

Abstract

Applicant filed an international application, made a demand for international preliminary examination by facsimile, and sent the original by mail. The original was lost in transit, and the EPO, acting as the appointed IPEA but neither a designated or elected Office, informed the applicant that the demand would not be accepted. The applicant appealed, but the Board determined that there was no jurisdiction to hear the appeal.

EPO boards of appeal decisions

Date of decision 27 November 1989

Case number J 0020/89 - 3.1.1

Summary of Facts and Submissions

- I. On 19 May 1988, the Appellant corporation filed an international application under the PCT, claiming the priority of a US patent application filed on 21 May 1987 and designating only Australia and Japan. The EPO was neither receiving Office nor designated Office nor elected Office, but, in accordance with the terms of an agreement with the USPTO, acted as International Searching Authority (ISA).
- II. The international search report was mailed to the Appellant on 11 August 1988.
- III. On 16 December 1988 the Appellant's European professional Representative forwarded by facsimile to the EPO a demand for international preliminary examination according to Chapter II of the PCT, signed on behalf of the Appellant and a covering letter including instructions to pay the necessary fees.
- IV. On 20 December 1988 the authorised Representative signed the original of the covering letter and sent it together with the original of the Demand on EPO Form 1037. Registered post was not used. These originals, confirming the facsimile, have not been traced and appear to have been lost in the mail.
- V. The 19 months period of Article 39(1) PCT expired on 21 December 1988.
- VI. 23 January 1989 was the last day on which action could be taken under the 20 months period of PCT Chapter I in Japan.

VII. By letter received on 6 March 1989 the Representative applied for: (a) further processing under Article 121 EPC; (b) re-establishment of rights under Article 122 EPC; (c) application of Article 48(2)(a) and (b) PCT.

VIII. By a document headed "Notification" dated 31 March 1989, the EPO acting as International Preliminary Examining Authority (IPEA), confirmed that: (a) the demand for international preliminary examination of 16 December 1988 was considered not to have been made pursuant to Rule 92.4 PCT; (b) Article 39(1) PCT was not applicable because no Contracting State had been elected before expiry of 19 months from the priority date. All requests for remedies were refused as Rule 82.1(a) PCT was not applicable and the EPO had no other competence or authority to allow the time limit, which had been missed, to be deemed to have been observed.

IX. On 8 April 1989 the Representative filed a "Notice of Appeal" against the "Notification" of 31 March 1989 and applied for: (a) admission of the appeal; (b) admission of the demand for preliminary examination as of the date 16 December 1988; (c) consequently, admission of election of Japan and Australia.

X. An appeal fee was paid on 8 April 1989.

XI. In "Grounds of Appeal" set out in his "Notice of Appeal", the authorised Representative, (a) concerning the admissibility of the Appeal, submitted that:

- the "Notification" was effectively a decision which adversely affected the Appellant; and had been taken by the Receiving Section (sic) on behalf of the EPO as an International Preliminary Authority;

- the Appeal was also admissible on general equitable grounds because without such a legal remedy there would be no possibility of any reconsideration of even a blatantly erroneous formalities decision by the EPO acting as ISA or IPEA;

(b) and, concerning the substance, developed arguments previously submitted in a letter of 28 February 1989, received on 6 March 1989, and asked again for further processing (Article 121 EPC) and re-establishment of rights (Article 122 EPC). He requested Oral Proceedings if the Board was not inclined to allow the appeal. Such proceedings were appointed.

XII. Before the Oral Proceedings, the Applicant was invited to express his view on the question whether the Boards of Appeal of the European Patent Office have jurisdiction in the international phase of a PCT application over a decision taken by the European Patent Office as IPEA in such a case.

XIII. By letter dated 15 June 1989 the Representative submitted that, as there is no Appeal provided for in the PCT, the provisions of the EPC (Article 106, Article 150(2), Article 150(3), Article 125) should be interpreted as giving jurisdiction to the Boards of Appeal.

XIV. In the Oral Proceedings the Representative maintained his previous arguments and requests for relief. He contended that nothing in the PCT or the EPC prevented the Board from having jurisdiction and that there was no other possibility of a review of the decision of the IPEA.

Reasons for the Decision

1. Before it may consider the present case on its merits, the Legal Board of Appeal is required to decide whether, during the international phase of a PCT application, it has jurisdiction to examine decisions taken by the European Patent Office acting in its capacity as an International Preliminary Examining Authority (IPEA) within the meaning of Chapter II of the Patent Cooperation Treaty (cf. Articles 150, 155 EPC).

