

UDSKRIFT
AF
HØJESTERETS DOMBOG

HØJESTERETS DOM
afsagt fredag den 25. november 2005

Sag 200/2003

(2. afdeling)

1) Barry R. Goldin

2) Sherwood L. Gorbach

3) Valio Ltd.

(advokat Peter-Ulrik Plesner for alle)

mod

Ankenævnet for Patenter og Varemærker

(kammeradvokaten ved advokat Stig Grønbæk Jensen)

I tidligere instans er afsagt dom af Østre Landsrets 10. afdeling den 5. maj 2003.

I pådømmelsen har deltaget fem dommere: Marie-Louise Andreasen, Wendler Pedersen, Peter Blok, Niels Grubbe og Lars Bay Larsen.

Sagen er behandlet skriftligt, jf. retsplejelovens § 387.

Påstande

Appellanterne, Barry R. Goldin, Sherwood L. Gorbach og Valio Ltd., har gentaget deres påstand.

Indstævnte, Ankenævnet for Patenter og Varemærker, har påstået stadfæstelse.

Anbringender

Appellanterne har for Højesteret yderligere anført, at patentmyndighederne har anvendt reglerne i patentloven forkert, idet de ved anvendelsen af patentlovens § 72, stk. 1, 2. pkt., ikke

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foretog en konkret helhedsvurdering, men begrænsede sig til at vurdere betydningen af Hofman-Bangs forhold. Myndighederne burde i stedet have lagt vægt på, hvad den ansvarlige fuldmægtig Oy Jalo vidste eller eventuelt burde have vidst. Landsretten burde ikke have inddraget nye faktiske og retlige forhold i prøvelsen, men burde have hjemvist sagen til fornyet behandling ved patentmyndighederne, således at appellanterne havde fået mulighed for en administrativ prøvelse i to instanser af disse spørgsmål.

Ankenævnet har hertil anført bl.a., at det følger af almindelige forvaltningsretlige regler om domstolsprøvelse af forvaltningsakter, at nævnet under retssagen kan supplere begrundelsen for den afgørelse, der er til prøvelse.

Supplerende sagsfremstilling

Sandra E. Marxen, Clark & Elbing, har i en erklæring af 14. maj 1998 anført følgende:

"Regarding the "due care" standard of the Danish Patent Office, I confirm that our system for entering incoming correspondence and meeting deadlines operates in a "double control" fashion and that the staff involved in the day to day operation of the system are qualified, properly trained, and properly supervised.

All incoming correspondence is reviewed first by a docket clerk who enters any docket dates from it into a database containing records for all of the firm's matters. The correspondence is then reviewed by the "billing" attorney and his/her secretary and entered into a completely separate database containing records for that billing attorney's matters. In many matters, the billing attorney delegates some tasks to a "supervising" attorney, who in turn delegates some tasks to a "handling" attorney. If there are supervising and handling attorneys for a matter, then the incoming correspondence is reviewed by each of these people and their secretaries and docketed in two additional completely separate databases. Finally, our foreign paralegal also maintains a separate docket. It is, therefore, not uncommon for a piece of correspondence to be seen by perhaps ten people and for its docket dates to be monitored by all of them.

In addition, in the case of foreign annuities, relevant incoming correspondence and docket dates taken from it are also reviewed by and maintained in yet another completely separate database by our outside annuity service Computer Packages, Inc.

At the time the first letters in this matter were sent and received, Clark & Elbing did not have a full time docket clerk and so I was personally responsible for the firm's dockets. I have nearly eleven years of experience in patent law and spent approximately eight of those years as part of and supervising docketing staffs of up to 40 people, including the annuity staff. The docket clerk who joined us in May 1997 had two years of experience and worked closely with me during her time here. Finally, the billing attorney for this matter is Paul Clark and the billing secretary is Michele Silver, who has over thirty years of experience.

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To review some of the more relevant dates and letters, on February 26, 1997, Oy Jalo Ant-Wuorinen wrote to Fish & Richardson and asked them to pay the DK annuity. Since the matter had been transferred to Clark & Elbing, Fish & Richardson duly forwarded the letter to Clark & Elbing on February 28, 1997.

Clark & Elbing gathers annuity instructions quarterly by sending each client a list of all annuities due and keeping those lists, the client's replies, and correspondence to and from our annuity service in a single general annuity file for each client. In keeping with this system, on March 4, 1997, a few days after the first letter from Oy Jalo Ant-Wuorinen, Clark & Elbing sent its customary list of all annuities due (including the DK annuity) to Oy Jalo Ant-Wuorinen asking for payment instructions. Having not received a reply, we sent a reminder on March 10, 1997. On March 12, 1997, Oy Jalo Ant-Wuorinen responded with instructions to pay all but the DK and JP annuities. In this letter, the DK and JP annuities were crossed out and next to these were the instructions "Another will pay!". Clark & Elbing sent these instructions exactly as provided by Oy Jalo Ant-Wuorinen to its annuity service, Computer Packages, Inc., which duly paid all but the DK and JP annuities as instructed.

In retrospect, it appears that "another" must have meant Fish & Richardson which shortly thereafter transferred responsibility to Clark & Elbing. However, because "another" was not specified in the instructions of March 12, 1997, they were taken as meaning someone other than Clark & Elbing would pay the annuities. The discrepancy between the February 26, 1997 instructions to first pay and later the March 12, 1997 not to pay the DK annuity was not discovered and questioned earlier because the February 26, 1997 letter was filed in the DK file rather than in the client's general annuity file with the March 12, 1997 letter. As you note, however, the failure to pay the annuity at the first due date is not the primary concern now.

