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D E C I S I O N
of 9 July 2002

Case Number: T 0526/00 - 3.3.3

Application Number: 89301642.8

Publication Number: 0330413

IPC: C08F 8/40

Language of the proceedings: EN

Title of invention:

Method for inhibition of scale formation, compositions thereof and method for preparation of such compositions

Applicant:

BAKER HUGHES INCORPORATED

Opponent:

-

Headword:

Re-establishment/BAKER HUGHES INC.

Relevant legal provisions:

EPC Art. 121, 122

EPC R. 69(1)

Keyword:

"Re-establishment - time limit for payment of the fee for further processing-isolated error"

Decisions cited:

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Catchword:

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Boards of Appeal

Chambres de recours

Case Number: T 0526/00 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 9 July 2002

Appellant: BAKER HUGHES INCORPORATED
3900 Essex Lane
Houston
Texas 77027 (US)

Representative: Johnson, Terence Leslie
Edward Evans Barker
Clifford's Inn
Fetter Lane
London EC4A 1BZ (GB)

Decision under appeal: Decision of the Examining Division of the European Patent Office posted 3 April 2000 concerning European patent application No. 89 301 642.8 rejecting a request for re-establishment of rights.

Composition of the Board:

Chairman: R. J. Young
Members: J. C. M. De Preter
B. L. ter Laan

Summary of Facts and Submissions

- I. European patent application No. 89 301 642.8 was filed on 20 February 1989.
- II. On 2 June 1998 a Communication pursuant to Article 96(2) and Rule 51(2) EPC was issued by the Examining Division inviting the applicant to file observations within a time limit of four months. This time limit was subsequently extended to six months. As this invitation was not complied with, a communication "Noting of loss of rights" pursuant to Rule 69(1) EPC was issued on 15 January 1999.
- III. A request for further processing which also completed the omitted act was received by the EPO by fax issued at 4.26 pm of the last day of the time limit, namely 25 March 1999. However, the fee for further processing was not received until 26 March 1999. A further communication "Noting of loss of rights" was dispatched on 14 April 1999.
- IV. In its submission filed on 16 April 1999 the applicant requested re-establishment of rights and paid the prescribed fee.

It was explained that instructions had been sent by fax on 25 March 1999 to the person who operated the deposit account from which European fees payable on applications handled by members of the representative's office were paid. These instructions made clear that the due date was 25 March 1999. By letter of 11 May 1999 the applicant supplied evidence that at 3.14 p.m on 25 March 1999 instructions had been faxed to Marks & Clerk to pay the fee for further processing on

- the same day.
- V. By decision of 3 April 2000 the competent formalities officer rejected the request for re-establishment of rights for the reason that sending instructions to a third party by fax to pay a fee in the afternoon of the last day of a time limit did not constitute taking all due care required by the circumstances.
- VI. On 14 April 2000 the applicant filed an appeal and paid the appropriate fee on 28 April 2000. The statement of grounds was filed on 22 May 2000. Its submissions can essentially be summarised as follows:

The applicant's representative had not deliberately had the fax sent to Marks & Clerk at about a quarter past three p.m on 25 March 1999. In the normal course of events the instruction would have been typed no later than on the preceding day and would have been sent to Marks & Clerk about 11 a.m on 25 March 1999. If for some reason instructions were being sent to Marks & Clerk knowingly late in the day ie after 11 a.m it would have been the practice of the office to telephone Marks & Clerk to warn them of the instruction and ensure that it was received and acted upon on the same day. No professional representative at the office was however informed of the late sending of the fax. Moreover, according to the case law of the EPO, routine tasks such as payment of fees may be instructed to assistants. In this particular case it could not be ascertained why the record manager, who should have checked the matter with Marks & Clerk did not do so as this person was normally reliable. Moreover, Marks & Clerk being the largest firm of European patent attorneys in the United Kingdom, it would be expected

that their systems would have been able reliably to arrange for payment of the fee on the same day.

