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D E C I S I O N
of 20 September 1999

Case Number: J 0017/98 - 3.1.1

Application Number: 95914696.0

Publication Number: -

IPC: G02B 5/18

Language of the proceedings: EN

Title of invention:

Deformable grating apparatus including stiction prevention means

Applicant:

The Board of Trustees of The Leland Stanford Junior University

Opponent:

-

Headword:

General authorisation/THE BOARD OF TRUSTEES

Relevant legal provisions:

EPC Art. 60(3), 119, 133(2), 150, 157(2)
EPC R. 26(2), 55, 65(1), 67, 68(2), 78(2), 81, 85a(1), 85b,
101(1), 104b, 104c(1)

Keyword:

"Appointment of professional representative"

"General authorisation"

"Notification"

Decisions cited:

G 0003/91, J 0011/93, J 0020/96

Headnote:

1. The filing of a general authorisation does not, without any additional information with respect to a specific case, imply the appointment of a professional representative.

2. The principle of protection of legitimate expectations according to which communications of the European Patent Office, including official forms, must be clear and unambiguous, does not extend so far as to require comprehensive legal advice to be contained in such forms.



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Patentamt

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Patent Office

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Boards of Appeal

Chambres de recours

Case Number: J 0017/98 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 20 September 1999

Appellant: The Board of Trustees of
The Leland Stanford Junior University
Stanford
California 94305 (US)

Representative: Steil, Christian, Dipl.-Ing.
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Decision under appeal: Decision of the Receiving Section of the European
Patent Office posted 16 April 1998 confirming
that European patent application No. 95 914 696.0
is deemed to be withdrawn pursuant to
Rule 104c(1) EPC.

Composition of the Board:

Chairman: J.-C. Saisset
Members: B. J. Schachenmann
M. B. Günzel

Summary of Facts and Submissions

- I. The present appeal lies from the decision of the Receiving Section of 16 April 1998 according to which Euro-PCT application 95 914 696.0 (PCT/US95/02963) was deemed to be withdrawn pursuant to Rule 104c(1) and Article 157(2)(b) EPC on the grounds that the fees due for entering the regional phase before the EPO (Rule 104b(1) EPC) were not paid in time.
- II. The decision under appeal was based on the finding that the communications under Rule 85a(1) and 85b EPC were correctly notified to the address of the non-resident US applicants (appellants) since they were not, at that time, represented by a European professional representative. Consequently, notification was deemed to have been made, pursuant to the then valid Rule 78(2) EPC, when despatch of these communications had taken place, i.e. on 13 November 1997. However, the fees had not been paid within the period of grace of one month of notification which expired on Monday, 15 December 1997.
- III. In their statement of the grounds of appeal the appellants denied that the communications pursuant to Rule 85a(1) and 85b EPC had been duly notified. Notification under Rule 78(2) EPC (in the then applicable version) was limited to cases where a non-resident applicant was not represented pursuant to Article 133(2) EPC. However, the applicants had previously filed general authorisations in favour of a number of professional representatives of several firms of patent agents and had thereby appointed not only one but several representatives. Hence, the communications under Rule 85a(1) and 85b EPC should have been addressed to one of them (Rule 81 EPC). Thus, according to Rule 82 EPC, notification could not be deemed to

have been made on 13 November 1997. Since no date of receipt was established by the EPO, the periods of grace under Rule 85a(1) and 85b EPC had not yet expired when the respective fees were paid on 17 December 1997. The appellants requested the Board to decide that the application had successfully entered the regional phase before the EPO and that the appeal fee be reimbursed.

IV. According to an annex to the summons to attend oral proceedings before the Legal Board, the decisive question was whether or not the filing of general authorisations had the effect that the persons indicated therein were appointed as representatives for later filed applications. It appeared that the act of appointing a representative consisted in informing the EPO for each specific case of the person who should represent a party in that case. The fact that a general authorisation was registered at the EPO could hardly be considered as such information. In that context it was also pointed to the decision J 11/93 concerning similar circumstances.

