

### Abstract

A priority claim based on an industrial design for a subsequent European application was denied by the Receiving Section; the applicant appealed. The Board rejected the appeal, finding that Article 87 EPC did not allow for a priority claim based on an industrial design. Additionally, the Board found that Article 4 of the Paris Convention did not suggest that an industrial design should be the basis of a priority claim since a design discloses the look of an invention, not the invention itself.

## **EPO boards of appeal decisions**

**Date of decision 11 June 1981 Case number J 0015/80 - 3.1.1**

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

- I. On 24 January 1979, the appellant deposited an industrial design (Geschmacksmuster) with the Amtsgericht of Hamburg in the Federal Republic of Germany.
- II. On 12 July 1979, the appellant filed a European patent application claiming priority inter alia from the deposit of the industrial design. Nine Contracting States (not including the Federal Republic of Germany) were designated in the application.
- III. On 14 September 1979, The Receiving Section wrote to the appellant, enclosing a copy of Article 87 EPC and advising that the European Patent Convention gave no possibility of claiming priority from the deposit of an industrial design. It was indicated that a decision might be applied for in accordance with Rule 69 (2) EPC.
- IV. On 5 November 1979, the appellant wrote applying for a decision in accordance with Rule 69(2) EPC and contending that the provisions of Article 87 EPC could not conflict with Article 4 of the Paris Convention for the Protection of Industrial Property (Paris Convention), which did not restrict the kind of industrial property right (apart from trade mark rights) on the basis of which priority might be claimed. Attention was drawn to two decisions of the German Federal Patent Court (BPatGE 9, 211 and 216, 10 November 1967), in which it had been accepted that an application for a utility model (Gebrauchsmuster) in the Federal Republic of Germany might claim priority based upon an earlier application for an industrial design in another Member State of the Paris Convention.

V. On 23 May 1980, the Receiving Section issued the decision under appeal, in which it held that priority could not be claimed for a European patent application on the basis of a previous deposit of an industrial design. Four reasons were given: (a) according to its Preamble, the European Patent Convention is a Special Agreement within the meaning of Article 19, Paris Convention. The European Patent convention must, therefore, be interpreted in the light of that Convention. The history of Article 87(1) EPC shows that it was designed to be in conformity with that Convention; (b) an attempt to secure amendment of the Paris Convention so as to recognise a uniform priority right based on patents, utility models and designs was defeated at the London Conference of Revision in 1934; (c) Contracting States of the European Patent Convention do not practice generally recognise a priority right for a patent application based on deposit of an industrial design. Although the German Federal Patent Court had recognised such a right (unpublished Decision of 25 April 1979 - 4W(pat) 138/77), in a Judgement of 22 April 1979 the Swiss Federal Supreme Court (BGE Vol. 101b,132 has expressly held that there is no such right and in a Decision of 28 November 1979 the Austrian Supreme Administrative Court (Österreichisches Patentblatt 1980 I. Teil 90-94) has denied that priority for an industrial design can be claimed on the basis of an earlier patent application; (d) as there is no general recognition in the Contracting States of a priority right for a patent application based on an earlier industrial design application, Article 4 of the Paris Convention cannot be the basis for qualifying the express language of Article 87 EPC.

VI. In a letter dated 26 June 1980, the appellant gave notice of appeal against the Decision of the Receiving Section, seeking reversal of the Decision and recognition of the claimed priority and set out a Statement of Grounds. The appeal fee was duly paid.

