

### Abstract

Applicant filed an international application requesting a European patent for all countries for which it was possible to seek one at the time and a national patent in Denmark. In the period between the filing and the deadline for entering the national phase the EPC came into force in Denmark. Applicant then entered the regional phase and included a designation and fee for Denmark. The Receiving Section refused the additional designation for Denmark as the EPC was not in effect there at the time of filing. The refusal was upheld by the Board.

## **EPO boards of appeal decisions**

**Date of decision 03 June 1991**

**Case number J 0030/90 - 3.1.1**

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

- I. The appellant filed a patent application on 29 July 1988 in accordance with international PCT procedure and claimed priority of 30 July 1987. The application was, on the one hand, for a European patent for all the countries in respect of which the European Patent Convention was in force on the date of filing, and on the other, for a national patent in Denmark.
- II. The European Patent Convention came into force in Denmark on 1 January 1990.
- III. On 26 January 1990, the appellant's international application entered the regional phase pursuant to Article 39 PCT and Rule 104b(1) EPC and the appellant paid the various designation fees, including one for Denmark.
- IV. By a decision dated 26 June 1990, the EPO Receiving Section held that the EPO could not be a designated Office for Denmark, as under Article 153(1) EPC in combination with Article 4(1)(ii) PCT Denmark could only be designated with a view to a European patent with effect from 1 January 1990, regardless of the grant procedure selected. Consequently, the designation of Denmark for a European patent was declared invalid.
- V. The appellant lodged an appeal on 6 August 1990, paid the relevant fee on the same date, requested that the contested decision be set aside and accordingly, in his final submission as recorded in the minutes of the hearing on 20 March 1990, requested that the case be remitted to the department of first instance with an order that Denmark be included with the other designated states. The

appellant based his claims on the following grounds as presented in his written submissions and at oral proceedings:

(1) the application is in conformity with the spirit of the PCT - in particular with its preamble and Articles 3 and 4(1) - and with the common objectives of the PCT and the EPC;

(2) the application is in conformity with case law of the Legal Board of Appeal by which it allowed an international application to be converted into a regional application and international applications and European applications to be consolidated;

(3) the request was supported by the fact that the EPO had violated the principle of good faith which should govern relations between the applicant and the Office.

VI. In view of the general interest of the case, its novelty and its apparent complexity, the Board invited the President of the European Patent Office to comment (Article 12a of the Rules of Procedure and decision J 14/90 dated 21 March 1991). He did so in a written submission and his comments were further elucidated at oral proceedings.

VII. In a communication dated 19 February 1991, the Board issued its initial findings and reflections with all due reservations.

VIII. The appellant agreed to the decision being issued in French (cf. decision J 18/90, OJ EPO 1992, 511, Reasons, point 1).

### **Reasons for the Decision**

1. Having considered in particular points IV and V above and Articles 106 and 108 EPC, the Board held that the appeal was admissible.

2. As to the substance, the Board considers the problem to be as follows: can the EPO be a "designated" Office in respect of a country for which, on the date on which a PCT application was filed, the EPC was not yet in force, and where the entry into force took place only prior to the start of the regional phase of the international application, or, in other words, on a subsidiary level, in the case of an international application seeking a national patent for such a country, can the applicant convert his application, after filing, into an application for a regional European patent?

2.1 The relevant provisions are Article 4(1)(ii) PCT and Article 153(1) EPC.

2.1.1 Article 4(1)(ii) PCT provides that a regional patent may be obtained for any designated state provided the following conditions are met:

- (a) firstly, the applicant must be able to obtain one;
- (b) secondly, the applicant must demonstrate his wish to obtain one;
- (c) and thirdly, the first two conditions above must be met on the date of filing of the request, as Article 4(1)(ii) requires that this wish be expressed in the request itself.

These provisions are reasonable and unambiguous and in the present case leave no room for interpretation.

Applying these provisions, it is clear that on the date of filing of the request, 29 July 1988, the first condition was not met. The applicant was not able on that date to obtain a regional European patent designating Denmark because the European Patent Convention did not enter into force for Denmark until 1 January 1990.

