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# D E C I S I O N
## of 20 December 2001

**Case Number:** J 0003/00 - 3.1.1

**Application Number:** PTC/EP...

**Publication Number:** -

**IPC:** ...

**Language of the proceedings:** EN

**Title of invention:**
...

**Applicant:**
N.N.

**Opponent:**
-

**Headword:**
Rectification of error/N.N.

**Relevant legal provisions:**
EPC Art. 75(1)(a), 106(1), 111(2), 151, 152
PCT Art. 2(xv), 11(1), 11(2)(a)
PCT R. 12.1(a), 19.4, 20.4(a), 20.6(b), 82 ter

**Keyword:**
"Rectification of errors made by a PCT Receiving Office (PCT Rule 82 ter)"
"Protection of legitimate expectations"

**Decisions cited:**
G 0002/97, J 0015/91

**Catchword:**
-

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

**Case Number:** J 0003/00 - 3.1.1

**D E C I S I O N**
**of the Legal Board of Appeal 3.1.1**
**of 20 December 2001**

**Appellant:** N.N.

**Representative:** N.N.

**Decision under appeal:** **Decision of the Receiving Section of the European Patent Office dated 20 October 1999 refusing the requests to accord the international application PCT/EP... the filing date of 27 April 1998 and the priority date of 29 April 1997.**

**Composition of the Board:**

**Chairman:** J. Saisset
**Members:** B. J. Schachenmann
J. C. M. De Preter

## Summary of Facts and Submissions

I. The present appeal was filed against a decision of the Receiving Section of the European Patent Office rejecting *inter alia* the appellant's request to accord the international patent application PCT/EP... (European patent application No. 98 ...) the filing date of 27 April 1998 and the priority date of 29 April 1997.

II. The appellant, a Swedish company, had filed the international patent application referred to above at the EPO as receiving Office under the PCT (RO/EPO) by telefax on 27 April 1998. By mistake the description and the claims were filed in Swedish, a language which the RO/EPO does not accept under Rule 12.1(a) PCT for filing of international applications.

III. On 18 May 1998, when the mistake was recognised, the appellant sent a description and claims in English to the RO/EPO. In reply, the RO/EPO issued a notification dated 24 July 1998 that, according to Article 11(2)(b) PCT, the day of receipt of the corrected documents, ie 18 May 1998, was accorded as international filing date. Consequently, the claim of priority was cancelled *ex officio*.

IV. By letter of 28 August 1998 to the RO/EPO the appellant requested that the application be awarded the international filing date of 27 April 1998 and that the *ex officio* decision (sic) to cancel the priority be revoked. In support of this request the appellant referred to the principle of protection of legitimate expectations according to which the EPO must warn a party of an impending loss of rights if such warning

can be expected in all good faith. As a first auxiliary request, the appellant requested restitutio in integrum under Article 48(2) PCT and Article 122 EPC "for the lost priority right" and paid the corresponding fee. Further auxiliary requests concerned the retroactive application of the meanwhile amended PCT guidelines (allowing, pursuant to amended Rule 19.4 PCT, the filing of international patent applications in Swedish) and the application of the principle of proportionality (considering the present application as a European patent application in view of the fact that direct filing of a European patent application in Swedish was possible).

V. On 21 September 1998 the appellant took the steps required under Rule 104b EPC for the entry into the regional phase before the EPO as designated Office and reiterated the submissions of 28 August 1998 for the purposes of the regional phase before the EPO. The main request now referred to restitutio in integrum pursuant to Article 48(2) PCT and Article 122 EPC "for the lost priority right". On 19 October 1998 the applicant filed a request under Article 23(2) PCT for early processing of the application by the EPO.

VI. By communication of 8 March 1999 the Receiving Section of the EPO informed the appellant that the request for re-establishment could not be allowed because the period for claiming priority was excluded from restitutio under Article 122(5) EPC. As far as the other requests were concerned, the legal conditions for applying the invoked provisions were not met. In reply to this communication the appellant requested a decision under Rule 69(2) EPC, unless its patent application could be awarded the filing date of

27 April 1998.

VII. In its decision of 20 October 1999 the Receiving Section of the EPO acting as designated Office set out that, according to Article 48(2) and Rule 82bis.2 PCT, any designated State could, as far as that State is concerned, excuse, for reasons admitted under its national law, any delay in meeting a time limit. However, there was no time limit to be met under the PCT for filing the application documents in the prescribed language. On the other hand, the 12 month time limit for claiming the priority was excluded from restitutio by Article 122(5) EPC.

