

# **Decision of the Enlarged Board of Appeal dated 16 February 2010**

G 0004/08

(Translation)

## **Composition of the board:**

**Chairman:** P. Messerli

**Members:** M-B. Tardo-Dino  
P. Alting van Geusau  
U. Kinkeldey  
S. Perryman  
B. Schachenmann  
J.-P. Seitz

**Appellant:** MERIAL

**Headword:** Language of the proceedings/MERIAL

## **Relevant legal provisions (EPC):**

**Article:** 14(1), (3), 153 EPC

**Rule:** 3, 4, 157(2), 159 EPC

## **Relevant legal provisions (EPC 1973):**

**Article:** 14(1), (3), 150(3), 153, 158 EPC

**Rule:** 1, 2, 107(1)(a) EPC

## **Relevant legal provisions (PCT)**

**Article:** 3(4), 22, 23 PCT

**Rule:** 12.1, 49.1, 49.2 PCT

## **Keyword:**

"Language of the proceedings"

**Catchword:**

*The Enlarged Board of Appeal, in response to the three points of law referred to it, concludes that:*

Question 1: *If an international patent application has been filed and published under the PCT in an official language of the EPO, it is not possible, on entry into the European phase, to file a translation of the application into another EPO official language.*

Question 2: *In written proceedings on a European patent application or an international application in the regional phase, EPO departments cannot use an EPO official language other than the language of proceedings used for the application under Article 14(3) EPC.*

Question 3: *This question is redundant.*

**Summary of facts and submissions**

I. By decision J 8/07 dated 8 December 2008, the Legal Board of Appeal (board 3.1.01) referred to the Enlarged Board of Appeal the following points of law:

(1) If an international patent application has been filed and published under the Patent Cooperation Treaty (PCT) in an official language of the European Patent Office (EPO), can the applicant, on entry into the regional phase before the EPO, file a translation of the application into another EPO official language which then becomes the language of all subsequent proceedings before the EPO?

(2) If the answer to that question is no, can EPO departments use, in written proceedings on a European patent application (or an international application in the regional phase), an EPO official language other than the language of proceedings used for the application?

(3) If the answer to question 2 is yes, what criteria must be applied to determine the official language to be used? In particular, must EPO departments agree to any such request from a party or parties?

## II. Circumstances of the case

The circumstances leading to the present referral are that the appellant filed in French an international patent application, published in French, for which the EPO was designated Office and International Searching Authority. On entry into the regional phase before the EPO, the appellant attached an English translation of the international application and requested that the language of the future proceedings should be English or, failing that, that English should be used in all written proceedings and decisions.

The first-instance department refused that request, under Articles 14(3) and 158 EPC 1973, on the grounds that the application had been filed, and published by the International Bureau, in French, and that French was therefore the language of the proceedings for the European phase.

The Legal Board of Appeal acknowledged firstly that a literal interpretation of Article 158(2) EPC, albeit one never hitherto followed, could support the appellant's main request, and that such an interpretation was not out of the question. Secondly, the board's intended refusal of the auxiliary request would be at odds with earlier decisions allowing the language of filing to be replaced by another official language in all correspondence with the EPO.

III. By a decision dated 14 January 2009, under Articles 9 and 10 of its rules of procedure, the Enlarged Board invited the EPO President to comment in writing on the points of law referred to it in decision J 8/07, and announced provisions concerning statements from third parties.

IV. The Enlarged Board held oral proceedings in English (Rule 4(1) and (2) EPC) on 16 November 2009. The appellant's final requests were as follows:

- (a) "that question 1 should be answered in the affirmative"
- (b) "that question 2 is answered irrespective of the answer to question 1 and that it is answered in the affirmative"
- (c) "that, in case question 2 is answered in the affirmative, the EPO should comply with the request of one of the parties, subject to the consent of any other parties".

V. The appellant's arguments may be summarised as follows.

*Question 1*

- Nothing in the EPC required the EPO official language in which the international application was drawn up to be maintained throughout subsequent proceedings before the Office.
  