2.1.2 Article 153(1) EPC unequivocally confirms the provision considered and applied above.

According to this article, the conditions which have to be met for the EPO to be a designated Office are as follows:

- (a) The state concerned must be designated in the application and the application must be for a European patent.
- (b) The state must be a Contracting State to the European Patent Convention for which the PCT has entered into force.

Once again, it is clear that the EPO can only be a designated Office in respect of a state which, on the filing date of an international application seeking a European patent, is a party to both the PCT and the EPC. Application of this to the present case confirms that, on 29 July 1988, Denmark was not designated with a view to obtaining a European patent and was not a party to the EPC.

2.2 Unless the above-defined conditions are met, in the opinion of the Board it is not possible to obtain a regional European patent by the PCT route for such a designated State.

In support of this finding, the Board refers to the Washington Diplomatic Conference, during which it was proposed to allow the applicant to express his wish to obtain a regional patent for a country designated in the request subsequent to filing and within a prescribed time limit.

Not only was this proposal rejected, but in any event, although it would have permitted a regional patent to be selected after the filing date, it would also have required the country concerned to belong to both the PCT and the regional organisation on the international filing date (cf. Records of the Washington Diplomatic Conference on the Patent Cooperation Treaty 1970, March 1970/DRAFT, p. 262).

3. The idea of converting a national patent into a European patent as invoked and defined by the appellant has no basis in any text or prior case law which could give it any substance. Endorsement of this idea would give rise to unacceptable consequences and thus confirm the validity of the above exegesis.

3.1 The filing date determines the law applicable to the application and the patent (in particular as regards the provisions relating to novelty and inventive step). It also determines, in accordance with Article 60 EPC, to whom the right to the patent belongs.

3.2 If, in the present case, it were to be accepted that the conversion effected on entry into the regional phase of an international application seeking a national patent is applicable retroactively to the filing date, this would imply the intrusion as of 29 July 1988, the filing date, of European patent law into Denmark, which did not recognise European patent law until 1 January 1990. Such an intrusion would be inadmissible, if not impossible, whatever the degree of harmonisation of the respective laws, or even irrespective thereof.

3.3 If, on the other hand, it were to be accepted that there is no retroactive effect and that, as far as Denmark is concerned, the European patent obtained by conversion should be given the date of entry into the regional phase as the filing date, in this case 26 January 1990, again that filing, which would basically be limited territorially to Denmark, would be anticipated by the PCT publication relating to the other designated states.

3.4 The concept of conversion examined above must not be confused with the conversion referred to in Article 135 et seq. EPC.

The conversion provided for in these articles is effected in the context of two bodies of law in force, the national law concerned and European law, and implies that, on the date of filing, the two laws coexist in the country concerned, which, as mentioned above, is obviously not the case.

3.5 Nor must this concept be confused with that of the consolidation of applications as explained in Legal Advice No. 10/81 (OJ EPO 1981, 349).

This case involved two applications, one PCT, the other European, which were filed on the same date but for different countries, not all of which were parties to both the PCT and the EPC on the date of filing.

3.6 Finally, there is no connection with the concept of transformation as used - in passing, as the Board acknowledges - in decision J 6/79 (OJ EPO 1980, 225) simply to define the passage of the application from the international to the European phase.

4. The Board notes that the present case is the first to come before it concerning the designation of a state arising out of the fact that the state became party to the European Patent Convention after it became party to the PCT.

The fact is that, in the past, before the EPC came into force for Denmark, the European Patent Office carried out search and examination functions for Denmark under the PCT.

As the appellant judiciously points out, the PCT and the EPC share numerous functions and a common spirit.

However, the Board considers that these considerations are not capable of altering its understanding of the terms of the two treaties.

5. Finally, EPO case law allows the principle of good faith to be applied in certain circumstances.

However, it does not seem that the appellant can be allowed the benefit of this principle in the present case, although he may well have believed that his position was well founded in some respects. The Board is forced to conclude that the appellant has failed to substantiate his allegation that the European Patent Office has been in breach of its obligation to act in good faith and, consequently, the Board has to reject the appeal on this count also, on the grounds that it is without merit.

## **ORDER**

For these reasons it is decided that:

The appeal is rejected. O.J. EPO issue: 1992,516

Case law reports: CLBA 1996