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D E C I S I O N
of 5 July 1995

Case Number: J 0013/93 - 3.1.1

Application Number: 87310640.5

Publication Number: 0274853

IPC: A01B 59/048

Language of the proceedings: EN

Title of invention:

Apparatus for the frontal connection of equipment to agriculturally usable motor vehicles, in particular farming tractors

Applicant:

J. I. Case GmbH

Opponent:

-

Headword:

Re-establishment/J. I. Case GmbH

Relevant legal provisions:

EPC Art. 122

EPC R. 78(3), 67

Keyword:

"Removal of the cause of non-compliance"

"Incorrect reference number"

"All due care (yes)"

"Re-establishment (yes)"

"Reimbursement of appeal fee (yes)"

Decisions cited:

J 0005/80, J 0007/82, J 0015/84, J 0002 and

J 0003/86, J 0009/86, J 0002/87, J 0003/87, J 0027/88,

J 0001/89

Catchword:

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Case Number: J 0013/93 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 5 July 1995

Appellant: J. I. Case GmbH
Industriestrasse 39
D-41460 Neuss (DE)

Representative: Orr, William McLean
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Decision under appeal: Decision of the Formalities Section of the
Examining Division of the European Patent Office
dated 30 April 1993 holding the application for
re-establishment of rights with respect to
European patent application No. 87 310 640.5
inadmissible.

Composition of the Board:

Chairman: R. L. J. Schulte
Members: G. Davies
J. P. B. Seitz

Summary of Facts and Submissions

- I. The European Patent application No. 87 310 640.5, filed on 3 December 1987 and claiming priority from two German applications dated 22 December 1986 and 12 June 1987 respectively, was published on 20 July 1988 (publication No. 0 274 853).
- II. By registered letter dated 20 April 1990, the EPO sent the applicant a communication pursuant to Article 96(2) and Rule 51(2) EPC, indicating that the application did not meet the requirements of the EPC and giving the applicant a period of four months from the date of notification of the communication in which to file observations and remedy the deficiencies. The applicant contends that this communication was never received.
- III. On 5 October 1990, the EPO sent a further communication by registered mail to the applicant informing him that the application had been deemed withdrawn for failure to reply to the communication of 20 April 1990.
- IV. On 10 January 1991, not having had any reply to its communication of 5 October 1990, the EPO closed the procedure in respect of the application with legal effect from 31 August 1990. The fourth renewal fee, which had been paid on 11 December 1990, was not refunded.
- V. On 9 December 1991, the fifth renewal fee was paid; the EPO refunded the fee on 10 January 1992.
- VI. By letter filed on 23 March 1992, the applicant's representative applied for re-establishment of rights and paid the respective fee. At the same time, the applicant filed a reply to the invitation to file

observations contained in the communication of 20 April 1990 from the Examining Division. In the request for re-establishment, the applicant submitted that the failure to reply in due time to the communication dated 20 April 1990 was due to the following circumstances.

There was no record that this particular communication had ever been received by the applicant's representative. At the time, the representative in charge of the case had been Mr Geldard. He had retired on 30 April 1991, since when Mr Orr had taken over the case. The present application was one of two applications filed by sister companies, this being filed by the applicant, J I Case GmbH and the other by J I Case Company (no. 88 301 717.0). The latter application had been expressly abandoned and the file at the representative's office closed on 8 December 1988. It now was apparent that the two communications from the EPO dated 20 April 1990 and 5 October 1990 bore the representative's file reference for the abandoned application instead of that for the present application. According to the evidence of Mr Geldard, the communication of 5 October 1990 was received and marked for filing with communications concerning abandoned cases, it being understood to relate to the abandoned application.

It was not therefore until the repayment of the fifth renewal fee was received on 5 February 1995, that Mr Orr realised that anything was amiss with the present application. After he took over the case in May 1991, the file had been routinely inspected at intervals to check that no examination report or other communication from the EPO remained unanswered. Following a file inspection on 8 July 1991, when it was noted that the latest document on file was an authorisation to pay the examination fee on 10 January 1989, it was assumed the

first examination report had not yet issued, the period of two and a half years since payment of the fee not being thought to be an excessive or unusual delay such as to cause enquiry to be made at the EPO. The next routine file inspection had been set therefore in computer records to take place on 20 July 1992.

As soon as the repayment of the fifth-year renewal fee had been brought to Mr Orr's attention on 5 February 1992, he made enquiries at the EPO and was duly supplied with a copy of the communication dated 20 April 1990 on 6 February 1992. The applicant submitted that this date represented the first actual notification of the examiner's report to the applicant and represented the date of the removal of the cause of non-compliance with the time limit for reply thereto, within the meaning of Article 122 (2). The request for re-establishment had been filed within two months of that date together with the reply to the examiner's report, so that the omitted act had also been completed within the two months period as required likewise by Article 122 (2). Evidence was also supplied concerning the efficiency of the systems operating at all times in the offices of the applicant's representatives and the due care taken by them in relation to this case and generally.

