

Abstract

Applicant's request to maintain his international application in a designated office following withdrawal by the receiving office was permitted. This was based on PCT Rule 51.1 and 51.3.

EPO boards of appeal decisions

Date of decision 05 June 1984

Summary of Facts and Submissions

I. The international application was filed on 2 August 1983 with the Japanese Patent Office acting as receiving Office. Among other countries, France was designated in the application. The application claimed priority from a Japanese first filing from 27 July 1983. The request form was signed by the representative.

The receiving Office invited the applicant on 8 August 1983 to submit an authorisation for the representative. The time limit expired on 8 September 1983 (Rule 80.2 PCT). The authorisation was filed with the Japanese Office on 9 September 1983, i.e. one day too late. The receiving Office declared the international application withdrawn on 3 October 1983 as no authorisation was received within the time limit (Article 14(1)(a) and (b), Rule 26.2 PCT). The normal treatment of the international application in the international phase was terminated.

II. The applicant now tried to maintain the effect of the international application i.a. for France for which the EPO was designated Office. On 17 October the applicant filed a request with the International Bureau in Geneva asking the latter to send copies of documents making up the international application to the EPO as designated Office pursuant to Article 25(1) PCT, which it accordingly did on the same date.

On 28 November 1983 the applicant filed a translation of the application and the authorisation with the EPO and paid the national fee (filing fee) and the designation fee for France. The search fee was not paid at the correct amount, but the applicant later paid the missing 20% of the search fee and the surcharge of 50% in accordance with Rule 85(a).

III. By letter dated 29 February 1984 (received 2 March 1984) the applicant filed a request for further processing of the international patent application and

asked that the legal consequences of missing the time limit for filing the authorisation before the Japanese Receiving Office be retracted. At the same time he requested restitutio in integrum into the time limit of two months for further processing (Article 121 EPC) and paid the fees on 2 March 1984.

Reasons for the Decision

1. Under Article 24(1)(ii) PCT, the effect of the international application provided for in Article 11(3) PCT ceases in any designated State with the same consequences as the withdrawal of any national application in that State inter alia if the international application is considered withdrawn by virtue of Article 14(1)(b) PCT. This legal consequence ensued with the communication dated 3 October 1983 from the Japanese Patent Office acting as receiving Office. The EPO as designated Office must, however, check whether provisions of the PCT, applicable under Article 150(2) EPC, do not prescribe that the proceedings be continued. Where the conditions under Article 25(2) PCT are met, every designated Office must maintain the effect of the international application as a national (regional) patent application pursuant to Article 11(3) PCT. Beyond this obligation, the designated Office may maintain this effect for other reasons (Article 24(2) PCT). The designated Offices are not prohibited from giving the applicant favourable treatment which goes beyond his rights laid down in the PCT.

2. Article 25(2) PCT obliges the designated Office to review the decision of the receiving Office and to maintain the effect of the application if the decision "was the result of an error or omission". This does not apply in the present case, because the Japanese Patent Office as receiving Office has rightly found that the authorisation was filed after expiration of the set time limit. The declaration that the application is deemed withdrawn was therefore correct.

3. It still remains to be examined whether the conditions for the application of Article 24(2) PCT are met. This provision contains an authorisation on the part of the designated Offices to maintain the effect of the international application as a national application. It will be primarily national law before the designated Office which governs the exercise of discretion. But it is also conceivable that other provisions of the PCT in their context give specific guidance for exercising discretion under Article 24(2) PCT. This guidance may be specific to such an extent that it limits the discretion and imposes an obligation on the designated Office to maintain the effect of the international application under certain circumstances.

From Article 48(2)(a) PCT stems the obligation for any Contracting State, as far as that State is concerned, to excuse, for reasons admitted under its national law, any delay in meeting any time limit. A Contracting State is to this extent "concerned" and its designated Office obliged to treat the international application accordingly when the effect of a national (regional) application pursuant to Article 11(3) PCT is lost for that State. The territorial effect of the international application is the key in interpreting the notion of "concerned" in Article 48(2)(a) PCT. The criterion to be applied by the authority of the Contracting State, namely whether there are "reasons admitted under its national law", is sufficiently specific and can be given effect directly even without implementing regulations on the national level. If there are such reasons pursuant to Article 48(2)(a) PCT under national (regional) law, the designated Office must "excuse" any delay in meeting any time limit.

