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Bezeichnung der Erfindung: A method and composition for regulating serum
Title of invention: calcium levels of mammals
Titre de l'invention :

Klassifikation / Classification / Classement : A61K 9/10, 37/30

ENTSCHEIDUNG / DECISION
vom / of / du 5 July 1989

Anmelder / Applicant / Demandeur : The Regents of the University of California

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Re-establishment of rights

EPÜ / EPC / CBE Article 122 (1) (2)

Schlagwort / Keyword / Mot clé : "Isolated mistake-restitutio" -
"date of removal of the cause of
non compliance"

Leitsatz / Headnote / Sommaire

Europäisches
Patentamt

Beschwerdekammern

European Patent
Office

Boards of Appeal

Office européen
des brevets

Chambres de recours



Case Number : J 27/88

D E C I S I O N
of the Legal Board of Appeal
of 5 July 1989

Appellant : The Regents of the University of California

Representative : Eric Potter & Clarcson
14 Oxford Street
Nottingham NG1 5BP (UK)

Decision under appeal : Decision of Receiving Section
of the European Patent Office
dated 08.06.88 rejecting request
for re-establishment of rights.

Composition of the Board :

Chairman : P. Ford
Members : L.C. Mancini
C.V. Payraudeau

Summary of Facts and Submissions

- I. This appeal is against the Decision of the Receiving Section dated 8 June 1988 refusing as inadmissible the application for re-establishment of rights dated 14 December 1987 concerning Euro-PCT application No. 86 904 723.3.

That application had been filed as PCT/US86/01553 with the US Patent Office, on 25 July 1986.

Priority was claimed from a US national patent application filed on 1 August 1985 and the international application was published with the international search report on 12 February 1987. All EPC Contracting States which were also PCT Contracting States (including Italy and the Federal Republic of Germany) were designated in the international application.

- II. On 17 March 1987, so that the application would enter the European phase, a European professional representative filed EPO Form but did not cross the box for the Federal Republic of Germany, did not enter Italy in the space reserved for States contracting to the PCT after the Form was printed (April 1982) and did not pay designation fees for those two countries, although he crossed the boxes for the eight other EPC Contracting States and paid the corresponding designation fees.

In so doing, the representative followed the order letter sent by the instructing US patent attorney. Unknown to him, that letter had accidentally omitted Italy and the Federal Republic of Germany from the list of EPC Contracting States to be designated.

III. The omissions came to light when one of the joint inventors received notification of the designation of inventors sent by the EPO on 25 June 1987 in accordance with Rule 17(3) EPC and noticed, that in the standard letter listing all the designated EPC Contracting States, Italy and the Federal Republic of Germany had been crossed out by the Office. The inventor sent a copy of this communication to the Appellant who received it on 25 September 1987 and in turn sent it to the US patent attorney who received it on 1 October 1987. On 16 October 1987 the US patent attorney checked his own records and, having discovered the omissions, immediately sent a telex to the European professional representative but as 16 October 1987 was a Friday and the telex arrived after office hours it was not considered until Monday 20 October 1987.

IV. The European representative at once sent a telex in reply pointing out that if the omitted designation of the two countries was due to an error, it might be possible to apply for re-instatement.

After the US attorney had informed the European representatives in a letter dated 21 October 1987 that the omission of the two countries was the result of an error and not a deliberate choice by the Appellant, on 14 December 1987 the representative filed an application under Article 122 EPC for re-establishment into the time limit for designating Italy and the Federal Republic of Germany and he paid the two designation fees without surcharge together with the fee for re-establishment of rights.

V. The representative argued that it was intended to maintain the designation of all EPC Contracting States and the omission of Italy and the Federal Republic of Germany was the result of a typographical error occurring when the US patent attorney prepared the letter of 5 March 1987

containing the instruction for the European representative. The letter was proof-read before despatch but the omission of the two States was not noticed.

VI. In the Decision under appeal, it was held that the application for re-establishment of rights had been filed too late (Article 122(2) EPC) since the removal of the cause of non-compliance with the time limit must have occurred on 25 September 1987 when the Appellant had been informed by the inventor that "two designations had been lost".

Even if the full implications and possible remedies of the situation were not immediately obvious to the Appellant, it was at least clear that Italy and Germany were deleted from the list of designated States. All information about non-payment of the two designation fees was available to the Appellant and its representatives. It followed that the question whether or not the Appellant fully understood the implications of the notice sent to the inventor did not prevent the two month time limit of Article 122(2) EPC from beginning to run from 25 September 1987.

