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D E C I S I O N
of 11 May 1994

Case Number: J 0028/92 - 3.1.1

Application Number: 91304692.6

Publication Number: 0481585

IPC: G01V 1/00

Language of the proceedings: EN

Title of invention:
Seismic surveying

Applicant:
ARCO British Limited

Opponent:
-

Headword:
-

Relevant legal norms:
EPC Art. 122
EPC R. 101(4)

Keyword:
"Missed Time limit for filing designation of inventor"
"All due care (yes)"
"Misinterpretation of provision of EPC not without basis or unreasonable"
"Re-establishment (yes)"

Decisions cited:
J 0007/82, J 0027/88, T 0191/82, J 0005/80, J 0002/86,
J 0003/86, J 0031/89

Catchword:
-



Case Number: J 0028/92 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 11 May 1994

Appellant: ARCO British Limited
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Guilford
Surrey GU1 1UE (GB)

Representative: Smith, Martin Stanley
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Decision under appeal: Decision of the Receiving Section of the European Patent Office dated 2 April 1992 rejecting the request for re-establishment of rights pursuant to Article 122 EPC.

Composition of the Board:

Chairman: R. L. J. Schulte
Members: G. Davies
J. C. M. de Preter

Summary of Facts and Submissions

I. On 23 May 1991, the Appellant filed European patent application No. 91 304 692.6, claiming priority from an application filed in the United Kingdom on 25 May 1990. When the application was filed, the designation of the inventor and the representative's authorisation were missing.

On 20 June 1991, the EPO sent a notification under Rule 42 EPC to the representative reminding him that the deadline for filing the designation of inventor was 16 months from the priority date, namely 25 September 1991.

On 20 September 1991, the authorisation and certified copy of the priority document were duly filed, but the designation of inventor was still missing.

On 7 October 1991, the EPO sent a communication pursuant to Rule 69(1) EPC to the applicant's representative informing him that the application was deemed to have been withdrawn for failure to file the designation of inventor. The communication was received in the office of the representative on 9 October 1991 but not seen by him personally until 14 October 1991, on his return from holiday.

On 13 December 1991, the applicant's representative filed a request for re-establishment of rights under Article 122 EPC and filed the designation of inventor. The respective fee was paid the same day.

In support of the request for re-establishment of rights, the Applicant's representative stated (in his original request and in further evidence submitted in response to a notification from the Receiving Section to

the effect that it intended to reject the request) that he had awaited receipt of the signed authorisation from the Applicant before filing the designation of inventor and priority document, believing that otherwise the filing of these documents would be deemed not to have taken place pursuant to Rule 101 (4) EPC. The representative had written a file note to his secretary, therefore, instructing her to contact the applicant again to obtain the authorisation and to file it on 20 August 1991, as requested by the Receiving Section, or, at the latest, with the declaration of inventor and priority document (both of which were already on file) by 25 September 1991. The secretary had followed these instructions but omitted to include the declaration of inventor together with the other documents, which had been duly filed on 20 September 1991. The secretary was mature, experienced and very competent. The mistake on her part was uncharacteristic.

II. In a decision dated 2 April 1992, the Receiving Section refused the application for re-establishment of rights for the following reasons: in its opinion, the applicant's representative had not taken all the due care required by the circumstances; he should have been aware that a designation of inventor may be validly filed before the required authorisation has been filed; had the representative exercised all due care, the declaration of inventor could have been filed on time together with the authorisation and priority document on 20 September 1991.

III. By letter dated 1 June 1992, received by the EPO by facsimile the same day, the Appellant's representative filed a notice of appeal against this decision and paid the appeal fee. A written statement of grounds of appeal was filed by facsimile on 12 August 1992. Subsequently,

in response to a communication of the Legal Board of Appeal pursuant to Article 110(2) EPC dated 11 February 1993, the Appellant's representative provided further evidence concerning the circumstances of the case and requested oral proceedings. Oral proceedings were held on 11 May 1994.

