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**D E C I S I O N**  
**of 9 April 1997**

**Case Number:** J 0027/95 - 3.1.1

**Language of the proceedings:** EN

**Appellant:**

Blanco Jiménez, Araceli

**Headword:**

Professional representation by legal practitioners

**Relevant legal provisions:**

EPC Art. 134(1) to (4), (7)

**Keyword:**

"Entitlement to undertake representation"  
"Legal practitioner qualified in a Contracting State"  
"Place of business in a Contracting State"

**Decisions cited:**

J 0019/89



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Boards of Appeal

Chambres de recours

Case Number: J 0027/95 - 3.1.1

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.1  
of 9 April 1997

**Appellant:** Blanco Jiménez, Araceli  
c/Panama 14  
ES-28036 Madrid (ES)

**Representative:** -

**Decision under appeal:** Decision of the Legal Division of the European Patent Office dated 11 May 1995 refusing the request to be recognized as a legal practitioner entitled to undertake representation before the European Patent Office in accordance with Article 134(7) EPC.

**Composition of the Board:**

**Chairman:** J.-C. Saisset  
**Members:** B. Schachenmann  
G. Davies

## Summary of Facts and Submissions

- I. On 9 June 1994 the appellant, a Spanish citizen, asked the EPO to recognize her as a legal practitioner entitled, pursuant to Article 134(7) EPC, to undertake professional representation in proceedings before the EPO. She presented documents establishing that she had obtained a law degree (*Licenciado en Derecho*) from the University of Madrid and was also admitted as a professional representative before the Spanish Patent Office.
- II. The Legal Division informed her on 17 June 1994 that she was not entitled to act as a professional representative before the EPO. The evidence submitted proved neither that she was a practising lawyer registered as such in a lawyers' association nor that she had her place of business in a Contracting State. Furthermore, since in Spain lawyers were not as such entitled to act as professional representatives before the Spanish Patent Office, Article 134(7) EPC was not applicable to them.
- III. On 12 January 1995 the appellant formally requested to be recognized as a legal practitioner within the meaning of Article 134(7) EPC and to be allowed to undertake professional representation in proceedings established by the EPC. Should this request not be allowed, an appealable decision was applied for.
- IV. Such decision was issued by the Legal Division on 12 April 1995. According to its findings Article 134(7) EPC only applied to legal practitioners entitled to act as representatives before their national Patent Offices by virtue of the exercise of the profession of legal practitioner "as such". However, in Spain legal practitioners were not as such entitled to act as

representatives in patent matters. To be allowed to act as a representative before the Spanish Patent Office any person, including legal practitioners, needed to be qualified as *Agente de la Propriedad Industrial*. In these circumstances, Article 134(7) EPC did not apply to legal practitioners in Spain. Consequently, the appellant's requests were rejected.

V. The present appeal lies from that decision, the notice of appeal and appeal fee having been filed on 31 May 1995. In her statement of grounds dated 9 June 1995 the appellant argued that the provisions of Article 134(7) EPC should not be interpreted narrowly. In particular, the wording of these provisions did not contain any limitation to legal practitioners entitled "**as such**" within their States to act as professional representatives in patent matters. In Spain the registration as *Agente de la Propriedad Industrial* was a pure formality completed within one afternoon upon production of evidence of the requisite university degree. As a legal practitioner qualified in Spain and registered *Agente de la Propriedad Industrial* she therefore complied with all requirements under Article 134(7) EPC and should be admitted as a professional representative before the EPO.

VI. In a communication dated 31 January 1997, the Legal Board draw the appellant's attention to the fact that, in order to be recognized as a legal practitioner under Article 134(7) EPC, she had to comply with the following requirements:

- (a) to be qualified as a legal practitioner in Spain, i.e. to be member of a *Colegio de Abogados*;
- (b) to have a place of business in Spain;

- (c) to be entitled to act as a representative in patent matters in Spain.

The appellant was requested to establish that she indeed complied with all these requirements. With regard to the last-mentioned condition the Board considered it doubtful whether, in the light of the *travaux préparatoires* of the EPC and the Spanish Law, the appellant's interpretation of Article 134(7) EPC could be followed.

- VII. In a letter dated 14 February 1997 the appellant informed the Board of her address in Spain and declared that her place of business was at that address. In a second letter filed on 13 March 1997 she added that the membership in a *Colegio de Abogados* in Spain was not required under Article 134(7) EPC. Nevertheless, she announced that evidence would be produced during the oral proceedings to the effect that she was indeed a member of a *Colegio*.

Furthermore, the appellant drew the Board's attention to a new Spanish Law of 26 November 1992 relating to general administrative procedure according to which a Spanish lawyer could represent a person before any authority including the Spanish Patent Office.

Therefore, she complied with the requirements of Article 134(7) EPC even in its narrow interpretation.

- VIII. At the oral proceedings held on 9 April 1997 the appellant presented a certificate of membership in the *Colegio de Abogados de Madrid* and a document of registration of an address in Madrid. The certificate of membership contained the statement that the appellant joined the *Colegio* on 25 March 1997 but was not a practising member thereof.

