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D E C I S I O N
of 22 November 2002

Case Number: J 0006/00 - 3.1.1

Application Number: 95901359.0

Publication Number: 0794749

IPC: A61F 5/56

Language of the proceedings: EN

Title of invention:
A jaw position-regulating oral device for preventing snoring

Applicant:
Ingemarsson-Matzen, Natashia

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC R. 104b; 88
PCT Art. 22(1); 23(1) and (2); 39(1)(b); 40(1) and (2)
PCT R. 82ter; 90.3(c)

Keyword:
"Withdrawal of the priority claims in the international phase"
"Unambiguous declaration (no)"
"Analogous application of Rule 82ter PCT (yes)"

Decisions cited:
J 0011/80, J 0011/94, J 0027/94

Catchword:
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Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: J 0006/00 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 22 November 2002

Appellant: Ingemarsson-Marzen, Natashia
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 30 November 1999 refusing the request that in application No. 95 901 359.0 the withdrawal of the priority claims made in the international application on 24 May 1996 has no effect for the EPO.**

Composition of the Board:

Chairman: M. K. S. Aúz Castro
Members: M. J. Vogel
M.-B. Tardo-Dino

Summary of Facts and Submissions

I. The appellant filed the international patent application PCT/DK 94/00438 (EURO - PCT 95901359.0) on 24 November 1994 claiming priority from three DK patent applications (No. 1315/93 dated 24 November 1993; No. 0152/94 dated 7 February 1994; No. 1077/94 dated 19 September 1994).

The demand for international preliminary examination was submitted on 22 June 1995. On 21 May 1996 the appellant sent a letter to the EPO, received there on 23 May 1996 stating the following:

"In order to initiate the regional European phase of PCT/DK94/00438 we herewith forward an EPO form 1200, a fee calculation sheet, a copy of form IB/306 concerning Applicant's change of name and address as well as an EPO form 1037."

Three days later by a letter to the International Bureau dated 24 May 1996 the appellant declared the following:

"With reference to PCT Article 39(1) and Rule 90bis we hereby withdraw the priority claims made in the above international application on behalf of the Applicant. It is understood that the withdrawal has no effect for the elected Offices US, AU, CA, JP, FI, NO and EP, where processing of the international application has already started."

After having filed the translation of the priority application No. 1315/93 in reply to the communication pursuant to Rule 51(6) EPC the appellant was informed

on 29 January 1999 that there was no priority claimed anymore for the international application.

On 26 March 1999 the appellant requested that the withdrawal of the priority claims had no effect for the EPO arguing that the requirements of Article 40(2) PCT had been fulfiled since examination pursuant to Article 94 EPC before the EPO had expressly been requested before the withdrawal of the priority claims by the letter dated 24 May 1996.

In its decision of 30 November 1999 refusing the appellant's request the Examining Division held that the withdrawal of the priority claims made in the international application by letter dated 24 May 1996 had effect for the EPO. The earlier beginning of the processing before the regional office had neither been requested expressly as Article 40(2) PCT provides nor was the request allowable under the principle of protection of legitimate expectations developed by the Boards of Appeal nor could the error be rectified under Rule 88 EPC nor would the appellant have been entitled to request a communication under Rule 69(2) EPC during the international phase.

II. On 3 February 2000 the appellant lodged an appeal and paid the prescribed fee. The statement of grounds of appeal was received on 30 March 2000. The reasons for the appellant's request to set aside the contested decision so that the withdrawal of the priority claims made in the international application on 24 May 1996 had no effect for the EPO, can be summarized as follows:

1. Her, the appellant's, letter of 21 May 1996 was

clearly to be understood as an express request to proceed to the examination and other processing in the sense of Article 40(2) PCT. She intended, for economic reasons, to start the national phase only in some selected states and to withdraw subsequently the priority claims as she had done in her letter dated 24 May 1996 to the International Bureau.

2. Furthermore, the fact that the EPO had recorded 21 May 1996 as the date of filing of the request for examination strongly indicates that the office had checked at the same time whether the requirement of the Convention as to the representation of the applicant (Article 27(7) PCT, 134(1) EPC) had been met. This check is in fact processing in the sense of Article 40(2) PCT.

3. In any case the true intention of the appellant's letter of 21 May 1996 was clear so that the correction of the wording erroneously chosen should be allowed under Rule 88 EPC in the way that the request should have read "Examination under Article 94 EPC and Article 40(2) PCT is hereby requested".

4. Even if the Board did not share this view the request would be allowable having regard to the decision J 11/80 (OJ EPO 1981, 141) where the Board found that a request for withdrawal of a European patent application should only be accepted without question if it is completely clear and unambiguous. Having regard to the withdrawal of the priority claims unambiguousness was not given.

