

CHAMBRE DE RECOURS JURIDIQUE

2 NOVEMBRE 1983

J 03/83

DOSSIERS BREVETS 1983.VI.J1

G U I D E D E L E C T U R E

DESIGNATION D'ETAT.RESTITUTIO IN INTEGRUM

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I - LES FAITS

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| 31 mai 1978 | : Dépôt d'une demande nationale de Brevet en Grande Bretagne par Associated Engineering Italy S.p.A (A.E.I) |
| 2 mai 1979 | : A.E.I. dépose, sous couvert de la priorité britannique et par l'intermédiaire d'un mandataire, une demande de brevet européen (n° 79300743.6) désignant six états contractants de la Convention de Munich. |
| 12 décembre 1979 | : Publication de la demande de brevet européen par l'O.E.B. |
| 13 mars 1981 | : A.E.I. demande que l'Italie soit ajoutée aux six états précédemment désignés et paie une taxe de désignation supplémentaire |
| 21 janvier 1982 | : Un fonctionnaire de la 2° Direction générale de l'O.E.B. notifie au déposant le rejet de la requête en correction, considérée comme tardive. |
| 16 mars 1982 | : A.E.I. exerce un recours en application de l'art. 69 §2 de la C.B.E. |
| 13 mai 1982 | : Le Président de la 2° Direction générale de l'O.E.B. rejette le recours. |
| 25 mai 1982 | : A.E.I. fait appel devant la Chambre de recours juridique. |
| 2 novembre 1983 | : La Chambre de recours juridique rejette l'appel. |

II - LE DROIT

1er problème : COMPETENCE DE LA CHAMBRE DE RECOURS JURIDIQUE

A - LE PROBLEME

1°/ Prétentions des parties

Le demandeur

prétend que le rejet de sa demande en correction a été prononcée par une instance incompétente pour appliquer la règle 88 qui aurait été le texte pertinent.

2°/ Enoncé du problème

La chambre de recours juridique peut-elle statuer sur l'appel contre une décision rendue par une instance incompétente de l'O.E.B. ?

B - LA SOLUTION

1°/ Enoncé de la solution

"In accordance with article 10, Rules of Procedure of the Board of Appeal (Official journal EPO 1/1983,?) a Board shall the case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, inless spécial reasons present themselves for doing otherwise".

2°/ Commentaire de la solution

La Chambre de recours rappelle que la requête en correction de désignation d'états peut être examinée au titre de la règle 88 et non de la règle 69 (att.nr. J 10/82, J.O. OEB, 3/1983,94). Or la 2° Direction générale avait reçu compétence exceptionnelle pour appliquer la règle 69 mais non la règle 88 qu'elle aurait du utiliser dans l'espèce.

La Chambre de recours reconnaît qu'il y a là "une déficience fondamentale" dans la procédure, qui lui permet de renvoyer l'affaire devant le département qui aurait été compétent en première instance.

Toutefois, des circonstances exceptionnelles peuvent justifier l'examen d'une telle demande par la Chambre de recours juridique. Elle admet la présence de telles circonstances en l'espèce et se déclare compétente pour statuer. Les circonstances exceptionnelles consistaient dans l'accord du demandeur et dans la présentation de l'ensemble du dossier devant la Chambre de recours.

2ème problème : BIEN FONDE DE LA DEMANDE DE CORRECTION

A - LE PROBLEME

1°/ Prétentions des parties

Le demandeur

prétend qu'il est possible de corriger la demande de brevet européen en ajoutant un Etat désigné, même après la publication de la demande.

2°/ Enoncé du problème

Est-il possible de corriger la désignation des Etats après publication de la publication de la demande de brevet européen ?

B - LA SOLUTION

1°/ Enoncé de la solution

"The appellants have failed to establish that the granting of the request for correction under Rule 88 EPC would not be contrary to the public interest. Accordingly the request must be refused".

2°/ Commentaire de la solution

Le demandeur soutenait que l'addition d'un Etat désigné après publication de la demande de brevet européen pourrait être admise sur le fondement de l'article 122 CBE prévoyant la *restitutio in integrum*.

