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D E C I S I O N
of 2 March 1999

Case Number: T 0338/98 - 3.4.2

Application Number: 92202873.3

Publication Number: 0546589

IPC: G02C 1/02

Language of the proceedings: EN

Title of invention:

Lens holding means for glasses, particularly for rimless glasses

Applicant:

Lindberg, Poul J.

Opponent:

-

Headword:

Restitutio/LINDBERG

Relevant legal provisions:

EPC Art. 122, 86(2)

Keyword:

"Restitutio - all due care (no) - change of professional representative-assistant"

Decisions cited:

J 0005/80, T 0287/84

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: T 0338/98 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 2 March 1999

Appellant: Lindberg, Poul J.
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Representative: Kraus, Jürgen Helmut, Dipl.-Phys. Dr.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 25 November 1997
rejecting the application for restitutio in
integrum filed in connection with European patent
application No. 92 202 873.3.

Composition of the Board:

Chairman: E. Turrini
Members: B. J. Schachenmann
A. G. Klein
S. V. Steinbrener
V. Di Cerbo

Summary of Facts and Submissions

- I. European patent application No. 92 202 873.3 was filed as a divisional application of European patent application No. 87 901 400.9. The applicant (appellant) was represented by professional representative A who was receiving his instructions not directly from the appellant but via an independent advisor C hired by the appellant to supervise his patent activities.
- II. With letter of 2 June 1994 (see English translation thereof), representative A was informed that the appellant had decided "to gather all our patent and trade mark activities at one and the same agent (...)". He was therefore asked to transfer all files to a new representative B "as quickly and effectively as possible".
- III. On 20 June 1994 representative B contacted representative A by letter. It contained the following statements (see English translation thereof):

"The cases in question are a European patent application, a Canadian application which has lapsed, but which may be reinstated, and one or more issued patents/pending applications as well as a watch case in the name of X.

In this connection we ask you to send us immediately all the relevant files.

As long as we are not in possession of the files, we cannot assume the responsibility of the cases in question. However, this does not apply to the European

- case even though we also lack the files of this case."
- IV. On or around 25 January 1995, it was arranged for advisor C to collect those files which were still in the possession of representative A. According to his own statement of 30 May 1997 advisor C "reviewed these files and forwarded the relevant parts thereof to" representative B.
- V. At the office of representative B a secretary presumably checked the files received from advisor C, but nothing was recorded in the computer system concerning European patent application No. 92 202 873.3
- VI. On 8 March 1995 the EPO issued a notice drawing attention to the fact that for the European application No. 92 202 873.3 the renewal fee for the 9th year had not been paid before or on the due date of 31 January 1995 but that it could still be validly paid within six months of said date, provided that the additional fee was paid at the same time. The notice was addressed to representative A who was still registered at the EPO as the appellant's representative for the present application.
- VII. Representative A transmitted the notice of the EPO to representative B with letter of 10 March 1995, received on 13 March 1995. In a subsequent telephone conversation on 15 March 1995 representative A informed representative B of the existence of the present application. Since representative B had no knowledge of it, they agreed that representative A should check whether he still had this file. As to the question of paying the renewal fee with the additional fee the

recollections differ: according to B they agreed that A would effect the payment of the fee, whereas, according to A, this was discussed only as a theoretical option "should the need arise" (see the declaration dated 1 November 1995).

VIII. On 1 September 1995 the EPO issued a communication under Rule 69(1) EPC informing representative A that European patent application No. 92 202 873.3 was deemed to be withdrawn under Article 86(3) EPC because the renewal fee referred to above was not paid in due time. In response to that communication representative A informed the EPO that he had ceased to represent the applicant for this application.

IX. On 1 November 1995 an application for restitutio in integrum in respect of the time limit in question was filed. It was submitted that, at the time the loss of rights occurred, representative A could assume that he was no longer in charge of the application in question since advisor C had collected all the appellant's files on 25 January 1995. As concerns representative B, it was argued that he had expressly refused to take over the responsibility as long as he had not received the files. Since he had not received the relevant file when the loss of rights occurred, he was not the person responsible for the case in the meaning of Article 122(1) EPC. Thus, neither of the professional representatives involved had violated the requirement of due care pursuant to Article 122 EPC. On the other hand, it appeared that advisor C, who was a properly selected, instructed and supervised assistant of the appellant, had failed to transmit the file in question to representative B. However, according to the

jurisprudence of the Boards of Appeal, such failure of an assistant carefully selected for his task did not prevent reestablishment of rights.