The notion "any time limit" encompasses all time limits to be monitored by the applicant according to the PCT. It includes time limits before the receiving Office. In the absence of comprehensive legal remedies in the international phase, Article 48(2)(a) PCT is of fundamental importance for the legal security on the PCT-route and must therefore be given a wide interpretation (cf. Legal Board of Appeal J 05/80, OJ)/1981, 343). In order to give effect to the obligation to "excuse" the delay in meeting a time limit before the receiving Office, the designated Office must avail itself of the power given to it under Article 24(2) PCT. In this area Article 24(2) is not a matter for discretion but a basis and procedural mechanism for carrying out the obligation stemming from Article 48(2)(a) PCT.

4. What general procedural conditions must be fulfilled under Article 24(2) PCT emerges - indirectly - from the reference to Article 25 PCT in this provision (by the words "...even where such effect is not required to be maintained by virtue of Article 25(2)"). Article 24(2) PCT contains no detailed provisions on how the national (regional) phase is to be entered before the EPO as designated Office. Therefore this provision must be seen as a sub-category of Article 25(2) PCT wherein the finding that the contested decision to withdraw the international application was the result of an error or omission is not germane to the case.

The procedural requirements, namely (a) the request in due time by the applicant under Article 25(1)(c) and Rule 51.5 PCT and (b) compliance with the national requirements specified in Article 25(2)(a) PCT for the entry of the national (regional) phase (i.e. payment of the national fee within the prescribed time limit - Rule 51.3 PCT - and, as in this case, filing of a translation must therefore be met.

5. With his request of 17 October 1983 addressed to the International Bureau in Geneva, the applicant complied with Article 25(1) and Rule 51.1 PCT. The applicant furthermore furnished the translation of the international application to the EPO as designated Office within the prescribed period (Article 25(2)(a) and Rule 51.3 PCT). He also paid the national fee partly within this time limit, partly - together with a surcharge - within a period of grace allowed under the EPC under comparable procedural situations (Rule 85a EPC).

6. In assessing whether there are reasons pursuant to Article 4882) PCT "excusing" under the EPC - which is the "national law" before the EPO according to Article 2(x) PCT - any delay in meeting a time limit, a comparison must be made of the procedural steps under the PCT and EPC. If there are found to be similarities with the EPC, the PCT applicant must be allowed equivalent protection and, on similar conditions, offered the possibility of having the legal consequences which have ensued retracted. The words "reasons admitted under ... national law" are to be interpreted as a general reference to a comparable situation in national (regional) law (the EPC in the present case).

7. Legal remedies in the EPC in respect of delays in meeting time limits are in particular further processing of the patent application (Article 121 EPC) and re-establishment of rights (Article 122 EPC).

In the case in question the applicant has missed, in the international phase, the time limit under Rule 26.2 PCT. This time limit is fixed by the competent authority (the receiving Office), according to the circumstances of the particular case, at between one month and normally not more than two months from the date of invitation to correct the defect (Rule 26.2 PCT). It is therefore to be compared with time limits set by the European Patent Office to which Article 121 EPC applies. The legal consequence in Article 14(1)(b) PCT of withdrawal of the international application flowing from non-compliance with the time limit must therefore be retracted by applying Article 121 EPC *mutatis mutandis*.

8. The application of Article 121 EPC further presupposes that the applicant files the request for further processing, pays the relevant fee and completes the omitted act within two months of the date on which either the decision to refuse the application, or the communication that the application is deemed to be withdrawn, was notified (Rule 69(1) EPC). The communication dated 3 October 1983 from the Japanese Patent Office as receiving Office concerning the effect of withdrawal pursuant to Article 14(1)(b) PCT is to be treated as a communication pursuant to Rule 69(1) EPC.

