

Abstract

The EPO Legal Board of Appeals confirmed that PCT applicants may utilize and benefit from provisions under the European Patent Convention, in this case, the payment of designation fees after expiry of the prescribed time limit.

EPO boards of appeal decisions

Date of decision 07 July 1981

Summary of Facts and Submissions

I. On 2 October 1978 the appellant filed International Application PCT/FR 78/00026 claiming the priority of a national patent application made in France on 3 October 1977 and designating the Federal Republic of Germany, the United Kingdom, Luxembourg, Sweden and Switzerland as States for which a European Patent was desired.

II On 5 April 1979, the International Bureau of the World Intellectual Property Organization published the international application together with the international search report. The period within which the national fee and the designation fees had to be paid thus expired on 5 July 1979 (Art. 22(1)(3) PCT, Rule 104b(1) EPC).

III. The national fee was duly paid on 31 May 1979 but the designation fees were not paid until 3 October 1979, after the Receiving Section had notified the appellant, by letter dated 14 August 1979, that the application must be deemed to have been withdrawn.

IV. By a Decision dated 19 December 1979, given at the appellant's request, the Receiving Section held that the European patent application was deemed to have been withdrawn, in accordance with the provisions of Articles 79(2) and 150(2) EPC, as the designation fees had not been paid in due time.

V. On 23 January 1980 the appellant claimed that the new Rule 85a EPC was applicable in this case. The surcharge prescribed by Rule 85a EPC was duly paid.

VI. On 8 February 1980 the appellant lodged an appeal against the Decision of the Receiving Section, stating the grounds therefor. The appeal fee was duly paid. Referring to the view of the Receiving Section, expressed during a telephone conversation, that Rule 85a EPC would not be applicable to Euro-PCT

applications, the appellant submitted that: (a) when the European Patent Office informed the appellant that the application was deemed to have been withdrawn, on 14 August 1979, there was still time to request *restitutio in integrum*. The fact that Rule 69 EPC had been invoked instead of Article 122 EPC was a trivial and excusable error, contributed to by incorrect information given by the European Patent Office; (b) the appellant had requested application of Rule 85a EPC within the prescribed period, an application which in the appellant's submission could not be refused, since the rules applicable to a European patent application were equally applicable to a Euro-PCT application; (c) in the case of another European patent application the same error had been corrected by applying the provisions of Article 122 EPC.

VII. By letter dated 30 October 1980, the Legal Board of Appeal informed the appellant that in the particular case *restitutio in integrum* did not seem to be entirely excluded, but that it would be necessary for the reasons given in the Statement of Grounds to be developed in detail.

VIII. By letter dated 29 December 1980, referring back to the appeal lodged on 8 February 1980, the appellant requested *restitutio in integrum* in the alternative to the other relief sought. It appears from the appellant's letter and from a written statement made by the lady in charge of administration in his representative's office, that the representative had instructed her to pay all necessary fees and that she had interpreted Article 78 EPC as meaning that only the filing fee had to be paid within one month after filing when a PCT application designating the European Patent Office passed to the national phase.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is admissible.
2. The appellant based his appeal on two possible remedies: application of Rule 85a EPC and *restitutio in integrum* in accordance with Article 122 EPC. The Board has examined both possibilities, because *restitutio in integrum* would be less expensive than application of Rule 85a EPC.
3. *Restitutio in integrum* in accordance with Article 122(1) EPC is conditional upon the applicant showing that, where he was unable to observe a time limit *vis-à-vis* the European Patent Office, all due care required by the circumstances has been taken.
4. During the Munich Diplomatic Conference in 1973, when the expression "all due care required by the circumstances" was inserted in place of the expression

"force majeure", which had been employed in the draft text, it was observed that if an applicant had been represented by a professional representative the latter also would have to show that he had taken all due care required by the circumstances (Minutes of the Munich Diplomatic Conference for the Setting Up of a European System for the Grant of Patents, published by the Federal German Government, M/PR/1, points 574, 575, 577, 578 and M/PR/G, Annex I, Chap. II, Section 10, second paragraph). This interpretation seems to be correct.

5. At the same Conference, there was also discussion of the question whether one could excuse the negligence of an employee of a professional representative who normally carried out his work in a satisfactory manner. On this point it was noted that some routine tasks, such as typing dictated documents, posting letters and parcels and noting time limits, are normally carried out not by the professional representative personally, but by his staff. This follows normal commercial and professional practice. During the Conference, the AIPPI delegation gave a concrete example of the difficulties which can arise in this respect. Discussion of this example led to the amendment of the text mentioned in point 4. It is clear from the discussion that the Conference had no wish to rule out the possibility of excusing the negligence of an employee (Minutes, loc.cit., point 559 et seq. and point 571, second paragraph).

