

Abstract

The applicant filed an international application, and after the expiry of the 19 month time limit to do so the applicant submitted a demand for international preliminary examination and a request for a re-establishment of rights, arguing that the examination fee paid at the time of filing should be viewed as an implicit demand for an international preliminary examination. The EPO, acting as the International Preliminary Examination Authority, found that there were no grounds to re-establish the applicant's rights and refused the demand. On appeal, the Board found that there was no jurisdiction for it to consider the case.

EPO boards of appeal decisions

Date of decision 16 December 1992

Case number J 0015/91 - 3.1.1

Summary of Facts and Submissions

I. The appellant filed an international patent application within the meaning of the PCT with the European Patent Office's branch at The Hague on 3 November 1989 designating Australia (for a "petty patent"), Germany, Japan, The Republic of Korea and Burkina Faso (each regarding a utility model) as designated States. According to the copy of the fee payment form on file (the receipt form for the application documents - EPO Form 1010), other fees including the search fee and the fee for the international preliminary examination were also paid on the same date.

II. The international search report was established by the EPO and sent to the applicant on 22 February 1990. The application was published on 17 May 1990.

III. The applicant sent the forms requesting international preliminary examination (the demand) to the EPO in a letter dated 4 May 1991 (received on 6 May 1991).

IV. Shortly afterwards, in a letter dated 6 May 1991 (received on 6 May 1991), the applicant submitted (1) a request for correction addressed to the European Patent Office Munich and (2) an application for re-establishment of rights. The applicant's professional representative argued that the examination fee of DEM 2 120 had been paid in due time, i.e. when the application was filed, that this was to be construed as a demand for international preliminary examination and that the designation of States in the PCT application was therefore to be interpreted as an election of States for the international preliminary examination. He added

that on his instructions his secretary had telephoned the EPO's information desk on a number of occasions to ask whether anything further needed to be done with regard to the demand for examination, that she had been answered in the negative, and that he was prepared to submit an affidavit to this effect.

V. On 12 July 1991 the EPO sent the applicant Form "PCT/IPEA/424 (January 1985)" marked "International Preliminary Examining Authority (IPEA) essentially notifying him that, (a) the demand for international preliminary examination had been received by the EPO after expiry of the 19th month from the earliest priority date (contrary to Art. 39(1)(a) PCT); (b) the demand had nevertheless been properly filed in accordance with regulations, but because it had been filed late, the applicant would not benefit from the extended time limit - 30 months from the earliest priority date (Art. 39(1)(a) PCT) - for commencement of the regional/national phase; (c) if the demand were withdrawn before examination commenced 75% of the fee would be refunded. The Office further stated that it was unable to allow the correction requested by the applicant -transforming the payment of the examination fee into a demand for international examination -because the demand had not been made in the prescribed form (Art. 31(3), second sentence, Rule 53.1(a) PCT) and because, contrary to Article 31(4)(a) and Rule 53.2 PCT, it had not elected at least one of the States designated in the international application. Citing decision J 12/82 (OJ EPO 1983, 221), it added that the mere payment of a fee could not be a substitute for filing a request in due time.

VI. In a letter dated 9 August 1991 (received on 12 August 1991) the applicant filed an appeal against the EPO's communication of 12 July 1991, simultaneously paid the appeal fee and requested as follows:

- (1) That it be found that the EPO, acting in this case as IPEA, had received the demand for examination;
- (2) In the alternative: That the applicant be invited to correct any defects in his demand of 3 November 1989 and a time limit for the correction of defects be set;
- (3) In the extreme alternative: Should requests 1 and 2 be refused, that a date for oral proceedings be set.

The grounds for appeal consisted essentially of the following points: Procedural grounds:

The appeal was admissible because the appellant had been adversely affected and because in the present case, unlike in J 20/89 - where the Board, applying

the provisions of Article 150(2) EPC and Rules 40.2(c) and 68.3(c) PCT, had held that it did not have jurisdiction to examine appeals against decisions taken by the EPO acting as IPEA - the EPO was not acting solely in its capacity as IPEA, but also as receiving Office, hence its decisions were open to appeal under Article 152(1) EPC in conjunction with Articles 150(2) and 106 et seq. EPC.

Substantive grounds:

Here the appellant essentially re-stated the grounds put forward in his petition of 6 May 1991 (see IV above).

