Abstract
Applicant filed an international application designating several EPC Contracting States for national protection but without any check mark in the box signifying a desire for a European patent. The Board found that Article 4(1) PCT and Article 153(1) EPC, in the forms in force at the time of filing, required that any designation for a European patent occur at the time of filing.

EPO boards of appeal decisions

Date of decision 15 December 1997
Case number J 0019/93 - 3.1.1

Summary of Facts and Submissions

I. On 27 August 1991, T. Inc. filed European patent application No. PCT/US at the USPTO as receiving Office, claiming priority from a US application of 4 September 1990.

The acknowledgement of receipt (Form PCT/IB/301), notified under Rule 24.2(a) PCT by the International Bureau on 5 November 1991, listed:

(1) for the purposes of a national patent, the national Offices of Switzerland (CH), Germany (DE), the United Kingdom (GB) and Japan (JP);

(2) for the purposes of a European patent, the EPO, for Austria (AT), Belgium (BE), Switzerland (CH), Germany (DE), Denmark (DK), Spain (ES), France (FR), the United Kingdom (GB), Greece (GR), Italy (IT), Luxembourg (LU), the Netherlands (NL) and Sweden (SE).

II. The application was published with the international search report on 19 March 1992. The published document listed all the above-named states as states designated for the grant of a national or European patent.

III. On 1 April 1992, a demand for international preliminary examination was filed, containing elections of all the states listed in the published international application. In accordance with Rule 61.2 PCT, the International Bureau sent notifications of election to each of the elected Offices on 21 May 1992.

IV. By a fax of 20 May 1992, the International Bureau informed the US representative that the US Patent and Trademark Office (USPTO) as receiving Office (US/RO) had corrected the grant request form containing the

designations, with the effect that France was the only state designated for the grant of a European patent.

The second sheet of the grant request form (Form PCT/RO/101 of January 1990) did not contain a cross in the check-box for a European patent, nor were any of the signatory states of the Munich Convention deleted.

Otherwise, the following states had been designated for the purposes of a national patent: CH, LI, DE, GB and JP.
Finally, France (FR) was entered in the space "reserved for designating States (for the purposes of a national patent) which have become party to the PCT after publication of this form".

V. On 22 May 1992, the applicants, via their US representative C., sent an amended designation sheet to the receiving Office (US/RO), containing:

- for the purposes of a European patent: CH and LI, DE, FR and GB;

- for the purposes of a national patent: JP.

VI. On 20 July 1992, the receiving Office, US/RO, notified the applicants' US representative that the request for rectification had been refused, on the following grounds:

"Firstly the request is not timely, i.e. it is outside of the period provided for in PCT Rule 91.1.

"Secondly, the request is inappropriate. Each designation must be listed at the time of filing. The original request listed only France for EP protection. Applicant cannot and this Receiving office cannot later modify the request to include undesignated EP countries."

VII. The International Bureau felt bound, in turn, to follow the interpretation of the receiving Office US/RO and informed the US representative C. on 25. August 1992 that it was deleting ex officio the designation of the following states as not having been designated in the original request: for a European patent, AT, BE, DE, DK, GB, IT, LU, NL and SE, leaving France (FR) as the only designated state.

In a previous notification of 20 August 1992, the International Bureau had already informed the US representative C. of this situation, confirming that: "Due to an oversight, the notification PCT/IB/30, mailed 5 November 1991 is

erroneous as far as the designations for a European regional patent are concerned.

"The receiving office US/RO has confirmed that on request form as originally filed only France (FR) is designated for a European Patent ...

"As a consequence of what has been said above the notification of election mailed 21 May 1992 is also erroneous (see corrected version attached). A correction of the front page of the pamphlet will be published on 17 September 92.
The IB regrets any inconvenience caused."

VIII. The international preliminary examination report was communicated to the EPO as elected Office on 2 November 1992.

IX. On 9 February 1993, the applicants completed the acts required for entry into the regional phase before the EPO as elected Office, by filing EPO Form 1200 and paying designation fees in respect of CH/LI, DE, FR and GB, claiming that these states had already been designated in the original international application as filed with the receiving Office US/RO.

X. Parallel with this request for examination, the applicants requested a decision by the EPO confirming that the states listed above (CH/LI, DE, FR and GB) had been validly designated for the purposes of obtaining a European patent.

XI. In its decision of 26 July 1993, the Receiving Section refused this request.

The Receiving Section considered, in the first place, that such a request must be taken to constitute a request for correction under the terms of Article 27(4) PCT, which allows designated Offices to apply national law if it is more favourable to applicants than the corresponding provisions of the PCT.

In the present case, the applicable provisions of the PCT are those which were in force when the application was filed on 27 August 1991, ie those which came into effect on 1 January 1985.

