 filed in response to communications from the EPO the applicant provided further facts and evidence as regards the incidents that had led to the non-observance of the time limit for further processing.

In particular, it stated that after Ms Crews left the US law firm, Ms Vogel became the responsible attorney for a significant portion of Ms Crew's cases, including the present application. The secretary of Ms Crews also left the US law firm. Ms Vogel worked together with Ms Crew's former assistant, Dr Vaze, who had no legal experience prior to 2013 but received his patent agent's licence on 12 August 2013. He was not permitted to make any strategic decisions.

When the first reminder as regards the deadline for further processing was received on 26 May 2014, Dr Vaze indicated to Ms Vogel that, according to his notes, Ms Crews had communicated to him "that the deadline had been satisfied". Ms Vogel consulted the document management system and incorrectly understood the letter

dated 25 February 2014 (Annex 3) to be the confirmation of the indication in Dr Vaze's notes "that the deadline was satisfied".

VII. In the appealed decision the examining division decided that the application was deemed to be withdrawn with effect as of 6 March 2014, that the request for re-establishment of rights in the time limit for further processing was rejected as not allowable, and that all fees paid after 5 March 2014, except the fee for re-establishment, would be refunded once the decision had become final.

VIII. The decision is not signed, nor are the names of the examiners or of a formalities officer stated. At the bottom of the page containing the order the words: "For the Examining Division" are all that appear.

In the reasons for the decision, it is set out that the time limit for further processing was not missed due to an isolated mistake in an otherwise satisfactory system but was rather the result of the following interrelated, consecutive errors:

1. The transfer of responsibility in the US law firm for the present application was not communicated to the EP representative.

2. The letter of the EP representative dated 2 April 2014 was not stored in the internal document management system of the US representative.

3. The email dated 25 February 2014 was interpreted as a confirmation of instructions to request further processing.

4. It was not discernible that the US representative tried to acquire information from the European representative as to the status of the file or whether the instructions from the applicant had been received.

IX. With its appeal against this decision, the appellant requested in writing that
- the decision be set aside,
- the request for re-establishment of rights be allowed and
- the decision that the application be treated as deemed withdrawn be reversed.

X. In the grounds of appeal, the appellant disputed the findings in the decision as regards the four mistakes outlined in the appealed decision as follows:

1. The receipt of a reminder from the European representative was not part of the system in place for monitoring the time limit and was not relevant for the mistake that led to the removal of the time limit.

2. The storing of a letter that sets a deadline in an electronic document system when the letter has been correctly processed could not be considered to be a necessary part of a well-functioning system.

3. The third mistake as such, namely that the deadline was erroneously updated as "being satisfied", was not in dispute. Nevertheless this mistake occurred within a proper, appropriate system. A single mistake and associated cross-check led to the non-observance of the time limit for further processing. The letter dated 25 February 2014 was incorrectly understood to be the

confirmation of the indication in Dr Vaze's notes that "the deadline was satisfied". Dr Vaze's notes were required to be relied upon due to the transfer of Ms Crew's cases, accompanied by a large increase in workload and the leave of Ms Crew's secretary. Thus the system and actions of the US representative were such that all due care had been taken.
The correct legal test was not to analyse every step of the process and decide whether or not one or more mistakes had been made of the type that would not permit re-establishment, because this would put an unachievably high duty on attorneys such that any mistake by an attorney would almost inevitably result in re-establishment failing. Also, no protection of public interests was achieved by such a strict application. Rather, re-establishment should be offered if the mistake occurred even though a proper, appropriate system for the circumstances had been put in place.

4. As regards the alleged fourth mistake, in the light of the information given by Dr Vaze, the US representative would not have sought confirmation from the European representative as to the status of the file. Consulting the EP representative was not a normal part of a deadline monitoring system.

XI. The board summoned the appellant to oral proceedings and issued a communication under Article 15(1) RPBA setting out its preliminary opinion on the appeal. Oral proceedings were held on 27 February 2019. The appellant informed the board on the same day of its absence at the oral proceedings.

Reasons for the Decision

1. **Request for re-establishment**

1.1 **Formal requirements of the request for re-establishment**
The formal requirements of Article 122(1) EPC in conjunction with Rule 136 EPC for the request for re-establishment to be admissible are met.

