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D E C I S I O N
of 17 October 2005

Case Number: J 0006/05 - 3.1.01

Application Number: 04100377.3

Publication Number: 1566498

IPC: E03F 5/22

Language of the proceedings: EN

Title of invention:

Method of pumping wastewater, and wastewater pump

Applicant:

Uponor Innovation AB

Opponent:

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Headword:

-

Relevant legal provisions:

EPC Art. 14(1), (2), 80(d)
Paris Convention Art. 2(2)

Keyword:

"Application documents in language of a Contracting State
other than English, French or German; further requirements of
Article 14(2) EPC met (no)"
"According a filing date (no)"

Decisions cited:

J 0015/98, J 0009/01

Catchword:

Until the Revised EPC 2000 enters into force, an application filed in an official language of a Contracting State other than English, French or German, e.g. in the Finnish language, does not produce the result provided for in Article 80 EPC, i.e. no date of filing is attributed, if the other conditions provided for in Article 14(2) EPC, namely the applicant having its residence or principal place of business within the territory or being a national of that (same) Contracting State (here: Finland), are not fulfilled.



Case Number: J 0006/05 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 17 October 2005

Appellant: Uponor Innovation AB
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Decision under appeal: Decision of the Receiving Section of the
European Patent Office dated 15 November 2004
refusing the request to accord a date of filing
on the basis of the application as filed in the
Finnish language.

Composition of the Board:

Chairman: J.-C. Saisset
Members: E. Lachacinski
R. Menapace

Summary of Facts and Submissions

I. The appellant (applicant), a company with seat in Sweden, lodged an appeal, received on 30 December 2004 together with a payment order for the appeal fee, against the decision of the Receiving Section, posted on 15 November 2004, refusing the applicant's request to accord 3 February 2004 as date of filing of the application and according as date of filing 6 February 2004 instead.

The statement of grounds was received at the EPO on 15 March 2005.

II. The documents filed with the EPO in electronic form on 3 February 2004 comprised, *inter alia*, a Request for grant (EPO Form 1001) in English and a description and 12 claims, both in Finnish. On 6 February 2004 an English translation of the description and the claims was filed.

III. In the decision under appeal, the Receiving Section of the EPO took the view that the benefit of Article 14(2) EPC to file a European patent application in a language other than in one of the three official languages of the EPO is limited to natural or legal persons having their residence or principal place of business within the territory of a Contracting State having a language other than English, French or German as an official language and to the official language(s) of that State. It was furthermore held that decision J 15/98 was an isolated decision which did not apply to the present case and had been overruled by decision J 09/01. The Receiving Section concluded that an application from a

natural person having its residence or principal place of business in Sweden, if not filed in an official language of the EPO (English, French or German), has to be filed in Swedish, in order to obtain a date of filing (Article 80(d) EPC in conjunction with Article 14(2) EPC).

IV. In its statement of grounds, the appellant argued essentially as follows:

- (i) From decision J 15/98 it is clear that the reference to Article 14 EPC in Article 80(d) EPC is made only to identify the possible languages to be used, it does not also include the entitlement to use these languages,
- (ii) As stated in J 15/98, the effects deriving from the filing date cannot depend solely on the nationality of the applicant, as there is no ground for discrimination in this respect.
- (iii) It is surprising that the Receiving Section considered decision J 15/98, which is very clear and was published in the O.J. [2001,183], to be "very isolated". Furthermore, the finding that the said decision does not apply to the present case has not been, in any way, substantiated.
- (iv) The Receiving Section had totally misinterpreted decision J 09/01 where the Board of Appeal only considered and rejected *restitutio in integrum* (for lack of due care in respect of the filing language for a European patent application), but

did not rule on the date of filing. Therefore, it did not overrule decision J 15/98.

V. The appellant's requests were the following:

- (i) If the Board of Appeal is of the opinion that decision J 09/01 has to be taken into consideration, referral of the question to the Enlarged Board of Appeal,
- (ii) Reimbursement of the appeal fee due to a substantial procedural violation, the Receiving Section having misinterpreted the provisions of Article 80 EPC and the established case law, namely J 15/98, which unambiguously established the procedure to be followed.
- (iii) According of 3 February 2004 as date of filing
- (iv) Oral proceedings, should the Board of Appeal not intend to revoke the decision under appeal.

