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**Datasheet for the decision
of 23 October 2013**

Case Number: J 0001/12 - 3.1.01
Application Number: 04252760.6
Publication Number: 1595787
IPC: B64C9/02, B64C3/24, B64F5/00,
B29C70/44, B64C9/00, B29C70/86
Language of the proceedings: EN

Title of invention:

Method for fabricating a composite material control surface
for an aircraft.

Patent Proprietor:

Fuji Jukogyo Kabushiki Kaisha

Headword:

Assignment of a filing date and a priority date from an
earlier application filed under Art. 75(1)(b) EPC 1973 and
deemed withdrawn under Art. 77(5) EPC

Relevant legal provisions:

EPC 1973 Art. 77(5)

Keyword:

Assignment of lost filing date and lost priority claim to new
application (no)
Protection of legitimate expectations (no)

Decisions cited:

J 0018/96, J 0003/80, G 0005/88, G 0007/88, G 0008/88,
G 0002/97, J 0003/87, J 0014/94

Catchword:

The deemed withdrawal in Article 77(5) EPC 1973 is irreversible. The negative consequences for the applicant shall be equated by other means, in particular by refund options and the possibility to convert the European patent application into national applications. The assignment to a later application of a filing date belonging to an application deemed withdrawn under Article 77(5) EPC 1973 would circumvent this legislative will.



**Juristische Beschwerdekammer
Legal Board of Appeal
Chambre de recours juridique**

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Case Number: J 0001/12 - 3.1.01

D E C I S I O N
of Legal Board of Appeal 3.1.01
of 23 October 2013

Appellant: FUJI JUKOGYO KABUSHIKI KAISHA
(Applicant) 7-2, NISHISHINJUKU 1-CHROME
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office dated 14 July 2011**

Composition of the Board:

Chairwoman: B. Guenzel
Members: D. Prietzel-Funk
K. Garnett

Summary of Facts and Submissions

- I. This appeal lies against the decision of the Examining Division dated 14 July 2011 refusing the request to assign 19 December 2003 as the date of filing of the European Patent application 04 252 760.6.

- II. On 27 May 2004, the EPO received the application in suit, which had been filed with the UK Patent Office on 12 May 2004. The application claimed priority from the Japanese patent application JP 2002-374764 of 25 December 2002. On 21 September 2004, the Receiving Section of the EPO sent a communication to the applicant (hereafter: the appellant) and pointed to a deficiency in the application regarding the fact that the filing date of 25 December 2002 of the claimed priority document did not fall into the year preceding the application. It asked the appellant for clarification. No answer was given. Without further communication, the application was published on 16 November 2005 with the filing date of 12 May 2004 and without a priority date.

- III. By letter dated 13 June 2007, the appellant requested that a filing date of 19 December 2003 be assigned to the application in suit. It referred to the decision of the UK Patent Office dated 18 September 2006 (BL O/263/06), where it was concluded that a patent application had been received at the UK Patent Office on 19 December 2003 but then was misplaced in the UK Patent Office. On request of the Examining Division, the appellant submitted copies of that application and of the documents which were said to have been filed

with the UK Patent Office on 19 December 2003. After having examined these documents the Examining Division found it sufficiently proven that those documents were identical to those of the application in suit. However, nothing relating to that earlier application had been received by the EPO within the fourteen-month time limit of the priority date 25 December 2002 specified by Article 77(3) (5) EPC 1973.

- IV. By the impugned decision, dispatched on 14 July 2011, the Examining Division rejected the request of the appellant to assign the filing date of 19 December 2003 to the application in suit, holding essentially as follows:

With reference to Article 77(5) EPC 1973, a European patent application filed with a central industrial property office shall be deemed withdrawn if it does not reach the EPO before the end of the fourteen-month period after filing or after the date of priority. This was the case here. Since re-establishment of rights was not available, the applicant carried the risk of any delays in the transmission of the application to the EPO as well as for non-transmissions. The fact that no communication under Rule 41(3) EPC 1973 was issued and the loss of the priority right was not notified to the appellant under Rule 69(1) EPC 1973 did not avail the applicant under the doctrine of good faith with respect to the lost priority date. Thus, the time limit under Article 77(5) EPC 1973 could not be considered as having been met.

- V. The appellant filed a notice of appeal on 14 September 2011, paying the appeal fee on the same date. A statement of the grounds of appeal was received at the EPO on 23 November 2011.