Regarding the letters leading up to the final due date of October 31, 1997, Hofman-Bang's reminders of July 21, 1997 and October 9, 1997 that were sent to Fish & Richardson, these letters were forwarded to Clark & Elbing on August 4, 1997 and October 9, 1997, respectively. It appears that the docket clerk and billing secretary both looked in the client's general annuity file, saw that Oy Jalo Ant-Wuorinen had indicated "Another will pay!", and took no further action.

The next relevant series of letters begin with Oy Jalo Ant-Wuorinen's letter of November 28, 1997 to Clark & Elbing, which says "as informed to you on March 12, 1997, we already take care of the annuities for the DK and JP patents". This letter further instructed Clark & Elbing to remove the annuity dates for all other matters from its records. A few days later, on December 3, 1997, Clark & Elbing received Hofman-Bang's letter of November 27, 1997 noting that it was marking the DK matter as abandoned and removing it from its records. Clark & Elbing's docket clerk, apparently still under the impression that another would pay the annuity and certainly taking Oy Jalo Ant-Wuorinen's letter of November 28, 1997 as an indication that Clark & Elbing had not been and still was not responsible for paying the annuity, marked "no docketing required" on the November 27, 1997 letter. She also noted that the matter was still listed as "issued" in the database.

Then on December 5, 1997, the Clark & Elbing billing secretary reviewed the Hofman-Bang letter of November 27, 1997 and the docket clerk's note that it was still listed as "issued", and as a result sent Hofman-Bang a fax noting that annuity was "paid by another computer service" and the matter was "alive". This fax was sent without being reviewed by the billing attorney or myself, who likely would have questioned it. Finally, on December 8, 1997, Hofman-Bang replied to this fax noting that in fact the annuity wasn't paid and the patent had in fact lapsed. Again, this fax was not brought to the billing attorney's or my attention. These two failures to have all correspondence reviewed by at least the billing attorney are clear violations of our system's rules and quite inexplicable since those involved have many years of experience and know our systems well."

Højesterets begrundelse og resultat

Hofman-Bang var ved modtagelsen af Patentdirektoratets skrivelse af 25. november 1997 om patentets bortfald ikke i besiddelse af oplysninger, som gjorde det muligt for patentbureauet at fastslå, om den manglende betaling af 12. årsafgift skyldtes en beslutning om ikke at opretholde patentet eller beroede på en fejl. Fristen på 2 måneder i patentlovens § 72, stk. 1, 2. pkt., kan derfor ikke regnes fra Hofman-Bangs modtagelse af skrivelsen.

Den omstændighed, at fristen ikke som antaget af Ankenævnet skal regnes fra dette tidspunkt, kan ikke afskære domstolene fra at tage stilling til, fra hvilket andet tidspunkt fristen skal regnes. Der er derfor ikke grundlag for at hjemvise sagen til patentmyndighederne med henblik på, at disse skal træffe en ny afgørelse i medfør af patentlovens § 72, stk. 1, 2. pkt.

Det må som anført af landsretten lægges til grund, at Clark & Elbing, som var patenthavernes amerikanske patentagent, senest ved modtagelsen af telefaxskrivelsen af 8. december 1997 fra Hofman-Bang var eller burde have været klar over, at patentet var bortfaldet som følge af manglende betaling af årsafgift, og at dette skyldtes en fejl. Anne Micco har oplyst, at hun videregav telefaxskrivelsen, der var stilet til Paul T. Clark og Michelle Silver, til sidstnævnte, og det kan ikke alene på grundlag af de erklæringer, der er afgivet af Michelle Silver og Sandra E. Marxen, anses for godtgjort, at skrivelsen ikke blev forelagt Paul T. Clark personlig. Allerede som følge heraf kan der ikke lægges vægt på det af appellanterne anførte om, at den manglende reaktion på skrivelsen skyldtes en enkeltstående fejl begået af en assistent. Herefter, og da det under de anførte omstændigheder ikke kan være afgørende, at det var patentbureauet Oy Jalo, der i forhold til appellanterne var ansvarlig for årsafgifternes betaling, tiltræder Højesteret, at fristen efter patentlovens § 72, stk. 1, 2. pkt., skal regnes fra den 8. de-

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cember 1997 og derfor var overskredet, da begæringen om genoprettelse blev indgivet til Patentdirektoratet ved skrivelse af 24. marts 1998.

Det kan ikke føre til en anden vurdering, at den dagældende bestemmelse i patentlovens § 66, i henhold til hvilken Hofman-Bang var udpeget som dansk fuldmægtig for patenthaverne, muligt ikke var i overensstemmelse med EU-retten.

Højesteret stadfæster herefter dommen.

Thi kendes for ret:

Landsrettens dom stadfæstes.

I sagsomkostninger for Højesteret skal Barry R. Goldin, Sherwood L. Gorbach og Valio Ltd., solidarisk betale 75.000 kr. til Ankenævnet for Patenter og Varemærker.

De idømte sagsomkostningsbeløb skal betales inden 14 dage efter denne højesteretsdoms afsigelse. Sagsomkostningsbeløbet for Højesteret forrentes efter rentelovens § 8 a.

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Udskriftens rigtighed bekræftes.

Højesteret, den 25. november 2005.



Helle Hansen

overassistent