

### Abstract

The issue on appeal was whether the IPEA had misinterpreted certain elections made in a demand under the Chapter II procedure.

## **EPO boards of appeal decisions**

**Date of decision 24 March 1995**

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

- I. International application GB91/00925 was filed with the British Patent Office on 7 June 1991, claiming a priority of 8 June 1990.
- II. The Applicant filed a demand for international preliminary examination with the British Patent Office, acting as International Preliminary Examining Authority (IPEA), on 3 January 1992. The form for the demand (PCT/IPEA/401) contained the following indications in Box No. V "Election of States": Under the heading "Regional Patent" Spain and Greece were added to the preprinted list of States for a European Patent. The box for "EP European Patent" was not crossed. Under the heading "National patent" the United Kingdom and four States outside the Contracting States to the EPC were crossed.
- III. The IPEA cancelled in the form the election of Spain and Greece, which States were not bound by Chapter II of the EPC. It informed the Applicant accordingly with form PCT/IPEA/425, dated 22 January 1992.
- IV. By communication of 13 April 1992, the Receiving Section informed the Applicant that the fees for entering the regional phase had not been paid within the time limit laid down in Rule 104b (1) EPC, but that they could be validly paid within a period of grace, provided that a surcharge was paid, failure to do which would result in the application being deemed to be withdrawn. The Applicant replied, by letter of 22 April 1992, that the fees had not been paid as the application was still in the international phase, the demand fee having been paid. Not having been informed of its election, the EPO requested the International Bureau of WIPO (IB) to forward the notification of election and the international preliminary examination report. In reply, the IB informed the EPO that it had not been elected. By notification pursuant to Rule 69(1) EPC, dated 27. November 1992, the Applicant was informed that the application was deemed to be withdrawn because the fees for entering the regional phase had not been paid.

V. The fees for entering the regional phase were paid on 29. October 1992, and on 2 December 1992 the EPO received form 1200.

VI. By letter of 3 December 1992, the Applicant requested restoration of the application, submitting that there was a genuine but obvious error. On 12 December 1992, he paid oe 622 as a surcharge and on 31 December 1992 oe 67 as fee for re-establishment. In support of his request, he argued that there was an implied election of the EPO in the PCT demand. In the alternative, he submitted that the error was made even though due care had been taken.

VII. This request was rejected and the application was stated to be deemed to be withdrawn by decision of the Receiving Section, dated 4 October 1993, since re-establishment was excluded under Article 122(5) EPC, contrary to the previous case law, according to decision G 3/91 of the Enlarged Board of Appeal.

VIII. The Applicant filed an appeal by letter of 2 December 1993, received on 3 December 1993, paying the appeal fee at the same time.

IX. In his statement of grounds of 7 February 1994, received on 9 February 1994, in his reply to a communication of the Board and in the oral proceedings, held on 24 March 1995, he submitted that it was the proper interpretation of the demand form that it included an election of the European patent [sic]. The writing of Spain and Greece could only be interpreted as an indication that the EPO was intended to act as an elected Office for these States, since neither had been designated for a national patent. The decision of the Receiving Section was erroneous in accepting the attitude of the IB and the IPEA. He further argued that the notification of the communication pursuant to Rule 85a EPC addressed to the Applicant himself was without legal effect. It should have been addressed to the representative for the international application who was automatically the representative referred to in Rule 81(1) EPC. If this was not accepted, the EPO should correct the error in the demand according to Rule 88 EPC. As a last possibility, he asked to be re-established into the time limit for electing the EPO.

X. The Appellant requested that the decision under appeal be set aside and the request for re-establishment be allowed.

### **Reasons for the Decision**

1. The appeal, which is admissible, lies from the decision of the Receiving Section refusing a request for re-establishment of rights in respect of the time limits for the demand for international preliminary examination (Article 31 PCT) and for payment of the fees for the entry into the regional phase (Rule 104b (1)(b) EPC).

2. That decision only deals with the question whether the request was admissible. This question is, however, only relevant if a time limit has been missed. Therefore, the question raised by the applicant, whether his demand, on its proper interpretation, contained a valid election of a State for a European patent has to be dealt with first.

3. The IPEA deleted the handwritten indication of Spain and Greece and informed the Applicant accordingly. From this it has to be derived that the IPEA understood the demand as meaning that no Contracting State to the EPC should be elected for a regional patent.

4. The different interpretation, proposed by the applicant, raises the question whether or not the EPO has competence to interpret the declaration in another way. The demand is addressed to the IPEA, which is the competent body for dealing with it (cf. Articles 31(6), 34, Rules 60, 61, 66, 69, 71 PCT). It follows from this that the interpretation of the demand is at the outset the task of the IPEA.