6. For the purposes of the present case it is not relevant to take account of rules of national laws concerning the liability of an agent to his principal for wrongful acts or omissions of the agent's employee. The Board must restrict itself to interpreting the concept of "due care required by the circumstances" in the context of Article 122(1) EPC. In the opinion of the Board, one could not expect of an assistant entrusted with routine tasks the same rigorous care as is demanded of an applicant or his professional representative. Nothing in the detailed discussions on *restitutio in integrum* during the Munich Diplomatic Conference would lead to a contrary interpretation.

7. To benefit from Article 122 EPC, a professional representative who employs assistants must be able to establish that he has used due care required. In general, then, he should choose for the work a suitable person, properly instructed in the tasks to be performed, and he should exercise reasonable supervision over the work.

8. However, account should also be taken of the fact that by Article 134(1) EPC, the Contracting States have in principle confined representation of applicants before the European Patent Office to "professional representatives" who, by virtue of their qualification should guarantee the best possible representation. It follows that a representative cannot relieve himself of responsibility for carrying out tasks which, by reason of his qualification, fall upon him personally, such as, for example, the interpretation of laws and treaties. If he delegates such tasks to

an employee and if the latter makes an error in the course of that work which results in the failure to observe a time limit, the representative cannot establish that he took all due care required by the circumstances.

9. In the present case, the professional representative gave the lady in charge of administration in his office, whose integrity and competence the Board does not doubt, the general task of paying all fees due within the prescribed periods. Thus an employee was given tasks which she had to carry out independently and which exceeded the scope of mere routine tasks, the more so because - far from easy - interpretation of two recent international treaties was involved. The professional representative cannot therefore, for the purpose of avoiding the loss of a right, establish that he took all due care required by the circumstances. It follows that the appellant cannot be granted restitution of rights.

10. The appellant asks primarily for application of Rule 85a EPC. This Rule provides that, if the designation fee for a European patent application has not been paid within the period prescribed by Article 79(2) EPC, it can be paid within a further period of two months, upon payment of a surcharge within the same period. But Rule 85a EPC does not mention Rule 104b(1) EPC, which is applicable to Euro-PCT applications.

11. In the present case, the time limit which the applicant has not respected is precisely that which covers the transition from the international to the regional, i.e. European phase. At this point both the Patent Cooperation Treaty and the European Patent Convention apply. However, Article 150(2) EPC provides that in case of conflict the provisions of the PCT prevail.

12. Article 48(2)(a) PCT prescribes that any Contracting State shall, as far as that State is concerned, "excuse", for reasons admitted under its national law, any delay in meeting any time limit. According to the definition in Article 2(x) PCT any reference to national law applies equally to a treaty which provides for the filing of regional applications. The expression "excuse" is a broad term and must therefore be interpreted in its widest sense. In the opinion of the Board, the provision thus in principle covers any national and regional provisions that extenuate a mistake or waive the consequences of non-observance of time limits. In any case, the Board considers that the application of provisions concerning restitutio in integrum (Article 122 EPC) and further processing of the application for a European patent (art. 121 EPC) is covered by Article 48(2)(a) PCT, when the necessary conditions are fulfilled. But Rule 85a EPC has the same objective and allows the applicant to continue the procedure when he has failed to observe certain time limits, and the Board sees no reason to exclude this provision from the application of Article 48(2)(a) PCT.

13. The fact that those filing PCT applications have at their disposal an alternative remedy not open to applicants for purely European patents in the same situation, namely the possibility of restitutio in integrum under Article 122 EPC, is no reason for depriving them of the benefit of Rule 85a EPC. It is true that the exclusion of this possibility for applicants for European patents by Article 122(5) EPC led to the adoption of Rule 85a EPC. But this is no reason to refuse PCT applicants this other remedy which does not call for an excuse on the part of the applicant. The question whether PCT applicants are more privileged than non-PCT applicants for European patents is irrelevant in law so far as the interpretation of Article 48(2)(a) PCT is concerned.

14. Given that, in principle, Rule 85a EPC is within the scope of Article 48(2)(a) PCT, the Board is of the opinion that the obligations resulting from that Article are in any case applicable to situations arising during the transition from the international to the European procedural stages. Having regard to their purpose, the time limits of Rule 104b(1) EPC, which have not been observed in this case, form an integral part of that phase of the procedure. Rule 85a EPC is therefore applicable.

15. In the present case, the applicant paid the designation fees on 3 October 1979 and, on 23 January 1980, also the surcharge specified in Article 2(3)(b) of the Rules relating to Fees, in accordance with the Decision of the Administrative Council of 30 November 1979.

16. It follows that all the conditions for application of Rule 85a EPC are satisfied. Consequently, the Decision of the Receiving Section must be set aside.

17. No application has been made for reimbursement of the appeal fee in accordance with Rule 67 EPC and the circumstances of the case would not justify such an order.

ORDER

For these reasons, it is decided that:

The Decision of the Receiving Section of the European Patent Office dated 19 December 1979 is set aside.