VII. Replying to a communication from the Board dated 10 February 1992 concerning the question of jurisdiction, in a letter dated 17 March 1991 the appellant again referred to Article 150(2) EPC, which states that international applications may be the subject of proceedings before the EPO. If the EPO had been acting as receiving Office under the PCT it would, under the PCT, also have had to accept a demand for international preliminary examination. Under Article 150(2) EPC the actions of the EPO also had to be subject to review in accordance with the due process of law. The provisions of Articles 106 et seq. EPC concerning appeals must therefore also be applicable.

VIII. Oral proceedings were held on 16 November 1992 on the understanding that they were to be limited to the question of the Board's jurisdiction to hear the present appeal.

The appellant maintained the requests as set out in the notice of appeal, amplifying (clarifying) his first auxiliary request by stating explicitly that the correction of defects requested was to be effective from the date of the demand in question, i.e. from 3 November 1989, and also filing a further auxiliary request for the matter of jurisdiction to be referred to the Enlarged Board of Appeal.

In support of his contention that the Boards of Appeal did have jurisdiction the appellant also cited both *Singer R.*, "Europäisches Patentübereinkommen" (Cologne 1989, p. 700, Note 3, para. 2, re Art. 150 EPC), which states: "Furthermore, international applications can also be the subject of proceedings before the EPO specifically created for these [i.e. European applications] where, for example, the EPO is acting as receiving Office and searching authority in respect of applications under the PCT which are not European patent applications or Euro-PCT applications.", and the PCT "Applicant's Guide" which, in Vol. I, 1991 edition, paragraph 163, states amongst other things: "The PCT does not provide for any appeal or petition during the international phase"

and which goes on to say that some national courts or appeal boards have accepted appeals against decisions taken by national or regional Offices in their capacity as receiving Offices. Finally, he also argued that Article 125 EPC conferred jurisdiction.

Reasons for the Decision

1. The appeal is directed against a communication sent out by the EPO under Chapter II of the Patent Cooperation Treaty (PCT) acting in its capacity as International Preliminary Examining Authority (IPEA).

The appeal and the appeal fee were received by the EPO within two months of its issuing the impugned communication. Before examining the other admissibility criteria, the Board must in the present case first address the issue of its jurisdiction.

2. In an earlier decision (cf. J 20/89, OJ EPO 1991, 375, 378, point 2) the Legal Board of Appeal held that Boards of Appeal lacked jurisdiction to examine any act of an IPEA not relating to an invitation to pay additional fees or a protest against such an invitation under Rule 68.3(c) PCT.

The appellant argues that the Board of Appeal does have jurisdiction in the present case, because, unlike in the above-cited case, where it was acting solely as an IPEA, the EPO had also previously acted as receiving Office. However, he fails to take account of the fact that when the EPO is performing its role as a PCT authority on the basis of that treaty and of the procedural acts for which it provides, the sphere of action of its departments is limited.

The PCT implicitly provides for two main phases, the "international" and the "national" phases, with the international preliminary examination procedure forming part of the international phase (cf. Mousseron J.M., "Traité des Brevets", Paris 1984, p. 961, Note 1001, and "PCT Applicant's Guide", Vol. I, 1991 edition, paragraphs 10-13).

Under Article 34(1) PCT the procedure before the International Preliminary Examining Authority (IPEA) is governed in the first instance by the provisions of the PCT itself, in the second by the Regulations, and in the third by the agreement which the International Bureau concludes, under the PCT and the Regulations, with that Authority.

Rule 68.3(c) PCT, in conjunction with Article 34 PCT, confers a specific competence to examine decisions on a "three-member board" or "other special instance of the International Preliminary Examining Authority", or "any

competent higher authority". Under Article 3 of the "Agreement between EPO and WIPO under the PCT" of 7 October 1987, which entered into force on 1 January 1988 (OJ EPO 1987, 515), this function, or competence, was part of the competence vested in the European Patent Office in respect of its IPEA activity as a whole. Under Article 155(3) EPC this function, or competence, devolved to the EPO's Boards of Appeal. Both Rule 68.3(c) PCT and Article 155(3) EPC thus relate solely to the examination of a protest against an invitation to pay an additional fee owing to lack of unity. The impugned decision, or "communication", does not however fall into this category.

In J 20/89 (OJ EPO 1991, 375, 378, point 2) the Board has already established that, save as is provided in Rules 40.2(c) and 68.3(c) PCT, there is nothing in either the PCT itself, or the Regulations under it, providing for appeal during the international phase (cf. also the corresponding passage in paragraph 163 of the "PCT Applicant's Guide" cited above). Article 25 PCT provides for review by the designated Offices of a refusal by the receiving Office to accord a filing date or a decision to declare an application withdrawn. Nor does the "Agreement between EPO and WIPO under the PCT" of 7 October 1987 contain provisions to any other effect.