- "Language of the proceedings" was a concept unique to the EPC. In the absence of corresponding PCT provisions, the EPC's rules applied only after entry into the European phase, whereas the appellant's focus was on the point of entry.
  
- The EPO President's arguments were based on Article 14(3) EPC 1973, but for international applications filed under Article 3(4) PCT and its implementing Rule 12.1 PCT the language regime of Article 14(1) and (3) EPC did not apply to those drawn up in non-EPO official languages, such as Japanese. The translation referred to in paragraph 3 of Article 14 EPC 1973 was that prescribed by the article's previous paragraph, which excluded international applications not drawn up in an official language of an EPC member state. In that case the language of the proceedings was laid down on entry into the European phase in accordance with Article 158(2) EPC 1973. But the latter provision should apply to international applications generally. Otherwise, legal uncertainty would result, with Article 14(3) EPC applicable in some cases but not in others (such as Japanese applications). Nor did Article 158 EPC 1973 refer to Article 14(3) EPC 1973, or vice versa.
  
- Rule 49.2 PCT delimited the contracting states' translation requirements and gave applicants required to supply a translation a choice between the official languages possible. Taking that rule as a guide, contracting states could not require another translation when it was not necessary, but that did not mean they could not accept

one if supplied by the applicant. The rule was proof that the general principle of equivalence between Euro-PCT and European filings – which led to the unequal treatment mentioned – could not on its own justify the application of Article 14(3) EPC to Euro-PCT applications.

- That principle in fact covered a whole chain of equivalence, with Article 150 EPC 1973 placing Euro-PCT and European applications on the same footing, and Article 66 EPC doing likewise for European and national ones. Equivalence of Euro-PCT, European and national filings was intended to create certain benefits, such as priority rights or the recognition of an international application's effects under the Paris Convention (Article 11(4) PCT). But there were also differences between Euro-PCT and European applications; drawing only on such provisions as suggested that Euro-PCT filings had to comply with the EPC language regime would make no sense.

- In any case, supplying a translation into an EPO official language other than that in which the Euro-PCT application had been filed was not a question of changing the language of the proceedings, but rather of exercising a choice open under the texts to any applicant on entry into the European phase, whatever the original language might have been.

- There was a general trend which supported the appellant's view that nothing in the EPC was at odds with its requests. More specifically, decision G 1/05, especially its points 10.2, 12.2 and 13.1, 13.3 and 13.5, illustrated the principle underlying this appeal, namely that whatever was not expressly forbidden was implicitly allowed. That was how the Enlarged Board was to be understood when it said in substance that, in the absence of provisions to the effect that the parent application's subsequent fate had repercussions for proceedings on a divisional one, it had no legal basis for prescribing further restrictions. Any stricter conditions needed were a matter for the legislator.

- The referral was right to say that question 1 was to be examined in the light of EPC 1973. However, it did not refer to any particular timeframe, so the appellant had asked the Enlarged Board to rule also on the position under EPC 2000.

- As regards the language regime under EPC 2000, Article 14 EPC now had a new wording and Rule 157(2) EPC was at odds with the PCT. In its written submissions the appellant confined itself to the conflict between its position and new Article 153(2) EPC.

- Lastly, during oral proceedings it filed Legal Advice No. 10/92 rev. (OJ 1992, 662) on "Consolidation of a European patent application with a Euro-PCT application", which according to its introduction was aimed at pending and future applications designating EPO member states for which the PCT had not yet entered into force. The appellant said it had submitted it not as a legal basis for its request but as additional evidence – especially its point V and the example of the Swedish application – that Article 14 EPC was not compatible with the PCT and that English could be replaced by another language.

- In its written pleadings the appellant also argued that the restrictive interpretation followed by the contested decision was discriminatory, wrong in law, and detrimental to the interests of international firms using English as their working language.

