

EJ0015.98 - 003677434

## **DECISIONS OF THE BOARDS OF APPEAL**

**Decision of the Legal Board of Appeal dated 31 October 2000**

**J 15/98 - 3.1.1**

(Language of the proceedings)

Composition of the board:

Chairman: J.-C. Saisset

Members: V. Di Cerbo

M. K. S. Aúz Castro

**Applicant: Benas de Brigante, Norah Martha**

**Headword: Filing date/BENAS DE BRIGANTE**

**Article: 14(1) and (2), 80, 78(2), 90(3) EPC**

**Rule: 9(1) RFees**

**Keyword: "Preliminary and formalities examination - accordance of a date of filing - language of the filed documents" - "Rules common to all proceedings - language privilege"**

*Headnote*

*An application filed in one of the languages referred to in Article 14, paragraphs 1 and 2, produces the result provided for in Article 80 EPC, ie a date of filing is attributed, irrespective of the fact that the applicant neither has its residence or*

*principal place of business in a Contracting State nor is a national of a Contracting State, provided that all the other requirements of Article 80 EPC are satisfied.*

### **Summary of facts and submissions**

I. European patent application No. 97 500 145.4, claiming the priority of a Uruguayan patent application filed on 26 August 1996, was filed in the Spanish language on 25 August 1997 at the Spanish Patent and Trademarks Office (Oficina Española de Patentes y Marcas) by a European representative.

The application was forwarded to the European Patent Office under Article 77(1) EPC and was received on 4 September 1997. On the same date 80% of the filing fee and the search fee were paid.

A translation of said application was received by the Receiving Section of the EPO on 16 September 1997.

II. By a communication pursuant to Rule 39 EPC dated 22 October 1997 the representative of the applicant was informed that his client was not entitled to the benefit of Article 14(2) EPC because her nationality was Uruguayan and her place of residence was in Uruguay and that the filing fee had to be paid without any reduction. Furthermore the European patent application did not meet the requirements laid down in Article 80 EPC for according a date of filing, since the description and the claims were not filed in one of the languages referred to in Article 14(1) and (2) EPC. Since in the meantime, however, a translation in English of the application had been filed, the date of receipt of said translation (i.e. 16 September 1997) had been accorded as filing date to the European patent application. Finally it was mentioned in the communication that the date of the Uruguayan patent application no longer lay within the 12-month period for claiming priority and that, accordingly, there was no right to priority.

Communication of the loss of the priority right was sent on 17 December 1997 pursuant to Rule 69(1) EPC.

With fax sent on the same date the applicant objected to the change of the filing date of the application and the rejection of the claimed priority by the Receiving Section.

In a communication under Article 113 EPC it was confirmed to the representative that the date of filing of the European patent application was 16 September 1997; the representative was invited to file further comments up to 22 March 1998.

In a letter received on 13 March 1998 the representative admitted that due to an administrative oversight, a mistake had been made regarding the language used when filing the European patent application, but submitted that this mistake could have been corrected if the Receiving Section had informed him in time, i.e. on 25 August 1997. The application of the principle of good faith was invoked.

III. In a decision posted on 9 April 1998 the Receiving Section rejected the applicant's requests to allow 25 August 1997 as date of filing of the patent application in suit and to re-establish the priority right.

The reasons given by the Receiving Section for its decision can be summarised as follows:

(a) since the applicant is Uruguayan and Uruguay is her state of residence or principal place of business, she is not entitled to claim the benefit of Article 14(2) EPC; it follows that the date of filing the application can only be the date of filing the application in English, i.e. 16 September 1997;

(b) since the application forwarded by the Spanish Patent Office arrived at the EPO only on 4 September 1997, when the priority had already expired, the Receiving Section could no longer warn the representative about the deficiency in the application. Indeed on 4 September 1997 no correction was allowable any more. Therefore the principle of good faith could not be applied to the present case.

IV. On 4 June 1998 a notice of appeal against the decision of the Receiving Section was filed by the applicant. On the same date the appeal fee was paid.