Under Article 150(3) EPC a PCT application for which the EPO acts as designated or elected Office is deemed to be a European patent application. In those cases, i.e. in the national or regional phase of an international application, therefore, the question as to the jurisdiction of the Board of Appeal is placed in a different framework. In the present case the EPO was acting neither as an elected Office nor as a designated Office. There can therefore be no doubt - nor does the appellant claim otherwise - that the procedural steps in question took place during the international phase of the PCT application procedure.

3. The fact that the EPO had previously acted as receiving Office for the international application in question provides no basis for Board of Appeal jurisdiction. Under Article 31(3) PCT the demand for international preliminary examination must be made "separately from the international application" and, under Article 31(6)(a) PCT, submitted "to the competent International Preliminary Examining Authority referred to in Article 32". Citing this article, the "PCT Applicant's Guide", Vol. I, 1991 edition, paragraph 213, plainly states that the demand must be submitted to the competent IPEA and "not to the receiving Office". Hence there is a clear distinction between proceedings before a receiving Office and those before an IPEA, a distinction further emphasised by the PCT's providing for activities to be carried out by an International Searching Authority (ISA) between those assigned to the receiving Office and the IPEA. Nor is there any procedural link between these activities, as neither the application nor the search report is forwarded to the IPEA. An application can

only be transmitted to WIPO and the International Searching Authority (ISA) (cf. Art. 12(1) PCT), while the search report goes to the receiving Office and WIPO (Art. 18(2) PCT). During the PCT application procedure itself these various functions can be performed by one and the same authority, i.e the EPO in the present case. This does not however mean that the various stages in the PCT procedure have been merged, especially as the search phase is obligatory (Art. 15(1) PCT), while the international preliminary examination is not (Arts. 31 to 38 PCT). The impugned communication was, moreover, issued by the EPO in its capacity as "International Preliminary Examining Authority". It was not acting either as ISA or as receiving Office.

The fact that Article 150(2) EPC states that international applications may be the subject of proceedings before the European Patent Office, in which case the provisions of the PCT, supplemented by those of the EPC, shall be applied, does not detract from the above. The aim of this provision is to allow the EPO to transfer international applications to the procedure created for European patent applications (cf. Singer, *op. cit.*, p. 700, Note 3, para. 1, re Art. 150 EPC). As already indicated in 2 above, this was not done in the present case. Nor is the activity being assessed here one which, like the examination of protests under Rule 68.3(c) PCT, falls within the jurisdiction of the EPO or its Boards of Appeal under the above provisions.

Finally, the applicant also referred to a passage in paragraph 163 of the "PCT Applicant's Guide" according to which some national courts or appeal boards have accepted appeals against decisions taken by receiving Offices. A mere allusion to the practice followed in some PCT Contracting States, without an explanation of the legal provisions invoked, is by its very nature no basis for any consideration of whether the Boards of Appeal have jurisdiction. In fact, this same paragraph states that "appeals are not provided for" during the international phase of the application procedure under the PCT. Moreover, as already stated in 1 above, the present appeal is against an action taken by the EPO in its capacity as IPEA, and not against one taken by the EPO as receiving Office.

In point 4 of J 20/89 (OJ EPO 1991, 375) the Board concluded that it lacked jurisdiction because in that particular case the EPO had been acting solely as IPEA, and not as ISA or receiving Office as well. In spite of what the appellant may think, the converse may not be inferred from that decision; the facts of that case were different, as he himself concedes.

In support of his view that the Boards of Appeal of the EPO do have jurisdiction, the appellant also referred to Article 125 EPC. That provision however does not apply on account of Article 34(1) PCT.

4. For the above reasons the Board has no jurisdiction to examine the present appeal.

The Board will accordingly refrain from commenting on the merits of the present case.

Nor is there any reason for the Board to comment on the question of jurisdiction in appeals directed against actions taken by the EPO in its capacity as receiving Office.

5. The legal position being clear, the Board does not see any need to refer the question of jurisdiction to the Enlarged Board of Appeal under Article 112(1)(a) EPC.

6. The preliminary point examined here was the question of jurisdiction. This question having been answered in the negative, there is no need to clarify other admissibility criteria.

ORDER

For these reasons it is decided that:

1. The Board of Appeal has no jurisdiction to decide the present appeal.
2. The request for this point of law to be referred to the Enlarged Board of Appeal is refused.

O.J. EPO issue: 1994,296

Case law reports: CLBA 1996