The applicant's representative argued alternatively that the delay in filing a request for re-establishment of rights had been due to the failure of the EPO to refund the fourth-year renewal fee. Had it done so, the facts of the case would have come to light one year earlier and steps would have been taken to file the request in time.

The applicant's representative subsequently on 19 February 1993 wrote to the EPO concerning the uncertainty whether the examination report of 20 April

1990 had ever been received at its office and asked the EPO if it could confirm that the letter had been received in view of the fact that it had been despatched by registered mail. The EPO responded on 4 March 1993, stating that it was no longer possible to initiate an enquiry with the postal authorities as almost three years had elapsed since the despatch of the communication in question.

- VII. By decision dated 30 April 1993, the Formalities Section of the Examining Division held that the application for re-establishment of rights was inadmissible because it had been filed outside the period of one year immediately following the expiry of the unobserved time limit provided for by Article 122(2), third sentence. According to the decision, the unobserved time limit in question was the deadline for responding to the communication dated 5 October 1990 (effective date 15 October 1990) containing the notification that the application had been deemed withdrawn, i.e. 17 December 1990 (15 December being a Saturday). Moreover, the Examining Division stated that, even if the request for re-establishment had been admissible, it would not have been allowed because not all the due care required by the circumstances had been taken by the applicant's representative. The failure of the EPO to refund the fourth renewal fee did not affect that situation.
- VIII. On 12 June 1993, the applicant filed a notice of appeal against the decision of the Examining Division. The appeal fee was paid on 22 June 1993 and the statement of grounds of appeal was filed on 6 September 1993.
- IX. In the grounds of appeal, the appellant argued essentially as follows:

The period for replying to the examiner's report dated 20 April 1990 did not begin to run until 6 February 1992, the date when a copy thereof had been faxed to the representative by the EPO and he became aware of the cause of non-compliance with the time limit for the first time. The application for re-establishment had therefore been made in time and the steps taken by the EPO leading to the closure of the application in August 1990 should be treated as a nullity.

The decision under appeal proceeded on the assumption that the examiner's report was in fact notified to the appellant's representative on or about its effective date (30 August 1990). However, there was no evidence that the report had in fact been received at the time. On the contrary, the appellant had submitted evidence to show that the communication would appear not to have been received. The appellant submitted therefore that it could not be criticised for failing to reply to a document until it was shown that it had actually received the communication in question, referring to Rule 83 (2) and J 15/84 of 4 June 1985 (EPOR 1979-1985 A 226).

Alternatively, the appellant argued that, even if the communication had been received, which was disputed, it was likely that it would have been allocated to the wrong file because the EPO had used the incorrect reference number. It was submitted, therefore, that a communication with a wrong reference number was misleading and should be treated as void, relying on J 2/87 (OJ EPO 1988, 330), J 3/87 (OJ EPO 1989, 3) and J 1/89 (OJ EPO 1992, 17).

The appellant argued also that the subsequent communication dated 5 October 1990 should be treated as a nullity in view of the fact that the earlier

communication to which it related had not been received. Moreover, the notice of 5 October also bore an incorrect reference resulting in it having been misfiled. It was submitted that a communication with a wrong reference was misleading and therefore void.

The appellant also submitted that, if contrary to its submissions, the Board were to accept the Examining Division's finding that the request for re-establishment was inadmissible because it should have been filed within one year of the deadline for replying to the communication of 5 October 1990 (ie by 17 December 1991), then the appellant relied on the failure of the EPO to refund the fourth-year annuity fee paid on 11 December 1990. Had that refund been made early in 1991, it would have been clear to the appellant that something had gone seriously wrong and he would have taken steps, as he had done following repayment of the fifth-year renewal fee, to remedy the situation. Accordingly, the application for re-establishment would have been made twelve months earlier and been in time. It was submitted in this connection that the appellant should not be prejudiced by a default of the EPO.

Reasons for the Decision

1. The appeal is admissible.

2. The application for re-establishment was held by the Examining Division not to have been filed within two months from the removal of the cause of non-compliance with the time limit (Article 122(2) EPC). According to its decision, the date of the removal of the cause of non-compliance was the date of notification of the communication dated 5 October 1990 informing the

appellant that the application had been deemed withdrawn, ie 15 October 1990. The deadline for filing a request for re-establishment was in its view therefore 17 December 1990.