5. Besides this, the request is allowable under the principle of good faith and the protection of legitimate expectations recognized by the Boards of Appeal in circumstances where the loss of substantive rights and minor procedural irregularities would be disproportionate. In the present case the appellant - even though she and her representative acted in good faith - has lost the priority claims on the basis of procedural technicalities. Moreover, it was reasonable to assume that the EPO-staff would have a practical knowledge of the economic reasons behind the withdrawal of the priority claims. Therefore the assumption was justified that the letter dated 24 May 1996 would be interpreted in its true intention, namely to maintain the priority in the regional phase before the EPO.

III. The Board issued a communication attached to the summons to oral proceeding held on 11 July 2002 stating that its provisional opinion was in line with the contested decision. During the oral proceedings the Board invited the appellant's representative to discuss the question whether Rule 82ter PCT would be applicable in this case. After having closed the debate the Board decided to notify the decision in writing.

Reasons for the Decision

1. *Admissibility*

The appeal complies with Articles 106 to 108 EPC and is therefore admissible.

2. *Allowability of the request*

2.1 The Board agrees with the appellant to the extent that under Rule 90bis.3 PCT the applicant of an international application may withdraw a priority originally claimed at any time prior to the expiration of the 20 or 30 month time limit pursuant to Article 22(1) or 39(1) PCT. As stated in Rule 90bis.6(a) PCT, the withdrawal of any priority claim shall have no effect in any designated or elected Office where the processing under national/regional law has already started (Article 23(2) or Article 40(2) PCT). Consequently, as long as the application is still within the international phase, the withdrawal of a priority claim is governed by the provisions of the PCT and affects all designated and elected States without any exception.

2.1.1 Contrary to the submissions of the appellant her application was still within the international phase when she addressed the notice of 24 May 1996 to the International Bureau, since processing under the EPC had not yet started. Generally the designated or elected Offices are not entitled to proceed with the examination or other processing before the expiration of the 20 or 30 month time limit respectively (i.e. the beginning of the national phase, Article 23(1) and Article 40(1) PCT; 21 or 31 months pursuant to Article 39(1)b PCT, Rule 104b EPC - in force until 29 February 2000, OJ EPO 1999, 660 ff, now Rule 107 EPC). Only after the expiry of these time limits does the national/regional phase start and the withdrawal of the priority claim is no longer regulated by the PCT, but by the provisions of the national/regional patent legislation. An exception to Article 40(1) PCT is

provided for by Article 40(2) PCT: it stipulates that the national/regional phase may start if the applicant files an **express** request to proceed to the examination of the international application.

2.1.2 In the case under consideration the application was still in the international phase when the appellant made her declaration of 24 May 1996. The Board agrees that EPO-Form 1200 had been filed and the fees required by the EPC had been paid in due time on 21 May 1996 to initiate the regional phase before the EPO. However, the procedural acts alone do not end the international phase, because, as pointed out above, the international phase cannot be terminated before the expiry of the 31 month time limit merely by performing the acts prescribed in the then valid Rule 104b EPC, but only by an express request pursuant to Article 40(2) PCT.

2.1.3 However, there are two reasons to conclude that the appellant had not validly requested to enter the regional phase before the end of the 30 month time limit under Article 40(2) PCT.

First of all the second sentence of her letter to the International Bureau dated 24 May 1996 ("It is understood that the withdrawal has no effect for the elected Offices EP et al., where processing of the international application has already started.") provides no basis for an earlier beginning of the national/regional phase before the Offices of the elected States. The notice of 24 May 1996 is simply a legal declaration within the international phase which, pursuant to Rule 90bis.3(c) PCT, became effective on its receipt by the International Bureau. A check whether in fact the national phase had already been

validly initiated in all the elected States mentioned in the applicant's notice is not foreseen in the PCT.

Before the International Bureau (i.e. within the international phase) - the principle of "all or nothing" applies meaning that no possibility of withdrawing priority claims only with respect to some of the designated or elected States exists.

Secondly there is no doubt that the declaration of 24 May 1996 could have had effect for those elected States, where the application had not yet entered the national or regional phase in due form, only if an express request pursuant to Article 40(2) PCT had been made. As such a request had not been filed the application remained in the international phase until the end of the 30 or 31 month time limit respectively.

