

### Abstract

While entering the regional phase before the EPO, the applicant failed to file a translation of the application into an acceptable language for the EPO. After being notified by the Receiving Section that the application was being considered withdrawn because of this oversight the applicant requested a re-establishment of rights under Article 122 EPC (due care). The Receiving Section denied this request and the applicant appealed. The Board reversed this decision on the basis that the applicant had in fact exercised due care.

## **EPO boards of appeal decisions**

**Date of decision 23 August 1994**

**Case number J 0026/92 - 3.1.1**

### **Summary of Facts and Submissions**

I. On 28 November 1990, the Appellant filed international application PCT/JP90/01540, claiming priority from a national patent application filed in Japan on 6 December 1989. This application was given the European patent application No. 90 917 692.7. The Appellant's representative subsequently filed an application for entry into the European regional phase on 30 August 1991 without a translation of the application into one of the official languages of the EPO.

The time limit prescribed in Article 22(1) PCT and Rule 104b(1) EPC with respect to furnishing a translation of the international application expired on 6. September 1991 (twenty-one months from the priority date).

The Appellant's representative was advised by a communication of 2 October 1991, pursuant to Rule 69 (1) EPC, that the application was deemed withdrawn because a translation of the international application into one of the official languages of the EPO had not been furnished in accordance with Article 158 (2) EPC within the period specified under Article 22 (1) PCT.

An English translation was subsequently filed on 11. October 1991.

II. On 28 November 1991, the Appellant filed, by facsimile, an application for re-establishment of rights under Article 122 EPC, with respect to the missed time limit.

By a Decision dated 2 March 1992, the Receiving Section of the EPO rejected the application for re-establishment of rights. The Receiving Section was of the

opinion that all the due care required by the circumstances had not been taken. The confidential clerk of the Appellant's representative (who had mistakenly believed that the translation had already been filed by the Appellant's US patent agent) could be reasonably expected to know that the translation of a Japanese application may only be filed at the EPO by an authorised European representative and not by a US agent. Certain statements in the evidence put forward by the Appellant's representative also showed a lack of knowledge of the EPC and of the Patent Cooperation Treaty, which was incompatible with the due care required by Article 122 EPC.

III. On 4 May 1992, the Appellant's representative filed a notice of appeal against this decision, paying the appeal fee on the same day. The Statement of Grounds of Appeal was filed on 26 June 1992.

IV. The evidence submitted by the Appellant's representative in support of the application for re-establishment of rights before the first instance, in the grounds of appeal and in response to a communication of the Board dated 9 February 1993, may be summarised as follows.

The clerk who had had the responsibility for handling the European application in this case had worked in the office of the Appellant's representative for about 40 years. He had great experience and thorough knowledge of the requirements for filing patent applications throughout the world and, in particular, had more than 10 years' experience of working with the PCT and EPC. During this time, he had been instructed in regular discussions with a representative and had acquired practical experience. In the 40 years of the clerk's activity, he had never previously failed to file all required documents. When filing applications based on orders and instructions of foreign colleagues, these were always sufficiently clear and complete.

The Appellant's representative was entitled therefore to entrust the clerk with dealing with routine, formal matters connected with the filing of European applications. It was submitted that a decision on whether or not a translation was required when filing a PCT/EP application was such a purely formal matter, it being dependent only on whether the PCT application had been published in an official language of the EPO or not. However, in this case, the clerk had been misled by the instructions received on 26 August 1991 from the US instructing patent attorney, who had not mentioned specifically that the translation had to be filed. On the contrary, in the letter of instruction and on the translation of the PCT-application, the clerk had found a reference to the "English language translation of the PCT application as filed". These two references had led the clerk to believe that the translation had been filed, when what was actually meant was that the US attorney was enclosing a translation of the PCT

application as filed. At the time the instructions were received, the case had to be handled as a matter of urgency as the deadline for entry into the regional phase was 6 September 1991. The application for entry was mailed on 29 August 1991, and the mistake leading to this application for re-establishment of rights occurred therefore on that date. When the mistake was discovered in early October, the clerk was available to provide the above evidence regarding the reasons for his mistake. However, the person in question died of heart failure in December 1991 and in presenting the present appeal therefore it had not been possible to question him further on the subject.