VII. On 25 July 1988 the Appellant filed an appeal against this decision. The appeal fee was paid on 2 August 1988. The statement of grounds of appeal supported by written arguments, evidence and affidavits was filed on 3 October 1988.

VIII. In support of the admissibility of the application for re-establishment the Appellant contended, in particular, that the removal of cause of non-compliance did not occur until 20 October 1987, i.e. the date on which the European representative was made aware by the US attorney that it was the Appellant's intention to have Italy and the Federal

Republic of Germany designated in the EPC regional phase proceedings.

- IX. The evidence submitted, and in particular the US attorney's explanations, showed that the inventor did not understand the relevance of the notification received by him from the EPO and sent it to the Patent, Trademark and Copyright Office of the Appellant for them to query why the designations for Italy and the Federal Republic of Germany had been crossed out.
- X. It was submitted that the status of the two designations was not clear and therefore was not known to the Appellant's US attorney until he had checked with his legal assistant and consulted with the European representative, i.e. not until after 16 October 1987, when he first realised that the designation fees had not been paid within the required time period, as the result of an isolated error in the work of the normally efficient and reliable legal assistant.

From the US attorney's statements it appeared that the receipt by the Appellant of the inventor's letter on 25 September 1987 did not constitute removal of the cause of non-compliance since, at that time, the Appellant and his attorney still believed that Italy and the Federal Republic of Germany had been designated and were also unaware that the deadline for paying designation fees had not been met. The notice sent under Rule 17(3) EPC to the inventor had no more than raised a question in the Appellant's mind and its receipt could not in itself constitute removal of the cause of non-compliance. As indicated from the memo dated 25 September 1987, sent from the Appellant to the attorney, the Appellant did not understand the Rule 17(3) notice and sought clarification. Thus, until that clarification was given by the European

representative (rather than elucidated by the US attorney) the Appellant and the US attorney remained in ignorance of the non-compliance with the time period for payment of the designation fees.

- XI. During the oral proceedings which were held on 5 July 1989, the US patent attorney explained that he had himself perused the memo of the Appellant on 5 October 1987. He was at this time under the strong impression that the ten European countries had been designated and after having examined the notice sent to the inventor and consulted his documentation about such notices was convinced that this form had no legal significance as regards the designation of EPC Contracting States. Consequently, he considered the matter as purely formal and thought best to wait for the return of the legal assistant, who was at the time on holiday, to clarify the question and answer the Appellant. As he was himself on holiday until the 13 October 1987 and had had on his return a heavy workload to attend to, it was only on the 16 October 1987 that he re-examined the question with the legal assistant and discovered then the error which had been made.

The US patent attorney also gave a detailed explanation of the procedure of his firm for instructing the filing of European patent application. He explained that:

- upon request from a client the firm's legal assistant was instructed to contact a European representative and request that a European patent application be filed;
- the legal assistant then prepared a request letter in which the European representative was instructed to file the European patent application;

- the instruction letter was reviewed by the patent attorney prior to its being sent, to insure accuracy of the request. In the present case, although he had personally made this review he had not detected the omissions of the Federal Republic of Germany and Italy.
- when the European representative confirmed that the European patent application had been filed, the legal assistant checked the confirmation with the request letter and, finally, sent a letter to the client confirming that the European application had been filed. This was the reason why the assistant had not been able to detect the initial error.

The practice was to list individually each of the European countries in the request letter for which a designation fee was to be paid. This practice was effective because the firm had filed many foreign applications and this was the first and only instance of error in designation.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. **Admissibility of the application for re-establishment of rights.**
 - 2.1 In accordance with Article 122(2) EPC, an application for re-establishment of rights must be filed within two months of the date of removal of the cause of non-compliance with the time limit.
 - 2.2 In the present case, the application was filed on 14 December 1987. This means that this application is admissible only if the Board is able to find that the cause

of non-compliance had been removed on or after 14 October 1987.

- 2.3 According to the established case law of the Boards of Appeal, the removal of the cause of non-compliance is a question of fact and occurs on the date on which the responsible person (i.e. the patent applicant or proprietor or his authorised agent, as the case may be) is made aware of the fact that a time-limit has not been observed (T 192/82, OJ EPO 1985, 189; J 9/86 dated 17 March 1987. Reasons, paragraph 8, not published).
- 2.4 The Receiving Section has found that this date was the date of receipt by the Appellant of the letter from the inventor to which was annexed a copy of the notice of inventorship, i.e. on 25 September 1987, so that the application for re-establishment of rights was inadmissible.
- 2.5 On the other hand, the Appellant has argued that the date of removal was the date on which the European representative confirmed to the US attorney that designation of the Federal Republic of Germany and Italy had not been made and was no longer possible except by way of re-establishment of rights, i.e. 20 October 1987.
- 2.6 After careful consideration of all the facts, the Board has reached the conclusion that the responsible person in the present case was neither the Appellant nor the European representative but the US patent attorney who was the authorised agent of the Appellant and was duly empowered to take all necessary measures to obtain designation of the Federal Republic of Germany and Italy since there has never been any doubt that such instructions had been given by the Appellant to the US attorney. In these circumstances, contrary to the finding of the Receiving Section, the date of removal of the cause of non-compliance cannot be the