- VII. In response to a Communication of the Rapporteur of the Board issued on 23 August 2001 the appellant's representative stated in a submission received on 31 December 2001 that no problem would have arisen if the fax instruction had been sent before about 11 a.m and that there would have been adequate time for Marks & Clerk even if instructions were sent late, about 3.30 p.m. However, in such cases it was the office's practice to telephone Marks & Clerk to seek confirmation that the fee had been or would be paid that day. Even if the office had failed to contact Marks & Clerk by telephone, it would have been expected that Marks & Clerk would telephone the office to advise if there would be a problem.
- VIII. A second communication was issued by the Board accompanying a summons to oral proceedings which were held on 9 July 2002. During these oral proceedings, where the meanwhile retired responsible representative of the appellant had been replaced by two other members of the office, the appellant's representatives further explained that when a fax was sent to Marks & Clerk on the last day of a time limit, according to the office's practice the responsible representative or his secretary always drew the urgency of the matter to the attention of the records manager whose failure in this case constituted an isolated error in an otherwise satisfactory system.

Reason for the Decision

1. The appeal is admissible.
2. It appears from the file that during the course of the examination procedure five communications pursuant to Article 96(2) and Rule 51(2) EPC were sent by the Examining Division between 1993 and 1997 and that in two cases where a request for further processing had to be filed, the conditions for complying with Article 121(2) EPC were fulfilled in due time, including the payment of the appropriate fee through a third party ie Marks & Clerk. This shows that in the office of the representative of the appellant there was a normally satisfactory system for monitoring time limits and also an effective system of collaboration with a third party which operated the deposit account from which European fees due for applications handled by the members of the representative's office were paid.

Thus when after a sixth Communication, the Appellant was sent a communication "Noting of loss of rights" and again a request for further processing was filed, the omitted act was completed by fax in due time albeit in the afternoon of the last day of the time limit ie on 25 March 1999. The fee for further processing was however paid and received by the EPO only on 26 March 1999. Evidence was supplied that a fax had been sent to Marks & Clerk, containing the name of the applicant, the number of the application, the amount of the fee (76 Euro) and the due date, the latter in bold type.

However that instruction had been faxed at 3.14 p.m on 25 March 1999. According to the declaration of the Group Management Accounts Supervisor of Marks & Clerk, on that very day the person responsible for incoming

faxes was on holiday while new staff recruits did not realise that a timely payment of EPO fees was important.

Although this explanation is rather surprising, the Board accepts that, as Marks & Clerk is one of the largest firms of European patent attorneys in the United Kingdom, this third party had to be considered as reliable and that Marks & Clerk could normally have arranged for the necessary payment on the same day. However, no relevant reason was given why this instruction was faxed not only on the last day of the time limit but in the afternoon of that day.

Thus the question arises as to whether it could be expected with reasonable certainty that timely action would be taken. It emerges from the written submissions of the Appellant, which were reiterated during the oral proceedings, that it was the task of the records manager, who was normally reliable, to see the payment through ie to check with Marks & Clerk that the payment had in fact been made in time. Furthermore, the Board accepts as plausible the submission of the appellant at the oral proceedings that it was the practice of that office at the relevant time for the responsible representative or his secretary to draw the attention of the records manager to such last day instructions eg when sending a fax to Marks & Clerk on the last day of a time limit.

Taking into account all the circumstances of the case the Board is of the opinion that the failure of the records manager, coinciding with the admitted malfunction at Marks & Clerk, constituted an isolated error in an otherwise satisfactory system and that

therefore re-establishment of rights may be granted.

Order

For these reasons it is decided:

1. The decision under appeal is set aside
2. The appellant is granted re-establishment of rights in respect of the non-observed period ending on 25 March 1999 for payment of the fee for further processing.

The Registrar:

E. Görgmaier

The Chairman:

R. Young