According to these provisions, the designation of contracting states for the purposes of obtaining a patent is only possible in the original international application, and once this is filed, it is no longer possible to add a new designation, not even via a request for correction of a clerical error. This is also the line taken in the Receiving Section's communication of 20 July 1992.

The provisions of Rule 4.9 PCT regarding precautionary designation of all the contracting states did not enter into force until 1 July 1992, ie after the filing on 27. August 1991 of the international application in question. Consequently, these provisions cannot be applied to the present case.

From Article 4(1)(ii) PCT, it is clearly apparent that an applicant filing an international application who wishes to obtain a regional patent (in the present case, a European patent) must state this intention explicitly in his initial request. To facilitate this, the PCT request form contains a box headed "EP" which can be marked with a cross by the applicant and has the effect of authorising the EPO to act as designated Office for all the EPC contracting states. The applicant can later specify, on entry into the regional phase, the individual states for which patent protection is sought.

In the absence of any such designation, as in the present case, the EPO cannot act as designated Office. Moreover, since numerous national laws permit the use of the PCT route for obtaining a national patent, and since the PCT request form takes account of this by including, below the box for the European patent, a number of boxes for the specific designation of contracting states for the purposes of a corresponding national patent, marking these boxes cannot be construed as establishing the wish to obtain a European patent for these same countries.

Article 45(2) PCT allows states to provide under their national law that any designation of the state in the international application shall be equivalent to an application for a regional patent. Parallel with this, Article 4(1)(ii) PCT in fine provides that if, under national law, the designation of the state in the international application is equivalent to an application for a regional patent, then such a designation shall be treated as an indication of the wish to obtain the regional patent.

In such cases, the EPO acts as designated Office under Article 153(1) EPC.

Under French law, the designation of France in an international application is equivalent to filing a European patent application for that country; in this case, therefore, the receiving Office could only treat the designation of France as an application for a European patent involving France, and, in the absence of any other European designation, the view of the receiving Office must be that the other EPC contracting states were expressly excluded from the international application.

Moreover, under the terms of Rule 91.1(e)(i) PCT, the rectification of errors in the international application may only be carried out by the receiving Office, which in this case has refused to comply with the applicant's wishes.

Correction on the basis of Rule 88 EPC is also ruled out, in so far as the applicant has failed to show that the designation of states in the international application as filed at the receiving Office (USPTO) is inconsistent with his intentions at the time of filing. A subsequent change of intention cannot be seen as constituting an error susceptible of rectification.

From this, it follows that the EPO grant procedure has only been validly initiated for France, according to that country's national law.

XII. On 27 September 1993, the applicants appealed against this decision, paying the appropriate fee on the same day.

XIII. In support of their appeal, the appellants claimed, firstly, that the Receiving Section had omitted to decide on the first of their requests, and secondly, that it had misinterpreted and distorted their second request.

Re point 1:

On 10 February 1993, at the time of entry into the regional phase before the EPO, the applicants, now the appellants, had applied for a decision regarding the text of the patent, on the basis of which the EPO would have to decide if the request was supported by Article 113(2) EPC.

Since, under Article 78 EPC, the request for grant is part of the patent application, and since it contains designations of the contracting states for which protection is sought, the EPO had to decide which text (ie which designations) had been approved by the applicants in accordance with Article 113(2) EPC.

In the present case, there are four successive texts relating to the designation of states:

(1) The first text, filed by the US representative on 27. August 1991.

(2) A second text, prepared at an unknown date by the USPTO as receiving Office and transmitted by that Office to the International Bureau but not communicated in any way to the applicant.

(3) The text forming the subject of a publication on 19. March 1992 by the International Bureau and indicating that the EPO was the designated Office for all the states which were parties to the EPC.

(4) A fourth text forming the subject of a publication corrected by the International Bureau and indicating that the EPO was the designated Office for France only.

Clearly, therefore, identifying which of these texts establishes the designation of states is a necessary preliminary to an assessment of the case.

To consider the first of these texts would mean that the appellants are requesting an opinion on their interpretation of Article 153(1) EPC, not a correction on the basis of Rule 88 EPC.
Considering the second text would mean that rectification was being requested on the dual basis of Articles 113(2) and 125 EPC.

No requests have been submitted in respect of the third version of the text.

For the fourth text, the version which appears to have been considered by the EPO, rectification would be requested on the basis of Article 125 EPC.

From this, it is apparent that establishing the authoritative designation was indeed a precondition for examining the second request.

In failing to give anything like a clear decision on this first request, the Receiving Section committed a procedural error of sufficient seriousness to warrant reimbursement of the appeal fee.

Re point 2:

In the statement of reasons for its decision, the Receiving Section interpreted the second request as constituting a request under Rule 88 EPC for the correction of errors in the documents filed with the EPO.

