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D E C I S I O N
of 6 February 1996

Case Number: J 0011/93 - 3.1.1
Application Number: 91915567.1
Publication Number: WO 92/02937
IPC: G21K 5/10

Language of the proceedings: EN

Title of invention:
X-ray backscatter detection system

Applicant:
IRT Corporation

Headword:
IRT Corporation

Relevant legal provisions:
EPC Art. 133(2), 134(1)
PCT Art. 48(2)(a)
EPC R. 78(2), 78(3), 81

Keyword:
"Notifications to applicants"

Decisions cited:
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Catchword:
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Boards of Appeal

Chambres de recours

Case Number: J 0011/93 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 6 February 1996

Appellant:

IRT CORPORATION
6020-300 Cornerstone Court West
San Diego
California 92121 (US)

Representative:

Wilson, Nicholas Martin
WITHERS & ROGERS
4 Dyer's Buildings
Holborn
London EC1N 2JT (GB)

Decision under appeal:

Decision of the Receiving Section of the European Patent Office dated 14 May 1993 according to which European PCT application No. 91 915 567.1 is deemed to be withdrawn.

Composition of the Board:

Chairman: R. L. J. Schulte
Members: J. P. B. Seitz
G. Davies

Summary of Facts and Submissions

- I. International patent application PCT/US91/05558 was filed with the US PTO acting as receiving office on 5 August 1991 by US professional representative Neil F. Martin, in the name of IRT Corporation, 3030 Callan Road, San Diego CA 92121 (USA).

The application designated the EPO for the purpose of obtaining a European patent and claimed the priority of US patent applications:

- US 563 041 of 6 August 1990
- US 704 292 of 22 May 1991.

- II. On 12 March 1992 the Receiving Section of the EPO informed Mr Martin, the US representative, of the procedural steps to be taken for entry into the regional phase before the EPO.

By letter dated 30 September 1992 sent directly to the applicant company, the Receiving Section of the EPO informed it pursuant to Rule 85(a)(1) EPC that the due fees had not yet been paid but that they could still validly be paid within a period of grace of one month from notification of said communication together with a surcharge.

- III. On 6 November 1992 Mr N. M. Wilson, European patent attorney, acting on behalf of the applicant "as will be seen from the authorisation ... of copending application 87301332.0", filed a Form 1200 in order to enter the European regional phase of the application, and ordered that the due fees plus surcharge be debited from his account.

IV. By letter dated 26 November 1992, the Receiving Section of the EPO informed the European professional representative that they had already sent the applicant a communication according to Article 49 PCT and Article 133(2) EPC giving it the opportunity to pay the fees within the prescribed time limit and that nevertheless the applicant had failed to comply with the requirements prescribed by Rule 104b(1) EPC within the period of grace, which had expired on 30 October 1992.

On the same day i.e. on 26 November 1992, the Receiving Section sent the European representative a notification pursuant to Rule 69(1) EPC informing him that the European application was deemed to be withdrawn.

In his answer dated 1 December 1992 the European representative pointed out that the applicant, not having either its residence or principal place of business within the territory of one of the Contracting States, had to be represented by a professional representative. Since in the present case, as indicated in the previous letter dated 6 November 1992, the applicant was already represented by him, it was incumbent on the EPO to address every letter to the appointed representative.

Moreover, had the letter dated 30 September 1992 been correctly forwarded to the European attorney, it would then not have been deemed to have been delivered until the tenth day following its posting, i.e. on 10 November 1992, so that the requirements of Rule 104b(1) EPC would indeed have been complied with within the stipulated period of grace.

V. By request dated 12 January 1993 the applicant formally applied for a decision on the withdrawal of the application, under Rule 69(2) EPC.

Subsequently, the applicant submitted in a letter dated 26 February 1993 that the authorisation filed in respect of European patent application No. 87 301 332.0 had been intended to be a general one in order to allow the then appointed attorney to represent the applicant in respect of all matters before the EPO.

It was also pointed out that the said authorisation bore no number or title specific to a particular application so that it should be deemed to be a general power. Therefore, the communication pursuant to Rule 85a(1) EPC should have been sent to the attorney already empowered and not directly to the applicant, and with respect to the provisions of Rule 78(3) EPC the fees paid on 6 November 1992 had been paid within the period of grace.

VI. On 14 May 1993 the Receiving Section of the EPO decided as follows:

- The representative's request of 26 February 1993, under Rule 69(2) EPC, for proceeding before the European patent office is rejected.
- The application No. 91 915 567.1 is deemed to be withdrawn. The national fees and surcharges paid on 10 November 1992, will be refunded.

VII. On 7 July 1993 the applicant lodged an appeal against this decision and paid the corresponding fee.

In its statement of grounds of appeal dated 24 August 1993 and received at the EPO on 26 August, the applicant essentially submitted that the official communication under Rule 85a(1) EPC should have been sent to the authorised European representative since he had been

duly empowered to act on behalf on the applicant by a general authorisation filed with the EPO on 17 February 1987 together with another European patent application bearing No. 87 301 332.

