

### Abstract

Applicant filed a European patent application by facsimile, then sent the original by mail. The facsimile version arrived before the expiration of the priority period; the mailing only arrived after. The Receiving Section considered the date of receipt of the original by mail to be the filing date and therefore the priority claim was rejected. The Board reversed, finding that Article 75(1)(b) EPC allows regional applications to be given as their filing date the date the application is received by the office of a Contracting State.

## **EPO boards of appeal decisions**

**Date of decision 24 March 1986**

**Case number J 0020/84 - 3.1.1**

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

I. Appeal cases J 20/84 in respect of European patent application No. 84 710 004.7 and J 23/85 in respect of European patent application No. 84 710 027.8 are consolidated with the written consent of the appellants pursuant to Article 9(2) of the Rules of Procedure of the Boards of Appeal (OJ EPO 1983, 7).

II. Both European patent applications were filed by telecopier at the German Patent Office on 30 January 1984 and 20 August 1984 respectively, shortly before the priority year expired for both. The telecopies were forwarded by the German Office to the European Patent Office (EPO). The applicants also sent the originals from which the telecopies were prepared, together with accompanying letters, to the EPO. These were received by the latter only after the priority year had expired.

III. By decisions dated 24 July 1984 and 27 September 1985 the Receiving Section of the EPO did not recognise the date of receipt of the telecopied European patent applications at the German Patent Office as the date of filing within the meaning of Article 80 EPC, pointing out that the date of filing accorded to the European patent applications could only be the day on which the applications reached the EPO after being forwarded by the German Patent Office or sent by the applicant; in support of this it explained that Rules 24(1) and 36(5) EPC ruled out the possibility of European patent applications being filed by telecopier.

IV. The appellants appealed against these decisions on 10 September 1984 and 29 October 1985, at the same time paying the appeal fees and submitting

statements of grounds. Those statements concentrated in the first place on the fact that the word "post" in Rule 24(1) EPC also included the postal telecopier service. Rule 36(5) represents an exception to the provisions of its preceding paragraphs 2 to 4 from which no conclusions could be inferred affecting patent applications. The reasons advanced by the Receiving Section, particularly the inferior quality of documents transmitted by telecopier, were not relevant. Since telecopied documents complied with the requirement that documents be filed in written form and could not be called into question they could also not be refused a date of filing pursuant to Article 80 EPC.

V. The appellants requested that the contested decisions be set aside and that their respective patent applications be accorded the date on which the telecopies were received at the German Patent Office as their date of filing within the meaning of Article 80 EPC. They also requested reimbursement of the appeal fee.

### **Reasons for the Decision**

1. The appeals comply with Articles 106 to 108 and Rule 64 EPC and are therefore admissible.

2. The German Patent Office allows communications intended to ensure observance of a time limit and also patent applications to be filed by telegram, telex or telecopier (for further details see Schulte, Patentgesetz, 3rd edition, comment No. 85 preceding Section 35 and references; re telecopies, see Federal Court of Justice in Blatt für Patent-, Muster- und Zeichenwesen 1981, 416, specifically: 417). A precondition for using a telecopier, however, is that the German Patent Office makes telecopier facilities available to the general public for filing patent applications. As a result of trials since August 1980 the German Patent Office operates a round-the-clock telecopier service available to the public for filing documents and patent applications (Communication 7/85 of the President of the German Patent Office dated 26 April 1985, Blatt für Patent-, Muster- und Zeichenwesen 1985, 173). Consequently at the German Patent Office where a telecopier is used a date of filing can be accorded at any rate to national German patent applications.

3. The same applies in the case of international applications under the PCT filed at the German Patent Office as receiving Office. According to a decision of the Assembly of the PCT Union taken at its 12th session from 24 to 28 September 1984 (see PCT Gazette 1984, 3093) international applications, even if filed by telecopier, may be accorded a filing date pursuant to Article 11(1) PCT. The Assembly nevertheless made it clear that PCT receiving Offices were not obliged to provide applicants with telecopier facilities for filing patent

applications. In other words Article 11(1) PCT - i.e. a legal rule corresponding to Article 80 EPC - does not prevent an application filed by telecopier being accorded a date of filing. Rule 92.4 PCT - corresponding to Rule 36(5) EPC - was not mentioned by the PCT Assembly at all. It therefore draws no conclusion from this Rule that an application filed by telecopier cannot be accorded a date of filing. It follows therefore that a date of filing can also be accorded to international applications under the PCT filed by telecopier at the German Patent Office as receiving Office. The same applies to EuroPCT applications, i.e. international applications by means of which the applicant wishes to be granted a European patent under Article 153 EPC by the EPO as designated Office.