Taking as the "relevant event" the date of the communication from the Japanese Patent Office as receiving Office, further computation of the time limit for filing

the request for further processing pursuant to Article 121 EPC is determined by Rule 83(4) EPC in conjunction with Rule 85 EPC. In the present case the two-month time limit therefore expired on 5 December 1983 (3 December 1983 was a Saturday).

9. Now the question arises how the procedural time limit for the remedy under Article 121 EPC (further processing) fits in the procedural framework of the PCT. The procedural situation of normal entries into the national phase (Articles 22 and 23 PCT) must be compared with cases of an early break-up of the international application ensuing from a declaration that the application is deemed withdrawn. In the "normal" situation it is the end of the time limit for fulfilling the national requirements (Articles 22 and 39(1) PCT) which marks the demarcation. Up to this point in time designated Offices must not process or examine the international application (Articles 23(1) and 40(1) PCT). These provisions are construed as implying that no national (regional) time limit may expire prior to the time limit under Article 22 PCT. The EPC specifically states that in cases of conflict the provisions of the PCT prevail and quotes the prolonged period for filing the request for examination under Article 94(2) EPC as an example (Article 150(2) EPC). Another example, not expressly mentioned in the EPC, is the annual fee (cf. Notice for PCT-applicants OJ 3/1979, 110).

From this set of provisions in their context the following general principle can be deduced: no time limit set under the EPC may expire prior to the time limit set by the PCT for the fulfillment of national requirements before the designated Offices.

In case of early break-up of the international procedure the expiry of the time limit under Rule 51.1 and 51.3 PCT marks the end of the international phase. The time limit for filing the request for further processing may therefore not expire prior to the time limit set by this provision. By chance, the time limits under Article 121 on the one hand and Rule 51.1 and 51.3 PCT coincide. They start from the same event (notification of loss of right) and have the same length (two months). It is therefore in accordance with Article 150(2) EPC and Rule 51.1 and 51.3 to require the request to be filed within two months from the notification of the receiving Office declaring the international application to be deemed withdrawn.

10. The applicant did not meet the two months' time limit for the request for further processing under Article 121 EPC and Rule 51.1 PCT. This time limit is also amenable to an "excuse" under Article 48(2)(a) PCT. Here the comparable remedy under the EPC is *restitutio in integrum*.

11. By letter dated 29 February 1984 (received 2 March 1984) the applicant applied for restitutio in integrum into the two-month time limit for further processing and paid the appropriate fees on 2 March 1984. The removal of the cause of non-compliance was the information from the EPO on 28 February 1984 that further processing had to be requested and that the time limit under Article 121(2) EPC had expired. The omitted act has also been completed, i.e. the request for further processing has been submitted and the fee for further processing has been paid. The request for restitutio in integrum was therefore filed in time (Article 122(2) EPC).

Taking into account the complex procedural situation (cf. Decision of the Legal Board of Appeal, J 6/79, OJ EPO 1980, 225) the grounds put forward by the representative and the facts on which he relies demonstrate that all due care required by the circumstances has been taken.

As the application for restitutio in integrum into the time limit under Article 121(2) EPC is allowed and the conditions for the application of this procedural safeguard are fulfilled, it follows that the application shall be further processed by the EPO pursuant to Article 24(2) in conjunction with Article 48(2)(a) PCT, Article 25 PCT and Article 121 EPC and the effect of the international application as a European application pursuant to Article 11(3) PCT has to be maintained.

12. The competence of the Examining Division for the decision to maintain the effect of the international application emerges from Article 153(2) in conjunction with Article 25 and Article 24(2) PCT. The Receiving Section is responsible for the further processing of the application, and it is to this Section that the application must be remitted (Article 16).

ORDER

The applicant's request of 24 November 1983 for review of the Decision of the Japanese Patent Office, acting as receiving Office, which considered the international application withdrawn and the request of 29 February 1984 for restitutio in integrum into the time limit for further processing are allowed. The effect of international application PCT/JP83/00250 as a European patent application (No. 83 902 449.4) for France shall be maintained pursuant to Article 24(2) PCT in conjunction with Article 25, Rule 51.1 and 51.3, Article 48(2)(a) PCT, Article 121 EPC and Article 122 EPC. The application shall be transmitted to the Receiving Section for further processing.