As regards the significance of said document, the appellant submitted that, had it been unclear for the addressee because it bore neither application number nor any other indication linking it to a specific application, it was then incumbent on the EPO to query the exact meaning of the form.

It was further pointed out that the payment of fees can be done by any person and that it was inconsistent to send a first official communication to the representative in the international phase, i.e. Neil Martin et. al. in San Diego (USA) and a second communication pursuant to Rule 85a(1) EPC directly to the applicant, who was not deemed to be aware of every procedural step to be followed before the EPO.

Concerning the notification of the communication dated 30 September 1992, it was submitted that Rule 78(2) EPC does not mention "applicants" but only "addressees" not having either their residence or their principal place of business within the territory of one of the Contracting States. Therefore, in the absence of a European representative, the correct addressee was to be understood as being the representative appointed for the international phase.

Moreover, the practice of the EPO of following the Legal Advice No. 18/92 was wrong at least with respect to payment of fees, since no provision of the EPC expressly required that communications under Rule 85a EPC be sent

directly to the applicant rather than to their already appointed professional representative for the international phase, whose duty it was to deal with the complexities of patent law and procedure.

An applicant not being aware of these rules would simply assume that any mail received from the EPO had already been received by his representative, wherever his residence might be, and would therefore not pay any particular attention to it.

In conclusion, the applicant submitted that it was contrary to the principle of good faith governing relations between the EPO and an applicant to send directly only to the latter official communications with respect to payment of fees when a representative had been specially appointed to take all necessary actions in order to maintain the application.

VIII. It was requested that the decision under appeal be set aside, and that the application be allowed to proceed.

IX. In a communication dated 2 December 1994 the rapporteur of the Board informed the appellant that at first sight the appeal was to be rejected for the following reasons:

- The notification under Rule 85a(1) was correctly sent to the applicant itself since it had neither residence nor principal place of business within the territory of one of the Contracting States and it had therefore to be represented by an authorised representative and act through him in all proceedings established by the EPC.
- The authorisation filed with the application No. 87 301 332.0, although bearing no precise indication, could not be considered to be a general

authorisation, it being also noted that the recommended Form 1004 (OJ EPO 1992, 85) had not been used.

- Therefore the notification dated 30 September 1992 was deemed to have been made when its despatch took place, even if the addressee never in fact received it.
- The Receiving Section of the EPO first became aware of the change of address of the applicant in February 1993, i.e. after the loss of rights occurred.

X. In its response dated 29 June 1995 the appellant made the following observations:

- Although the applicant had neither residence nor principal place of business within the territory of one of the Contracting States, and assuming that it had no European authorised representative, the notification under Rule 85a(1) should not have been sent to the applicant himself since the latter could not in the case in suit be the "addressee" specified by the provisions of Rule 78(2) EPC.

In fact in cases such as the present one where the applicant has already appointed a professional representative for the international phase, albeit a representative not entitled to act before the EPO, it was then incumbent on the EPO to send every notification to that representative rather than only to the applicant itself who was not supposed to be aware of every fine distinction of the procedure before the EPO.

This was all the more necessary when the office had taken the first step of dealing directly with the agent appointed during the international phase of the application, although he was not entitled to act before it.

- The applicant then reiterated that the authorisation filed with the previous application No. 87 301 332.0, although not being a EPO recommended Form 1004, did not bear any precise indication allowing to connect it with a specific patent application. If the EPO had had any doubt about its significance, it should have sought clarification in that respect.

XI. In its last statement in writing dated 19 January 1996, the appellant emphasized the following additional points:

- Euro PCT applicants should enjoy the same rights as Euro applicants. This was not the case where the appellant was at a disadvantage simply because the notification directly sent to him was deemed to have been made when despatch took place, whereas a notification made to an applicant having its residence within the territory of one of the Contracting States would in fact result in an additional period of grace in favour of the addressee, whose payment in this particular case would have been deemed to have been made in time.
- The legal advice No. 18/92 according to which notifications under Rule 85b shall be forwarded to a non-European applicant by means of ordinary mail at its last known address is inconsistent especially when the EPO has already directly dealt with the appointed US representative.

XII. The appellant stood by its previous requests, and oral proceedings were held on 6 February 1996.

Reasons for the Decision

1. The appeal is admissible.
2. As stated in the previous communications dated 2 December 1994 and 22 March 1995, the Legal Board of Appeal has no competence at the present stage of the proceedings to consider the application under Article 122 EPC for re-establishment of rights. In fact, it is for the Receiving Section of the EPO being the first instance to decide upon such a request but it may not take any action until the Legal Board of Appeal has taken a decision on the pending appeal.
3. Regarding the appeal itself, it must be rejected for the following reasons:
 - 3.1 According to Article 133(1) EPC, natural or legal persons not having either a residence or their principal place of business within the territory of one of the Contracting States must be represented by an authorised representative and act through him in all proceedings established by the EPC, other than in filing the European patent application.

Being a company having its seat in the United States of America, IRT Corporation had to be represented by an authorised representative for the purpose of the regional phase before the EPO.