4. Under Article 75(1)(b) EPC a European patent application may be filed, if the law of a Contracting State so permits, at the national patent office of that State. The second sentence of that provision reads:

"An application filed in this way shall have the same effect as if it had been filed on the same date at the European Patent Office"; in other words the date of receipt at the national Office is the date of filing of the European patent application within the meaning of Article 80 EPC, provided that the conditions specified therein (and not disputed here) are met. It goes without saying that the date of filing assumes even greater importance for patent law purposes where it determines whether a period of priority has been observed.

5. Legally it appears wholly conceivable that the said fundamental legal effect ensuing when a date of filing is accorded is ruled out by the Convention or its Implementing Regulations where an application is filed by telecopier. But in the Convention itself only Article 80 might suggest that telecopying is ruled out. The same might also be inferred from Rule 24(1) or Rule 36(5) of the Implementing Regulations. However, a legal rule which excluded the said effect would have to be unambiguous both in its wording and as regards the recognisable intention of the legislator. This requirement is intrinsic in any exclusion clause. In view of Article 164(2) this applies in particular where a legal effect provided for in the Convention is ruled out by the Implementing Regulations.

6. Telecopying as such is not mentioned in the Convention or its Implementing Regulations, but Rule 36(5) contains provisions relating to telegrams and telexes and the Board of Appeal considers it permissible to relate by analogy all statements concerning these types of telecommunication to telecopier as well. This would also appear to be justified by Rule 92.4 PCT in which also "other like means of communication producing a printed or written document" are equated with "telegraph" and "teleprinter". In the present decision, therefore, reference is

made solely to telecopying, i.e. the form of telecommunication with which this case is concerned, but taken to mean all forms of telecommunication which - to quote the said PCT Rule - "produce a printed or written document".

7. Article 80 EPC could be said to preclude a date of filing being accorded because it requires patent applications to be filed in written form, as can be inferred from the words "eingereichte Unterlagen" - "documents filed" - "documents produits". It might be argued that all that is received over a telecopier are electric signals and that their automatic transmission to paper is an internal matter at the receiving end. In the German Patent Office, however, unlike the EPO, this form of transmission is a public service, because that Office's telecopiers are made available for public use and what the German Patent Office's telecopier reproduces on paper is regarded as what is actually received, so that here - leaving aside the question of signature - there can be no difference in nature between it and a communication deposited in an overnight letter-box. Risks inherent in any transmission by telecopier to paper must of course be borne by the applicant. The requirement inferred from Article 80 EPC that applications must be filed in written form is, however, complied with if the communication is reproduced on paper. This applies at any rate when the telecopier is put at the disposal of the public for the purpose of filing patent applications in this form as well. The conclusion to be drawn from the foregoing is that Article 80 EPC does not preclude the filing by telecopier of European patent applications.

8. Rule 24(1) EPC states that "European patent applications may be filed either directly or by post". Thus worded, the provision has no unequivocally exclusive character, as two matters remain unclear: in the first place, the question of whether documents sent by telecommunication are excluded both by the word "directly" and by the word "post". Furthermore, it is not clear whether the options to file "directly" or "by post" are exhaustive, as would be the case were the word "only" used, or whether they are examples of possible forms of filing. The historical documentation relating to the EPC reveals that the Chairman of the Patents Working Party considered a provision corresponding to Rule 24(1) totally unnecessary. However, the Working Party accepted a proposal put forward by one delegation to "add a provision whereby a European patent application may be filed both directly and by post. Such clarification would seem to be necessary given certain legislation in the Member States" (doc. 7669/IV/63 of 6 November 1963, p. 13). By "certain legislation" earlier national provisions were evidently meant which permitted only the recorded act of personal "deposit" or "filing". The intention behind the introduction of Rule 24(1) EPC was therefore to secure the possibility of documents being filed by "post", in the sense of letter and parcel post, at all offices. There is nothing,

however, in Rule 24(1) to suggest that other forms of filing not specified therein are not permitted.