La Chambre de recours rejette cet argument au motif que l'article 122 ne joue que pour la restauration des droits perdus par suite de l'inobservation d'un délai. Or la désignation des Etats contractants est un acte instantané intervenant au moment du dépôt de la demande et ne concernant donc pas la notion de délai. L'article 122 est donc inapplicable et le problème doit être traité sur le fondement de la règle 88.

Sur le fond, le demandeur considérerait que la correction pourrait être admise et ne porterait pas atteinte à l'intérêt des tiers. La Chambre de recours rappelle en réponse que le rôle de la publication est précisément de faire connaître aux tiers la liste des Etats désignés dans la demande de brevet. Au vu de cette liste, les tiers sont donc en droit de penser qu'aucune protection provisoire ni aucun brevet européen n'existeront dans les Etats non-désignés. La Chambre de recours s'estime incompétente pour prendre des mesures de protection des intérêts des tiers qui auraient entrepris l'exploitation de l'invention entre la date de publication de la demande et l'addition d'un Etat supplémentaire. De telles mesures interféreraient avec le pouvoir souverain des Etats d'organiser la sanction de la contrefaçon.

La Chambre de recours, rappelle que la seule hypothèse exceptionnelle où une correction de la désignation des Etats pourrait intervenir, est celle où la publication aurait été faite prématurément ou de manière erronée sans que cela soit dû à une faute du demandeur ou de son mandataire (voir att. J 12/80, J.O.O.E.B. 5/1981, 143).

Dans sa jurisprudence passée, la chambre avait admis une addition à la liste des Etats désignés lorsque la demande n'avait pas encore été publiée ou même lorsque la publication intervient au cours de la procédure de rectification. (att. J 08/80 du 18 juillet 1980, J.O. O.E.B. 1980 p.293, D.B. 1982.III.7; att. J 04/80 du 17 sept.1980, J.O. O.E.B. 1980, P.351, D.B.1981.III.8; att. J 12/80 du 26 mars 1981, J.O. O.E.B. 1981, p.143, D.B.1982.III.11).

Dans tous les cas, la correction avait été subordonnée à la présence d'une "erreur" au sens de la règle 88 CBE.

La Chambre a, en revanche, déjà rejeté une requête en rectification d'erreur pour omission d'Etat désigné formée après la publication de la demande (att. J 03/81 du 7 déc.1981, J.O. O.E.B. 1982,p.100, D.B.1982.III.16) en considération de motifs tirés, comme dans le cas présent de l'intérêt des tiers.

Europäisches Patentamt
Beschwerdekammern

European Patent Office
Boards of Appeal

Office européen des brevets
Chambres de recours

Veröffentlichung im Amtsblatt	X /Nein
Publication in the Official Journal	XX /No
Publication au Journal Officiel	XXI /No

Aktenzeichen / Case Number / N° du recours : J03/83

Anmeldenummer / Filing No / N° de la demande :

Publikations-Nr. / Publication No / N° de la publication :

Bezeichnung der Erfindung:

Title of invention:

Titre de l'invention :

ENTSCHEIDUNG / DECISION

vom / of / du 2 November 1983

Anmelder / Applicant / Demandeur : ASSOCIATED ENGINEERING ITALY S.p.A.

Stichwort / Headword / Référence : Decisions by Formalities Officers/
Associated Engineering

EPÜ / EPC / CBE Rules 9(3), 67,88

Rules of Procedure of the Boards of Appeal Article 10

"Decisions by Formalities Officers" - "Exceeding entrusted powers" -
"Substantial procedural violation" - "No remittal to department of
first instance" - "No reimbursement of appeal fee" -