- 3.1.1 As regards this issue, the appellant contends that it was in fact duly represented by Mr Wilson of Withers & Rogers, authorised representatives, as should have been seen from the general authorisation filed together with copending European patent application No. 87 301 332.0.
- 3.1.2 A copy of said authorisation dated 30 January 1987 is on the file, bearing no application number. Also no cross has been placed in the pre-printed boxes of the filed EPO Form 1003 which is normally used to cover one or several specific European patent applications, in order to fulfil the provisions of Rule 101(1) EPC.
- 3.1.3 As correctly stated by the first instance, nothing in the said document allowed the Receiving Section to understand the applicant intended that it had to be regarded as a general power rather than as a specific one for the sole purpose of proceeding with the application together with which it had been filed.
- 3.1.4 The fact that in a letter dated 26 February 1993 the applicant confirmed that its intention at that time was to enable Withers & Rogers to act in respect of all patent transactions before the EPO, cannot **a posteriori** render wrong the interpretation the Receiving Section made of the document on receipt thereof.

Moreover, since the usual recommended Form 1004 for general powers had not been used, no doubt could reasonably subsist in the mind of the Receiving Section such as to induce it to query the real scope of the filed authorisation.

The Board also makes the observation that the authorisation-in-suit has never been registered by the EPO as being a general one, and that even if it had been so registered it would then have been incumbent on the

applicant to communicate the number allotted to the general authorisation so that the Receiving Section could take it into consideration before sending the communication pursuant to Rule 85a(1) EPC to the applicant itself at its last known address, rather than to the representative.

Under these circumstances the Board considers that when said communication was issued on 30 September 1992 no European professional representative had yet been appointed by the applicant.

3.2 Hence the provisions of Rule 81 EPC, according to which - if a representative (i.e. a European one) has been appointed - notifications shall be addressed to him, could not apply but consequently only those of Rule 78(2) EPC relating to notifications in respect of **addressees** not having either a residence or place of business in one of the Contracting States and who have not appointed an authorised representative.

3.2.1 Such notifications shall be effected by ordinary mail bearing the last address of the addressee, and shall be deemed to have been made when despatch has taken place.

However, in the present case the appellant disputes that the **addressee** as meant by Rule 78(2) EPC must be understood as being the applicant himself rather than his representative appointed for the international phase although not entitled to act before the EPO.

In the Board's view, this opinion cannot be accepted since on the one hand Rule 78(2) construed in conjunction with Rule 81 EPC unambiguously excludes an unauthorised representative from the addressees it refers to, and since on the other hand the EPO would violate the provisions of Articles 133(2) and 134(1) EPC

if it happened to send a notification to an unauthorised representative other than for the sole purpose of the filing of the European patent application.

Moreover, the wording "addressee" in Rule 78(2) EPC clearly encompasses not only applicants but also other parties to the proceedings before the EPO, e.g. opponents, parties as of right, etc...

3.2.2 Nor can the Board agree with the contention of the appellant according to which the discrepancy between Rule 78(2) and Rule 78(3) EPC is to the disadvantage of non-European applicants and contravenes therefore the principle of equality of rights every applicant for a European patent must enjoy.

In fact as regards this issue it cannot be contended that the differences between the aforesaid Rules, which result in an advantage for applicants having their residence within the territory of one of the Contracting States, constitute a violation of the provisions of Article 48(2)(a) PCT which shall prevail in case of conflict, according to Article 150(2) EPC.

Simply, the principle of equality of rights is complied with by the fact that:

- Euro-PCT applicants and Euro applicants not having a residence within one of the EPC Contracting States and not duly represented receive notifications by ordinary mail which is deemed to be delivered at the day of its despatch,
- on the contrary, both Euro-PCT applicants and Euro applicants resident within the territory of one of the Contracting States enjoy the benefit of notifications under Rule 78(3) EPC.

Therefore, Euro-PCT applicants and Euro applicants are treated on the same footing by the EPO.

3.2.3 The Board wishes to emphasize in this respect that any disadvantage resulting in respect of notifications for applicants not having a residence in the Contracting States is the result of the intention of the authors of the Convention, and that although provisions of law may be interpreted if unclear, they cannot be modified on the pretext of lack of clarity.

3.3 As regards the other argument put forward by the appellant, relating to the principle of good faith governing relations between the EPO and applicants, the Board makes the following observations:

In the letter dated 12 March 1992 sent directly to the representative appointed during the international phase, the latter was duly informed that **any future** notification or matter would be addressed exclusively to the applicant itself, respectively its European representative, if the appointment of the latter were to be communicated to the EPO in due time.

Therefore, the appellant cannot pretend that the EPO's attitude was inconsistent when it sent the communication pursuant to Rule 85a(1) EPC to the applicant, who at the time had not yet appointed an authorised representative.

3.4 Finally concerning the rule of proportionality referred to by the appellant, it must be borne in mind that it only applies in borderline cases, i.e. not in the case in suit, in support of other grounds already substantiating to a certain extent the allowance of the appeal.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:



M. Beër

The Chairman:



R. L. J. Schulte