On 6 August 1998 the statement of grounds of appeal was filed. The appellant requested that the error made when filing the application be considered "to have been put right" and that the priority right claimed be respected, modifying the date of filing accorded, which should be 25 August 1997.

The appellant's submissions are summarised as follows:

(a) The statement of the Receiving Section that the principle of good faith could not be applied to the case in suit for the reason that the patent application had been filed before the Spanish Patent Office rather than before the EPO is contrary to the regulations of the EPC governing the filing of patent applications. Indeed, according to Article 75 EPC a European patent application may be filed, if the law of a Contracting State so permits, at the central industrial property office or other competent authority of the state; an application filed in this way shall have the same effect as if it had been filed on the same date at the European Patent Office. Hence the appealed decision did not apply this provision correctly, since it implied that the effects of filing an application before the office of a Member State were different from the effects of filing an application before the EPO. Furthermore, pursuant to Rule 24 EPC, the national patent offices were obliged to carry out the formal check, or at least a visual one, of the document handed over. It followed that drafting the patent application in Spanish was a mistake that could have been immediately demonstrated if the ex officio examination had been carried out on time, since said mistake could have simply been deduced from checking the nationality of the applicant. In other words, given that according to the principle of good faith the EPO should contact the applicant in case of formal irregularities if they could be easily identified and rectified in due time, the national offices of the contracting States, when they were acting as Receiving Sections should also do the same, or at least the possibility of a subsequent correction should be allowed.

(b) The refusal by the Receiving Section to apply Rule 88 EPC, justified with the assumption of the non-applicability of said provision to the case in suit since the intention to file the application in English was not obvious, could not be agreed with. Indeed the intention of the applicant was always to claim the priority of the Uruguayan application, as could be inferred from the fact that said priority was claimed on the first filing date. The filing of the application in English being only a formal requirement, it was clear that it would have been met if the obvious mistake had not been made.

### **Reasons for the decision**

1. The appeal complies with Articles 106 to 108 and Rules 1(1) and 64 EPC and is therefore admissible.

2. The appeal concerns the question whether the appellant is entitled to 25 August 1997 as filing date of the patent application in suit with the consequence that the formal requirements for claiming the priority of the Uruguayan patent application would be fulfilled.

Indeed, because of the shifting of the filing date to the date when an English translation of the application was received by the EPO (i.e. 16 September 1997), the claimed priority right could not otherwise be recognised since the one-year time limit from the date of filing of the first patent application had already expired.

3. The appeal shares the rationale of the decision of the Receiving Section, according to which, for the date when the application was filed with the Spanish Patent Office to be accorded as filing date, the said application should have been filed in English. As explained below, however, this starting point is based on an erroneous interpretation of the relevant provisions and therefore the Board, in the exercise of its power to interpret the law, is enabled to reach a decision on the case in suit without recourse to the submissions of the appellant.

4. A European patent application may be filed at the central industrial property office of a Contracting State and has the same effect as if it had been filed on the same date at the EPO according to Article 75(1)(b) EPC.

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 cited under (a), (b), (c) and (d) whereby the description and claims must be either in an official language of the EPO, or in one of the other languages of the Contracting States which is authorised by Article 14(2) EPC.

In the case in suit the application was filed in an official language of a Contracting State other than English, French nor German i.e. in the Spanish language by an applicant who had neither her residence nor principal place of business in a Contracting State, nor was she a national of a Contracting State.

Spanish is an official language of a Contracting State and is as such one of the authorised languages according to Article 14(2) EPC.

The core of the problem in the present case is therefore to decide whether the facts that the applicant did not have her residence or principal place of business in a Contracting State and was not a national of a Contracting State means that the application failed to meet the formal language requirement at the date of filing before the Spanish patent office.

The solution to this problem depends on the interpretation of Article 80(d) EPC.

This provision refers to "... one of the languages referred to in Article 14, paragraphs 1 and 2, ...", "... in einer der in Artikel 14 Absätze 1 und 2 vorgesehenen Sprachen ...", "... dans une des langues visées à l'article 14, paragraphes 1 et 2 ...".

