

CHAMBRE DE RECOURS JURIDIQUE
12 NOVEMBRE 1984
J 19/84

DOSSIERS BREVETS 1984.VI.J 35

GUIDE DE LECTURE

Restitutio in integrum : oui

I - LES FAITS

- 22 novembre 1979 : THE MEAD CORPORATION (US) dépose une demande de brevet européen 79.303.661.8
- 23 juillet 1980 : Publication de la demande
- 10 août 1983 : La Division d'Examen de l'OEB informe le mandataire du déposant qu'elle s'apprête à délivrer le brevet européen selon le texte qu'elle lui communique.
- 17 octobre 1983 : Le mandataire du déposant informe la Division d'Examen qu'il souhaite amender le texte de la revendication principale selon la copie jointe. Celle-ci ne reproduit pas entièrement les modifications manuscrites de l'original.
- 9 décembre 1983 : La Division d'Examen indique au mandataire du déposant que les modifications demandées ont été acceptées. Elle joint le nouveau texte de la revendication principale qui ne correspond pas exactement aux modifications demandées.
- 19 décembre 1983 : Le mandataire du déposant fait savoir à la Division d'Examen que les modifications ne sont pas adéquates. Sa lettre ne parvient pas à l'OEB (?).
- 3 mai 1984 : L'OEB rejette la demande de brevet européen pour non-paiement de la taxe de délivrance et d'impression et de non-communication de la traduction.
- 3 juillet 1984 : Le mandataire fait appel : mais par suite d'une erreur de sa part, le paiement de la taxe de recours n'est reçu par l'OEB que le 8 août 1984.
- 30 juillet 1984 : Le mandataire du déposant forme un recours en restitutio in integrum (article 122 CBE). Il indique comme motif de recours l'erreur d'une secrétaire dans l'envoi du chèque.
- 12 novembre 1984 : La Chambre de Recours juridique restaure le déposant dans ses droits, ordonne la restitution de la taxe de recours et la correction du texte modifié.

II - LE DROIT

A - LE PROBLEME

L'erreur d'un employé du mandataire peut-elle justifier la restauration du déposant dans ses droits, selon l'article 122 de la Convention de Munich ?

B - LA SOLUTION

1°/ Enoncé de la solution

2. "... Puisque la responsabilité de la distribution du courrier du mandataire incombait à sa secrétaire, la Chambre doit normalement vérifier si l'employée en question avait été choisie avec soin, avait reçu une formation correcte et avait été raisonnablement supervisée (cf. décisions J 05/80 du 7 juillet 1981, in JO OEB 1981, 173 et J 16/82 du 2 mars 1983 in JO OEB 1983, 262). Néanmoins, dans le cas présent, puisque l'erreur de négligence est une de celles qui pouvait être commise une fois par une secrétaire remplissant toutes les conditions ci-dessus, il n'est pas nécessaire d'analyser ces problèmes en l'absence d'une preuve quelconque de négligence habituelle de sa part. Dans ces circonstances, la Chambre est prête à admettre que les critères habituels de diligence ont été satisfaits".

2°/ Commentaire de la solution

La présente décision parait matérialiser l'évolution de la jurisprudence de la Chambre de Recours juridique vers un plus grand laxisme en matière d'application de l'article 122 de la Convention de Munich. Plutôt que d'exiger la preuve positive de "toute la diligence requise par les circonstances", la Chambre de Recours se contente de la preuve de l'absence de faute.

Europäisches
Patentamt
Beschwerdekammern

European Patent
Office
Boards of Appeal

Office européen
des brevets
Chambres de recours



Case Number: J 19/84

J35

DECISION
of the Legal Board of Appeal
of 12 November 1984

Appellant: THE MEAD CORPORATION
Mead World Headquarters
Courthouse Plaza Northeast
Dayton, Ohio 45463
US

Representative: Hepworth, John
J.M. Hepworth & Co.
Furnival House
14/18 High Holborn
London, WC1V 6DE
Great Britain

Decision under appeal: Decision of the Formalities Officer of Directorate
General 2 dated 3 May 1984 rejecting European
Patent Application No. 79302661.8 in pursuance
of Articles 97(1) and (2) and 113(2) EPC.