V. In a response to the communication of the Board and during the oral proceedings of 20 September 1999, the appellants submitted the following additional arguments:

- (i) Even if it is agreed that a professional representative has to be appointed in each specific case falling under Article 133(2) EPC, it does not follow vice versa that a valid appointment can only be effected individually for each specific case. Neither the EPC nor any supplemental information of the EPO expresses such a requirement.

- (ii) It is clear that non-EPC resident applicants **must** appoint a professional representative under Article 133(2) EPC. Hence, for those applicants, a distinction between authorisation and appointment of a representative does not make sense. In these circumstances any authorisation has to be understood as appointment of a professional representative, as well.

- (iii) The applicants had filled and signed the official EPO document "General Authorisation" by which they authorised certain representatives to represent them and act for them before the EPO. This document does not point to any difference between authorisation and appointment of a representative. Neither were the applicants informed by the EPO of such a difference in the communications under Rule 85a(1) and 85b EPC. As a consequence they could legitimately believe that, by authorising European representatives, they had done everything necessary to avoid a mistake at that stage of the procedure. Even if a legal distinction could be made between authorisation and appointment, the principle of good faith had to be applied in the present circumstance.

- (iv) The present circumstances also differed from case J 11/93 in which no general authorisation had been filed. The decision J 11/93 did not, therefore, take into account the good faith of the appellants in having filed general authorisations.

Reasons for the Decision

1. The appeal complies with the requirements of the provisions mentioned in Rule 65(1) EPC and is therefore admissible.

2. In the circumstances of the present case the European Patent Office acted as an elected Office pursuant to Article 39 PCT and Article 150(3) EPC. In such proceedings the provisions of the EPC have to be applied, unless there is a conflict with provisions of the PCT (Article 150(2) EPC). Thus, notification of communications were correctly effected under Article 119 and Rules 77 to 82 EPC as valid at the time.

3. The appellants do not contest that the fees required for entering the regional phase before the EPO were not paid within the time limit provided for in Rule 104(b) EPC. However, they submit that the communications pursuant to Rules 85a(1) and 85b EPC were not duly notified since they had been sent, pursuant to the then valid Rule 78(2) EPC, to their US address instead of to one of the representatives listed in the general authorisations dated 29 March 1984 and 5 September 1989.

4. The first question to be considered is therefore, whether the filing of the general authorisations referred to above amounted to an appointment of the persons indicated therein as professional representatives for the patent application at issue.
 - 4.1 As can be derived from Rule 100 and Rule 101 EPC, respectively, the Convention distinguishes between the appointment of a representative and the filing of an authorisation.

4.2 In proceedings before the European Patent Office, if a party wishes to be represented by a professional representative, the Office needs to be informed of that fact as well as of the person(s) (name, address) **appointed** as representative for that case. Both, Rule 26(2)(d) EPC concerning the request for grant and Rule 55(d) EPC referring to the notice of opposition require that such information be provided for each case. The same applies, by analogy, to international applications entering the regional phase before the EPO which is a procedural act corresponding to the filing of a European patent application direct (see G 3/91, OJ EPO 1993, 8, point 1.8 of the reasons). Unless the European Patent Office is informed that and by whom the applicant wishes to be represented in a certain case, i.e. a representative has been appointed, the applicant alone is entitled to exercise the procedural rights in connection with this application (see also Article 60(3) EPC).

4.3 On the other hand, the filing of an **authorisation** pursuant to Rule 101 EPC serves the purpose of establishing whether a representative acting before the European Patent Office on behalf of a party has indeed been enabled by the party to do so. As also follows from Rule 101(1) EPC, last sentence, the filing of the authorisation and the notification of the appointment of a representative are thus, on principle, two separate procedural acts.

With respect to **general** authorisations Rule 101(2) EPC provides that they **enable** "a representative to act in respect of all patent transactions of the party making the authorisation". Thus, by definition, general authorisations do not refer to a specific case. Neither do they allow the European Patent Office to assume, without any additional information, that a person

listed therein should be appointed as a representative in a specific case. The party making the general authorisation is by no means bound to appoint one of the representatives listed therein or to appoint any representative, at all.