### *Question 2*

As regards question 2, to be answered independently of question 1, the appellant argued that the practice which had developed since the Administrative Council of the European Patent Organisation decided on 7 December 1990 to rescind Rule 3 EPC, and which was based in particular on decision J 18/90, could not simply be ignored. It was not seeking to restore that rule, but merely to simplify proceedings for the parties. True, the Office was not a party, but there was nothing to stop it using another official language in its correspondence with parties and in its decisions. For legal certainty it would suffice if the patent were granted in the language of the proceedings, that being the language in which the application was filed or in which the translation of the international application was supplied on filing, and which applied only to the text of the application, any amendments and the patent.

### *Question 3*

This question had to be answered in line with the general principle of Community law that any citizen had the right to a reply in the language used in his request. In the oral

proceedings the appellant said that was not tantamount to changing the language of the proceedings; parties had a right to ask for decisions in their language. If all parties agreed, the EPO had to accede to such a request.

## VI. Observations by the EPO President

### *Question 1*

The President submitted that for international applications entering the European phase the existing legal framework did not permit the filing of a translation into an official language other than that of the published application. Otherwise the language of the proceedings could be changed for Euro-PCT filings only, whereas this possibility had been abolished for all EPO proceedings in 1991. Allowing it for Euro-PCT applicants on entry into the European phase would mean treating direct and Euro-PCT applicants differently. Parity could be restored only by changing the law and restoring Rule 3 EPC. But then the problems solved by rescinding it would resume.

International and European applications were in the same situation: under Article 14(3) EPC, a translation was required only if the original application was not drawn up in an EPO official language. That practice had been followed consistently, and translations supplied when the original application was in an EPO official language were ignored (see e.g. the EPO's Guide for Applicants, Part 2, 4th edition, point 330).

When the Legal Advice text was submitted during oral proceedings, the President's representative said there had not yet been time to update all the texts following revision of the EPC. True, that was not a legal argument, but it did suggest that circumspection was appropriate, given that the advice in question was intended to help Euro-PCT applicants performing procedural acts for countries which were not contracting states to both EPC and PCT.

### *Question 2*

In support of her position, the President set the language regime used for proceedings before the EPO in its historical context since 1973.

The language regime laid down in Article 14 EPC had remained unchanged since its inception.

*Before 1991*, Rule 3(1) EPC had softened the primacy enjoyed by the language of the proceedings in all EPO proceedings for both the Office and the applicant or patentee, not only – as now – for any amendments to the application, but also for correspondence between applicant and Office.

Rule 3(1) EPC allowed the language to be changed, but only for correspondence between the applicant and the Office. Amendments to the application or the patent had to be made in the original language. Changing the language of the proceedings did not mean that the application had to be published in the new one – an issue which remained topical because if the first two questions were answered in the affirmative the issue of the translation's validity would arise.

The original language remained the reference language throughout the proceedings: the patent specification was published in it; it was used for the authentic text of the application or patent in all proceedings at the EPO and in the contracting states; divisional applications had to be filed in it, and references to it had been inserted into various provisions (e.g. on the European search report) which had omitted it.

The reason the Council, on 7 December 1990, had *rescinded Rule 3(1) EPC* and amended Rule 1 EPC had been to rationalise the grant procedure and simplify and liberalise the language arrangements to meet the needs and interests of users of the European patent system. For example, if the professional representative changed, Rule 1 EPC as amended enabled the new one to use the official language with which he was most familiar; for applicants and patentees, only amendments to the application or patent were excluded. This system had been maintained in EPC 2000.

In view of the above, the President did not comment on question 3.

VII. *Amicus curiae* briefs



Two such briefs were received.

The *epi* (Institute of professional representatives before the European Patent Office) reached the same conclusions as the appellant, based on the same arguments but its own interpretation of the texts.

The *Association Romande de Propriété Intellectuelle* concluded from Article 153(2) EPC – stipulating that an international application for which the EPO was a designated or elected Office, and which had been accorded an international date of filing, was equivalent to a European application – that Article 14(3) EPC applied also to Euro-PCT filings. Allowing the language of the proceedings to be changed for such filings would introduce a principle not envisaged in the EPC, applicable only to Euro-PCT applications, and oblige the EPO to make a second publication.