The time limit for further processing is not ruled out from the re-establishment of rights under Article 122(4), Rule 136(3) EPC. Rule 136(3) EPC merely rules out the periods for which further processing is available; but does not mention the period for further processing as such.

The appellant filed its request in writing on 29 September 2014, which was within two months of the removal of non-compliance with the period for further processing (Rule 136(1) EPC). Further it paid the necessary fees and completed the omitted acts by submitting the request for further processing (Rule 136(2), second sentence, EPC) and the reply to the communication dated 26 August 2013 (Rule 135(1), second sentence, EPC).

The appellant also substantiated its request for re-establishment within the relevant time limit of two months according to Rule 136(2), first sentence, EPC by stating the grounds on which the request was based in its letter dated 29 September 2014. The later submissions of 13 April 2015 and 19 May 2016 were not provided within the time limit. A number of decisions have held that facts presented after the expiry of the time limit can merely amplify but not alter the basis

of the provided grounds (see J 5/94, reasons 4, 5; J 15/10, reasons 3.2).

1.2 **Allowability of the request for re-establishment**

1.2.1 **Mistake of the US representative**

The appellant correctly acknowledged that the responsible US representative, Ms Vogel, erred when she instructed the removal of the deadline for further processing from the internal docketing system without taking further actions and thus caused the non-observance of the time limit for further processing. As this behaviour, which in the appealed decision had been identified as the third mistake, led to the non-observance of the period for further processing, the board does not need to decide whether further mistakes also occurred in the sequence of actions or whether the system for monitoring time limits as such was insufficient or not. Contrary to the appellant's view, it is not deemed to be decisive whether the mistake occurred in an otherwise well-functioning system or not because the legislator provided for re-establishment only for those cases where the applicant, in spite of all due care required by the circumstances having been taken, was unable to observe a time limit.

1.2.2 **Relevant persons to apply all due care**

From this it is clear, that in the first place, it is the applicant who has to observe all due care. If a professional representative is appointed, the duty of all due care applies both to the applicants themselves and their professional representatives (J 5/80, OJ EPO 1981, 343, reasons 4; J 3/08, reasons 4; T 742/11, reasons 3; T 2274/11, reasons 3). All due care must

also be applied by third persons who are not professional representatives if they are entrusted with a patent application by an applicant (J 3/08, reasons 8; J 9/16, reasons 5, 30; J 3/88, reasons 3). This is justified because these persons are then acting for the applicant and perform the necessary steps in the procedure in the applicant's place (J 3/08, reasons 4, 8). Thus, it has been decided in a number of decisions that a non-European representative can also be held responsible for meeting the obligations of any representative whose duty it is to care for their client's interests, irrespective of whether such representative is entitled to represent before the EPO or any other patent office (J 25/96, reasons 3.2; J 9/16, reasons 30; J 3/88, reasons 3). Moreover, it has to be noted that the monitoring of specific time limits that were set expressly does not depend on knowledge of EPC law (J 9/16, reasons 30), so that a non-European representative also has to take all due care to guarantee that the given time limits (in the present case the time limit for further processing) are observed.

1.2.3 **All due care of the US representative in the present case**

When the US representative, Ms Vogel, consulted the document management system and believed that the letter dated 25 February 2014 was an instruction for the EP representative to request further processing she did not act with all due care required by the circumstances. The letter dated 25 February 2014 did not give the slightest indication that the EP representative had already been instructed to request further processing. Quite the contrary, this document clearly demonstrated that no action had been taken at

that stage. As stated above, the necessary legal assessment did not even require any specific knowledge of the EPC, but simply the common legal skills that can be expected of any representative.

As a consequence Ms Vogel did not act with all due care when she nevertheless instructed the deadline to be removed and omitted to inform the EP representative that the appellant wished to request further processing.