Composition of the Board:

Chairman: R. Singer
Member: P. Ford
Member: O. Bossung

SUMMARY OF FACTS AND SUBMISSIONS

- I. European patent application No. 79303661.8 was filed on 22 November 1979 and published under No. 0013479 on 23 July 1980.
- II. In the course of substantive examination of the application, by a Communication pursuant to Rule 51(4) and (5) EPC, issued on 10 August 1983, the Examining Division informed the applicant's representative that it was intended to grant a European patent in the text indicated in the Communication.
- III. On 17 October 1983, the representative wrote to the Examining Division concerning certain amendments desired to the text of the main claim and the corresponding statement of invention. A photocopy of the text of the main claim as originally filed, showing desired handwritten amendments, was enclosed with the representatives' letter. As can be clearly seen from the copy document, the handwritten amendments at the bottom of the page were not completely reproduced on the copy.
- IV. Nevertheless, on 9 December 1983, the Examining Division issued a new Communication pursuant to Rule 51(4) and (5) EPC stating, inter alia, that the amendments requested in the letter of 17 October 1983 had been made. The copy of the main claim as amended by the Examining Division, which was sent to the representative with the Communication dated 9 December did not conform in all respects with the amendments requested by the representative and, in particular, included words apparently intended to replace the words omitted from the representative's text but which were not agreed with the representative.
- V. According to the representative, he sent a letter to the Examining Division dated 19 December 1983, a copy of which he has produced, pointing out that there was a difference in wording between the claim which accompanied the Communication dated 9 December and the claim which had accompanied his letter dated 17 October 1983. Unfortunately, the letter dated 19 December 1983 never reached the file of the case and there is no evidence that it was ever received by the European Patent Office.

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- VI. As the Examining Division in fact heard nothing from the representative, and no fees for grant and printing and no translations of the claims were received, on 3 May 1984 a Formalities Officer, acting for Directorate General 2, issued the decision under appeal, refusing the European patent application.
- VII. On 3 July 1984 the appellant's representative lodged Notice of appeal and a Statement of Grounds. In the Statement of Grounds it was submitted that by the letter of 19 December 1983 the representative had raised objection in due time to the Communication dated 9 December. Accordingly, examination of the application should have been resumed. In any event, there exists no text of the application agreed with the applicants. The decision to refuse the application should be set aside, examination should be resumed and the appeal fee should be reimbursed.
- VIII. By mistake, the representative's office sent the voucher for payment of the appeal fee and the representative's cheque drawn in favour of the EPO therefor, to the appellant in the U.S.A., by whom they were subsequently returned. Thus the appeal fee, received by the EPO on 8 August 1984, was not paid in due time.
- IX. The appellant applied for re-establishment of rights by letter dated 30 July 1984. In response to a request for further information from the Legal Board of Appeal, the representative explained, in a letter dated 17 September 1984, that the voucher and cheque must inadvertently have become attached to the reporting letter to his client owing to the use of paper clips, rather than staples, in his office to fasten documents together. The despatching of mail was the responsibility of the representative's secretary. So far as was known, this was the first time that such a mistake had occurred but, to prevent its recurrence, documents would in future be fastened together by stapling. The fee for re-establishment of rights was duly paid.

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REASONS FOR THE DECISION

1. The appeal fee having been paid out of time, it is necessary for the appellant to be re-established in its rights if the appeal is to be considered admissible.
2. Article 122(1) EPC, in effect makes it a condition for re-establishment of rights that the person applying for re-establishment shows that "all due care required by the circumstances" was taken. The appellant's representative submits that the posting of the voucher and cheque for the appeal fee to the appellant was clearly inadvertent and that the mistake was not one of a kind that had previously occurred. That it was an inadvertent mistake can be considered to be self-evident and the Board is prepared to accept the representative's statement that a mistake of this kind had not previously occurred. Since the responsibility for despatching the representative's mail was that of his secretary, the Board has normally to consider whether the employee concerned was carefully chosen, properly instructed and reasonably supervised (cf. Decisions of the Board J 05/80 dated 7 July 1981 in OJ EPO 1981, 173 and J 16/82 dated 2 March 1983, in OJ EPO 1983, 262). However, in the present case, since the inadvertent mistake is one that could be made once by a secretary fulfilling all those requirements, there is no need to question these matters in the absence of any evidence of general carelessness on her part. In all the circumstances, the Board is prepared to consider that the requisite standard of care has been established.
3. Since all the other requirements of Articles 106 to 108 and Rule 64 EPC have been fulfilled, the Board considers the appeal to be admissible.
4. It is clear from the file of the case that the appellant is correct to contend that the decision to refuse the European patent application was taken on a text which was neither that submitted to the EPO nor agreed by the applicant for the patent.

At the time when the decision to refuse was taken, the disapproval communicated by the letter of 17 October 1983 was still effective.

The amendments made by the Examining Division to the text submitted with the letter of 17 October 1983 were more than simple, non-controversial, corrections of obvious clerical errors. Accordingly, the express consent of the applicant, through its representative, was necessary before they could be regarded as agreed.

5. It follows that the decision under appeal must be set aside as it was not taken in accordance with Article 113(2) EPC. This was inter alia a substantial procedural violation which justifies reimbursement of the appeal fee.

ORDER

For these reasons,

it is ordered that:

1. The appellant is re-established in its rights and the appeal is deemed to have been filed and the appeal fee to have been paid in due time.
2. The decision to refuse the European patent application dated 3 May 1984 is set aside.
3. The appeal fee shall be reimbursed to the appellant.
4. The European patent application is remitted to the Examining Division for examination to be resumed.