VII. In its Statement of Grounds, the appellant inter alia criticized the lack of detail in the Receiving Section's analysis of the practices in the Contracting States. The appellant argued that at least as far as a European application extended to the Federal Republic of Germany it should be possible to claim priority for that State. The commentary of Bodenhausen (Guide to the application of the Paris Convention for the Protection of Industrial Property, BIRPI, 1968) and the Decision of the German Federal Patent Court (4 W pat 138/77) were favourable to the appellant. The disagreement at the London Conference of Revision in 1934 had been over a proposal for a uniform priority period for all industrial property rights: this, therefore, was not relevant.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC, and is, therefore, admissible.
2. Article 87(1) EPC provides that a person who has duly filed in or for any State party to the Paris Convention for the Protection of Industrial Property, an application for a patent or for the registration of a utility model or for a utility certificate or for an inventor's certificate, or his successors in title, shall enjoy, for the purpose of filing a European patent application in respect of the same invention, a right of priority during a period of twelve months from the date of filing of the first application.
3. The provisions of Articles 87 to 89 and Rule 38 EPC together form a complete, self-contained, code of rules of law on the subject of claiming priority for the purpose of filing a European patent application. The language of some of the provisions is, to a large extent, taken over from that used in Article 4 of the Paris Convention. However, this code of rules of law is, and was designed to be, independent of the Paris Convention. It forms part of the system of law common to the Contracting States which was established for the grant of patents for inventions: cf. Article 1 EPC.
4. As long ago as the third meeting of the "Patents" Working Party in Brussels (25 September - 6 October 1961), it was decided that the subject of priority should be exhaustively regulated in the European Patent Convention as then envisaged and that the Convention should not include any cross-references to the Paris Convention (cf. Document IV/65 14/61-D, 13 November 1961, page 84). The Working Party expressly pointed out that any cross-references to the Paris Convention would have the disadvantage that "provisions would apply that were subject to differences of interpretation". There was no subsequent deviation from this early policy decision: successive drafts of the relevant Articles were merely amended to keep the provisions in line with changes made to Article 4 of the Paris Convention, but no other significant changes of substance were made. The United International Bureaux for the Protection of Intellectual Property (BIRPI) and their successor, The World Intellectual Property Organization (WIPO), guardians of the Paris Convention, participated in the drafting of the European Patent Convention at all stages and finally noted that the provisions of the Paris Convention "had been taken fully into account" (Comments in the preparatory documents for the Munich Diplomatic Conference by WIPO, M/27, 18 April 1973, para. II.1).
5. The European Patent Office cannot be directly bound by Article 4 of the Paris Convention, since the European Patent Organisation is not a party to that Convention.

6. As appears from what has been said in paragraphs 3 and 4 above, Articles 87 to 89 and Rule 38 EPC are not intended merely to lay down general principles. Article 87 (1) EPC is clear in its language and seems to exhaustively state the kinds of prior applications that can give rise to rights of priority. Prima facie, therefore, since Article 87 (1) EPC does not expressly provide that a person who has duly deposited an industrial design shall enjoy, for the purpose of filing a European patent application, a right of priority, no such right of priority exists.

7. However, it must not be forgotten that the European Patent Convention is a special agreement within the meaning of Article 19 Paris Convention and that such an agreement can be made by Contracting States to the Paris Convention "in so far as it does not contravene the provisions of" that Convention. The question therefore arises whether the general understanding of the effect of Article 4 Paris Convention is that the deposit of an industrial design clearly gives a right to claim priority when making a later patent application in respect of an invention disclosed by the deposited design. Such a general understanding could possibly lead to an interpretation of Article 87(1) EPC going beyond its terms.

8. The Board regards the successive revisions of Article 4, Paris Convention, which brought about the addition of paragraphs C, E and I, as reflecting the view that if the Convention is intended to give a right of priority for a patent application based on anything other than an earlier patent application, this must be expressly provided for. Thus paragraph I (2), inserted at the Stockholm Diplomatic Conference in 1967, mentions as a basis for priority rights for inventors' certificates only patents, utility models and inventors' certificates. Furthermore, the language of various modern international Conventions dealing with patents is consistent always with the view that only an earlier application for protection of an invention can be the basis for claiming priority for a later application for a patent.