The Appellant's representative submitted that the clerk may also have been misled by the fact that no copy of the published PCT application was available so that it was not directly visible that this application had not been published in an official language of the EPO. Moreover, English versions of practically all documents had been on file. It was further submitted that the confusion of the clerk may have been due to reduced vitality in the last months of his life. Although such reduced vitality had not been noticed at the time the present EP application had been filed in August 1991, subsequently the Appellant's representative had reason to believe that his abilities had been reduced; for example, he had failed to deal with a matter of annual fees with which he had been familiar and responsible for years.

With regard to the assertion of the Receiving Section that a person with sufficient knowledge of the PCT and EPC should have known that the translation may only be filed at the EPO by an authorised European representative, it was pointed out that Article 133(2) EPC permits a US applicant to file a European patent application and that therefore it was not excluded that a translation be filed together with such an application. In such a case, the EPO would normally ask the applicant to designate an authorised representative. Moreover, nothing in Article 20 PCT precluded WIPO from transmitting to the EPO a translation filed together with the documents it is obliged thereunder to communicate to designated offices.

It was the practice of the Appellant's representative, followed in this case, when signing applications to be filed in accordance with an order and full instructions from foreign colleagues, to check whether all the documents mentioned in the application form were attached thereto. This was the first time in all the years of working with the clerk responsible for this case that he had made a mistake and failed to mention a document to be filed on the application form and to attach all requisite documents.

Evidence was also submitted to show that a well- established system for noting and supervising time limits existed in the representative's office. The system

comprised a set of cards for each day of the year, showing the initials of the responsible representative, the year of the time limit, the name of the applicant, the number of the case, the country or region for which a patent was sought, the kind of time limit or operation to be done and the date filed. All time limits were noted separately. The system indicated the kind of time limits to be met so that the responsible person supervising the time limits could check whether the time limit could be extended or not. Parallel records of all time limits were noted in the personal agendas of each technical assistant or representative. Complete lists of all time limits were also prepared in advance for the next couple of months and made available to everybody in the office. Lists of the time limits to be dealt with by individuals were also produced regularly. Periodically, at least weekly, a representative checked the whole system of time limits and discussed urgent cases with those responsible.

It was submitted, however, that in this case the time limit for filing the translation of the international application into an EPO language had not been missed due to an inefficient supervision of time limits but due to a misinterpretation by the responsible clerk of instructions received from the Appellant's US attorney. Moreover, the clerk was very experienced and had been properly instructed and supervised in his work. It had been proper therefore for the representative to rely on the person in question to carry out the routine task of preparing the requisite documents in this case for filing. The mistake, therefore, represented an isolated mistake in an otherwise satisfactory system. Reasons for the

## **Decision**

1. The appeal is admissible.
2. The application for re-establishment of rights fulfils the conditions laid down in paragraphs (2) and (3) of Article 122 EPC and is admissible.
3. Article 122 EPC provides for an applicant who, in spite of all the due care required by the circumstances having been taken, was unable to observe a time limit vis-à-vis the EPO, thereby losing a right or other redress, to have his rights re-established upon application subject to the conditions referred to in paragraph 1, above, being met. It is the established jurisprudence of the Boards of Appeal that Article 122 EPC is intended to ensure that, in appropriate cases, the loss of substantive rights does not result from an isolated procedural mistake within a normally satisfactory system (J 2 and 3/86, OJ EPO 1987, 362).
4. Whether or not a request for re-establishment of rights may be allowed, however, depends on whether or not the Appellant can show that all the due care

required by the circumstances of the particular case was in fact taken to comply with the time limit. With respect to due care, the following principles relevant to the present case were laid down by the Board in J 05/80 (OJ 1981 343):

(1) When an applicant is represented by a professional representative, a request for re-establishment of rights cannot be acceded to unless the representative himself or herself can show that he or she has taken the due care required of an applicant or proprietor by Article 122(1) EPC.

(2) If the representative has entrusted to an assistant the performance of routine tasks, the same strict standards of care are not expected of the assistant as are expected of the applicant or his representative.