VI. In response to a communication of the Board issued on 28 July 2005 pursuant to Article 11(1) of the Rules of Procedure of the Boards of Appeal the appellant maintained his arguments and requests, in particular the request for referral of the question to the Enlarged Board of Appeal should the Board not follow decision J 15/98, and submitted that overruling said decision would not be fair in view of the following:

- (i) Many patent offices nowadays accord a date of filing to patent applications filed in any

language provided that the translation is filed within a determined time limit,

- (ii) Often the mother tongue of the inventor is different from the official language in the state in which the applicant has its principal place of business. It is important, on the one hand to obtain an effective filing date as early as possible, on the other, that the Inventor himself checks and therefore may read the specification in his mother tongue, before the application is filed.
- (iii) In the case of a transfer of an invention, e.g. from a Finnish inventor to a Swedish applicant, the latter would be put in a much worse situation than if the inventor himself filed the application within the European Patent Office.

Additionally the appellants' representative informed the Board that neither the applicant nor his representative would participate at the oral proceedings.

- VII. At the oral proceedings the Board decided to continue the proceedings without the appellant on the basis of Rule 71(2) EPC and announced its decision.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. The present appeal seeks to obtain 3 February 2004 as the filing date of the application, which was filed on said day on behalf of the appellant, a company having its principal place of business in Sweden, in the Finnish language.
3. Pursuant to Article 80 EPC the date of filing of a European patent application shall be the date on which documents filed by the applicant contain the information mentioned in subparagraphs (a) to (c) and "a description and one or more claims in one of the languages referred to in Article 14, paragraphs 1 and 2".

Article 14(1) EPC provides that the official languages of the EPO shall be English French and German, and that European patent Applications must be filed in one of these languages.

Paragraph 2 of Article 14 EPC, first sentence reads: "However, natural or legal persons having their residence or principal place of business within the territory of a Contracting State having a language other than English, French or German as an official language, and nationals of that State who are resident abroad, may file European patent applications in an official language of that State."

4. As the description and the claims filed on 3 February 2004 were not in an official language of the EPO, but in Finnish, the official language of a Contracting State, the legal basis for the use of that language for filing a European patent application is Article 14(2) EPC to which Article 80(d) EPC refers.

Article 14(2) EPC concerns the filing of applications (" ... may file European patent applications in a language") and provides an exception from the general language regime as defined by the first sentence of Article 14(1) EPC ("However, ...") and that such exceptional use of other languages is conditional upon the following:

- (a) the language is an official language of a Contracting State,
 - (b) the applicant is a natural or legal person having its residence or principal place of business within the territory, or is a national resident abroad of a Contracting State having a language other than English, French or German as an official language;
 - (c) the application is filed in an official language of "that State", i.e. in an official language of (one of) the Contracting State(s) in respect of which the applicant qualifies under (b).
5. The crucial question in the present case is then whether the reference in Article 80(d) EPC to "the languages referred to in Article 14, paragraphs ... 2"

comprises all three conditions (a), (b) and (c) set out above.

If the answer is in the affirmative, then the filing of claims and description in Finnish by a company having its principal place of business in Sweden could not lead to a filing date by virtue of Article 80 EPC. As Finnish is not an official language in Sweden (in contrast to Swedish, which is an official language of Finland) only conditions (a) and (b) were fulfilled. Hence a date of filing could not be accorded before condition (c) was also met by filing the description and claims either in Swedish or in one of the official languages of the EPO - here on 6 February 2004, on which day the application was received in English. This was the view taken by the Receiving Section in the decision under appeal.

6. This view is in sharp conflict with decision J 15/98 which held that an application filed in one of the languages referred to in Article 14(2) EPC produces the result provided for in Article 80 EPC, i.e. a date of filing is attributed, irrespective of the fact that the applicant neither has his residence or principal place of business nor is a national of a Contracting State (see Head note). That means nothing else than that only condition (a) must be fulfilled, conditions (b) and (c) - "the entitlement to use one of these languages" - being totally irrelevant for the purposes of obtaining a filing date pursuant to Article 80 EPC. It would be sufficient to file the description and the claims in any of the (meanwhile numerous) languages qualifying under Article 14(2) EPC, i.e. in an official language

(other than English, French or German) of one of the presently 31 Contracting States, e.g. Finnish.