3. The appellant on the other hand contends that the date of the removal of the cause of non-compliance was 6 February 1992, the date upon which he had received for the first time a copy of the EPO communication containing the examiner's report dated 20 April 1990 from the EPO, and that that communication had never been received in his office.

4. According to Rule 78(3) EPC, where notification is effected by registered letter, in the event of a dispute as to receipt it is incumbent on the EPO to establish that a letter has reached its destination or to establish the date on which the letter was delivered to the addressee, as the case may be. In this case, the EPO acknowledged in its communication of 4 March 1993, addressed to the appellant that, since almost three years had elapsed since the despatch of the communication dated 20 April 1990, it was no longer possible to initiate an enquiry with the postal authorities. The EPO was not able therefore to prove that the communication dated 20 April 1990 had been received by the appellant's representative. This being so, the Board finds that the Examining Division could not refer to 15 October 1990, the date of notification of the communication dated 5 October 1990 to the effect that the application had been withdrawn, as the date of the removal of the cause of non-compliance and the starting point for the two-month period for filing a request for re-establishment under Article 122(2) (J 15/84 of 4 June 1985, followed). Moreover, the communication was sent to the appellant with an

incorrect reference number. The representative in the present case therefore had not been informed that the application had been deemed withdrawn.

5. According to the submissions of the appellant, the two-month time limit began on 6 February 1992. The application for re-establishment of rights was received on 23 March 1992 and was therefore made in due time. The Board finds that 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, 6 February 1992 (cf J 07/82 (OJ EPO 1982, 391), T 191/82 (OJ EPO 1985, 189), J 9/86 of 17 March 1987 and J 27/88 of 5 July 1989 (both unpublished but cited in Schulte-Kartel EPÜ 119 to 122 Nos. 42 and 44)).
6. The Examining Division also held that, even if the application for re-establishment had been admissible, it would not have been allowed because not all the due care required by the circumstances had been taken by the appellant's representative.
7. 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 5, 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)).

8. Having duly considered the evidence submitted in support of the application for re-establishment of rights and of this appeal, the Board is satisfied that the appellant's representatives exercised all the due care required by the circumstances in this case. On this issue, the Board had the benefit of additional evidence which was not available to the Examining Division. The appellant's representative has satisfactorily demonstrated that there is established in his office a normally effective system for monitoring the various time limits prescribed by the EPC (cf J 02/ and J 3/86, *supra*). Since the EPO has not established that the examiner's report of 20 April 1990 was ever received at the appellant's office, the Board finds that the fact that the subsequent communication of 5 October 1990 was misfiled does not in all the circumstances amount to a lack of due care. The document carried an incorrect reference number, which by coincidence related to an abandoned application. It was not surprising therefore that the appellant's then representative, Mr Geldard, was misled by the incorrect reference and decided no further action was required in relation to that communication. Moreover, it was pointed out that it is not unusual to

receive a notice of a finding pursuant to Article 96(3) in the case of an abandoned application. The Board is satisfied that the misfiling of this document was an isolated mistake in an otherwise satisfactory system and resulted from Mr Geldard and his secretary being misled by the incorrect reference. In this connection, it is noted by the Board that the reference used by the EPO was a reference originally given by the appellant's representative on a letter relating to two applications, the present application and the application in the name of J I Case Company, subsequently abandoned. Subsequent communications relating to the present application sent by the appellant to the EPO bore the correct reference number. However, throughout the proceedings and until this application for re-establishment of rights was made, the EPO used the incorrect reference on all communications sent to the appellant's representative (five in all). This unfortunate state of affairs contributed to the mistakes made in this case.

9. The Board has also taken into account the evidence that the file relating to this application was monitored at regular intervals by first Mr Geldard and then Mr Orr and that it was concluded by them on the basis available to them on the file that the Examiner's Report was still awaited. It is satisfied that there was no reason for them to have concluded otherwise and that all the due care required by the circumstances was taken by them in monitoring the file.
10. The Board is satisfied, therefore, that in spite of all the due care required by the circumstances having been taken by the appellant's representative, he was unable to observe the time limit for replying to the communication of 20 April 1990. The application for re-establishment of rights is allowed.

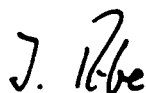
11. The Board has noted also that, contrary to Rule 78(3) EPC, the Examining Division took its decision without establishing that the communication dated 20 April 1990 reached its destination, in spite of the existence of a dispute on the matter with the appellant. As the Board found in similar circumstances in J 15/84, *supra*, that must be considered a substantial procedural violation within the meaning of Rule 67 EPC, giving rise to a refund of the appeal fee.

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.
3. The case is remitted to the Examining Division for further prosecution.
4. Reimbursement of the appeal fee is ordered.

The Registrar:



J. Rückerl

The Chairman



R. Schulte