### **Reasons for the decision**

1. As regards admissibility, the referred questions about choosing and determining the languages to be used in EPO proceedings raise a point of law of fundamental importance addressed by the Legal Board and not uniformly answered in the boards' case law. The referral is therefore admissible under Article 112(1)(a) EPC.

#### *Question 1:*

The Enlarged Board considers justified the request that it rule on the language of Euro-PCT applications on entry into the European phase – the subject of question 1 – not only for the past under EPC 1973 but also for the future under EPC 2000. It has therefore examined it from both angles.

#### 2. Under EPC 1973

2.1 The basis for answering question 1 is Article 14(3) EPC 1973, albeit in conjunction with Article 158(2) EPC 1973.

(a) Article 14(3) EPC 1973 provides that "[t]he official language of the European Patent Office in which the European patent application is filed or, in the case referred to in paragraph 2, that of the translation, shall be used as the language of the proceedings in all proceedings before the European Patent Office concerning the application or the resulting patent, unless otherwise provided in the Implementing Regulations".

(b) Article 158(2), first sentence, EPC 1973 provides that "[t]he international application shall be supplied to the European Patent Office in one of its official languages".

2.2 Article 14(3) EPC 1973 assumes a language of filing that has already been defined and will be the language of the subsequent proceedings, whereas the appellant, positioning itself earlier in time, argues that Article 158(2) EPC 1973 makes no distinction according to the international application's language of drafting or publication; therefore, a translation supplied in an official language, or in a different official language, meets the requirements of this article and becomes the language of the proceedings.

The appellant infers this general principle from paragraph 2 of Article 158 EPC 1973 by reading it in isolation from the other paragraphs.

2.3 According to that interpretation, when an international application enters the European phase its applicant is in the same position as a direct European applicant, who has a free choice of official language; the earlier international phase is ignored.

But this interpretation distorts the actual provisions, precisely because it depends on ignoring the remainder of the article, its correlation with other provisions, and the factual context – as the analysis below will show.

2.4 It is simply not compatible with the principle of equivalence between European applications and international ones for which the EPO acts as designated or elected Office, expressly laid down in Article 150(3) EPC 1973 and implemented in particular by Article 158 EPC 1973.

Under Article 150(3) EPC 1973, an international application for which the EPO acts as designated or elected Office is deemed to be a European application. Allowing a change of language when a Euro-PCT application published in an EPO official language enters the regional phase would mean supposedly identical applications being treated differently depending on whether they are international or direct European filings. Language is not a mere procedural matter, after all; it goes to the heart of the patent's substance. Translations are – legitimately – suspect; that justifies precautions, exemplified by the way in which the original application remains the point of reference in case of translation (Article 14(2) EPC) and by Rule 46.3 PCT governing the language of amendments.

Article 158 EPC 1973 comprises three inter-related paragraphs. Paragraph 1 lays down a principle, paragraphs 2 and 3 specify its scope and the limits of its implementation. That principle is that publication of the international application **replaces** [Enlarged Board's emphasis] the publication of a European patent application, subject to the article's paragraph 3 and to restrictions regarding the prior art under Article 54(3) EPC if the conditions laid down in paragraph 2 are not fulfilled. The wording used in paragraph 1 ("**shall take the place of**", "**remplace**" or "**tritt an die Stelle**") is unequivocal: the applications concerned are identical.

In itself, paragraph 2 of Article 158 EPC 1973 sets just two general and essential conditions for an international application to be regarded as a European one, namely paying a fee and supplying the application in an EPO official language (see point 2.1(b) above). In an international context, that requirement had to be made clear, because an international application's language of filing and publication is not necessarily an EPO official language. That special requirement for international applications corresponds to Article 14(1) EPC 1973 for European applications. Sandwiched as it is between paragraph 1, which implicitly provides that international and European applications are identical, and paragraph 3, which prescribes publication if the international application was not published in an EPO official language, its scope is precise and limited to applications not published in such a language, as Rule 107(1) EPC 1973 clearly confirms.

