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**Datasheet for the decision
of 14 June 2006**

Case Number: J 0005/05 - 3.1.01

Application Number: 03016876.9

Publication Number: 1518655

IPC:

Language of the proceedings: EN

Title of invention:

Apparatus and process for injection moulding articles of plastic material

Applicant:

John Palmer Corporation

Opponent: -

Headword: -

Relevant legal provisions:

EPC Art. 14(1),(2), 80(d)

Keyword:

"According a filing date (yes)"

"Application documents in language of a Contracting State other than English, French or German; further requirements of Article 14(2) EPC met (no)"

Decisions cited:

J 0015/98, J 0009/01, J 0006/05

Headnote:

Before entry into force of the Revised EPC 2000, an application filed in an official language of a Contracting State other than English, French or German, e.g. in the Italian language, may be allocated a filing date under Art. 80 EPC, however, only an applicant meeting the further requirements as set out in Art. 14(2) is entitled to proceed with such application.



Case Number: J 0005/05 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 14 June 2006

Appellant: John Palmer Corp.
P.O. Box 754
East Brunswick
New Jersey 08816 (US)

Representative: Vittoriano Lunati
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Decision under appeal: Decision of the Receiving Section of the
European Patent Office dated 15 November 2004
refusing the request to accord a filing date on
the basis of the application as filed in the
Italian language.

Composition of the Board:

Chairman: H. Preglau
Members: C. Heath
U. Tronser

Summary of Facts and Submissions

I. European patent application No. 03 ..., claiming the priority of an Italian patent application No. MI 2002... filed on 31 July 2002, was filed in the Italian language on 24 July 2003 at the EPO by a European representative. In the request, the European representative stated the following: "This new application is in Italian language. We'll send you the verified English translation by the prescribed term. The power form, the priority document and the English translation thereof are missing. We'll send them to you as soon as possible." A translation of the application into the English language and a power of attorney were received by the EPO on 6 August 2003. The filing fee was duly paid.

While the inventor was resident in Italy, the applicant was a corporation having its seat of business in New Brunswick, NJ, USA.

II. By a communication dated 17 September 2003, the representative of the applicant was informed that a filing date of 24 July 2003 could not be accorded, as the applicant, a US corporation, was not entitled to file in the Italian language pursuant to Article 14(2) EPC, and consequently, the filing date under Article 80 EPC was the date when the English translation of the description, claims and abstract was received on 6 August 2003. Due to these circumstances, no priority date could be claimed, as this laid outside the 12 months period.

The applicant's representative responded to this communication by letter of 1 October 2003, contesting the position of the Receiving Section and requesting that a filing date of 24 July 2003 be accorded.

The EPO sent out a communication of the loss of rights pursuant to Rule 69(1) EPC on 10 February 2004.

Subsequently, on 8 March 2004, the applicant's representative applied for a decision on this matter by the Receiving Section according to Rule 69(2) EPC.

III. The EPO rendered a formal decision on 15 November 2004 that accorded a filing date of 6 August 2003. The decision maintained the position that a filing date under Article 80 EPC could not be accorded where an application was filed in a language that the applicant was not entitled to use under Article 14(2) EPC.

Furthermore, the principle of good faith in this case could not be invoked, as the office could not be expected to react within five working days between the filing of 24 July and the expiry of the priority period on 31 July 2003 in order to alert the applicant's representative of the fact that no filing date could be accorded for the Italian language filing.

IV. On 12 January 2005, the applicant's representative filed an appeal. The appeal fee was duly paid on 13 January 2005, and on 14 March 2005, the grounds for appeal were submitted which can be summarised as follows:

- (a) The Receiving Section should essentially have applied decision **J 15/98** that in a comparable case (a Uruguayan national resident in Uruguay filing in the Spanish language) accorded a filing date already to the Spanish language version. Both in the decision **J 15/98** as well as in the present case, a non-national and non-resident of a Contracting State had made a filing in one of the languages mentioned in Article 14(2) EPC.

- (b) The filing in the Italian language met all requirements set fourth in Article 80 EPC, and in particular contained a description and one or more claims in one of the languages referred to in Article 14, paragraphs 1 and 2.

- (c) The Receiving Section erroneously relied upon decision **J 9/01** that concerned a case of *resitutio in integrum* and only implicitly held that a national and resident of Curaçao could not be accorded a filing date for an application filed before the European Patent Office in the Dutch language.