- X. With decision dated 25 November 1997 the Examining Division rejected the application for restitutio in integrum. It was found that at least during the telephone conversation between the two representatives (See point VII., supra) they should have come to a clear arrangement on who was to pay the renewal fee or they should have contacted the client. Even if indeed neither of the representatives was responsible at that time, the applicant himself would have been responsible for the application as he had decided to have the files transferred by his advisor C. Thus, he would have had the duty to make sure that all files indeed were transferred from one representative to the other.
- XI. On 26 January 1998 a notice of appeal was filed against this decision. The appeal fee was paid on the same date. The appellant requested (main request) that the decision under appeal be set aside and that the request for re-establishment of rights be granted.
- XII. In the grounds of appeal of 25 March 1998 the appellant substantially reiterated the arguments presented before the first instance. During the oral proceedings held on 2 March 1999, it was in addition argued that the telephone conversation of 15 March 1995 did not change anything for the representatives. Representative A could still assume that his duty of care had ended when the files were handed over on 25 January 1995. This was confirmed by the fact that he found the relevant file wrapper empty when he checked it after the telephone

conversation referred to above. For representative B the duty of care had still not begun since, irrespective the telephone conversation, it was clear that he did not assume the responsibility for the application until he was in the possession of the file. As to the role of advisor C, it was maintained that he had only acted as an assistant dependant on the appellant's instructions. Even if he was a professional advisor and engineer who had been working in the field of patent matters for years, he nevertheless was not authorized to act independently on behalf of the appellant. The latter, on the other hand, had acted with all due care when entrusting the task of supervising the transfer to advisor C.

XIII. In the course of the oral proceedings the appellant requested that, if the Board did not grant the main request, the following questions be referred to the Enlarged Board of Appeal (auxiliary request):

1. Is it sufficient for a person to qualify as an "assistant", whose failure is excusable in the meaning of Article 122 EPC, not to hold authorization to act on behalf of the applicant but to do only dependent work upon applicant's instruction?
2. Where a loss of rights occurs during change of representation before the EPO
 - (a) does a duty of due care in the meaning of Article 122 EPC continue for the old representative after he could assume that applicant's authorisation for him to act as

applicant's representative has ended;

- (b) does a duty of due care in the meaning of Article 122 EPC for the new representative already begin after he has received applicant's offer to act as a new representative but before having accepted this offer (conclusion of agency agreement)?

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 EPC and with Rules 1(1) and 64(b) EPC. It is therefore admissible.
2. The patent application was deemed to be withdrawn due to the appellant's failure to meet the time limit pursuant to Article 86(2) EPC. According to the decision under appeal *restitutio in integrum* pursuant to Article 122 EPC could not be granted since the requirement of "all due care" was not met in the circumstances of the present case.
3. According to Article 122(1) EPC an applicant shall, upon application, have his rights re-established if he was unable, in spite of all due care required by the circumstances, to observe a time limit *vis-à-vis* the EPO. According to the constant jurisprudence of the Boards of Appeal the same duty of care is required of a professional representative representing the applicant in the proceedings before the EPO (see e.g. J 5/80, cited by the appellant). In considering whether "all

due care required by the circumstances" has been taken, the word "all" is important and the circumstances of each case must be considered as a whole (T 287/84, OJ EPO 1985, 333).

4. In the present case the circumstances were such that the appellant instructed his representative A "to transfer all files" to representative B (see point II, supra) who should take over the handling of the cases. Representative B received a copy of this letter. Thus, it was clear for both representatives that a transfer of responsibility for "all" the appellant's cases had to be effected. Representative B also made it clear that he did not assume the responsibility until he was in the possession of the files (see point III, supra).

4.1 However, from the documents submitted by the appellant during the present proceedings it must be concluded that only vague information concerning the patents and patent applications to be transferred was exchanged between the persons involved (see points II. and III., supra). In particular, no list clearly defining the applications and/or files to be transferred was drawn up.