2.5 Rule 107 EPC 1973 is an implementing provision for Article 158(2) and (3) EPC 1973. It lists the formalities to be completed for entry into the European phase before the EPO as designated or elected Office. In its sub-paragraph (a), Rule 107(1) EPC 1973 requires the applicant to "supply, *where applicable*, the translation of the international application required under Article 158, paragraph 2" ("remettre, *le cas échéant*, la traduction de la demande internationale, requise en vertu de l'article 158, paragraphe 2"; "die *gegebenenfalls* nach Artikel 158 Absatz 2 erforderliche Übersetzung der internationalen Anmeldung einzureichen") [Enlarged Board's emphasis].

The correlation between paragraphs 2 and 3 of Article 158 EPC 1973 themselves, and between them and Rule 107(1)(a) EPC 1973, gives the words "translation to be supplied where applicable" the meaning of "translation of the international application where needed to comply with paragraph 2 of Article 158 EPC 1973", i.e. where the international application was published in a non-EPO language. Only then does the whole thing make sense.

The freedom to choose one of the three official languages at this point applies in a specific scenario – one in which a translation is necessary because the international application was published in a non-EPO language. The idea that, when that scenario does not apply, the three languages are interchangeable would not spring immediately to the mind of a reader who sought to give Article 158 and its implementing Rule 107(1)(a) EPC 1973 the meaning directly attributable to them. On the contrary, it would presuppose ignoring the words "where applicable".

2.6 Articles 22 and 39 PCT, referred to in Article 158(2) EPC 1973 as regards the fee payable, are the counterparts of Rule 107 EPC 1973; they too govern the formalities for entering the national or regional phase. They require the applicant to "furnish a copy of the international application ... and a translation thereof (**as prescribed**)" [Enlarged Board's emphasis].

2.7 Rule 49.1 and 49.2 PCT, governing the arrangements for applying Article 22 PCT, provide that in case of multiple official languages the applicant may choose any one of them and may not be required to supply a translation if the international application

was published in one of those languages. These provisions must be seen in their context: circumscribing what designated national offices may prescribe and protecting applicants against unnecessary stipulations. The wish to save applicants from having to supply needless translations does not mean that offices have to accept them if applicants see fit to provide them. The *e contrario* argument deployed to that effect is not correct. Such argumentation presupposes two contrary factual situations. The factual situation limiting what an office may prescribe in this regard is that the language in which the international application was drawn up or published coincides with an official language of that office.

The opposite situation, justifying *e contrario* argumentation, is where the international application was published in a language not accepted by the office. So the opposition is not between offices and applicants; it is between two situations as regards the language of the international application, which determines the offices' room for manoeuvre in respect of their own official languages.

2.8 So whilst the PCT may not have a general language regime, it does have certain rules. Rule 49.2 PCT is unequivocal: a translation is required "[i]f there are several official languages **and** a translation must be furnished" [Enlarged Board's emphasis]. Interchangeable languages, at the applicant's discretion, are alien to the situations envisaged by the PCT's authors. Thus there is no conflict between EPC and PCT.

2.9 For the Enlarged Board, the above interpretation of the texts is borne out by the legal uncertainties, e.g. in the publication regime, to which the appellant's interpretation would lead. Article 158(3) EPC 1973 provides that if the international application was published in a non-EPO official language, the EPO publishes the application supplied as specified in paragraph 2 (see point 2.1(b) above). Here, clearly, the legislator had in mind only a situation where a translation was necessary. To argue from that provision alone, governing a very specific situation, that no new publication is necessary because the international application was published in an official language is entirely speculative and throws up new questions, not least the following: where in the EPC is any support to be found for equating the translation with the original application, given that (see point 2.4 above) translations are inherently less reliable?

2.10 The argument that the principle of equivalence enshrined in the EPC applies only to substantive law (priority claims, for instance), and the reference to the chain of equivalences, leading ultimately to national filings under Article 66 EPC, which seeks to show that this equivalence would be absurd if it were absolute, does not affect the provisions analysed above, whose clear wording and logical construction exclude the appellant's interpretation whilst not giving rise to any inconsistency.

2.11 The appellant submitted Legal Advice 10/92 rev. (OJ EPO 1992, 662) late in the proceedings, not – it concedes – because it offers a direct legal basis for its request, but rather as support for the view that changing the language is possible, as the appellant has always maintained.