- (d) Even if the Receiving Section's point of view was correct, the applicant's representative should have been given notice of the defective application within the one week period between filing and expiry of the priority period. The office could have easily detected that filing in the Italian language was not permissible for the applicant, and an immediate notification by the office could have avoided a loss of rights. The principle of good faith was stressed in a number

of decisions, eg **J 5/88**. In particular, **J 3/00** had held that in the case where the description was filed in an impermissible language (Swedish) and only two days remained in order to save the priority period, the office should have given due notice.

V. In answer to the summons for oral proceedings scheduled on 14 June 2006, the applicant's representative informed the Board by letter of 12 May 2006 that neither the applicant nor its representative would participate at the oral proceedings.

VI. The applicant's representative requested in writing cancellation of the decision of the Receiving Section dated 15 November 2004 and accordance to the European application of the date of 24 July 2003 as the date of filing, therefore granting the application the benefit of the priority deriving from the Italian patent application MI 2002 A 001710 of 31 July 2002.

Reasons for the decision

1. The case as argued by the appellant essentially concerns two issues. First, whether a filing date of 24 July 2003 can be accorded for an application filed in one of the languages covered by Article 14(2) EPC by an applicant not entitled to use such language. Second, if the first question is answered in the negative, whether a filing date of 24 July 2003 can be accorded none the less by applying the principle of good faith.

**The requirements of according a filing date under
Article 80 EPC**

2. A filing date can be accorded under Article 80 EPC if the conditions listed under Article 80(a) - (d) are fulfilled. Of particular importance here is requirement (d) that reads as follows:

"The date of filing of a European patent application shall be the date on which documents filed by the applicant contain:

...

(d) a description and one or more claims in one of the languages referred to in Article 14, paragraphs 1 and 2, even though the description and the claims do not comply with the other requirements of this Convention."

3. Interpretation of this provision requires an understanding of the language regime of the EPC as set out in Article 14. It is thus convenient to give some explanations in this respect before interpreting the above mentioned provision.

The official languages of the European Patent Office shall be English, French or German. European patent applications therefore must be filed in one of these languages, Article 14(1) EPC.

The language regime has been a historical compromise between efficient procedures before the EPO on the one hand side, and the claims for sovereignty of the

Contracting States on the other, between the interests of applicants and patentees, and those of their competitors (Haertel in: Münchener Gemeinschaftskommentar zum Europäischen Patentübereinkommen, Article 14, marginal note 6 (4th supplement without year), hereinafter MK). In order to compensate applicants from Contracting States having a language other than English, French or German, a particular solution was devised in Article 14(2). Such applicants may file European patent applications in an official language of that state, obtain a reduction in the filing, examination, opposition and appeal fees of 20% when using such language (Rule 6(3) and Article 12(1) Rules relating to Fees), and may, throughout the proceedings before the European Patent Office, bring any subsequent translation of the application into conformity with the originally filed text. When filing in a national language other than the EPO's official languages, the applicant has the obligation to file a translation within three months after the filing of the European patent application (but no later than 13 months after the priority date), Rule 6(1).

Thus, when compared to applicants from non-contracting states, three privileges are accorded to those nationals or residents mentioned in Article 14(2): the possibility of filing in a non-official language, the fee reduction and the possibility of subsequently correcting translation errors. Maintenance of the language regime is ensured by severe sanctions: if any document other than the European patent application is filed in a language other than that prescribed by the

Convention, the document shall be deemed not to have been received, Article 14(5).

4. This system of distinguishing between nationals of Contracting States with one of the official languages, nationals of Contracting States with another language, and nationals of non-contracting states will change once the EPC 2000 comes into force. Under the revised EPC 2000, Article 14(2) reads as follows:

"(2) European patent application shall be filed in one of the official languages or, if filed in any other language, translated into one of the official languages, in accordance with the implementing regulations. Throughout the proceedings before the European Patent Office, such translation may be brought into conformity with the application as filed. If a required translation is not filed in due time, the application shall be deemed to be withdrawn."

The revised wording is in accordance with Article 5 Patent Law Treaty 2000 where at least the description can be filed in any language in order to obtain a filing date. Of the above-mentioned privileges granted to nationals or residents of Contracting States with a language different from the EPO working languages, only the reduction in the filing fee will remain under the EPC 2000.

Thus, under the future EPC 2000, an application filed in any language even by a national or resident of a non-contracting state would be allocated a filing date.

5. After having set out the basic features of the EPC language regime with respect to patent applications, it is appropriate to analyse the relationship between the current language regime and Article 80 that sets out the minimum requirements of a patent application so that a filing date can be accorded.