Leitsatz / Headnote / Sommaire

SUMMARY OF FACTS AND SUBMISSIONS

- I. On 2 May 1979, the appellants filed European patent application No. 79300743.6, which was subsequently published on 12 December 1979 under No. 0005910. They claimed priority from a United Kingdom national patent application filed on 31 May 1978 and designated six Contracting States but not Italy. Designation fees for six States were duly paid. Subsequently, by letter dated 18 March 1980, they requested examination of the application and the examination fee was duly paid.
- II. By letter dated 13 March 1981 the appellants requested correction of the designations in the application by the addition of Italy. An additional designation fee was paid.
- III. By a communication dated 21 January 1982, a Formalities Officer of Directorate-General 2 informed the appellants that the request for correction had been made too late and therefore could not be granted. The additional designation fee would be refunded. The communication stated that the appellants could apply for a decision in the matter in accordance with Rule 69(2) EPC.
- IV. By letter dated 16 March 1982 the appellants applied for a decision in accordance with Rule 69(2) EPC.
- V. By a decision dated 13 May 1982, the Head of Formalities of Directorate-General 2 issued a decision purporting to reject the request for correction on the ground that it was made too late.
- VI. By letter dated 25 May 1982, the appellants filed notice of appeal against the decision, seeking its cancellation. The appeal fee was duly paid.
- VII. In their Statement of Grounds of the appeal, filed on 14 September 1982, the appellants contended that the failure to designate Italy had been the result of a mistake,

that correction had been sought as soon as possible after the discovery of the mistake and that addition of the designation of Italy would not be against the public interest. As proof of the relevant facts, they referred to a written declaration, made under the English "Statutory Declarations Act 1835", by the appellants' representative, which had been filed with the request for correction of the mistake. They submitted that there was no dispute about the intention to designate Italy or about the making of a mistake. They also contended that it was not against the public interest to allow correction of the mistake after publication of the application. Publication of the list of Designated States with a European patent application gave the public no indication of the States in which rights existed or would exist. That could only be discovered by further searching. Furthermore, the EPC provided, or the Office could impose, conditions that would safeguard the public interest. Reference was made to Articles 122 and 125 EPC.

VIII. By a communication dated 5 May 1983, the Legal Board of Appeal invited observations on the view that the list of Designated States published with a European patent application did provide the public with information on the countries for which a patent might be granted and for which rights under Article 67 EPC might be available. The public was entitled to assume that a patent would not be granted for, and rights under Article 67 EPC would not be available in, States which were not then mentioned. Save in most exceptional circumstances there could be certainty as to the legal position in those States. Article 122 EPC could not apply to the present case, since it did not concern inability to observe a time limit.

IX. On 1 July 1983, the appellants filed observations in reply, submitting that, since correction of designations after publication might be permitted in exceptional circumstances, the present request did not break new ground. The existence of Article 122 EPC indicated that the interest

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of applicants might outweigh the public interest. There was no procedural barrier to correction of the mistake in the present case. Rule 88 EPC gave the Office power to correct mistakes and Article 125 EPC gave the Office the possibility of formulating appropriate procedural principles where there were none in the Convention or the Regulations.

- X. On 2 August 1983, by telephone, the Legal Board of Appeal drew the appellants' representative's attention to the fact that it appeared to the Board that the Head of Formalities of Directorate General 2 had given the decision appealed from under Rule 88 EPC and not under Rule 69(2) EPC, and, therefore, that he was not entitled to give it. Nevertheless, the Board could avoid remitting the case to an Examining Division if the appellants were prepared to waive their right to have the case remitted. The appellants' representative agreed to consider the matter and to take instructions from the appellants.
- XI. By letter dated 26 September 1983 the appellants' representative notified the Legal Board of Appeal that the appellants were prepared to waive their right to have the case remitted to an Examining Division.

REASONS FOR THE DECISION

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. By virtue of the provisions of Article 21(3)(c) EPC, the Legal Board of Appeal is empowered to examine this decision, which purports to be that of an Examining Division entrusted to a Formalities Officer in accordance with Rule 9(3) EPC.
3. In accordance with Rule 9(3) EPC, the President of the European Patent Office may entrust to employees who are not technically or legally qualified examiners the execution of individual duties falling to the Examining Division and involving no technical or legal difficulties. Accordingly, by a Notice of the Vice-President, Directorate-General 2, dated 10 August 1979, supplemented and reprinted in a Notice dated 8 January 1982, (Official Journal EPO 3/1982, 112) the giving of decisions under inter alia Rule 69(2) was entrusted to Formalities Officers of Directorate-General 2. However, the giving of decisions under Rule 88 EPC has never been entrusted to Formalities Officers.
3. The Legal Board of Appeal has previously held in a case similar to the present one (Case No. J10/82, Official Journal EPO 3/1983, 94) that a person making a request under Rule 88 EPC for correction of a designation of States is entitled to have that request dealt with by an Examining Division and not under the procedures of Rule 69 EPC. The principles expressed in paragraphs 4 to 6 of that decision (loc.cit., 96) are applicable to the present case, with one qualification only.
4. In accordance with Article 10, Rules of Procedure of the Boards of Appeal (Official Journal EPO 1/1983, 7) a Board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise.