7. The reasons given for that liberal interpretation of Article 80(d) EPC, in effect that the reference to Article 14(2) EPC is limited to the possible languages under that provision and does not also comprise the conditions for their use by individual applicants, are, however not convincing for the Legal Board of Appeal in its present composition:

- 7.1 The main argument put forward is that the effects from a filing date are the same whether the applicant is a national or has his residence in a Contracting State or whether he is a national of a State which is not a member of the EPC. Indeed, these effects cannot depend solely on the nationality of the applicant, since there is no ground for discrimination in this respect (Point 4, 10th full paragraph of the reasons).

This argument is, however, beside the point, for the requirements for obtaining a filing date, which are at issue here, are a matter completely different from the effects of a filing date, once it has been accorded. Indeed, these effects do not depend on the applicant's nationality, the principle of non-discrimination in this respect already being laid down in the Paris Convention. Before this and other principles and rights concerning an applicant apply, it has to be established, that the person in question - here a company having filed application documents in a language other than an official language pursuant to Article 14(1) EPC - has acquired the legal status of an applicant within the meaning of the EPC, namely by

filing application documents which satisfy the requirements set out in Article 80 EPC.

- 7.2 The other argument, put forward also by the appellant and the sole argument presented in the literature cited in decision J 15/98 - see: Bossung, "Münchener Kommentar 1986", Artikel 80 Rdnr. 63, the other authors only reporting Bossung's view or not giving any reasoning (Lunzer) - is that in Article 80(d) EPC no (explicit) reference is made to the entitlement to use the languages under Article 14(2) EPC (8th, 10th and 11th paragraph of Point 4 of the Reasons).

However, this is a fact which, as such and taken out of context ("according to the literal construction of the provision" as it was put in J 15/98), is not conclusive for the statement that "it seems clear that the reference to Article 14 is made only to identify the possible languages to be used" (8th full paragraph of point 4 of the Reasons), quite to the contrary: by definition, a reference in a legal provision is a technique by which the content of one provision is incorporated into that of another, namely that of the provision referred to (here: Article 14(2) EPC) into that of the referring provision (here: Article 80(d) EPC). Hence, the true meaning of a reference (here to: "one of the languages referred to in Article 14, paragraph. ... 2" EPC) cannot be established without taking into account the meaning of the provision referred to.

As shown in Point 4, above, Article 14(2) EPC provides, for filing purposes only, for an exception from the strict principle of only three official languages of

the EPO, which - expressly (Article 14(1) EPC, second sentence) - applies also to the filing of applications. According to the unambiguous wording of the exception (" ... persons having in a Contracting State ... may file European patent applications in an official language of that State"), the three conditions as to person, language and Contracting state (see Point 4, above) are interlinked, so that all of them must be fulfilled for the exception to apply. This is confirmed, *inter alia*, by Bob van Benthem e.g. in IIC Vol. 6 - No. 1/1975, page 3, and Kurt Haertel in Münchner Kommentar Artikel 14, Rdnr. 16 - 23 . Hence, skipping over one of these conditions (as the Appellant suggests) or even two of them (as in J 15/98) would be in breach of what is one of the core provisions of the Convention, and risks undermining the language regime set up therein.

These two reasons - nature of the reference as such and its context within the EPC - alone already lead to the conclusion that Article 80(d) EPC is to be construed as referring to the language regime set up by Article 14(1) and (2) EPC as a whole, including the "entitlement" to use languages under Article 14(2) EPC as a precondition for obtaining a filing date.

8. This finding is supported by the legislative history, the purpose and the impact of the language regime pursuant to Article 14(1) and (2) EPC, and its importance for the functioning of the European patent system.
- 8.1 The limitation to three official languages of the EPO was a historical breakthrough, reached as early as 1962

(Report on the 4th meeting of the Working Group "Patents", Doc. (EEC) IV/215/62, pages 94,95). It was a political compromise reached among the six States then represented in the working Group, among them only Italy and the Netherlands (then represented by Bob van Benthem) having an official language other than English, German or French, which was, as such, never put in question again (see Haertel, *loc. cit.*, Rdnr. 6 and 7). There was no need, and there is not the slightest hint of an intention, to include also third States into that compromise, by extending exceptions as regards the use of languages other than the three official languages also for their nationals. Rather, the whole arrangement of Article 14 EPC was always intended for residents and nationals of Contracting States only (van Empel, *The Granting of European Patents* (1975), Section No. 275; cf. Haertel, *loc. cit.*, footnote 16).