9. The Patent Cooperation Treaty (PCT) furnishes a particularly clear example of this. Article 8 (1) PCT provides that an international application for a patent made in accordance with that treaty may contain a declaration "claiming the priority of one or more earlier applications". In accordance with Article 2 (i) PCT, unless expressly stated otherwise, "application means an application for protection of an invention; references to an "application" shall be considered as references to applications for patents for inventions, inventors' certificates, utility certificates, utility models, patents or certificates of addition, inventors' certificates of addition, and utility certificates of addition." There is no "express" statement anywhere in the Treaty or Rules which could qualify this very precise definition of "application" so as to make Article 8 (1) PCT and PCT Rule 4.10 include an earlier deposit of an industrial design. It is true that Article 8 (2) (a)

PCT makes cross-reference to Article 4 of the Stockholm Act of the Paris Convention, and that Article 1 (2) PCT requires that no provision of the PCT shall be interpreted as diminishing rights under the Paris Convention but paragraphs 11-15 below refer to differences in interpretation of Article 4 Paris Convention.

10. The former European Convention Relating to the Formalities Required for Patent Applications, signed at Strasbourg in 1953, which was also a special agreement within the meaning of the Paris Convention, included, in Annex II, a form which could be adopted by Member States for use by applicants wishing to make national patent applications with claims of priority. The English text of this form, which was adopted and made compulsory in at least the United Kingdom, included a declaration that "(an) applications(s) for protection for an invention or inventions has(ve) been made in ..." etc. It cannot reasonably be suggested that the imposition of a statutory obligation to use this form, which would necessarily exclude priority claims based on design or trade mark applications, constituted a breach of the Paris Convention by the United Kingdom.

11. Contrary to the arguments of the appellant, in the opinion of the Board it is the law under the Paris Convention that, in relation to patent applications, a right of priority under that Convention exists if the prior application is for the protection of an invention as such and contains a disclosure of it. The deposit of an industrial design in essence protects aesthetic appearance. Although the deposited design may incorporate an invention, according to national design laws the deposit will not protect the invention as such. The commentary of Bodenhausen, relied on by the appellant, does not support the appellant's case. It merely points out, correctly, that in certain specific cases, not including patents, claims for priority for the protection of one kind of industrial property may be based upon claims for protection of another kind (cf. Bodenhausen, *op. cit.*, note (i) to Article 4 Section A (1)).

12. One of the main arguments of the appellant is based on decisions of the German Federal Patent Court in which priority claims for German utility model and patent applications based on industrial design applications have been recognised. The most recent Decision (4 W(pat) 138/77, 25 April 1979), the only one relating to a patent application relies mainly on the earlier published decisions of the same Court (BPatGE9, 211, 216, 10 November 1967) on claims to priority for utility model applications based on the earlier filing of United States Design Patents. The decisions of 1967 necessarily could not take into account the international developments at the Stockholm Conference of that year, the Washington Diplomatic Conference of 1970 (PCT) or the Munich

Diplomatic Conference of 1973 (EPC). They relied heavily upon the views of authors writing in the early decades of the present century.

13. As noted in paragraph V (c) above, the Swiss Federal Court and the Austrian Supreme Administrative Court, both courts of final instance, came to different conclusions. Their decisions, more recent than the German decisions of 1967, both take account of the Stockholm Revision Conference of the Paris Convention. The Austrian decision also considered the 1967 German decisions.

14. The Board does not think that it is necessary or useful to investigate in detail the law and practice relating to priority claims for national patent applications in the Contracting States of the European Patent Convention. Nothing put forward by the appellant or found in any documents referred to by the Receiving Section persuades us that a Court of any Contracting State other than the Federal Republic of Germany has ever acknowledged a priority right of the kind claimed in the present case.

15. The Board therefore concludes that the Paris Convention is not generally interpreted in the Contracting States of the EPC in a way that would be favourable to the appellant if the Paris Convention were directly applicable. It follows that the answer to the question posed above in paragraph 7, second subparagraph, is that there is no reason to read Article 87 (1) EPC more broadly than its express terms and scope require.

## **ORDER**

For these reasons it is decided that:

The appeal against the Decision of the Receiving Section dated 23 May 1980 is dismissed.

**O.J. EPO issue: 1981,213**

**Case law reports: CLBA 1996**