CHAMBRE DE RECOURS JURIDIQUE

27 AVRIL 1987

J.18/86

DOSSIERS BREVETS 1987.V.12

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

- DATE DE DEPOT DE LA DEMANDE DE BREVET EUROPEEN
- DATE DE RECEPTION DES PIECES AUPRES DE L'AUTORITE NATIONALE COMPETENTE

II) Les faits :

18 juin 1984	:	dépôt d'une demande de brevet canadienne ;
17 juin 1985	:	la demande de brevet européen, revendiquant la priorité canadienne, est adressée par voie postale à l'Office britannique des brevets ;
19 juin 1985	:	date de réception de l'envoi postal avec la demande de brevet européen en cause ;
27 juin 1985	:	le demandeur requiert auprès de l'Office britannique des brevets la modification de la date de réception au 18 juin 1985 ;
31 juillet 1985	:	l'Office britannique des brevets estime que l'attribution de la date de dépôt appartient à la section de dépôt de l'OEB, le cas échéant à la Chambre de recours ;
2 août 1985	:	la section de dépôt adresse au demandeur une notification, attirant son attention que le droit de priorité ne peut être revendiqué, dans la mesure où la demande de brevet européen n'a pas été déposée dans le délai de douze mois*

* article 87(1) : Celui qui a régulièrement déposé, dans ou pour l'un des Etats parties à la Convention de Paris pour la protection de la propriété industrielle, une demande de brevet d'invention, de modèle d'utilité, de certificat d'utilité ou de certificat d'inventeur, ou son ayant cause, jouit, pour effectuer le dépôt d'une demande de brevet européen pour la même invention, d'un droit de priorité pendant un délai de douze mois après le dépôt de la première demande.

30 août 1985 : le déposant demande la modification de la date de dépôt au 18 juin 1985

3 mars 1986 : la section de dépôt rejette la requête, constate que la date de dépôt est le 19 juin 1985 et que la demande de brevet en cause n'a pas de droit de priorité ;

8 avril 1986 : le demandeur forme un recours ;

27 avril 1987 : la Chambre de recours juridique rejette le recours.

II) Le droit :

A) le problème :

a) prétentions :

1. la section de dépôt :

la section de dépôt est liée par la date de réception des pièces communiquée par l'Office national et ne peut antidater le dépôt d'une demande de brevet européen

2. le demandeur :

la section de dépôt doit tenir compte de dispositions nationales permettant, dans des cas exceptionnels, d'antidater le dépôt de demandes.

b) énoncé du problème :

la date de réception des pièces fixée par un Office national peut-elle être modifiée par la section de dépôt, sur la base de dispositions nationales applicables à l'Office national concerné ?

B) la solution :

1) énoncé de la solution :

"Des dispositions de la règle 24 CBE, il découle que la date de dépôt d'une demande de brevet européen est toujours la date à laquelle les pièces de la demande ont été effectivement reçus, soit directement auprès de l'OEB soit auprès de l'autorité nationale compétente. Si tel n'était pas le cas, il serait difficile de justifier pourquoi chaque autorité nationale compétente est tenu d'indiquer sur les pièces de la demande la date de réception et d'informer le demandeur et l'OEB de leur date de réception" (cf. point 7, 2e paragraphe, des motifs de la décision):
"Rien dans la CBE n'admet la possibilité d'appliquer une disposition d'une législation nationale en vue de fixer la date de dépôt d'une demande de brevet européen" (cf. point 10 des motifs de la décision).

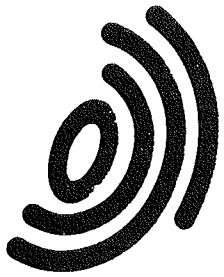
2) Commentaires de la solution :

La date de réception des pièces auprès de l'OEB ou auprès des autorités nationales compétentes (qui sont à cet égard, en quelque sorte, des "offices récepteurs européens") est, en règle générale, la date de dépôt de la demande fixée d'après les dispositions de la CBE, qui ont institué "un droit commun aux Etats contractants en matière de délivrance de brevets d'invention" (article 1 CBE). La procédure de délivrance centralisée d'un brevet européen débute par l'attribution d'une date de dépôt d'après des dispositions uniformes et applicables à tout dépôt de demande de brevet européen, quelque que soit le lieu européen du dépôt (article 80, règle 24 CBE). La Chambre de recours juridique a, de ce fait, en l'espèce, écarté, à juste titre, toute application de dispositions nationales permettant d'attribuer à une demande, dans des cas déterminés, une date de dépôt antérieure à la date de réception des pièces.