1.2.4 **All due care required by the specific circumstances**

The further facts, presented in the request for re-establishment of rights and in the letters which were submitted after the two-month period for re-establishment of rights, do not require a different appreciation of the care required. Therefore, it does not have to be decided whether the further facts presented after the deadline for re-establishment of rights merely completed the original submission or altered its basis. Even if the further submissions were found to be admissible, in particular the fact that the responsible US representative, Ms Vogel, had not merely relied on the letter dated 25 February 2014 in the document system but had also consulted the assistant Dr Vaze and his notes, the appellant had not shown that all due care required by the circumstances had been taken. Contrary to the statements of the appellant, the responsible US representative was not allowed to rely on the notes of her assistant, Dr Vaze, who had communicated to her that, according to his notes, nothing needed to be done.

Regarding the duties of a representative, the established case law of the Boards of Appeal recognises

that not everything must be done personally by the representative; rather, routine tasks can be delegated to assistants. Nevertheless, representatives cannot relieve themselves of the responsibility for carrying out tasks which, by reason of qualification, fall upon them personally, such as, for example, assessing whether everything has been done to observe a time limit (R 18/13, reasons 21). If the representative delegates such tasks to an assistant or relies on the assistant's notes, and if the assistant makes an error in the course of that work which results in the failure to observe a time limit, the representative cannot establish that they took all due care required by the circumstances. Rather, once the representative gets the file on their desk for their own action, in order to comply with the relevant time limit, responsibility passes to that representative in all respects. The administrative system has worked satisfactorily in so far as the case has been forwarded to the representative. Once it is in the representative’s area of responsibility, it is recognised in the case law of the Boards of Appeal that it is part of the general duties of the representative to perform an own assessment irrespective of the reliability of the assistant (R 18/13, reasons 21; T 439/06, OJ EPO 2007, 491, reasons 10; T 1561/05, reasons 2.3.2; J 1/07, reasons 4.8). This also applies if the the representative's workload is high due to a transfer of cases from another attorney, because a high workload does not absolve a representative from responsibilities or lessen the degree of due care required.

1.2.5 **Unachievably high duty for the representative**

This requirement of due care - contrary to the appellant's line of argument - does not implement an

unachievable high duty or an overly strict approach but is in line with the intention of the legislator as reflected in the clear wording of Article 122(1) EPC. This article clearly refers to "all due care required by the circumstances having been taken" and not "all due care having been taken *most of the time*".

Furthermore, the exception from the high standard of due care is only available for assistants who are merely carrying out routine duties; it is not available for representatives who are entitled to act on behalf of the applicant (R 18/13, reasons 21). In the exercise of their duty of care, a representative who is responsible for the client and acts on behalf of it is not to be equated with a mere assistant (R 18/13, reasons 19). Being therefore different from an isolated mistake that an assistant might make under certain circumstances, such a mistake is not excusable if made by the representative (R 18/13, reasons 19; T 198/16, reasons 3.2.1 (a)).

A historical interpretation of the law as made by the Enlarged Board of Appeal in R 18/13 shows that the reports on Article 122 EPC, only state that "the Conference did not want to rule out that an employee could be excused", while the possibility of apologising for any fault on the part of the applicant or the representative was not discussed. This means that an excuse for the representative's fault was out of the question.

The case law on "an isolated mistake in an otherwise satisfactory system" cannot thus be relied on to ignore a failure to act by the professional representative themselves. As a consequence, and as also acknowledged by the Enlarged Board of Appeal in R 18/13, an obvious

mistake – however isolated - by a representative in performing the assessment once they have received the file does not comply with the requirement of all due care (R 18/13, reasons 21).

1.3 Thus, the requirements for re-establishment of rights under Article 122(1) EPC are not fulfilled.

2. Rule 113 EPC

The appellant has not invoked any further deficiencies in the appealed decision. Nevertheless, the board notes that in the present case neither the names nor the signatures of the responsible examiners or a formalities officer are given. In decision J 16/17, it is stated that unless an exception under Rule 113(2) EPC applies, this is a procedural mistake because the requirements of Rule 113(1) EPC are not fulfilled (for more details see J 16/17, reasons 2, 3 and 5).

However, in the present case the appeal was not based on this deficiency. Furthermore, any relation to the refusal of the appellant's request for re-establishment of rights is not apparent neither has it been argued. Under these circumstances the board acknowledges special reasons and decides on the merits of the appeal instead of remitting it (Article 11 RPBA).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

C. Eickhoff W. Sekretaruk

Decision electronically authenticated