According to the literal construction of this provision in all three official languages it seems to be clear that the reference to Article 14 is made only to identify the possible

languages to be used. No reference is made to the entitlement to use these languages.

If this interpretation is correct, then an application in Spanish would produce the result provided for by Article 80 EPC, i.e. the date of filing.

Indeed the aim of Article 80 EPC is to accord a filing date according to the date of filing of a European patent application. Spanish is an official language of a Contracting State. Pursuant to Article 14(2) EPC it is possible to use Spanish to file an application. It follows that according to the EPC an application filed in the Spanish language can be accorded a filing date. The effects deriving from the filing date are the same whether the applicant is a national or has his residence in a Contracting State or whether the applicant 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.

The wording of Article 14(2) EPC also seems to be compatible with the above interpretation since this provision has no statement concerning or even referring to the according of a date of filing to European patent applications.

It follows from the above that according to Article 14(2) EPC an application in one of the languages of the Contracting States other than the official languages of the EPO is possible and according to Article 80(d) EPC said application is accorded as date of filing the date it was filed in this language.

The above conclusions are supported by the views of commentators: see in particular: *Singer*, Europäisches Patentübereinkommen, 1989, Article 80 Rdnr. 2; *Lunzer*, The European Patent Convention, Revised English Edition by Lunzer, London 1995, Article 80.02; *Bossung*, Münchener Kommentar 1986, Artikel 80 Rdnr. 63; see also *Singer/Stauder*, Europäisches Patentübereinkommen, 2. Auflage 2000, Artikel 80, Rdnr. 14.

It follows that 25 August 1997 is the filing date to be accorded to the application in suit. It further follows that the appellant's request of concerning the grant of the priority date on the basis of the Uruguayan patent application filed on 26 August 1996 is allowable.

In this context the Board does not agree with the example given in the Guidelines for Examination A.VIII.3.1 with regard to the interpretation of Article 80(d) EPC.

5. The appellant has not challenged the decision of the EPO that he was not entitled to a 20% reduction in the filing fee. This decision is indeed totally correct, since, as is apparent from the above, the applicant is a national of a non-Contracting State and therefore has no right to this benefit.

The payment of the remaining 20% of the filing fee (ie DEM 50) took place on 16 October 1997, and therefore, according to the Receiving Section statement, which considered 16 September 1997 as the filing date, within the time limit (one-month) provided for in Article 78(2) EPC.

The direct consequence of the present Board's finding, ie that 25 August 1997 is to be considered as the filing date, is that the payment of the 20% of the filing fee took place too late, ie after the expiry of the above one month time limit cited.

Since this problem is closely linked to the granting of the requested filing date, and therefore is to be considered within the subject-matter of the appellant's request, the Board considers that this delay should not involve the applicant in the consequence provided for in Article 90(3) EPC.

Pursuant to Article 9(1), fourth sentence, of Rules relating to Fees, any small amounts lacking may be overlooked without prejudice to the rights of the person making the payment, where this is considered justified.

The Board is satisfied that all these conditions are fulfilled in the case in suit. In particular the applicant's error in paying only 80% of the filing fee in due time can be



excused since it resulted from an understandable mis-interpretation of the provisions provided for in Article 14(2) EPC and since the applicant acknowledged this (and paid the missing 20%) as soon as the Receiving Section made her aware that she was not entitled to the 20% reduction. Furthermore, according to the prevailing case law of the Boards of Appeal a missing amount of up to 20% may be considered to be a small amount (see T 290/90, OJ EPO 1992, 368; J 27/92, OJ EPO 1995, 288; T 161/96, OJ EPO 1999, 331). Decision T 905/90, OJ EPO 1994, 306, Corr. OJ EPO 1994, 556, cannot be considered as deviating from the above case law since it only introduces a discretionary element in the evaluation of the "smallness".

### **Order**

#### **For these reasons it is decided that:**

1. The decision under appeal is set aside;
2. The case is remitted to the Receiving Section with the order to award 25 August 1997 as the filing date.