Europäisches Patentamt
Beschwerdekammern

European Patent Office
Boards of Appeal

Office européen des brevets
Chambres de recours



Case Number : J 18/86

D E C I S I O N
of the Legal Board of Appeal
of 27 April 1987

Appellant : ZOUEKI, George
4812 Avenue Verdun
Verdun (Quebec)
Canada J46 1N1

Representative : Houghton, David
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Decision under appeal : Decision of the Receiving Section of the European Patent Office dated 3 March 1986.

Composition of the Board :

Chairman : P. Ford
Member : G.D. Paterson
Member : O. Bossung

Europäisches Patentamt
Beschwerdekammern

European Patent Office
Boards of Appeal

Office européen des brevets
Chambres de recours

Veröffentlichung im Amtsblatt	Ja/Nein
Publication in the Official Journal	Yes/No
Publication au Journal Officiel	Oui/Non

Aktenzeichen / Case Number / N° du recours : J 18/86

Anmeldenummer / Filing No / N° de la demande : 85 304 376.8

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

Bezeichnung der Erfindung: Multipurpose apparatus for drilling, engraving
Title of invention: and carving ophthalmic lenses
Titre de l'invention :

Klassifikation / Classification / Classement : B 28 D1/14

ENTSCHEIDUNG / DECISION
vom / of / du 27 April 1987

Anmelder / Applicant / Demandeur : ZOUEKI, George

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Filing Date/ZOUEKI

EPÜ / EPC / CBE Articles 1, 75, 80 and Rule 24

Kennwort / Keyword / Mot clé : "Filing date is date of receipt by national authority"

Leitsatz / Headnote / Sommaire

1. Rule 24 EPC provides a comprehensive and self-sufficient system in accordance with which the EPO can determine the date of filing of a European patent application, wherever (in accordance wih Article 75(1) EPC) it is filed.

2. Nothing in the EPC admits of the possibility of applying a provision of any national law (~~such as UK Rule 97~~) to the determination of the date of filing of a European patent application.

Summary of Facts and Submissions

I. The European patent application was posted in Sheffield, England on 17 June 1985, and was received at the UK Patent Office (UKPO) in London on 19 June 1985. The application claims priority from a Canadian application filed on 18 June 1984. The UKPO marked the documents making up the application with the date of their receipt, namely 19 June 1985, and issued a receipt to the Appellant, which indicated that date as the date of receipt. It forwarded the documents to the EPO on 21 June 1985, and they were received at the EPO on 26 June 1985.

II. On 27 June 1985 the Appellant requested the UKPO to amend the receipt so as to indicate that the date of filing was 18 June 1985. Following conversations between the Appellant and the UKPO, an oral hearing took place on 5 July 1985 in the UKPO before a Superintending Examiner acting for the Comptroller in order to consider the request. Pursuant to this hearing, a document entitled "Review of Date of Receipt", was issued to the Appellant by the Superintending Examiner on 31 July 1985, in which he expressed the opinion that the decision on the filing date to be accorded to the European patent application was clearly a matter for the Receiving Section of the EPO, and ultimately for the Board of Appeal. He considered that the UKPO was bound to mark the application documents with the date on which they were actually received. A copy of the "Review of Date of Receipt" was sent to the EPO on 5 August 1985.

III. The Receiving Section of the EPO issued a communication on 2 August 1985, which drew attention to the fact that the claim to priority from 18 June 1984 did not fall within the year preceding the date of filing of the European

patent application. By letter dated 30 August 1985, filed on 2 September 1985, the Appellant referred to Rule 97 of the Patents Rules 1982 (UK Rule 97), and requested that the application be accorded 18 June 1985 as its date of filing. Supplementary submissions were contained in a letter from the Appellant dated 23 December 1985. A Decision was issued by the Receiving Section on 3 March 1986, in which it was held:

1. that the request that the application be accorded a date of filing of 18 June 1985 is refused;

2. that the date of filing is 19 June 1985;

3. that the application has no right of priority.