- VI. Following the sending of a communication with the Board's provisional opinion of the case, the appellant filed comments on 24 May 2013.
- VII. Oral proceedings were held on 23 October 2013, during which the appellant requested that the decision under appeal be set aside and the filing date of 19 December 2003 and a priority date of 25 December 2002 be accorded to the European patent application, alternatively, that the filing date of 19 December 2003 and a priority date of 25 December 2002 be accorded to a new application to be filed with content identical to that of the present application.
- VIII. The appellant's arguments in support of these requests can be summarised as follows:
- The loss of the filing date as well as of the priority date of the application filed in December 2003 arose through no fault of the appellant, and the representative had taken all reasonable steps for a validly filed application in a responsible and thorough manner before the UK Patent Office. It would therefore be unfair to penalise the appellant in circumstances where all necessary steps had been undertaken by its representative in due time. Also the appellant was not warned by the UK Patent Office that there was a potential problem with the application. Had this been brought to the attention of the appellant earlier, action could have been taken much sooner.
 - It was within the power of the EPO to accord a new filing date to an application if it decided that this was appropriate. In the present case, no third party

would be disadvantaged by doing so. A European Patent application filed with a competent national office should have the same (legal) effect as if it had been filed on the same date with the EPO, thus the application should be accorded the same filing date as if it had been filed with the EPO itself, namely 19 December 2003.

- The appellant could have relied on the fact that the application would be published with the priority date, because (a) no communication under Rule 41(3) EPC 1973 was issued (b) the loss of the priority right under Rule 69 (1) EPC 1973 was not notified to the appellant and (c) the consequences of the failure to reply to the communication dated 21 September 2004 were not explained to the applicant. Thus, the appellant must be protected in its legitimate expectations, similarly to the appellant in the decision J 18/96 (1 October 1997), since it was entitled to believe that the application would be published with the priority date.

IX. At the end of the oral proceedings the Board announced its decision to dismiss the appeal.

Reasons for the Decision

The appeal satisfies the requirements of Articles 106 to 108 EPC and Rule 99 EPC and is therefore admissible.

Request to assign the filing date of 19 December 2003

1. The Board has to consider whether, contrary to Article 80 EPC 1973, it is justified to assign the application in suit the filing date of 19 December 2003 instead of 12 May 2004, the date on which the application in suit

was received by the UK Patent Office (Article 75(1)(b) EPC 1973). The reason why it is said to be justified is that the appellant had filed a European patent application with the UK Patent Office on 19 December 2003 with the same documents as those underlying the present application, but which, through no fault of the applicant, had never reached the EPO.

2. To begin with, the Board, for the purposes of this appeal, accepts as a fact that a European patent application claiming 25 December 2002 as priority date was filed on 19 December 2003 with the UK Patent Office with identical documents as those underlying the present application.
3. The legal framework for the correct processing of European patent applications filed with a central industrial property office of a contracting state within Article 75(1)(b) EPC 1973 such as the UK patent office is as follows:

Article 77(2) EPC 1973 provides that such European patent applications - apart from those which are subject to certain secrecy provisions under Article 77(1) EPC 1973 - are to be forwarded to the EPO within six weeks after filing. Article 77(5) EPC 1973 supplements this provision by providing for the legal consequences if European patent applications do not reach the European Patent Office before the end of the fourteenth month after filing or, if priority has been claimed, after the date of priority. It stipulates that these applications shall be deemed to be withdrawn. This happens irrespective of the reasons why the applications do not reach the EPO and as well by operation of law.

4. It follows from Article 77(5) EPC 1973 that the European patent application filed on 19 December 2003 with the UK Patent Office is deemed to have been withdrawn, because no documents concerning this application reached the EPO at any time. In such a situation, no re-establishment of rights is provided for, since the EPC provides for re-establishment of rights only in situations where there has been a failure to observe a time limit which it is for the user to observe. This was not the case here.
5. There being no provision in the EPC itself to help the appellant, it has to be considered whether there is any basis on which it might nevertheless be equitable to "re-install" it (the appellant's word) to a position in which it would have been if the application filed on 19 December 2003 had reached the EPO in due time, by assigning its filing date to the application in suit.
6. In the Board's view, several considerations argue against such a result.

The Board does not see that a decision to assign the earlier filing date would comply with the will of the EPC legislator, as derived from the purposeful understanding of the context of the relevant provisions of the EPC. Article 77(5) EPC 1973 EPC provides that an application which does not reach the EPO within a certain time limit is deemed to be withdrawn. This applies even if this was not the fault of the applicant. In such a situation the legislator expressly provided in the last sentence of Article 77(5) EPC 1973 for the refund of the filing, search and designation fees. In addition, Articles 135(1)(a) and 136(2) EPC provide facilities for a conversion of the lost European patent application into national patent

applications. It follows that the legislator of the EPC clearly recognized the harsh consequences of Article 77(5) EPC 1973 for an applicant. But, having recognised the problem, the legislator did not provide for the possibility of the applicant regaining the lost application. Instead, the choice was made of the irreversibility of the deemed withdrawal, and for the harsh consequences for the applicant to be compensated by means other than the revival of the lost application, in particular by the refund options and the possibility of converting the European patent application into national applications. It has already been decided by the Legal Board of Appeal that these refund options are to be seen as a clear alternative to the missing possibility of restoration of rights (J 3/80 of 31 January 1980, Point 5 of the Reasons).