2.2 The principle of protection of legitimate expectations requiring the EPO to warn the applicant of an impending loss of rights, does not apply in favour of the appellant, either. As she only filed Form 1200 on 21 May 1996 to enter the regional phase, she could have no reasonable expection of receiving a warning of any loss of rights. The EPO not knowing that she intended to withdraw the priority claims three days later by a letter to the International Bureau had no reason to issue such a warning. Since there was no hint given that the appellant intended for financial reasons to start the national or regional phase before the end of the time limit pursuant to Rule 104b(1) EPC in some elected States pursuant to Article 40(2) PCT and to withdraw the priority claims with effect for just some others. The wording of the appellant's letter of 21 May 1996 gave no reason to assume that the initiation of

early processing pursuant to Article 40(2) PCT was intended. The formulation "In order to initiate the regional phase" in combination with Form 1200 could only be taken as referring to the usual way of entering the regional phase pursuant to Article 40(1) PCT.

2.3 Furthermore, Rule 88 EPC does also not apply in favour of the appellant. This provision is applicable to correcting mistakes in documents filed with the EPO. It does not, however, cover the case where a procedural act before other institutions like the International Bureau has been erroneously omitted.

2.4 The appellant also drew attention to the Board's decision J 11/80 where it was held that the withdrawal of an application should only be accepted without query if it is completely clear and unambiguous. In that case the Board had to assess the following declaration (translated into English): "We withdraw the above-mentioned patent application. We do not wish the publication of the application documents to occur". The Board came to the conclusion that the two sentences of the declaration were dependent on each other and that therefore the application should only be withdrawn, if the publication would not take place.

This declaration is indeed comparable to the one of the appellant in the case under consideration, but the Board has to observe that case J 11/80 differs from the present case insofar, as in that case the Board had to decide on the interpretation of a declaration made to the EPO whereas in this case the declaration was made to the International Bureau.

2.5 However, the appeal is allowable under Rule 82ter PCT.

Rule 82ter PCT stipulates that if the applicant proves to the satisfaction of any designated or elected Office that the priority claim has been erroneously considered by the International Bureau not to have been made and if the error is an error such that had it been made by the designated or elected Office itself, that Office would rectify it under the national law or practice, the said Office shall rectify the error and shall treat the international application as if the priority claim had not been considered not to have been made.

2.5.2 In the case under consideration the question is not, as Rule 82ter PCT presupposes whether a priority claim was erroneously considered not to have been made, but whether the priority claims have been erroneously considered to have been withdrawn by the applicant. The situation is not literally covered by the wording of the provision. But it concerns as it were only the other side of the coin: in both cases the effect is the same, namely that the application is considered to be without priority claims. Therefore, the Board comes to the conclusion that Rule 82ter PCT can be applied analogously to cases where the priority claims have been considered to have been withdrawn.

2.5.3 The declaration of 24 May 1996 of the appellant concerning the withdrawal of the priority claims consisted of two separate sentences. In the first sentence the withdrawal of **the** priority claims - without any restriction was announced. This sentence was, seen in isolation, clear and unequivocal. In the second sentence, however, this was stated to be on the understanding that the withdrawal had no effect for certain elected Offices enumerated in this sentence, where processing of the international application had

already started. These two sentences cannot be separated from each other without neglecting their correlation and mutual dependence. The appellant made it quite clear that she was withdrawing the priority claims because according to her conviction this withdrawal had no effect with regard to certain states. In other words, the declaration was made conditionally on the withdrawal only having effect in some states and not in others. Thus the second sentence has to be taken into account as an integral part of the declaration of withdrawal. Hence, under no circumstances can the letter be understood as a clear and unequivocal declaration of withdrawal of the priority claims.

2.5.4 The Board has stated repeatedly that in the interest of legal certainty procedural declarations have to be unambiguous (see J 11/94, OJ EPO 1995, 596; J 27/94, OJ EPO 1995, 831). This implies that such a declaration must not be subject to any condition, leaving it unclear in which way or whether at all the declaration has to be taken into account. Therefore, such ambiguous declarations have no effect. In the case under consideration this would mean that no valid declaration of withdrawal of the priority claims exists.

2.5.5 Had the appellant at her option pursuant to Rule 90.3(c) PCT addressed the notice of withdrawal of the priority claims to the EPO as International Preliminary Examination Authority and had the error been made by the elected Office itself as in fact was also the case, that Office would rectify it under the case law of the Boards of Appeal specified above (points 2.5.3 and 2.5.4). Since the requirements of Article 82ter PCT are met, the Board rectifies the error with the consequence that the international

application is treated as if the priority claims had not been considered to have been withdrawn.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. It is stated that the declaration of the withdrawal of the priority claims in international application PCT (DK 94/00438 (EURO - PCT 95901359.0) of 24 May 1996 has no effect for the EPO.

3. The case is remitted to the first instance for further prosecution.

The Registrar: The Chairwoman:

S. Fabiani M. Aúz Castro