IV. The Appellant filed a notice of appeal on 8 April 1986 and paid the fee for appeal on the same day. A Statement of Grounds of Appeal was filed on 2 July 1986. The submissions set out therein were essentially as follows:

(1) Article 75(1)(b) EPC provides that "a European patent application may be filed ... if the law of the Contracting State so permits, at the central industrial property office of that State". The law of the UK does permit the filing of European patent applications at the UKPO. Rule 24(1) EPC permits European patent applications to be filed by post.

(2) Section 123 of the UK Patents Act 1977 gives the Secretary of State the power to make "such rules as he thinks expedient for regulating the business of the UK Patents Office in relation to ... applications for European patent applications ... and for regulating all matters placed by this Act under the direction of the Comptroller". UK Rule 97 was made under that

power, and is apt to cover the sending to the UKPO of any document sent to it by posting in the UK, including the European patent application in suit.

(3) For the operation of UK Rule 97 not to cover the posting of a European patent application in the UK to the UKPO as a receiving office of the EPO, there would need to be an express provision in UK law (in contrast to the position under Swiss law, which does contain an express excluding provision).

(4) Previous Decisions of the Boards of Appeal relating to the late payment of fees, where the fees were paid to a bank or post office where the EPO holds an account, in circumstances where the payer could not thereafter recover the fees, also support the Appellant, because once the application documents were posted, it was not possible to recover them.

V. In a communication from the Board dated 12 September 1986, the Appellant was invited to file observations directed especially to establishing that as a matter of law, it was proper to apply English law, and UK Rule 97 in particular, to the facts relating to the posting of the European application in England. Further submissions were filed by the Appellant on 11 November 1986. In particular, it was submitted that the effect of Article 75(1)(b) EPC is to cause European patent applications filed under it to be so filed under the provisions of the national law of the Contracting State in which they are filed; and that such an effect provides a single procedure for the Contracting States, even though in the application of Article 75 EPC, it may provide different effects in different circumstances.

Oral proceedings were appointed and took place on 19 March 1987.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC, and is therefore admissible.

2. Under Article 87 EPC, the Appellant enjoyed a right of priority in respect of his invention during a period of twelve months (the Convention year) from the date of filing of his Canadian patent application in respect of the same invention on 18 June 1984. In order that his European patent application can claim such priority right from 18 June 1984, the European application must accordingly have been "filed at the EPO" on or before 18 June 1985.

3. On 17 June 1985, the Appellant's representative posted the documents constituting the European application to the UK Patent Office (UKPO) in London from Sheffield, by first class letter post. In the ordinary course of post within the UK, a first class letter should be delivered at its destination on the day following the day of posting. Unfortunately, the letter containing the European application did not reach the UKPO until two days after posting, on 19 June 1985, i.e., one day after the Convention year expired. The question raised by this appeal is whether in these circumstances the Appellant can establish that for the purposes of the EPC the European application should be regarded as having been filed at the EPO on 18 June 1985, and thus still claim his right of priority.

4. The EPC is a treaty between the Contracting States. Its Preamble states that the Contracting States are "DESIRING that (the protection of inventions) may be obtained in

those States by a single procedure for the grant of patents ...". Article 1 EPC states that "A system of law, common to the Contracting States, for the grant of patents for invention is hereby established". Clearly such system of law includes both procedural and substantive law. Thus prima facie the EPO provides a system of procedural law which is common to the Contracting States.

5. Article 75 EPC states the manner in which a European patent application may be filed. Article 75(1)(a) EPC provides for filing directly at the EPO.

Article 75(1)(b) EPC provides that "A European patent application may be filed ... if the law of the Contracting State so permits, at the central industrial property office or other competent authority of that State. An application filed in this way shall have the same effect as if it had been filed at the EPO".

As far as the UK is concerned, it is not in dispute that the national law does "permit" the filing of a European patent application at the UKPO, even though there is no express statutory provision which gives such permission. The justification for such permission is set out in the "Review of Date of Receipt" (referred to in paragraph II. above), in the paragraph bridging pages 4 and 5.

6. Article 80 EPC defines the "date of filing" of a European patent application as the date on which "documents filed by the Applicant contain" information as specified in sub-paragraphs (a) to (d) thereof. Documents containing such information were in fact received at the UKPO on 19 June 1985, and there is no dispute that the European application is at least entitled to a filing date of 19 June 1985.