In reply to questions from the Board, the appellant conceded that she was not practising as a legal practitioner in Spain. However, she maintained that at her address in Madrid she worked as a representative in patent matters which, together with the membership in the *Colegio*, was sufficient for her to comply with the provisions of Article 134(7) EPC. Finally, she requested that the decision under appeal be set aside and that she be recognized as a legal practitioner within the meaning of Article 134(7) EPC.

### **Reasons for the Decision**

1. The appeal is admissible.
2. The issue to be considered is whether or not the appellant is entitled under Article 134(7) EPC to undertake professional representation in proceedings established by the EPC.
3. According to the practice of the EPO, legal practitioners who indicate their intention to undertake representation in proceedings before the EPO and present an authorization are entered in a register of legal practitioners, provided that they comply with the requirements of Article 134(7) EPC. The Legal Division is responsible for checking these requirements and for the registration of names in, or deletion from, the register of legal practitioners (cf. decision of the President of the EPO dated 10 March 1989 concerning the responsibilities of the Legal Division, point 1.1(c), OJ EPO 1989, 177).

However, the register of legal practitioners must be clearly distinguished from the list of professional representatives established in accordance with Article 134(1) to (4) EPC. Whereas, according to Article 134(4) EPC, the entry of a person's name in the list of professional representatives entitles them to act in all proceedings established by the Convention, the Convention does not contain any corresponding provision for legal practitioners. Their competence to undertake representation before the EPO is not general, but depends directly on their complying with the provisions of Article 134(7) EPC (cf. Mathély, *Le droit européen des brevets d'invention*, page 89; Van Empel, *The Granting of European Patents*, page 114f).

4. Thus, each time a legal practitioner makes a request to act as a professional representative in proceedings before the EPO, the Legal Division has the right to examine whether he or she satisfies the conditions under Article 134(7) EPC (cf. *travaux préparatoires*, Working Group "Patents", Report on the Session of 11 January 1962, doc. IV/215/62-D, page 41). If such a request is refused, it can be refiled and reconsidered on the basis of new facts at any time.
5. The Legal Board of Appeal, therefore, in the present case only has to consider whether or not the appellant **presently** satisfies the conditions provided for in Article 134(7) EPC. In doing so, it exercises its powers within the competence of the Legal Division (Article 111(1) EPC).
6. Article 134(7) EPC governing professional representation by legal practitioners refers to "any legal practitioner qualified in one of the Contracting States and having his place of business in such State". In the circumstances of the present case, the relevant

Contracting State is Spain. Thus, it is up to the appellant to establish that she is a legal practitioner qualified in Spain and having her place of business in Spain.

- 6.1 Considering first the qualification as a "legal practitioner" ("Rechtsanwalt", "avocat"), the Legal Board found in its decision J 19/89 (OJ EPO 199, 225) that a correlation has to be sought for comparable professions in the other Contracting States. In the present case, it was uncontested that the corresponding profession in Spain is the profession of *abogado*. In order to be qualified as an *abogado* in Spain, membership in a *Colegio de Abogados*, i.e. a bar association, is required (cf. Estatuto General de la Abogacia Española, Royal Order 2090/1982).

The Board is satisfied that according to the certificate dated 25 March 1997 presented at the oral proceedings the appellant is a member of the *Colegio de Abogados de Madrid* since 25 March 1997, albeit a non-practising one.

- 6.2 The other requirement referred to above concerns the place of business. According to Article 134(7) EPC a legal practitioner qualified in a Contracting State must have "his place of business in such State" ("und seinen Geschäftssitz in diesem Staat hat", "et y possédant son domicile professionnel"). It is to be noted that in all three languages of the Convention the expression "**his** place of business" (in contrast to "**a** place of business") is used. This formulation makes it clear that the place of business within the meaning of Article 134(7) EPC is the place (if any) at which a person practises his or her profession as legal practitioner.

The appellant conceded that she does not presently practise as a legal practitioner (*abogado*) in Spain, and this has been confirmed by the filed certificate of membership in the *Colegio de Abogados de Madrid*.

However, she maintained that she has a place of business in Spain as a representative in patent matters and that this was sufficient to comply with Article 134(7) EPC. The only evidence presented in support of this allegation was an official document showing the appellant to be registered at an address in Madrid.

However, this document is completely silent on the professional activities of the appellant. Despite the express invitation of the Board, the appellant failed to submit any further evidence regarding her professional activities at that address or elsewhere, be it as legal practitioner or as representative in patent matters. Thus, the only evidence before the Board is the registration of an address in Spain which cannot be accepted as a proof for a place of business within the meaning of Article 134(7) EPC.

7. In the absence of any evidence that the appellant has a place of business in Spain within the meaning of Article 134(7) EPC, the Board has to reject the appeal. In these circumstances it is neither necessary nor appropriate to consider the further issues on which the decision of the first instance were based (see point IV, *supra*).

**Order**

**For these reasons it is decided that:**

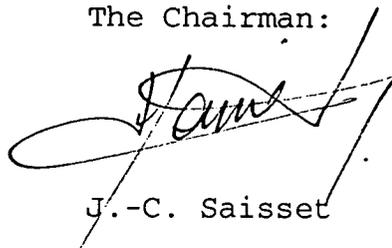
The appeal is dismissed.

The Registrar:



M. Beer

The Chairman:



J.-C. Saisset