However, the appellants maintain that such an interpretation is entirely mistaken: on the contrary, if the EPO had concluded that the text of the request to be considered was the one resulting from the filing at the receiving Office on 27 August 1991, then this designation sheet had to be read according to the letter and the spirit of Article 153(1) EPC, as meaning that four EPC contracting states had been correctly designated for the purposes of obtaining a European patent. This was unambiguously indicated by the request for a decision submitted on 10 February 1993.

Since this request, based on Article 153(1) EPC, was fundamentally different from a request based on Rule 88 EPC, this erroneous interpretation by the

Receiving Section constitutes a second substantial infringement of the rules of procedure before the EPO.

The appellants' objections to the impugned decision can be summarised as follows:

In principle, it is true that Article 4(1)(ii) PCT requires applicants wishing to obtain a regional patent to indicate this in their application. But this requirement has to be set against the provisions of Article 45(2) PCT, which are restated by Article 4(1)(ii) in fine, regarding the designation in the request of a state whose national law indicates that such a designation must be treated as equivalent to an application for a regional patent.

These provisions override the general rule and must be applied without having to correct the application.

The provisions must not be interpreted in the restrictive manner of the impugned decision, as meaning that the designation of France was necessarily equivalent to a European patent application for this country only.

On the contrary, Article 45(2) PCT refers explicitly to the regional patent treaty and therefore, in the present case, to Article 153(1) EPC, with the result that the EPO is the designated Office in the original international application.

Article 1 of French Law No. 77.682 simply applies the provisions of Article 45(2) PCT, so it is incorrect to claim that the designation of France in the original application was equivalent to a European patent application for this country alone. Moreover, the receiving Office committed a substantial procedural error by amending the designation in the application on its own initiative, without informing the applicant.

Consequently, Article 153(1) EPC must, in the context of this case, be read as follows:

"The EPO shall act as a designated Office within the meaning of Article 2(xiii) of the Cooperation Treaty for those Contracting States to this Convention in respect of which the Cooperation Treaty has entered into force and which are designated in the international application, wherein said designated States are namely CH, DE, GB, if, in the international application, the applicant designates a State, wherein said State is France, of which the national law provides that designation of that State shall have the effect of the application being for a European patent."

In the applicants' view, therefore, the recognition of the designation in the international application of France, Germany, the United Kingdom and Switzerland, for the purposes of a European patent, could not result from the rectification of an error in the said application, but it could follow from the combination of French law with the EPC and from the absence of any provision in the PCT expressly prohibiting such recognition.

As for the rectification of the supposed error, it was not the task of the Receiving Section to enquire into the applicants' original intentions regarding the states they wished to designate for the purposes of obtaining a European patent; the Section was required only to interpret the request for designation in accordance with the provisions of the EPC and the PCT.

Finally, it is wrong to claim that the publication of the international application for all the EPC contracting states had not affected the rights of the appellants, who, in view of this publication, had chosen the European route in preference to the national route for four states and who were unable ... to re-establish the national route for Switzerland after the International Bureau had discovered its alleged error.

XIV. For these reasons, and for the reasons given in their request of 9 February 1993, the appellants request that the board:

(1) set aside the Receiving Section's decision of 26. July 1993;

(2) decide on European patent application No. 91 917 843.4 as originally filed, containing designations of states

(3) state that this text must be interpreted, without correction, in the context of the provisions of Article 153(1) EPC, to mean that Switzerland, Germany, France and the United Kingdom have been designated for the purposes of obtaining a European patent.

XV. Duly informed of the provisional opinion of the Board the appellant withdrew his previous requests for a communication and for oral proceedings.

Reasons for the Decision

1. The appeal is admissible.

2. To resolve the dispute it is necessary, first, to define and interpret the texts which are applicable, and second, to apply them to the established facts of the case.

3. Applicable texts

3.1. Article 4(1)(ii) PCT provides that the request which must be included in the international application shall contain:

"the designation of the Contracting State or States in which protection for the invention is desired on the basis of the international application ("designated States")."
- If for any designated state a regional patent is available and the applicant wishes to obtain a regional patent rather than a national patent, the request shall so indicate.

- If, under a treaty concerning a regional patent, the applicant cannot limit his application to certain of the states party to that treaty, designation of one of those states and the indication of the wish to obtain the regional patent shall be treated as designation of all the states party to that treaty.

- If, under the national law of the designated state, the designation of that state has the effect of an application for a regional patent, the designation of the said state shall be treated as an indication of the wish to obtain the regional patent.

3.2. Article 45(2) PCT states, in turn, that the national law of a designated or elected state may provide that any designation or election of such state in the international application shall have the effect of an indication of the wish to obtain a regional patent under the regional patent treaty.