2.12 Quite apart from the delay in updating it following EPC 2000, mentioned by the President and a source of doubt as to its current validity, the Enlarged Board notes that this item of legal advice has no bearing on the case in point. It sets out the procedure for consolidating European and Euro-PCT applications, given that EPC contracting states are not always parties to the PCT.

2.13 It cannot be relevant, because in its example (point 14) the initial application is in Swedish, i.e. not an EPO official language. This example falls outside the question referred to the Enlarged Board, which arises only if the initial application was drawn up in an EPO official language.

2.14 Interestingly, the content of this legal advice does not actually lead in the direction the appellant claims:

(a) Its point 13 repeats, by means of the reference to point 7(e), that Article 14 EPC 1973 applies.

(b) It says the European application (if Swedish was the language of the initial Euro-PCT application) must be filed in Swedish.

(c) In such a case, the international searching authority attends to the translation of the Euro-PCT application into English. For the subsequent procedure, the example then gives two possible scenarios, both of which require that the Euro-PCT application be filed in the initial language (Swedish, in this case):

- either the Euro-PCT application was filed in Swedish and translated into English by the International Bureau, and the appellant does not supply a translation under Article 22 or 39 PCT – in which case consolidation is possible if an English translation of the European application is filed **in accordance with Article 14(2) EPC 1973** [Enlarged Board's emphasis]

- or (example II), the Euro-PCT application was filed in Swedish and the applicant supplied a French or German translation under Article 22 or 39 PCT – in which case consolidation is possible if he files **a translation of the European patent application into the language chosen for the translation of the Euro-PCT application** [Enlarged Board's emphasis].

2.15 So the initial application clearly remains the one drawn up in Swedish, and on entry into the European phase the applicant must file a translation under Article 14(2) EPC, this being either its own English translation replacing that of the International Bureau or a French or German translation replacing the English translation which did not come from the applicant. No conclusion other than the Enlarged Board's interpretation is possible.

### 3. Under EPC 2000

3.1 The EPC 2000 revision made no substantive changes to the relevant provisions.

3.2 Article 14(3) EPC was tidied up to make it easier to understand (and "comme langue de la procedure" added to the French version), but its substance remained completely unchanged.

3.3 Articles 150 and 158 EPC were more conspicuously amended, but only to update their texts and simplify them by moving certain provisions into the implementing regulations.

3.4 The *travaux préparatoires* for new Article 153 EPC, in which Articles 156 to 158 EPC 1973 were subsumed, are instructive as to the interpretation its authors had in mind. Thus page 217 of CA/100/00 states that "[n]ew Article 153(4) EPC largely corresponds to Article 158(3) EPC, stipulating **when** [Enlarged Board's emphasis] a translation of the Euro-PCT is to be filed with the EPO and published by the EPO ..." (see also MR/2/00, page 221, point 8).

In particular, however, paragraph 2 of Article 158 EPC 1973 – the basis for the appellant's interpretation that on entry into the European phase any EPO official language could be chosen as the language of the application – no longer exists as such, but has been subsumed into Article 153(4) EPC, to which Rule 159(1)(a) EPC refers. And that rule corresponds to old Rule 107(1)(a) EPC 1973 which referred to Article 158(2) EPC 1973.

Article 153 EPC reaffirms in its paragraph 3 the principle that the international publication of a Euro-PCT application in an EPO official language takes the place of the publication of the European application, and in its paragraph 4 that a new publication is necessary if the old one was in another language.

The first sentence of Article 153(4) EPC reads as follows: "If the Euro-PCT application is published **in another language**, a translation into one of the official languages **shall be filed** with the European Patent Office, **which shall publish it**" [Enlarged Board's emphasis].

To interpret this paragraph – in the absence of any clarification such as "in another language than English, French or German" – as allowing a translation into another official language is at odds with the text of the article, which clearly distinguishes between EPO official languages and others.