7. Rule 24 EPC sets out "General provisions" for the filing of a European patent application, in implementation inter alia of Articles 75 and 80 EPC. Sub-paragraph (1) permits such an application to be filed by post, either at the EPO or at a national authority such as the UKPO. Sub-paragraph (2) requires the authority where an application is filed to mark the documents with their date of receipt, and to issue a receipt stating inter alia their date of receipt. Furthermore, sub-paragraph (3) deals specifically with the situation when a European application is filed at a competent national authority (by virtue of Article 75(1)(b) EPC), and requires in this circumstance that the competent authority where the application is filed "shall inform the EPO of the nature and date of receipt of the documents, the application number and any priority claimed".

All these provisions in Rule 24 EPC point very strongly towards the conclusion that the date of filing of a European application is always the date on which the documents of the application are actually received, either directly at the EPO or at a competent national authority. If this were not so, it would be difficult to justify requiring each competent national authority to mark the documents with their date of receipt and to inform both the Applicant and the EPO of their date of receipt.

The national authorities of the Contracting States consider themselves bound by the provisions of Rule 24 EPC. Thus in the present case the UKPO followed all the above requirements. Beyond such requirements, each Contracting State is clearly free to regulate how and when applications may be filed nationally.

8. The EPO has issued "Guidelines for handling European patent applications at central industrial property offices or other competent authorities of Contracting States to the EPC", to such competent authorities. The June 1985 edition of such Guidelines is referred to in the Decision of the Receiving Section and, in particular, paragraph II.2 "Method of filing" was relied upon by the Appellant. This paragraph explains that each Contracting State is free to decide how and when applications may be filed in that State, and refers inter alia to the optional provision of an automatic post-box (which would determine the date when letters are received).

9. The case put forward on behalf of the Appellant is that although Rule 24 EPC refers to the "date of receipt" of an application, the date of receipt is not necessarily equivalent to the date of filing. Article 87(2) and (3) EPC was referred to as an example within the EPC where the date of filing may not be the same as the date of receipt - for example if a priority application is filed by post in the UK, and UK Rule 97 is relied upon to establish a date of filing earlier than the date of receipt of the application. It was therefore submitted that it is always necessary to look to the local circumstances to determine what the date of filing is.

In the present case (it was submitted) the "local circumstances" include the provision of UK Rule 97 in the national law, and this provision should be regarded as an aspect of the UK "deciding how and when" applications may be filed at the UKPO, just as the UK can decide to install an automatic post-box. UK Rule 97 was argued to be of general application, and apt to cover European applications, and to provide the same effect as a date determining device in an automatic post-box.

10. The Board has carefully considered UK Rule 97 in its context in the UK Patents Rule 1982, and the relevant provisions of the UK Patents Act 1977, under which UK Rule 97 was made. There is no doubt that if UK Rule 97 is read in isolation, its wording is broad enough to cover a European patent application "sent to the UKPO by posting it in the United Kingdom". However, the fact that its wording is broad enough to cover, and is apt to cover, the facts of the present case, does not mean that as a matter of law it should be so applied.

Authority for applying UK Rule 97 to a European patent application must be derived from the EPC. The relevant provisions of the EPC have been set out above, and in the Board's judgement there is nothing in such provisions which admits of the possibility of applying a provision of any national law (such as UK Rule 97) to the determination of the date of filing of a European patent application.

11. In the Board's view Rule 24 EPC provides, on its proper interpretation, a comprehensive and self-sufficient system in accordance with which the EPO can determine the date of filing of a European patent application, wherever it is filed, (provided it is filed in accordance with Article 75(1) EPC). Sub-paragraph (2) of Rule 24 EPC requires every authority (including the EPO itself) to mark the documents with their date of receipt and to inform the Applicant of this date, by providing a receipt with the date of receipt stated on it. Sub-paragraph (3) requires every competent authority within Article 75(1)(b) EPC to inform the EPO of the date of receipt of such documents. Sub-paragraph (3) does not require such a competent authority to provide any other information which could be relevant to the determination of the date of filing. Thus, in accordance with Rule 24(3) EPC, when a competent authority informs the EPO of the date of receipt

of documents which constitute a European patent application, that date of receipt is the date of filing which that application will be accorded.

There is nothing in the EPC which enables the EPO to accord a date of filing for such an application, other than the date of receipt of such documents at the competent authority, as notified to the EPO in accordance with Rule 24(3) EPC.