The designation of a filing date belonging to a lost application to the application in suit would thus clearly circumvent the legislative will.

The EPO has no discretion to review filing dates as it might like. In the case at hand, the legal framework does not permit the correctly assigned filing date to be changed. Thus, the question whether or not somebody was perhaps disadvantaged by an earlier filing date is of no relevance for this decision.

Having established this interpretation of Article 77(5) EPC, the Board cannot accept as relevant the argument of the appellant that it should not be penalised for mistakes that happened in the UK Patent Office regarding the earlier application. Possible errors made by the UK Patent Office occurred during the processing of the earlier application that is deemed to have been withdrawn and thus irremediably lost, not during the

processing of the application in suit. Consequently nothing can be made of the argument of the appellant that it was not warned by the UK Patent Office that there was a potential problem with the (first) application.

7. Regarding the appellant's assertion that Article 75(1) (b) EPC leaves no room for a distinction between the earlier and later applications in suit, the Board agrees that this provision foresees for a European patent application filed with a national Receiving Office to have the same (legal) effect as if it had been filed on the same date with the EPO. But the appellant's argument fails to acknowledge that the European patent application of December 2003 is deemed to have been withdrawn (Article 77(5) EPC 1973), and as a consequence lost its legal effectiveness, e.g. as to its filing date, irreversibly. Thus, no legal effect can be derived from this lost application.

As a result the board concludes that this request is not allowable.

Request to assign the priority date of 25 December 2002

8. As regards this request, the appellant relies on the principle of the protection of its legitimate expectations, arguing that it could have expected that the application in suit would be published with the claimed priority date because no notification of loss of rights was communicated by the European Patent Office.
9. It is established jurisdiction of the Boards of Appeal that the principle of protection of legitimate

expectations applies in proceedings before the EPO (e.g. decisions of the Enlarged Board of Appeal G 5/88, G 7/88, G 8/88 OJ EPO 1991, 137, Nr.3.2; G 2/97, OJ EPO 1999, 123). Users of the EPO are to be protected in their legitimate expectations and are not to be disadvantaged by conduct of the Office which was misleading or irregular (J 3/87, OJ EPO 1989,3; J 14/94, OJ EPO 1995, 824).

10. In the present case the Board judges that the principle of protection of legitimate expectations is not applicable in favour of the appellant. Nothing in the conduct of the EPO could have given rise to a belief on the appellant's behalf that the application in suit would have assigned to it, and would be published with, the priority date.

11. Firstly, in the letter of the Receiving Section dated 21 September 2004 the appellant was made aware of the fact that the filing date of 25 December 2002 of the claimed Japanese priority application did not fall within the year preceding the filing of the European patent application on 12 May 2004. With this communication the appellant was asked for clarification, but it did not answer. Contrary to the view of the appellant, this communication could not have given rise to any relevant legitimate expectation on behalf of the appellant; on the contrary, it could only have had the reverse effect.

Secondly, as a matter of fact, it was quite clear and indeed not disputed by the appellant that the priority date of the Japanese patent application had been irremediably lost for the application in suit before it was filed on 12 May 2004. According to the submissions of the appellant, the application in suit was only

filed after the appellant had found out that the earlier application had never reached the EPO. Therefore the Board concludes that the appellant could not reasonably have expected to have this priority date granted, irrespective of the fact that the EPO had informed it by the communication of 21 September 2004 about the missing preconditions.

Thirdly, the fact that the priority date was lost did not depend on a communication according to Rule 69(1) EPC 1973 or any other communication. Rather this was a consequence of the fact that the earlier application, together with the priority documents, never reached the EPO. No communication of the EPO before or after the publication of the application in suit could have prevented the loss of the priority date, which had already happened before the filing of the application in suit.

As a result, the Board concludes that there is no way to assign to the application in suit the priority date from the Japanese patent application.

The request to accord a filing date of 19 December 2003 and a priority date of 25 December 2002 to a new application with the same documents

12. The above considerations apply *mutatis mutandis* all the more to an application which is not even filed yet. However, in the absence of a first instance decision having been given on this issue, it is not a subject of the present appeal. This request is therefore also not allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairwoman:



C. Eickhoff

B. Guenzel

Decision electronically authenticated