8.2 More specifically, as regards the meaning of " in an official language of that State" in Article 14(2) EPC (condition (c), Point 4, above) for the requirements of Article 80 EPC, Kurt Haertel has a clear position: If a European patent application, without the conditions of Article 14(2) EPC having been fulfilled, has been filed in an official language of a Contracting State which is not an official language of the EPO, then the application has no legal effects. Neither a date or filing nor a priority right is established thereby (*loc. cit.*, Rdnr. 26 "Inadmissible Languages").

8.3 Inevitably, restrictions as to the filing language, affect applicants differently, depending on their working language/mother tongue. The fact that English is one of the official languages the EPO might well, to

some extent, make life easier for an US company than for its Japanese competitor; an inventor having its residence in Spain or Portugal may be, when filing a European Patent application, better off than an inventor living in South America. But these are generally accepted repercussions, never considered to amount to a legally critical discrimination. More specifically, it could be argued that arrangements like that of Article 14 in conjunction with Article 80(d) EPC, whereby a - certainly not negligible - advantage is granted by the Contracting State concerned to its own nationals, which advantage is withheld from nationals of third States, is covered by the explicit reservation in Article 2(2) of the Paris Convention with regard to "provisions ... relating to judicial and administrative procedure" (van Empel, *loc. cit.*).

8.4 By the same token, possible difficulties arising where the language of the representative or the inventor is different from that of the applicant are no justification for construing Article 80(d) EPC as the appellant suggests. This is all the more so, since pursuant to Article 14(2) EPC the relevant person is the applicant and not the representative whom he can freely select, and not the inventor who can choose whether and to whom he transfers his right to the patent (Article 60(1) EPC).

8.5 True, the revised version of the EPC no longer contains language requirements in respect of the filing date of an application (see Articles 14(2) and 80, Rule 25d - OJ 2003, Special Edition No. 1). But that version is not yet in force and the Board's decision must be taken on the basis of the law as it stands. Furthermore, the

future language regime will be different from what would be the result from the interpretation of Article 80(d) EPC put forward by the appellant relying on J 15/98. That interpretation would have the consequence that relatively "rare" languages could be freely used by any applicant whereas widely spoken languages, such as Japanese, Chinese or Russian were excluded *per se*, so that - e.g. Japanese applicants, responsible for 16,64% (in 2004 - see Annual Report of the EPO, page 72) of the European applications, could file a European application in Greek or Lithuanian, but not in Japanese. Such an arrangement was never contemplated by the legislator, neither when laying down the original - and still prevailing - language regime of the EPC, nor when making the relevant rules for the future, as they will enter into force on 13 December 2007.

9. In view of these facts and considerations the Board sees no need for commenting on the question, whether decision J 15/98 was overruled by decision J 09/01, as it was argued in the decision under appeal. It suffices to point out that the latter contains nothing which is contrary to the Board's findings in the present case.

10. Pursuant to Article 112(1) EPC a referral of a question to the Enlarged Board of Appeal should be made if that is required for ensuring uniform application of the law or for settling an important point of law (see decision T 15/01, Point 40 of the reasons). The Board is not aware that Article 80(d) EPC has ever been interpreted as not including all conditions set out in the first sentence of Article 14(2) EPC, either in the first-instance practice of the EPO or, with the exception of

decision J 15/98, in the case law of the boards of appeal. Under these circumstances and in view of the fact, that the requirements in question will cease to exist when the Revised EPC 2000 will enter into force end 2007, a ruling of the Enlarged Board of Appeal is not necessary for the purposes set out in Article 112(1) EPC. Hence, the relevant request of the appellant has not been allowed.

11. The appellant's request for reimbursement of the appeal fee shares the same fate already for the reason that pursuant to Rule 67 EPC such reimbursement may only be ordered where the Board deems the appeal to be allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

J.-C. Saisset