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D E C I S I O N
of 26 November 2004

Case Number: J 0016/03 - 3.1.1

Application Number: 02...

Publication Number: -

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Language of the proceedings: EN

Title of invention:

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Applicant:

Astex ...

Opponent:

-

Headword:

Withdrawal of international application/ASTEX

Relevant legal provisions:

EPC Art. 111(1)

PCT Art. 23(2), 40(2), 11(3), 24, 22, 39

EPC R. 107(1)

PCT R. 90bis.6(a)

Keyword:

J 0015/86, J 0004/87, J 0011/87

Decisions cited:

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Catchword:

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Case Number: J 0016/03 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 26 November 2004

Appellant: Astex Technology Limited
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Representative: Brasnett, Adrian Hugh
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Decision under appeal: Decision of the Receiving Section of the EPO
posted on 6 January 2003, by which the
Applicant was informed that the EPO cannot
process the European phase of the international
application PCT/GB02... and that the procedure
is therefore closed.

Composition of the Board:

Chairman: J. Saisset
Members: R. T. Menapace
R. Moufang

Summary of Facts and Submissions

- I. International application PCT/GB 02..., claiming priorities of 2 April and 23 July 2001 and designating also EP, was filed on 2 April 2002.

- II. On 10 and again on 11 September 2002 the applicant (Appellant) through his representative filed an explicit request for "processing under the EPC, as of the date of receipt of this letter, of the European regional phase of this PCT application" and performed all acts required for the entry into the European phase before the EPO, except that no fees were paid at that time.

- III. By a copy of notice IB/307 received on 23 September 2002 the EPO was informed by the International Bureau that the international application had been withdrawn on the date of receipt of the Appellant's notice effecting withdrawal on 12 September 2002 and that, consequently, there would be no international publication of the application.

- IV. The fees, including designation fees, filing, search and examination fee, were paid on 3 December 2002 by debit order.

- V. By letter posted on 6 January 2003 the Receiving Section of the EPO informed the Appellant's representative that it could not process the European phase of the application in question and that, therefore, the procedure were closed and the refund of the fees paid on 3 December 2002 would be ordered. It was explained that under Rule 90bis.6 PCT the

withdrawal of an international application has no effect in any designated Office where processing or examination of the international application has already started under Article 23(2) or Article 40(2) PCT. However, a request for early processing is deemed to have been validly made when the requirements for entry into the European phase as stipulated in Rules 107 and 110 EPC have been fully satisfied before the international application was actually withdrawn. In the present case the debiting of fees was ordered on 3 December 2002, which was after the withdrawal of the international application.

VI. In response to that letter of the Receiving Section and with express reference to it, the appellant, by facsimile letter dated and received on 14 January 2003, requested "a decision in writing from the Receiving Section in order that the matter can be resolved in an Appeal". Three day later the Office sent short notices to the appellant's representative informing him of the refund of the examination, claims, national basic, designation and search fee(s).

VII. On 7 March 2003 the Appellant gave notice of appeal "against the decision communicated in the letter of 6 January 2003", which communication he regarded to be a decision under Rule 69 EPC, together with a debit order for the appeal fee and the designation, filing, search, claims and examination fee(s), the latter five fees having been refunded in the meantime. The notice contained the request that the decision of the Receiving Section of 6 January 2003 be cancelled and that the application be allowed to proceed as a European patent application in accordance with the EPC,

that the appeal fee be refunded on the grounds that the Receiving Section had committed a procedural violation and a comprehensive statement setting out the grounds of appeal.

VIII. The appellant's arguments including those submitted in reply to the Board's communication dated 17 February 2004 can be summarised as follows:

The wording "where processing or examination has already started" in Rule 90bis.6(a) PCT implies a first step, not a completed procedure. The concept that the requirements for processing have to be "fully" satisfied has no basis in the PCT, the EPC, the case law or the current practice of the Office. The EPC distinguishes between acts necessary to start the processing of an application on the one hand, and the requirement to pay fees on the other. It is not necessary to pay fees simultaneously with the initiation of a European patent application (see the requirements for the accordane of a date of filing as opposed to the consequences of non-payment of the filing and the search fee - Articles 79, 80 and 90 (3) EPC, see also opinion of the Enlarged Board of Appeal G 4/98). This is also true for divisional applications, in that the actual filing date is decisive for the deadline pursuant to Rule 25(1) EPC, whereas the fees can be paid subsequently, namely within the specific time limits provided for in paragraph 2 of that provision.

In line with this, Rule 107 EPC does not require that all the acts necessary for entry into the European phase occur simultaneously. The act of Rule 107(1)(b)

EPC which is equivalent to an Article 80 EPC provision - in the present case the explicit request contained in the representative's letter received on 11 September 2004 to process the international application under the EPC - is decisive and sufficient for the start of that processing. As regards the outstanding fees prescribed in Rule 107(c)-(e), Rule 108 provides, just as Article 90(3) EPC, that where these fees have not been paid in due time, the application is "deemed to be withdrawn". This means that the loss of rights ensuing from non-compliance with this requirement, of which the appellant should have been given notice of it under Rule 108(3) EPC, has no retroactive effect.

- IX. By letter received on 29 September 2004 the Appellant confirmed his main request as being that the decision of the Receiving Section of 6 January 2003 be set aside and that the application be allowed to proceed as a European patent application.