date of receipt of the letter of the inventor by the Appellant but only the date at which the US patent attorney became aware of the omission made by the legal assistant from the order letter sent to the European representative.

2.7 However, in the Board's opinion, this date of removal of the cause of non-compliance can only be admitted as the effective date of removal if the responsible person (i.e. the US patent attorney) had exercised all due care in this respect. In other words, the Board considers that the effective date of removal of the cause of non-compliance is not necessarily the date at which the omission has been discovered but the date at which it should have been discovered if all due care had been observed.

2.8 In the present case, the US attorney's office received the Appellant's letter on 1 October 1987. The attorney himself only received it on 5 October 1987, (3 and 4 October being respectively a Saturday and a Sunday).

It results from the statements made by the US attorney during the oral proceedings that he considered that an explanation had to be given to the Appellant concerning the declaration of inventorship but the fact that the Federal Republic of Germany and Italy had been crossed out on the form did not appear to him as having any particular significance, because he was convinced that these countries had effectively been designated. Under this impression and after having consulted such documentation upon the European patent system as was available to him which confirmed him in his opinion that the matter was purely formal and of secondary importance, he considered it advisable to wait for the return of the legal assistant, who was on holiday, and to examine the matter further with her in order to answer the question raised by the Appellant.

Since he had not considered the matter as specially important, he did not re-examine the question immediately on the return of the legal assistant on 13 October 1987 but only during the normal course of business on the 16 October 1987.

- 2.9 The Board is convinced of the reliability of the explanation given by the US patent attorney and in particular of the fact that he had not been made aware that there was a possibility that the Federal Republic of Germany and Italy had not been designated when he had first considered the Appellant's query and that if he had had any doubt he would have acted immediately, as he did on 16 October 1987.

For these reasons, the Board considers that the effective date of removal of the cause of non-compliance is properly to be considered as 16 October 1987 and that consequently the application for re-establishment of rights filed on 14 December 1987 was filed within the time limit of Article 122(2) EPC:

- 2.10 According to the established case law of the Boards of Appeal, the provisions of Article 122 EPC are applicable to Euro-PCT applicants for the time limits which have to be respected when international applications are transformed into European applications (cf. J 6/79, OJ EPO 1980, 225).
- 2.11 The application for re-establishment of rights is therefore admissible.

3. Receivability of the application for re-establishment of rights

- 3.1 Although the Receiving Section has not decided on the receivability of the application, the Board has decided, in

application of Article 114(1) EPC, not to remit the case to the first instance, but to decide itself on the merit of the case in order to avoid further delays.

- 3.2 It results clearly from the evidence produced in the case that the clerical error was an isolated mistake within a normally satisfactory system made by a competent and usually reliable legal assistant, a mistake which the attorney had not discovered although he had received and signed the order letter. Such mistakes are unavoidable and Article 122 EPC is intended to ensure that such mistakes do not result in the loss of substantive rights (cf. J 2/86, J 3/86 OJ EPO 1987, 36).
- 3.3 The Board is satisfied that, in all the circumstances, all due care had been exercised by the Appellant's US patent attorney and that therefore the Appellant should be restored in its rights in respect of the designation of the Federal Republic of Germany and Italy.
- 3.4 In its decision the Receiving Section has noted without comment, that the designation fees for the Federal Republic of Germany and Italy had been paid by the Appellant without surcharge.
- 3.5 In this respect the Board observes that the possibility of re-establishment by paying the fee with a surcharge within two months after the expiry of the normal time limit (Rule 85(a)(2) EPC) (a limit which, in any case, had already expired at the time when the fees were paid), is only an alternative and simpler remedy offered to the Euro-PCT applicant, but that the applicant who applies for re-establishment of rights under Article 122 EPC does not have to pay any surcharge (cf. J 5/80, OJ EPO 1981, 342, point 13).

Order

For these reasons, it is decided that:

The decision under appeal is set aside and the Appellant is re-established in its rights.

The Registrar:

J. i/He

The Chairman:

Kevin Ford