9. Nor can it be inferred from Rule 36(5) EPC that a European patent application filed by telecopier at a national patent office is to be denied the effect referred to in Article 75(1) in conjunction with Article 80 EPC, i.e. cannot be accorded a date of filing. The wording of Rule 36 EPC in general, like that of its paragraph 5, cannot, however, unequivocally be regarded as an exclusion provision in the sense mentioned. As its individual paragraphs and title make plain, Rule 36 EPC as a whole relates only to "documents filed subsequently". According to paragraph 5, such documents may, "by way of exception to the provisions of paragraphs 2 to 4" also be sent by telegram or telex (paragraph 5, first sentence). In this case (paragraph 5, second sentence) a document confirming their contents must be filed within two weeks. It cannot thus be deduced from Rule 36(5) EPC that European patent applications may not be filed by telecopier. During the preparatory work relating to the EPC, however, there may have been an intention to exclude certain forms of filing (i.e. telegram and telex at the time). This much can be surmised from an earlier version of Rule 36(5) EPC, namely the provision entitled "Re. Art. 66, No. 11" in the "Second Preliminary Draft" of 1971, which explicitly ruled out the applicability of what is now Rule 36(5) to documents making up a European patent application. However, this earlier provision likewise can merely be taken to mean that a European patent application filed by telegram or telex need not be confirmed subsequently.

10. Hence, nothing in Article 80 EPC or the specified passages in the Implementing Regulations allows the conclusion to be drawn that an application filed by telecopier cannot be accorded a date of filing. Nor can any such indubitable, unanimous intention on the part of the Contracting States be inferred from the historical documentation relating to the Convention. Only from the time when the "Preliminary Draft of a Convention relating to a European Patent Law" of 1962/64 was being prepared are discussions recorded from which any intention to rule out certain forms of filing can be concluded (doc. 7669/IV/63 of 6 November 1963, p. 13). Nothing, however, in the working documents for the "Inter-Governmental Conference for the setting up of a European System for the Grant of Patents" indicates that this matter was discussed. The fact that during the working stage of this Inter-Governmental Conference the above-mentioned (under point 9) provision "Re. Art. 66, No. 11" in the 1962/64 Preliminary Draft was at first incorporated into the 1971 Preliminary Draft does not of itself represent an unequivocal declaration of intention either. No such intent can be assumed for the additional reason that the provision concerned was abandoned, i.e. ceased to appear in conjunction with Rule 36 EPC. It may be significant that the EPC Contracting States were

involved in the above-mentioned decision of the Assembly of the PCT Union (see point 3) in which it was not concluded from Rule 92.4 PCT (which is similar to Rule 36(5) EPC) that an application filed by telecopier cannot be accorded a date of filing.

11. The conclusion must therefore be that the present version of the EPC and its Implementing Regulations do not preclude a date of filing pursuant to Article 75(1)(b), second sentence, in conjunction with Article 80 EPC being accorded to a European patent application filed by telecopier at a national patent office, provided that office makes corresponding technical facilities available to the public which may also be used for filing patent applications.

12. Since there has been no substantial procedural violation as required by Rule 67 EPC, the appeal fees cannot be reimbursed. Although the first instance interpreted the Convention and Implementing Regulations thereto differently to the Board of Appeal, it is guilty of no procedural violation.

## **ORDER**

For these reasons, it is decided that:

1. Appeals J 20/84 and J 23/85 are consolidated.
2. The decisions of the Receiving Section of the European Patent Office of 24 July 1984 concerning European patent application No. 84 710 004.7 and of 27 September 1985 concerning European patent application No. 84 710 027.8 are set aside.
3. The date of filing within the meaning of Article 80 EPC accorded to the said European patent applications shall be that on which they were received by telecopier at the German Patent Office.
4. The requests for reimbursement of the appeal fees are refused.

**O.J. EPO issue: 1987,095**