IV. The arguments of the Appellant's representative in support of the appeal may be summarised as follows: his contact for the application in question was Dr M. of Oxford University; he was not in direct contact with the Appellant. He had been concerned that this circumstance, taken together with the holiday period, could mean that the signed authorisation would not be received by 20 August 1991. He had understood that, were he to file the designation of inventor and priority document, which were due to be filed by 25 September 1991, without the authorisation, there was a danger that they would be disregarded pursuant to Rule 101(4) EPC. He had been persuaded that this was the case by the final paragraph of a letter dated 20 June 1991 from the EPO requesting the filing of the authorisation, in which it was stated:

"If the authorisation is not filed (in the prescribed form) in due time, any procedural steps other than the filing of the European application taken by the representative will be deemed not to have been taken (Rule 101(4) EPC)."

Furthermore, the representative submitted that the view he had formed was not an unreasonable interpretation of Rule 101(4) EPC. Under these circumstances, it had been prudent to make arrangements to ensure that the designation of inventor and the priority document were filed together with the signed authorisation.

To that end, he had given written instructions to his secretary to contact Dr M. again, to ask him to get the authorisation signed by the Appellant and to return it in time to be filed by 20 August 1991, as requested by the Receiving Section. If late, the designation of inventor and priority document should be filed together with the authorisation by the due date of 25 September 1991. In the event, the authorisation had been received and sent to the EPO together with the priority documents on 17 September and received by the EPO on 20 September.

In spite of these written instructions, his secretary had failed to mention or include the designation of inventor with the letter she had prepared to accompany the documents. This was an isolated mistake on the part of the secretary, who had worked for the representative since September 1990, had been properly instructed and was normally reliable. She was an experienced colleague, with 20 years secretarial and administrative experience, who had helped the representative with the filing and prosecution of patent applications before the patent offices of the UK and USA as well as before the EPO and had never previously made a mistake. She performed her tasks with extreme competence and was fully trustworthy. In the representative's view, the instructions given to her were sufficient evidence of due care on his part. When he had signed the letter, he had checked to see that the documents mentioned therein were attached. He had not considered it necessary to double check with the file that the letter and its attachments were in order because he had confidence from experience that his secretary would have carried out her instructions correctly. A representative should not be expected to check everything done by a competent and experienced employee.

The representative also supplied evidence of the diary system in operation in his office for monitoring the various time limits prescribed by the EPC, including the diary entries relevant to the present case. The diary system was operated by the records manager of the representative's firm who had twenty years experience in patents and was extremely reliable. The diary entries relevant to this case provided evidence of due care in relation to the prosecution of the application.

Reasons for the Decision

1. The appeal is admissible.

2. The application for re-establishment of rights fulfils the conditions laid down in paragraphs (2) and (3) of Article 122 EPC and is admissible. In particular, the Board finds that the date of the removal of the cause of non-compliance with the time limit was the date that the representative personally became aware of the fact that the time limit had not been observed, that is, 14 October 1991, when the representative, who was the person responsible, returned from holiday and saw the EPO notification that the application was deemed withdrawn for failure to file the designation of inventor, dated 7 October 1991 (cf. J 07/82 (OJ EPO 1982, 391), J 27/88 of 5 July 1989 (unpublished), and T 191/82 (OJ EPO 1985, 189)).

3. Article 122 EPC provides for an applicant who, in spite of all the due care required by the circumstances having been taken, was unable to observe a time limit vis-à-vis the EPO, thereby losing a right or other redress, to have his rights re-established upon application subject to the conditions referred to in paragraph 1, above, being met. It is the established case law of the Boards

of Appeal that a request for re-establishment of rights cannot be acceded to unless the representative himself can show that the due care required of the applicant or proprietor by Article 122(1) EPC has been taken. It is incumbent on the representative to properly instruct and to exercise reasonable supervision over the work of any assistant to whom the performance of routine tasks has been entrusted (J 05/80, OJ EPO 1981, 343). Moreover, Article 122 EPC is intended to ensure that loss of rights does not result from an isolated mistake in an otherwise satisfactory system; thus, an appellant or its representative must be able to demonstrate that a normally effective system for monitoring time limits prescribed by the EPC was established at the relevant time in the office in question (J 02/86, J 03/86 (OJ EPO 1987, 362)).