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5. There are fundamental deficiencies in the first instance proceedings in the present case, which mean that the decision should be set aside since it was given by a person who had no power to give it. However, there are also special reasons why the case should not be remitted to the department of first instance. First, the appellants consent to the case being decided on its merits by the Legal Board of Appeal. Secondly, the Board has been given all the appellants' arguments in favour of allowing the request for correction of the mistake.
6. Having read the evidence, the Board is satisfied that the appellants always intended to designate Italy and that the failure to do so was the result of a mistake made in the offices of the appellants' representatives. It is also satisfied that there was no undue delay in applying for correction once it was realised that the mistake had been made.
7. In Case No. J03/81 (Official Journal EPO 3/1982, 100) the Legal Board of Appeal refused a request for correction of designation of States which had not been made until after publication of a European patent application, on the grounds that it was made too late. The Board expressed the view that the general rule must be that such a request must be refused, in the public interest, if it is not made until it is too late to add to the application as published a warning to third parties that the request has been made.
8. The appellants submit that no interest of the public would be damaged by the addition of Italy as a designated State after the publication in the present case. However, the Board adheres to the view expressed in the Communication dated 5 May 1983 that when the public sees the list of Designated States in publication it is entitled to assume that no European patent will be granted for, and no rights under Article 67 EPC will be available in, States not then mentioned, either in the list itself or in a warning notice

that an application for correction has been made. The only basis for permitting exceptions in accordance with the existing case law of the Boards of Appeal would be that publication took place prematurely or was erroneous, in either case due to no fault of the applicant or his representative: cf. Case No. J 12/80 (Official Journal EPO 5/1981, 143).

9. The appellants' argument that Article 67 EPC cannot provisionally confer protection in a Contracting State not designated in the application as published, although in accordance with the literal text of the Article, ignores the legal effect of a correction made under Rule 88 EPC. On general principles, once such a correction is made, the application must be considered always to have had the corrected text.
10. Furthermore, contrary to the arguments advanced in the appellants' Statement of Grounds of the appeal, Article 122 EPC cannot be used to add designations of States at grant which were not designated on publication. The reason is that Article 122 EPC is designated only to provide a means to re-establish rights lost by non-observance of time-limits. The concept of a time limit within Article 122 EPC, involves a period of time having duration. In a case of designation of States, there is no such period. States must be designated at an instant of time, namely in the request for grant: cf. Article 79(1) EPC.
11. Again, contrary to the submissions of the appellants, the European Patent Office has no power to make a proviso to the grant of a European patent which would be analogous to the provisions of Article 122(6) EPC and protect third parties who had started to use the invention during the period between publication of the European patent application and grant of the patent. The exercise of such a power would be a matter of

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substantial interference with the sovereign powers of Contracting States over questions of patent infringement and would hence require express authorisation in the EPC: cf. Article 64(3) EPC. The appellants' arguments that the matter is purely one of procedure and could be dealt with under Article 125 EPC, cannot be accepted, therefore.

12. The appellants have failed to establish that the granting of the request for correction under Rule 88 EPC would not be contrary to the public interest. Accordingly, the request must be refused.
13. In the circumstances of the present case, which are that the Legal Board of Appeal has considered the substantive issues in the case and has rejected the request for correction, it is not thought equitable to order reimbursement of the appeal fee notwithstanding the substantial procedural violation by the department of first instance.

ORDER

For these reasons,

it is decided that

1. The decision of the Head of Formalities of Directorate-General 2, dated 13 May 1982, is set aside.
2. The request of the appellants for the correction of the designation of States in respect of European patent application No. 79300743.6 is refused.