12. In accordance with this view of the function of the provisions of Rule 24 EPC, the Board is therefore unable to accept the submission on behalf of the Appellant that UK Rule 97 should be considered as equivalent to a date-determining post-box. Such a post-box is a means whereby a competent authority determines the date of receipt of documents which are filed at that authority, in order that such a date of receipt can be duly notified to the EPO in accordance with Rule 24(3) EPC. In contrast, UK Rule 97 is not concerned with determining the date of receipt of documents: it is concerned with determining the (notional) date of filing. In relation to a European patent application filed at a competent authority, it is for the competent authority to determine the date of receipt, and thereafter for the EPO to determine the date of filing (not vice versa).

13. Furthermore, the Board is not satisfied that on the proper interpretation of UK Rule 97, when considered in its context of the remainder of the Patents Rules 1982 and the Patents Act 1977, it was intended that it should be applicable to a European patent application filed at the UKPO as a competent authority with Article 75(1)(b) EPC.

Thus although, as previously recognised, when considered in isolation UK Rule 97 is apt to cover the filing of such

a European application, it does not follow on its true interpretation that it was intended to cover such a filing, or that it should cover such a filing.

In the first place, Section 119 of the 1977 Act does not provide that a European patent application may be filed at the UKPO (as a competent authority) by post. A European patent application is not "an application or other document" authorised or required by the 1977 Act to be filed. There is nothing in the 1977 Act which "authorises or requires" a European patent application to be filed anywhere. The provision of such authorisation is the function of Article 75 EPC. Thus it is not the UK Act or Rules that empowers an applicant for a European patent to file a European application at the UKPO by post: it is Rule 24 EPC in combination with Article 75 EPC.

In the second place, although UK Rule 97 was made by the Secretary of State by virtue of his power under Section 123 of the UK Act, which Section refers to "regulating the business of the (UK) Patent Office in relation to ... (inter alia) applications for European patents", it does not follow that Rule 97 is intended to be applied to European patent applications. Indeed, it would be perfectly consistent with the interpretation of Rule 24 EPC as discussed in paragraphs 11 and 12 above if UK Rule 97 does not apply to a European patent application; and it would be rather contrary to such interpretation of Rule 24 EPC if UK Rule 97 does apply to such an application.

14. Having regard to the conclusions set out above, it is not necessary for the Board to deal in detail with the other submissions made on behalf of the Appellant concerning (a)

the effect of the provisions of Swiss law, and (b) the decisions of the Boards of Appeal concerning the late payment of fees.

As to (a), the Board notes that under Article 2 of the Swiss Ordinance on Patents for Inventions of 19 October 1977, which applies to national Swiss patents, the date of submission is the mailing date, as proved by the post-mark. In contrast, Article 115(2) of the Ordinance, which specifically deals with European patent applications and patents that produce their effect in Switzerland, requires the Federal Bureau of Intellectual Property to indicate on the documents of a European patent application the date on which they were received. This requirement is fully consistent with Rule 24(2) EPC. The Board does not accept that under Swiss law, in the absence of Article 115(2) of the Swiss Patent Ordinance, Article 2 would have applied to European patent applications filed in accordance with Article 75(1)8b) EPC at the Swiss Federal Bureau. In the Board's view, even in the absence of Article 115(2) of the Ordinance, Rule 24 EPC would bind the Swiss Federal Bureau, just as it binds the UKPO.

As to (b), in the Board's view the decisions of the Boards of Appeal concerned with late payment of fees can be distinguished by the fact that they are each concerned with the "date of entry of a payment into an account at the post office or bank held by the EPO". The fact that once a letter is posted and thus put in the control of the UK postal authorities, it cannot be recovered, is not therefore analogous to the circumstances of the above decisions, because the UK postal authority is not equivalent to "an account held by the EPO".

15. For the above reasons, the Board is unable to allow this appeal.

Order

For these reasons, it is decided that:

1. The appeal is dismissed.

2. The Decision of the Receiving Section dated 3 March 1986 is confirmed.

The Registrar:

B A Norman

The Chairman:

P Ford

GD 3
Geschäftsstelle

München, den 19.5.87

Verteiler: Bezieher von Kopien der Entscheidungen der Beschwerdekammern

Betrifft: Entscheidung J 28/86

Der Leitsatz der vorgenannten Entscheidung ist geringfügig geändert worden.

Sie werden daher gebeten, das zusammen mit der Entscheidung übersandte Vorblatt gegen das beiliegende auszutauschen.

J. Rückerl
Geschäftsstelle