To then use that article to maintain that, because an official language is involved, no publication is necessary, is far-fetched and at a considerable remove from the text: if the first part of the sentence is interpreted as making no distinction between EPO official languages and others, it is hard to see why such a distinction needs to be made for the second part of the sentence, concerning publication.

The text is clear, and interpreting it as the appellant would wish would deprive it of its primary meaning and add a possibility which manifestly does not correspond to the scenario and circumstances it is intended to govern.

New Article 153(2) EPC reaffirms the principle of equivalence laid down in Article 150(3) EPC 1973. It says that "[a]n international application for which the European Patent Office is a designated or elected Office, and which has been accorded an international date of filing, shall be equivalent to a regular European application" and introduces the term "Euro-PCT application" into the Convention.

The sequence of paragraphs in new Article 153 EPC, which brings together extracts from old Articles 153, 150 and 158 EPC 1973, underscores that equivalence and helps to make the language regime a part of it.

3.5 As already mentioned (see point 2.8 above), the Enlarged Board cannot discern any discrepancy between the EPC and PCT provisions – often cited in pairs, incidentally – requiring the application of Article 150(2) EPC, which says that in case of conflict the PCT provisions prevail. In particular, the appellant has not shown which PCT provisions conflict with Articles 14 EPC and 158 EPC 1973 or 153 EPC, given that nothing in the PCT allows the language to be changed unless special circumstances apply (point 2.8).

3.6 The *epi*'s examples from Canada – assuming that its interpretation of Article 71 of the Patent Act Rules is commonly accepted there – concern the way in which that country has regulated its language regime within the scope offered to national offices by the PCT. It is clear from its Article 22 and Rule 49 that the PCT delegates to member states the task of prescribing when a translation is necessary and at the same time sets limits to what they may require (Rule 49.2, see point 2.8).

The member states' room for manoeuvre is constrained solely by certain limits which must not be exceeded. Within those limits, they are free to enact rules geared to ensuring a balance of interests.

3.7 Nor can the Enlarged Board discern an absence of procedural provisions which might require the application of Article 125 EPC.

3.8 As regards the literature, the most recent (fifth) German edition of Singer/Stauder, *Europäisches Patentübereinkommen* (2009), says for example under point 49 (page 1218) regarding Article 151 that the official language chosen when filing the international application is the language of the proceedings, which cannot be changed either during the international phase or on entry into the European phase. It then mentions that the issue of changing the language is the subject of a referral to the Enlarged Board. In "The Annotated European Patent Convention 1973" (14th edition, i.e. that cited by the appellant in the appeal proceedings) Derk Visser merely points out under Article 158(2) EPC on page 328 that the EPO requires a translation into an official language if the international application was not filed or published in such a language. That does not mean it is possible to replace one language with another. Rudolf Krasser (*Patentrecht*, 5th edition, page 663, paragraph 3) says the application must be filed in an EPO official language, and if that requires a translation the EPO publishes it.

3.9 The practical guidance published reflects the same interpretation. The EPO brochure "How to get a European patent – Guide for applicants, Part 2 – PCT procedure before the EPO – 'Euro-PCT'" (4th edition, updated to 1 April 2008), cited by the President, says on three occasions (points 111, 285 and 330) that the language of the proceedings is that in which the international application was published (if that was an EPO official language) or that of the translation supplied in one of the three EPO official languages, and cannot be changed. Applicants are advised that any translation filed unnecessarily will be ignored. The practical guide "European and International Patent Applications" (Rippe/Gough, 2002 edition) also says (on page 181 under "Languages of the proceedings") that if the international

application was filed and published in an EPO language, that is then the language of the proceedings for the regional phase before the EPO.

3.10 Lastly, citing considerations of fairness, the appellant maintains that being unable to change the language on entry into the European phase discriminates against it. But the Enlarged Board can say only that if there is such discrimination, any amendment of the clear texts in force is a matter for the lawmaker rather than for those charged with applying them.

3.11 The above analysis shows that neither EPC 1973 nor EPC 2000 can be interpreted as allowing, on entry into the European phase, a Euro-PCT application published in an EPO official language to be replaced by its translation into another such language.