Concerning the invoked protection of legitimate expectations it pointed out that, according to Rule 82ter PCT, a designated Office could rectify the filing date only if the applicant proves to its satisfaction that the international filing date was incorrect due to an error made by the receiving Office. However, it had not been proved by the applicant that an error in according the date of filing or in cancelling the priority was made by the RO/EPO. The international application in question was filed in Munich only two days before expiry of the priority period. Since the RO/EPO is located in the branch of the EPO at the Hague, it could not be expected to identify the deficiency (ie the fact that the application was in a language not accepted by it) and to inform the applicant accordingly within two days. The deficiency was therefore not readily identifiable by the RO/EPO and not easily correctable by the applicant within the time limit. Neither made the RO/EPO an error by not applying amended Rule 19.4 PCT which did not come into force until 1 July 1998, ie

after the filing of the international application.

The Receiving Section also refused to treat the present application as or like a European patent application since it was filed as an international patent application to which the provisions of the PCT supplemented by the provisions of the EPC apply, the former prevailing in case of conflict.

VIII. In its notice of appeal of 16 December 1999 the appellant requests cancellation of the entire decision.

The statement of grounds of 18 February 2000 mainly refers to the findings of the Receiving Section concerning the principle of legitimate expectations. In the appellant's submission these findings were based on the indication that the EPO in Munich could not possibly have discovered the filing error in time because of the organisation of the EPO. This indication however contradicted the intention of Article 11(2)(a) and Rule 20.6 PCT. All that was required by the RO/EPO in the present circumstances was to check if the text of the international application received was in one of the three accepted languages. It was quite legitimate to expect that such a basic control was made upon receipt and that the applicant, when a deficiency was discovered, was promptly informed about a need for correction in order to avoid a serious loss of rights. The appellant had indeed prepared an English text which was available before the original filing date of 27 April 1998 but, by error, was not used by an assistant accustomed to filing PCT-applications in Swedish at the Swedish Patent Office as receiving Office. The English text could therefore have been filed immediately.

The Swedish Patent Office, when acting as receiving Office for PCT applications, had the policy to react already on the filing day when there were obvious errors in the application. In contrast, the RO/EPO did not react until 24 July 1998, ie almost three months after the original filing date and a long time after the appellant himself had discovered the mistake. Had the RO/EPO acted promptly, the appellant would have been in a position to correct the filing error within the priority period.

IX. The appellant requested the Board of Appeal to establish the international filing date of 27 April 1998 for the PCT application or, as auxiliary request, that the documents filed on 27 April 1998 be regarded as a European patent application claiming a Swedish priority of 29 April 1997. Oral proceedings were requested, if the Board could not accept the arguments referred to above.

## Reasons for the Decision

1. Admissibility of the appeal and jurisdiction of the Legal Board of Appeal

1.1 The decision under appeal, even if it refers to proceedings before the PCT receiving Office (Article 2(xv) PCT), ie the "international phase", is a decision of the Receiving Section of the EPO acting as designated Office. The Receiving Section derived its jurisdiction from Rule 82ter PCT concerning rectification, in the proceedings before the designated Offices, of errors made by the PCT receiving Office or by the International Bureau during the international

phase. The present appeal is admissible as far as it is directed against such a decision of one of the departments of the EPO enumerated in Article 106(1) EPC.

1.2 The Legal Board of Appeal exercises its power within the competence of the department of first instance (Article 111(2) EPC). As the competence of the Receiving Section was derived from Rule 82ter PCT, the Legal Board of Appeal exercises its power only within the framework of this provision referring to the proceedings before the EPO as designated Office.

The appeal to be examined is not an appeal directed against an action taken by the EPO in its capacity as a PCT organ during the international phase (as in case J 15/91, OJ EPO 1994, 296), but refers to the question if the Receiving Section of the EPO should have rectified, pursuant to Rule 82ter PCT, a purported error of the RO/EPO for the purposes of the regional phase before the EPO. The present decision is therefore neither binding on the International Bureau nor on any other State designated in the PCT request and is not in contradiction to the findings in J 15/91.

2. Within the framework set out above the issue to be considered is whether the filing date of the international application is incorrect due to an error made by the RO/EPO which was such that, had it been made by the EPO itself, would have to be rectified under the EPC (see Rule 82ter PCT).