As mentioned above, Article 80(d) requires a description and one or more claims to be filed "in one of the languages referred to in Article 14, paragraphs 1 and 2". The relevant passage in the German version reads "in einer der in Artikel 14 Absätze 1 und 2 vorgesehenen Sprachen", in French "dans une des langues visées à l'article 14, paragraphes 1 et 2".

The wording of the provision has two possible interpretations. Either, the languages referred to are all those mentioned in Article 14(1) and (2), that is, all national languages of other Contracting States. In that case, Article 80(d) could be interpreted as referring to all the national languages in the Contracting States rather than to the language regime set out in Article 14(2). Alternatively, the provision could be interpreted as a reference to the languages that may be used under Article 14(2) in accordance with the nationality or residential status of the applicants. Both interpretations appear possible. The second one finds some support in the German version that speaks of "vorgesehene Sprachen". For nationals of non-contracting states, use of the non-official languages mentioned in Article 14(2) is definitely not foreseen, however.

6. The view that Article 80(d) only makes reference to the possible languages as such was taken by decision **J 15/98** of 31 October 2000 (OJ EPO 2001, 183), and is supported in academic writings by Bossung in: MK, 8th supplement 1986, Article 80, marginal note 63.

7. In the decision **J 15/98**, the Board held as follows:

"According to the literal construction of this provision [Article 80] 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 entitlement to use these languages. ... 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 to the EPC. Indeed these effects can not depend solely on the nationality of the applicant since there is no ground for discrimination in this respect."

Apart from **J 15/98**, also Bossung (as above) takes the view that it is not the language regime as a whole that is referred to in Article 80(d), but only the languages as such. He justifies this with the different wording of Article 80 ("languages referred to" in Article 80(d)) with "the case provided for in

Article 14, paragraph 2" in Article 90. Yet the semantic differences in both provisions do not give any clear indication that an actual difference in meaning was meant. Bossung also mentions the fact that the documents filed under Article 80 must clearly permit a decision on whether a filing date can be accorded or not, and the entitlement of the applicant (based on residence or nationality) would not be as easily recognisable as a certain language of filing. Ease of recognition, however, is a question of degree, and Bossung himself admits that the evaluation of the documents in order to allocate a filing date is no clear cut-matter (Bossung in: MK, Article 80 marginal note 115).

8. The opposite view that Article 80(d) requires compliance with the whole language regime set forth under Article 14(2) was taken in decisions **J 9/01** of 19 November 2001 and **J 06/05** of 17 October 2005, and in academic writings is supported by Haertel in: MK Article 14 marginal note 26.

A particularly thorough discussion of the matter can be found in decision **J 06/05** that takes a view diametrically opposed to the one set forth in **J 15/98**, essentially for the following reasons:

"(T)he requirements for obtaining a filing date, which are at issue here, are a matter completely different from the effects of a filing date, once it has been accorded. Indeed, these effects do not depend on the applicant's nationality, the principle of non-discrimination in this respect already being laid down in the Paris Convention. Before this and other

principles and rights concerning an applicant apply, it has to be established, that the person in question - here a company having filed application documents in a language other than an official language pursuant to Article 14(1) EPC - has acquired the legal status of an applicant within the meaning of the EPC, namely by filing application documents which satisfy the requirements set out in Article 80 EPC.

As shown in Point 4, above, Article 14(2) EPC provides, for filing purposes only, for an exception from the strict principle of only three official languages of the EPO, which - expressly (Article 14(1) EPC, second sentence) - applies also to the filing of applications. According to the unambiguous wording of the exception (" ... persons having in a Contracting State ... may file European patent applications in an official language of that State"), the three conditions as to person, language and Contracting state (see Point 4, above) are interlinked, so that all of them must be fulfilled for the exception to apply. This is confirmed, *inter alia*, by Bob van Benthem e.g. in IIC Vol. 6 - No. 1/1975, page 3, and Kurt Haertel in Münchener Kommentar Artikel 14, Rdnr. 16 - 23 . Hence, skipping over one of these conditions (as the Appellant suggests) or even two of them (as in J 15/98) would be in breach of what is one of the core provisions of the Convention, and risks undermining the language regime set up therein.

These two reasons - nature of the reference as such and its context within the EPC - alone already lead to the conclusion that Article 80(d) EPC is to be construed as referring to the language regime set up by

Article 14(1) and (2) EPC as a whole, including the "entitlement" to use languages under Article 14(2) EPC as a precondition for obtaining a filing date."