Reasons for the decision

Admissibility

1. Whether a document constitutes a "decision" within the meaning of Article 106(1) EPC or not depends on its substance and not on its form (decisions J 8/81, T 1062/99). Whilst the impugned letter by the Receiving Section did not expressly indicate that it constituted a decision against which an appeal was possible (as prescribed by Rule 68(2) EPC), it clearly contained all the essential elements of such an act by the competent department of the EPO, more specifically the reasoned

statement by the Receiving Section, that the application concerned will not be processed further and that the procedure is closed. This is underlined by the fact that the Receiving Section did not react to the appellant's subsequent express request for an appealable decision but by refunding the fees as announced in the impugned letter. All other relevant requirements being fulfilled as well, the appeal is admissible.

On the merits

2. Article 11(3) PCT provides that an international application shall have the effect of a regular national filing in each designated State. Thus, international application PCT/GB 02/01575 designating, amongst others, EP had the effect of a European patent application as of the international filing date. Pursuant to Article 24(1)(i) PCT the effect of an international application shall cease in any designated State, if the applicant withdraws his international application. However, this provision does not apply without exceptions as it follows from Rule 90bis.6(a) PCT (point 3, below) and Article 24(2) PCT (point 6, below)

3. Rule 90bis.6(a) PCT provides for an obvious and mandatory exception from Article 24(1)(i) PCT in that according to this provision the withdrawal of an international application shall have no effect in any designated Office "where the processing or examination of the international application has already started under Article 23(2) PCT or Article 40(2)" PCT, that is where and to the extent as an applicant has intentionally and effectively obtained the transition

- of his application from the international to the regional/national phase prior to the expiration of the applicable time limit under Articles 22 and 39 PCT, respectively.
4. Under Article 23(2) or 40(2) PCT any designated or elected Office, on the express request of the applicant (which he had made in the case at hand) "may" process or examine the international application "at any time". It is thus left to the discretion of any designated/elected Office to decide as a matter of policy whether it complies with requests for early processing or not. This implies that any such Office is entitled to make the actual taking up of the (early) processing of the application concerned conditional upon fulfilment of specific (and not unreasonable) requirements.

 5. The EPO has decided to offer early processing on condition that an applicant who wishes his Euro-PCT application to be processed by the EPO before expiration of the 31-month time limit under Article 22(3) and Rule 107(1) EPC must fully satisfy all the requirements for entry into the European phase (see Notice dated 1 December 2001, O.J. 2001, 587, point 5 and further "Euro-PCT Guide for Applicants", 2nd edition, point 298 and 353). These requirements include the payments prescribed in Rule 107(1)(c) to (e) EPC, a certainly not unreasonable condition. As this condition was not fulfilled in the present case when the Appellant made the statement of withdrawal of his international application, the EPO had not started the (early) processing of the application at the critical

point in time, so that this requirement pursuant to Rule 90bis.6(a) PCT was not met.

6. The non-applicability of the mandatory exception pursuant to said Rule does not, however, mean that the EPO then had no choice, but was bound to consider the effect provided for in Article 11(3) PCT to be terminated. Article 24(2) PCT provides that notwithstanding the withdrawal of the international application or a designation "any designated Office may maintain the effect provided for in Article 11(3)" PCT, i.e. of a regular national (here: European) application with the same filing date as that of the international application. This means, that contrary to the view apparently underlying the decision under appeal (... the EPO cannot process the PCT application") in the given situation it was actually within the discretion of the EPO to treat the application as a pending European application, although early processing within the meaning of Rule 90bis.6(a) PCT had not yet started before the EPO.

7. In the circumstances of the present case the Board considers it appropriate to exercise, under Article 111(1) EPC, the relevant discretionary power of the Receiving Section which was responsible for the decision under appeal, and to do so in favour of the appellant for the following reasons:
 - 7.1 The notice of withdrawal of the international application was given the day after the EPO had received the appellant's request for early processing together with all required documents. It was thus known to the EPO that the day before said notice of

withdrawal it was still the appellant's intention to single out "EP" from the "bundle" of the designations made in the international application and to pursue his application independently and directly before the EPO as a (purely) European application.

- 7.2 In these circumstances it could not reasonably be assumed that the appellant's notice of withdrawal of the international application was meant also to embrace the European application, for the procedural separation of which the appellant had already undertaken essential steps. Such an understanding of the Appellant's notice would presuppose either a radical and rather unlikely change of mind or a *venire contra factum proprium*. In any event, any possible doubt as to the Appellant's true intentions was removed at the latest by the receipt of the fees ten weeks later and apparently before the EPO had undertaken any steps in reaction to the notice of withdrawal.
- 7.3 According to the jurisprudence of the Legal Board of Appeal (e.g. J 11/87, J 15/86, 4/87) and the practice of the EPO (cf. Guidelines for the Examination in the EPO, E-VIII, 6.3) a statement of withdrawal must be unqualified and unambiguous in order to be accepted as such. The notice of withdrawal to the International Bureau of 12 September 2002 did not meet these criteria in respect of the European application which, therefore, should not be considered to have been affected by it.
8. As it is not clear whether the appellant maintained his request for reimbursement of the appeal fee, the Board has examined the question *ex officio* with the result, that such reimbursement is not equitable. The decision

under appeal suffered from an error of law as to the scope of the discretionary power of the EPO as designated Office under the PCT in the rare situation where an applicant had filed a request for early processing without also paying the required fees.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the 1st instance for further prosecution.

The Registrar:

The Chairman:

S. Fabiani

J.-C. Saisset