5. This does, however, not necessarily exclude an office, alleged to be an elected Office, from interpreting the demand as well. The Board has already decided that the interpretation of the request for grant form by the receiving Office and the IB in respect of a designation is not binding on the EPO in its function as designated Office (J 26/87, OJ EPO 1989, 329). This is justified because the international application has, in respect of a Contracting State to the EPC validly designated for a European patent, the effect of a European patent application (Articles 11(4), 45(2) PCT, Article 150(3) EPC). The valid designation puts the matter within the competence of the EPO as a designated Office (Article 2(xiii) PCT, Art 153(1) EPC).

6. In a similar way, the competence of the EPO to act as an elected Office is created by the valid election of a Contracting State to the EPC for which a European patent is requested (Article 2(xiv) PCT, Article 156 EPC). As an elected Office, the EPO cannot interfere with the formal examination of the demand, which is a matter for the IPEA. Therefore, it cannot, ex post, object to deficiencies or clarify cases of doubt. If there is, however, a declaration which is an unambiguous election of a Contracting State to the EPC for a European patent, this cannot be ignored by the EPO.

7. In the present case, the handwritten indication of Spain and Greece made clear that the Applicant intended to use the results of the international examination with effect for those States. This is the only meaning an election can have under Article 31(4)(a), first sentence, PCT. Since those States were not

designated for obtaining a national patent, and since they were not added under the heading "National Patent" but next to the box "EP" at the end of the list of the Contracting States to the EPC, the only possible interpretation was that the results of the international preliminary examination should be used in the proceedings before the EPO. It is true that the box "EP" before the list of Contracting States to the EPC was not crossed or ticked, but this was an omission of something obviously intended, taking into consideration the express indication of Spain and Greece.

8. As a matter of interpretation, the addition of Spain and Greece would not otherwise make sense, and this for two reasons.

Firstly, neither State was bound by Chapter II of the PCT and could not be validly elected (Article 31(4)(b), first sentence, PCT). This is the reason for the course of action prescribed in Section 606 of the Administrative Instructions under the PCT.

Secondly, it was not necessary to elect more than one Contracting State to the EPC in order to have the results of the international preliminary examination used with effect for all designated Contracting States. There is only one single grant procedure for all designated States under Article 118 EPC and Chapter II applies to the procedure before the EPO as a whole if only one Contracting State bound by Chapter II has been elected (Information for PCT applicants concerning time limits and procedural steps before the EPO as an elected Office under the PCT, OJ EPO Supplement to OJ EPO 12/1992, A.2, insofar identical to the previous versions of the Information, see OJ EPO 1984, 631). Whereas it was not possible to elect Spain and Greece, it was possible to have the results of the international preliminary examination used in the proceedings before the EPO with respect to the patent to be granted for Spain and Greece.

9. Apparently the Applicant did not realize this situation. The IPEA had to consider his perspective when dealing with his demand and interpreting his declaration. The mere deletion of Spain and Greece, while being formally in accordance with Section 606 of the Administrative Instructions under the PCT, reversed the meaning of the Applicant's declaration.

The Applicant's intention to have the results of the international preliminary examination used in the proceedings before the EPO (see above paragraph 7) was quite clear as long as Spain and Greece were listed under "Election of States". By simply deleting these States, the box "EP European Patent" remained without entry and the form no longer showed a basis for an election in respect of a regional patent. This disregards the declaration which the Applicant had actually made. A clear deviation by the IPEA from the intention expressed in the

demand is not binding on the EPO. In contrast to the course of action taken by the IPEA, it is, therefore, possible for the EPO to regard itself as a validly elected Office.

10. It is true that the election can only be made in the way as prescribed in the demand (Rule 53.1(a) PCT). Any defect in respect of the use of the form was, however, a remediable deficiency. In the present case the Applicant had made clear what he wanted, even if this was not expressed in the proper way. If the IPEA was of the opinion that this formal deficiency could not be corrected ex officio, the Applicant should have been invited under Rule 60 PCT to correct the deficiency, eg. by adding the missing cross in the box "EP European Patent". The information sent out relating to the deletion made was not sufficient for clarifying the situation. It was sent to the Applicant after the end of the time limit of 19 months, prescribed in Article 39(1) PCT, and did not give him a possibility to correct the demand early enough for making Chapter II applicable to the proceedings before the EPO.

11. As a consequence of the conduct of proceedings by the IPEA, the EPO has not been informed of its election and not received the international preliminary examination report which normally is the reason why the proceedings before the elected Office may start later (Article 39 PCT). Since the demand contained a valid election for a European patent, the Applicant cannot be made responsible for this omission and the provisions of Article 22 PCT shall not apply to the proceedings before the EPO. This has the consequence that under Rule 104b(1) EPC the time limit of 31 months applies.

12. Since the time of 21 months is not applicable, it has not been missed. The request for re-establishment of rights in respect of this time limit is unnecessary.

## **ORDER**

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The time limit applicable for performing the acts under Rule 104b(1) EPC in the present application was thirty one months.