(3) A culpable error on the part of an assistant made in the course of carrying out routine tasks is not to be imputed to the representative if the latter has shown that the necessary due care was exercised in dealing with the assistant. In this respect, it is incumbent on the representative to choose for the work a suitable person, properly instructed in the tasks to be performed and to exercise reasonable supervision over the work.

That decision also made it clear 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.

5. In the present case, therefore, for re-establishment of rights to be allowed the Board must be satisfied that the representative took all the due care required by the circumstances, and, in particular, took such care in relation to setting up the system for observing the time limit in question and in the choice, instruction and supervision of his assistant. In considering these issues, the Board has had available to it additional evidence in support of the Appellant's case for re-establishment of rights which was not before the Receiving Section.

6. In this case, a first consideration is whether the system for observing the time limit can be shown by the party to be normally satisfactory. The representative provided evidence which has satisfied the Board that there was established in his office a sophisticated system for ensuring that time limits were met, which was properly supervised and which showed that the various time limits relating to this case had been properly recorded. Thus, due care had been taken in setting up the system for observing the time limit in question.

7.1. Second, the question arises whether the representative exercised all the due care in the circumstances in the choice, instruction and supervision of his

assistant. According to the case law of the Boards of Appeal (see paragraph 4, above), routine tasks may be entrusted to an assistant provided that the necessary due care on the part of the representative has been exercised in dealing with the assistant. In this respect, it is incumbent upon the representative to choose for the performance of routine tasks a suitable person, properly instructed in the tasks to be performed, and to exercise reasonable supervision over their work. The Board is satisfied from the evidence that the clerk in question was a suitable person for the work; he had 40 years experience of patents, over ten years experience of working with the EPC and PCT, and had never previously in his long career made a mistake or failed to file a document on time. It is also clear from the evidence that the clerk had been properly instructed in his tasks. In this particular case, the mistake had arisen from a misunderstanding on his part of instructions received from the US patent attorney in the case, which had led him to believe that the missing translation had already been filed.

7.2. As regards whether the representative had exercised reasonable supervision over the work of his assistant in this particular case, according to the evidence he had signed the application for entry into the regional phase at the EPO and checked whether all the documents referred to therein were attached thereto. However, he had relied on the clerk to prepare the application and to furnish the requisite accompanying documents. The representative has submitted that it was reasonable to rely on the clerk in this matter and that the preparation of an application for entry into the regional phase at the EPO, including the provision of a translation of the international application, was a routine task which, according to the case law of the Boards of Appeal, he was entitled to entrust to an assistant. The Board accepts that, in the circumstances of this case, where the assistant in question had 40 years experience of filing patent applications based on orders and instructions from foreign patent attorneys and under the supervision of representatives in his office, the preparation of an application for entry into the regional phase before the EPO and the task of filing a translation of the relevant international application may be considered to have been a routine task for the clerk in question.

8. The same rigorous standard of care as is demanded of an applicant or his professional representative is not expected of an assistant (J 5/80, *supra*). According to the evidence, the clerk made a mistake in failing to file the required translation. In all the years he had worked in the representative's office, he had never before made a mistake. At the time the mistake was made, there is evidence also that he may have been in failing health since he died suddenly and unexpectedly not long thereafter. The Board is satisfied, therefore, that this was an isolated mistake in a normally satisfactory system. The Board finds also that the evidence shows that the failure to file the translation was due to a

misunderstanding on the clerk's part of the instructions received from the USA and not the result of a lack of knowledge of the EPC and PCT. For this reason, it does not consider the findings of the decision of the Receiving Section on this point relevant.

9. The Board is satisfied, therefore, that in spite of all the due care required by the circumstances having been taken, the Appellant was unable to meet the time limit for filing the required translation into an official language of the EPO of the international application in this case.

10. The application for re-establishment is allowed and the English translation of the international application shall be deemed, therefore, to have been filed in time.

## **ORDER**

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The rights of the Appellant are re-established in relation to the filing of the English translation of the international application within the time limit prescribed by Article 22(1) PCT.

Case law reports: CLBA 1996