#### *Second question*

4. The applicable law here is EPC 2000.

This question arises only because some decisions by EPO boards of appeal have allowed the language of the proceedings to be changed. But only decision J 18/90 (OJ 1992, 511) taken on 22 March 1991 – i.e. before the entry into force on 1 June 1991 of the rescindment of Rule 3 EPC by an Administrative Council decision dated 7 December 1990 – gives reasons. The others (even the most recent ones such as T 1125/00 or T 1443/04) simply refer to it.

4.1 Thus that decision is the sole basis for the legal doctrine cited (Derk Visser, *The Annotated European Patent Convention 1973* [14th edition], page 355 and, more clearly, *The Annotated European Patent Convention 2000* [15th edition], page 379).

4.2 The Enlarged Board notes however that the analysis in the decision (see reasons 1.2) quite simply and deliberately ignores the 1991 deletion of Rule 3(1) EPC which had originally been included in the Implementing Regulations in view of the Article 14(3) EPC reservation.

4.3 Rule 3(1) EPC before 1991 provided that "[o]n the request of the applicant for or proprietor of a patent, and following consultation of the other parties to the proceedings, the European Patent Office may allow the language of the proceedings to be replaced by one of its other official languages as the new language of the proceedings". Rule 3(2) stipulated that amendments to an application or patent had to be filed in the initial language of the proceedings. This then became paragraph 2 of Rule 1 EPC 1973, which in turn became Rule 3 in EPC 2000.

4.4 Today's Rules 3 and 4 EPC (former Rules 1 and 2 EPC 1973), when listing the possible exceptions, draw distinctions between written and oral proceedings and between parties and the EPO. Rule 3 EPC concerning written proceedings relates only to the parties, but an exception to the rule is made for amendments to the application or patent. Only in oral proceedings (Rule 4 EPC) does the Office have the same options as the parties.

4.5 In this context, which testifies to efforts to regulate the exceptions in detail, the abolition of Rule 3(1) EPC 1973 removed all legal basis for the previous practice. And that practice, once done away with, cannot be restored through the case law subject solely to the parties' consent. Here the Enlarged Board takes the same line as in G 1/05, when it pointed out (see reasons 13.1) that limitations abolished by the legislator could be re-introduced only by him. In the present case, the same principle applies, albeit in different circumstances: in G 1/05 a limitation had been abolished; here, a possibility.

4.6 CA/52/90 Rev. 1 of 31 August 1990 shows that Rules 1 and 3(1) EPC 1973 were revised and rescinded, respectively, with a view to simplification. It expressly states (see reason given under Rules 1 and 3) that "EPO practice has shown the application of Rule 3 to be fraught with problems, ranging from the drafting of an Examining Division communication in the wrong language to the publication of European A and B documents with title pages in the wrong language".

4.7 It seems unlikely that those problems, and others not mentioned, would not occur even if the parties agreed to change the language of the proceedings.

4.8 Lastly, the possibility, under the rules of procedure of the boards of appeal, that a rapporteur may use the official language with which he is most conversant is an internal measure. It has no effect on the language of the proceedings, which remains unchanged.

4.9 In support of its argument that non-discrimination between languages is a principle of Community law, the appellant cites a decision of the Court of Justice of the European Communities (Kik/OHIM, handed down on 9 September 2003). But this decision was given in a different legal framework, i.e. Community law, and concerns a language regime different from that of the EPC.

4.10 The Enlarged Board therefore concludes that the texts in force leave no room for a free interpretation tantamount to restoring Rule 3 EPC 1973.

### *Question 3*

5. As the answer to question 2 is no, question 3 is redundant.

### **Order**

**For these reasons it is decided that:**

#### **Question 1:**

If an international patent application has been filed and published under the PCT in an official language of the EPO, it is not possible, on entry into the European phase, to file a translation of the application into another EPO official language.

#### **Question 2:**

In written proceedings on a European patent application or an international application in the regional phase, EPO departments cannot use an EPO official language other than the language of proceedings used for the application under Article 14(3) EPC.

#### **Question 3:**

This question is redundant.