4. Having duly considered the evidence submitted in support of the application for re-establishment and of this appeal, the Board is satisfied that the Appellant's representative exercised all the due care required by the circumstances in this case. He has satisfactorily demonstrated that he has established in his office a normally effective system for monitoring the various time limits prescribed by the EPC (cf. J 02/ and J 03/86, **supra**). Likewise, he has established that he personally took all the due care required by the circumstances to ensure that the designation of inventor was filed in due time. He gave written instructions to his secretary telling her exactly what needed to be done by which deadlines. The Board is satisfied also that the secretary was a suitable person to be entrusted with the responsibility for carrying out such a task in accordance with his instructions. The person in question was experienced and had shown herself to be trustworthy in handling such matters, having made no previous

mistake in the year she had worked for the representative. He was entitled, therefore, to rely on her to perform a routine task for which he had given her precise instructions, without double-checking the file to verify that the letter and its attachments were in order. Moreover, it is the established case law of the Boards of Appeal that the same strict standards of care are not expected of an assistant as are expected of the applicant or his representative (J 05/80, *supra*). The oversight on the part of the secretary in failing to fully carry out the representative's instructions may in this case be regarded as an isolated procedural mistake within a normally satisfactory system (cf. J 2/86 and 3/86, *supra*).

5. The Receiving Section found in its decision (see paragraph II, *supra*), that a professional representative should be aware that a designation of inventor may be validly filed before the authorisation. The representative has pointed out that, at the time, he had interpreted Rule 101(4) EPC as meaning that, if he were to file the designation of inventor and priority document before the signed authorisation, these would be disregarded in accordance with Rule 101(4) EPC. He suggested that this was a reasonable interpretation of Rule 101(4) EPC, which he had understood also to be the meaning of the reference to that Rule by the Receiving Section in its letter of 20 June 1991 requesting him to file the authorisation.

Rule 101(4) provides that:

"If the authorisation is not filed in due time, any procedural steps taken by the representative other than the filing of a European patent application shall, without prejudice to any other

legal consequences provided for in the Convention, be deemed not to have been taken."

The Board, like the Receiving Section, finds that this provision has no legal relevance in this case because in fact the authorisation was filed in due time and an earlier filing of the designation of inventor without an authorisation would have been cured by the later filing of the authorisation, because the filing of an authorisation has retroactive effect.

With regard to the representative's interpretation of this Rule of the EPC, the Board observes that, in the present case, the representative's interpretation of the EPC was not the result of, and did not lead to, a failure to exercise all the due care required by the circumstances. Moreover, the failure to file the declaration of inventorship on time was not the direct result of the representative's interpretation of Rule 101(4). While it had led to delay in the filing thereof, the missed time limit was actually the result of the failure of the representative's secretary to correctly carry out his instructions.

The Board considers that there is no basis, therefore, for penalising the representative for having arrived at a not unreasonable interpretation of a Rule of the EPC, which subsequently turned out to be wrong. The Board accepts also that the Receiving Section's letter of 20 June 1991 was phrased in such a way as to encourage such an interpretation of the Rule. The representative had exercised due care in giving instructions to ensure that the documents were filed together, as he thought was necessary in accordance with his interpretation of Rule 101(4).

The Board finds that the representative's misinterpretation of the EPC in this case is to be distinguished from J 31/89 of 31 October 1989 (unpublished), where this Board found that an erroneous interpretation of the EPC on the part of a representative cannot be excused. In that case, the representative had had a mistaken understanding of what the Board described as a very clear provision of the EPC and his lack of knowledge of the provisions of the EPC in itself was held to show a lack of due care (cf. paragraph 3 of the Reasons for the Decision). In the present case, the misinterpretation of Rule 101(4) EPC by the representative was not without basis or unreasonable. It would be unreasonable to apply the principle that everyone is presumed to know the law even to circumstances where there may be genuine doubt and differences of opinion about the meaning of a legal provision.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The appellant is re-established in his rights.

The Registrar

The Chairman

M. Beer

R. Schulte