4.4 It is true that in the circumstances underlying the decision J 11/93 of the Legal Board of Appeal the authorisation was not registered as a general authorisation. However, in that case it was observed obiter that, had it been so registered, "it would then have been incumbent on the applicant to communicate the number allotted to the general authorisation so that the Receiving Section could take it into consideration before sending the communication pursuant to Rule 85a(1) EPC to the applicant ...". The Board concurs with this view according to which the filing of a general authorisation does not, without any additional information, imply the appointment of a professional representative (see also decision J 20/96, point 3.6 of the reasons). So far the present case is concerned, no such information linking the registered general authorisations to a specific case and/or to the appointment of a representative was communicated to the European Patent Office.

4.5 The fact that the applicants, as non EPC-residents, were obliged, pursuant to Article 133(2) EPC, to appoint a representative for the regional phase before the European Patent Office does not change anything in this respect. Rule 101(1) EPC, last sentence, clearly distinguishes, for the purposes of Article 133(2) EPC, between filing of the authorisation and notification of the appointment. Thus, also in cases of Article 133(2) EPC the filing of a general authorisation does not, as such, imply the appointment of a professional representative.

- 4.6 From the above it follows that no irregularities in the notification of the communications under Rule 85a(1) and 85b EPC can be recognized since they were correctly addressed, pursuant to the then valid Rule 78(2) EPC, to the applicants themselves who had not appointed a representative before the European Patent Office at that time.
5. The appellants further invoke the principle of protection of legitimate expectations governing the procedure between the EPO and the applicants (see point V(iii), supra). In particular, they maintain that neither the EPO form 1004 (General Authorisation) nor any other communication indicated that separate appointment of a professional representative was necessary for each case.
- 5.1 According to the established jurisprudence of the Boards of Appeal the principle of protection of legitimate expectations requires that communications addressed to parties to the proceedings must be clear and unambiguous. In particular, parties must not suffer a disadvantage as a result of having relied on a misleading information (see Case Law of the Boards of Appeal, 3rd. edition 1998, page 245 ff.).

However, in the view of the Board, the principle referred to above does not extend so far as to require the European Patent Office to give, in its forms, comprehensive legal advice. While, on the one hand, forms must be clear and unambiguous, they need not, on the other hand, contain detailed explanations of the law. This is especially true for legal issues which directly follow from the provisions of the Convention. In such cases legal advice contained in forms is to be

considered as voluntary service of the European Patent Office (see e.g. Rule 68(2) EPC, according to which the parties may not invoke the omission of a communication to the possibility of an appeal).

- 5.2 Consequently, the Board does not share the view of the appellants that EPO form 1004 (General Authorisation) should inform the users of the difference between filing a general authorisation and appointment of a representative. As set out above this difference results directly from the Convention itself. Thus, the fact that EPO form 1004 does not contain such information does not render it ambiguous or misleading.

The same considerations apply to the contents of the communications pursuant to Rule 85a(1) and 85b EPC. This is all the more so as the second communication contained the following "important information": "Since no professional representative entitled to practise before the EPO has been appointed so far (Art. 133(2) EPC), the present communication is being sent to the APPLICANT direct". From this information it was clear that the applicants' general authorisations, even if registered at the European Patent Office, could not be considered as an appointment of a professional representative for the application in suit.

6. Since, therefore, no substantial procedural violation on the part of the European Patent Office can be recognized, there is no basis for reimbursement of the appeal fee pursuant to Rule 67 EPC.

Order

For these reasons it is decided that:

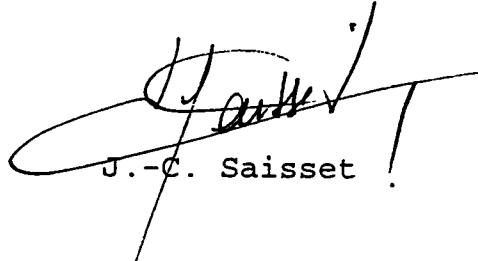
The appeal is dismissed.

The Registrar:



M. Beer

The Chairman:



J.-C. Saisset