2.1 According to the constant jurisprudence of the Boards of Appeal as confirmed by the Enlarged Board of Appeal in its decision G 2/97 (OJ EPO 1999, 123) the

protection of legitimate expectations requires the EPO to warn the applicant of any loss of rights if such a warning can be expected in all good faith. This presupposes that

- the deficiency can be readily identified within the framework of the normal handling of the case at the relevant stage of the proceedings and that

- the user is in a position to correct it within the time limit.

2.2 As regards the first condition referred to above the required handling of the case by the receiving Offices is defined, in the present circumstances, by Article 11(2)(a) PCT in combination with Rules 20.4(a) and 20.6 PCT.

According to Article 11(2)(a) PCT, if the receiving Office finds that the international application did not, at the time of receipt, fulfill the minimum requirements listed in Article 11(1) PCT for according a filing date, it shall, as provided in the Regulations, invite the applicant to file the required correction. These minimum requirements - one of them being the language requirement pursuant to Rule 12.1(a) PCT - are such that they can be readily determined on the face of the filed documents. Accordingly, Rule 20.4(a) PCT provides that the receiving Office shall determine "promptly after receipt of the papers purporting to be an international application" whether the papers comply with these minimum requirements. Pursuant to Rule 20.6(b) PCT "the receiving Office shall promptly mail the invitation to the applicant and shall fix a time limit" - not less than 10 days - for

filing the correction. If such time limit expires after the expiration of the priority year, the receiving Office may call this circumstance to the attention of the applicant (Rule 20.6(b), third sentence).

The only deficiency of the present international application was that it was not in a language prescribed for the RO/EPO (German, English, French) but in Swedish. However, such a deficiency is immediately and readily identifiable by the receiving Office on the face of the application in the course of the Article 11(1) PCT check.

Against this background, the appellant could expect in good faith that the receiving Office issued a warning when it checked and identified the deficieny "promptly after receipt" of the application. Considering, in addition, that the receiving Office had also to take account of the expiration of the priority year (cf. Rule 20.6(b) PCT, third sentence), it could be expected that such a warning was issued still before the end of the priority year, ie within the remaining two working days.

Any organisational constraint within the RO/EPO resulting in a delay of the check under Article 11(1) PCT cannot be to the detriment of the appellant relying on the provisions of the PCT. In particular, the fact that international applications filed at the EPO in Munich are forwarded to the branch at The Hague for the Article 11(1) PCT check appears not to be relevant in connection with the principle of legitimate expectations. The "receiving Office" within the meaning of Article 2 (xv) PCT is the EPO as a whole

(Article 151 EPC) and an applicant choosing the EPO as "receiving Office" for his international application may file it at Munich, The Hague or Berlin, as he sees fit (Article 152 in combination with Article 75(1)a) EPC; see also decision of the President of the EPO of 10 May 1989 on the setting up of a Filing Office in the Berlin sub-office of the EPO, OJ EPO 1989,218). Applicants can therefore expect that their international applications are treated in the same way independently of the place of filing.

2.3 As far as the second condition referred to above (point 2.1, supra) is concerned, the appellant has credibly submitted that an English text was prepared and made ready for the PCT application before 27 April 1998. Thus, immediately upon receipt of a warning by the RO/EPO, eg by telephone, the English text could have been filed by telefax. Alternatively, the complete application in Swedish language could have been filed at the Swedish Patent Office as PCT receiving Office. In any case the appellant would have been in a position to correct the deficiency at very short notice.

2.4 Thus, in the Board's opinion, the conditions for the protection of the legitimate expectations of the appellant are met in the particular circumstances of the present case. Consequently, as far as designations for the purpose of obtaining a European patent are concerned the international filing date accorded by the receiving Office has to be rectified under Rule 82ter PCT.

3. Since, in effect, the appeal is successful in that European patent application No. 98 932 064.3 claiming a Swedish priority of 29 April 1997 is accorded a filing

date of 27 April 1998 (see point IX, first auxiliary request), oral proceedings need not to take place.

## Order

## For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The international patent application PCT/EP... (European patent application No. 98 ...) is accorded a filing date of 27 April 1998, as far as the designations for the purpose of obtaining a European patent are concerned.

The Registrar: The Chairman:

S. Fabiani J.-C. Saisset