2. It has to be borne in mind that, save as is provided in Rules 40.2(c) and 68.3(c) PCT, there is nothing in that Treaty, or in the Regulations under it, providing for appeal during the international phase in proceedings before the authority acting as International Searching Authority (ISA) or as IPEA: This has been pointed out in the literature (cf. Kurt Haertel in "Zehn Jahre Bundespatentgericht", Heymanns, 1971, page 60, cited in Ulrich C. Hallmann "PCT Vertrag über die internationale Zusammenarbeit auf dem Gebiet des Patentwesens", 2nd ed., Heymanns, 1981), the accent being as much on the deliberate omission of procedure for appeals as on the non-existence of bodies capable of receiving them. Furthermore, in a letter dated 30 June 1989, relating to the matters the subject of the present proceedings, the International Bureau of WIPO, consulted on behalf of the Appellant, has, under the authority of M. Bartels (Head of the PCT Legal Section) confirmed that the PCT does not contain any provisions for appeal or petition during the international phase, in order to avoid complicating the procedure and in view of the short time limits provided for under the PCT. He pointed out that Applicants are not, however, entirely deprived of legal safeguards during the international phase and that all PCT Authorities will accept and duly consider any request for reconsideration of an earlier decision taken during the international phase, although this is not expressly provided for in the PCT. An elected Office could review a decision of an IPEA.

3. Since there is no appeal provided for under the PCT in the present case, it is necessary to consider whether, as the Appellant wishes and submits, recourse

may be made during the international phase to the provisions of the EPC relating to appeal.

4. In a case in which the EPO acts as ISA it may, in fact, also act as designated Office and in a case in which it acts as IPEA it may, in fact, also act as elected Office. When it is acting as a designated or elected Office, it has the same powers as any Office of a PCT Contracting State (cf. Articles 2(x) and 2(xii), PCT). Furthermore, Article 150(3) EPC provides that an international application for which the EPO acts as designated Office or elected Office shall be deemed to be a European patent application. Consequently, there is no obstacle to making use of appeal procedures provided for under the EPC to supplement the provisions of the PCT (cf. Article 150(2) EPC) in such cases. However, if, as in the present case, the EPO is neither receiving Office nor designated Office nor elected Office, but acts as ISA or IPEA during the international phase solely in accordance with an agreement with a national Office, it is necessary to decide whether it is acting simply by delegation on behalf of the national Office and, accordingly, is bound to a strict observation of the provisions of the PCT. Articles 17(1) and 34(1) PCT provide in effect that, in the international phase, the procedure is determined by the PCT, the Regulations made under it and the agreement made with the ISA or IPEA concerned. The Agreement between WIPO and the EPO (OJ EPO 1987, 515 et seq.) imposes obligations on the EPO to observe the administrative instructions and directives concerning the International Search and International Preliminary Examination. It follows that, in these circumstances, the provisions of the PCT Regulations, instructions and directives must take precedence over any EPC provisions. Consequently, the application of Article 150(2) EPC must be limited, so far as concerns appeal procedure, to supplementing the express provisions of PCT Rules 40.2(c) and 68.3(c), which relate only to the examination of protests against the charging of additional fees undertaken by boards or other special instances of ISAs or IPEAs.

5. Faced with the absence of a procedure for appeal during the international phase before the IPEA, organised under the PCT, the Appellant has argued that if he cannot make use of appeal procedures provided under the EPC an Applicant is deprived of legal safeguards against erroneous decisions made by the EPO acting as IPEA. The Legal Board of Appeal is unable to accept this argument. As M. Bartels of WIPO pointed out in the correspondence with the Applicant's representative referred to above, there can be - and in practice is - review of decisions taken in the international phase by designated or elected Offices during the subsequent national phase. It should also be borne in mind that when a demand for international preliminary examination is considered not to have been made, the Applicant still has the possibility of entering the national phase in accordance with PCT Chapter I, even if he loses the opportunity to

make use of the optional procedure of PCT Chapter II. Article 39(3) PCT empowers any elected Office to prevent a loss of rights resulting from Article 39(1)(a) or (b) PCT. Furthermore, Article 48(2) PCT requires every PCT Contracting State to excuse, so far as that State is concerned, for reasons admitted under its national law, any delay in meeting any time limit and allows such a State, so far as it is concerned, to excuse such delays for other reasons. Finally, as M. Bartels has pointed out, there is nothing to prevent a PCT Contracting State from considering that the provisions of Article 48(1) PCT and Rule 82 PCT have been satisfied, in the case of loss of documents in the mail, even though the IPEA concerned was of a different opinion.

ORDER

For these reasons it is decided that:

The Board has no jurisdiction to examine the present appeal.

O.J. EPO issue: 1991,375

Case law reports: CLBA 1996