3.3. Article 1 of the French Law No. 77.682 of 30 June 1977 concerning the application of the Patent Cooperation Treaty (PCT), done at Washington on 19 June 1970 and in force on 27 August 1991, at the time of filing the international application, provides that:

"If an international application for the protection of inventions, formulated in application of the Washington Treaty, contains a designation or election of France, that application shall be treated as indicating the wish to obtain a European patent under the provisions of the Munich Convention."

3.4. Article 153(1) EPC provides, meanwhile, that the EPO shall act as a designated Office for those contracting states to the Munich Convention for which the PCT has entered into force and which are designated in the international application if the applicant informs the receiving Office in the international application that he wishes to obtain a European patent for these states. This provision also applies if, in the international application, the

applicant designates a contracting state of which the national law provides that designation of that state shall have the effect of the application being for a European patent.

3.4.1. From these various provisions, which are entirely consistent with one another, it is unambiguously apparent:

- firstly, that the applicant must, in the international application filed at the receiving Office, indicate his intention of obtaining a regional patent for the designated state or states;

- secondly, that the designation in the international application of a state whose national law expressly provides that such an application is necessarily equivalent to a regional patent application shall only be valid in that state, in the absence of a special agreement, concluded pursuant to Article 149 EPC, with another group of states.

3.4.2. According to the latter Article, a group of contracting states may provide that they may only be designated jointly and that the designation of one or some only of such states shall be deemed to constitute the designation of all the states of the group. Furthermore, where the EPO acts as designated Office under Article 153(1) EPC, the states in the group are deemed to be designated jointly if the applicant has indicated in the international application that he wishes to obtain a European patent for one or more of the designated states of the group. The same applies if the applicant designates in the international application one of the states in the group, whose national law provides that the designation of that state shall have the effect of the application being for a European patent.

3.4.3. As France has not concluded a special agreement of this kind, to the effect that designation in the international application for the purpose of obtaining a national patent shall be equivalent to an application for a European patent, the application in question can only constitute an application for a European patent for France alone.

3.4.4. This, moreover, corresponds to the generally recognised principle of international law that a state can only legislate within the limits of its own sovereignty.

4. Established facts of the case

4.1. The only request for designation of states to be considered in this case is that originally filed at the receiving Office (USPTO) on 27 August 1991, as filled in by the applicants' representative.

4.2. In this request, filed on Form PCT/RO/101, the "EP" box, corresponding to an indication of the wish to obtain a European patent, had not been marked with a cross; therefore, the requirement imposed simultaneously by Article 4(1)(ii) PCT and Article 153(1) EPC is not fulfilled.

4.3. Moreover, the same request designates Switzerland, Germany, the United Kingdom and Japan for the purposes of a national patent.

4.4. Finally, France is designated for the purposes of a national patent in the space reserved for designating states which had become party to the PCT after the form was printed.

4.5. By virtue of the above-cited French law, of Articles 4(1)(ii) in fine and 45(2) PCT, and of Article 153(1) EPC, France was deemed to be designated in the international application for the purposes of obtaining a European patent.
4.6. However, as stated above, this designation is only valid for France and cannot be taken to imply that the other EPC contracting states had ever been designated, not even tacitly or on a precautionary basis.

5. Exact nature of the request

5.1. As the applicants themselves have said in their written submissions, the conclusions of their grounds for appeal cannot be regarded as constituting, even implicitly, a request for correction of the designations of states in the international application of 27 August 1991. On the contrary, they have based their argument on the fact, addressed in the foregoing reasons, that the interpretation of the designation of states according to the texts in force was clear and that it necessarily implied the designation of the EPO as the designated Office for the purposes of granting a European patent for CH with LI, DE, FR and GB.

5.2. In interpreting the appellants' request as a request for correction, before refusing it, the department of first instance was therefore seeking to act in their best interest.

5.3. Moreover, as the department of first instance pointed out, a subsequent change in the applicants' wishes did not constitute a basis for correcting the application.

5.4. This being the case, in assessing the argument to the appellants' advantage and interpreting, as it was entitled to do, a request which was not expressly

formulated and was therefore ambiguous, the department of first instance did not commit any substantial breach of procedure.

6. Finally, for the sake of completeness, it should be pointed out that the EPO as elected or designated Office is fully competent to interpret applications appointing it to act in these capacities, as it has done in the present case.

6.1. The Office is not bound by the interpretation of the receiving Office or of the International Bureau (J 4/94, J 26/87).

6.2. Moreover, in the present case, the International Bureau having corrected its first publication, the interpretations of the three instances coincide.

6.3. Under these circumstances, the appeal can only be dismissed.

ORDER

For these reasons it is decided that:

The appeal is dismissed.