In the Board's view, however, the exchange of precise information on the cases concerned appears to be an indispensable prerequisite for a careful transfer of a patent portfolio containing, as in the present circumstances, several patents and pending patent applications.

4.2 The lack of clear information about the cases to be transferred cannot be considered as an isolated mistake

in a special situation. It rather appears to be a system fault in the handling of the transfer which consequently carried the inherent risk of misunderstandings and errors. Moreover, the change of representative can hardly be characterized as an extraordinary situation for professional representatives as follows e.g. from the Code of Professional Conduct for European Representatives expressly considering such situations (OJ EPO 1986, 331, point 5(e)).

4.3 Thus, already the preparations for effecting the transfer of responsibility of the appellant's cases did not, in the Boards view, comply with the standard of care required by the circumstances.

5. The appellant further submitted that the transfer of the files was handled through advisor C acting as an intermediary who had presumably failed to transmit the file in question from representative A to representative B. However, since in the appellant's opinion advisor C acted as his assistant the same strict standard of care was not expected as demanded of the representatives themselves. Moreover, in the light of his qualification and experience, there was no need for the appellant to personally check whether he carried out his task properly. The Board cannot follow this argumentation.

5.1 If advisor C was indeed hired as an assistant, the tasks of supervising and effecting the transfer of the appellant's patent portfolio would clearly have exceeded mere routine work to be delegated to an assistant (as e.g. typing, posting letters and noting

time limits etc., see J 5/80). In fact, activities were obviously included which normally fall to the representative by virtue of his professional qualification such as e.g. reviewing the cases to be transferred (see point IV, supra). Thus, if advisor C were to be considered as the appellant's assistant, the appellant would not be able to establish that he had exercised all due care since he had delegated the tasks referred to above to an assistant.

5.2 If, on the other hand, C was hired as an independent advisor for the particular complex of cases (as submitted in appellant's letter dated 30 May 1997) in charge of preparing instructions for the appellant's patent attorneys (as indicated in the declaration of the advisor dated 30 May 1997), he does not appear to have acted as an assistant. The same strict standard of care would then apply to him as demanded of a professional representative. In that case, his assumed failure to transmit the file of European patent application No. 92 202 873.3 from representative A to representative B (which, however, was not established in the present proceedings), would not comply with the requirement of "all due care" pursuant to Article 122(1) EPC.

6. At the latest during the telephone conversation of 15 March 1995 (see point VII. supra), the professional representatives involved became aware that problems had arisen in connection with the transfer of European patent application No. 92 202 873.3 and, in particular, with the payment of the renewal fee due for that application. In these circumstances, the representatives could have been expected to make a

clear arrangement for solving these problems in order to avoid the impending loss of rights. In this context, it must be recalled that, on one hand, representative A was still registered as official representative for the case before the European Patent Office, and that, on the other hand, representative B at least clearly knew about the appellant's decision to entrust the case to him as his new representative for the future. The fact that in these circumstances they were unable to reach agreement about the way to proceed is not an indication that all due care required by the circumstances was taken at that moment. The same conclusion has to be drawn from the fact that, after their conversation, the appellant was not informed of the outstanding renewal fee and of the fact that the corresponding file had disappeared.

7. Thus, the Board concludes that, at several stages of the transfer of responsibility for appellant's patent portfolio, the persons involved did not act with all due care required by the circumstances. The appellant's main request (point XI., supra) cannot therefore be allowed.
8. As to the auxiliary request (point XIII., supra), none of the proposed legal questions needs answering for deciding the present case.

Question 1 is not relevant for the present appeal since the outcome of the proceedings is independent of whether or not advisor C acted as an assistant (see point 5, supra).

Regarding questions 2(a) and 2(b) the Board has come to

the conclusion that they also must be considered not to be relevant. In particular, it should be borne in mind that Article 122(1) EPC refers to all due care "required by the circumstances". Thus, much depends on the circumstances of each individual case considered as a whole. In the present circumstances it does not appear appropriate to formally delimit the individual responsibilities of each of the representatives during a transfer of cases requiring, by its very nature, close cooperation between the persons involved and naturally leading to overlapping responsibilities. Thus, no important point of law arises in this context which would justify a referral to the Enlarged Board of Appeal.

Consequently, the appellant's auxiliary request is not allowed, either.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

P. Martorana

E. Turrini