9. The Board in its current composition wishes to make the following observations.

The main concern of **J 06/05** lies in the argument that should a filing in any of the languages stipulated in Article 14(2) EPC be considered as a valid filing under Article 80 EPC even though effected by a person not being so qualified under Article 14(2) EPC, the intricate scheme of distinction between official languages, privileged non-official languages and persons entitled to use them would be undermined. The Board is aware of this problem. Due consideration should therefore be given to the legal regime of an application filed in a non-official language of the EPO under Article 14(2) EPC.

Article 14(2) EPC clearly stipulates rights and obligations for those nationals or residents entitled to file an application in a non-official language. These are the right to a fee reduction and to bring the translation into line with the original application, and the obligation to file a translation within a certain period of time. If under Article 14(2) EPC, a filing in a non-official language was deemed permissible by a national or resident of a non-contracting state, it should be clear which legal provisions would subsequently apply to such filing. In other words, would the applicant be entitled to a fee reduction (denied in the decision **J 15/98**), would the applicant be required to file a translation within a

certain period of time, and would the applicant be entitled to revert to his original filing in case of discrepancies between such subsequent translation and the original filing. These questions could be answered in two ways. Either, one could apply the provisions of Article 14(2) EPC analogously, or one could consider this case an unforeseen legislative gap to be filled by case law. Neither of the alternatives is acceptable, however.

10. An analogous application would require the two cases (filing by a national or resident of a contracting state, and filing by a national or resident of a non-contracting state) to be comparable. As was explained above, this is not the case, as the discrimination between nationals of contracting and nationals of non-contracting states was clearly intended.

11. The second alternative would require an unforeseen legislative gap, a situation that the EPC should have foreseen and regulated, yet failed to do so. As has been mentioned above, the language regime of the EPC makes a clear distinction between contracting member states with an official language of the EPO, contracting member states with non-official EPO languages, and non-contracting states. Nationals or residents of the first group should file in one of the official languages, nationals or residents of the second group may file in the national language of that state, and nationals or residents of the third group have to file in one of the official languages regardless of the national language of the country concerned. Allowing nationals or residents of the third group to file in one of the national languages of the

second group would thus create a legal vacuum for these applications that is neither desirable nor intended (see also P. Vigand, *Propriété Industrielle* January 2003, 22, 23).

12. While the Board therefore shares the view that only those persons mentioned in Article 14(2) EPC should be entitled to avail themselves of the privileges mentioned in this provision, it does not necessarily follow from this view that a filing date should be denied for an application made in the official language of a Contracting State that is not an official EPO language by a person other than those mentioned in Article 14(2) EPC. Rather, Articles 14 and 80 seem to have different purposes. Whilst Article 80 EPC is concerned with establishing a filing date, Article 14 EPC is concerned with the question of the further processing of an application. In other words, whilst Article 80 EPC stipulates the conditions under which it is possible to confer a filing date, Article 14 (1) and (2) EPC regulate who should be entitled to proceed with an application, and under which conditions. Allocating a filing date under Article 80 EPC does not necessarily mean that the applicant of such application is entitled to proceed with it under Article 14 EPC. Precisely because the disclosure of an invention is the paramount requirement for the accordance of a filing date, Article 80 EPC requires the minimum information necessary in order to allocate a filing date, and this should be an objective standard. The disclosure of an invention does not depend on the applicant's nationality, but on the objective contents of an application. An application in the Italian language contains the same objective information whether filed

by an Italian, a Japanese or an American applicant. Once the minimum information requirements under Art. 80 EPC are fulfilled, such application remains identifiable for the Office for the purposes of allocating a filing date when filed in any of the languages mentioned in Article 14(2) EPC.

13. In the Board's view, it is however a completely different matter to determine to what extent the applicant of such an application should be entitled to proceed therewith. This is regulated in Article 14(2) EPC, and only in Article 14(2) EPC.

The Board would thus concur with the decision **J 15/98** that any application filed in one of the languages mentioned in Article 14(2) EPC should be entitled to a filing date. Such a filing date as allocated by the Office may well serve to establish a priority upon which the applicant can rely when making subsequent filings abroad. But unless the application has been filed by a person entitled to use the language of filing according to Article 14(2) EPC, such person would not be permitted to proceed with the application. In other words, in such cases the only purpose the allocation of a filing date would serve is to establish a priority right to be used elsewhere. The application would not be eligible for further processing, however, due to the provisions of Article 14(2) EPC.

14. In accordance with the above considerations, the Board concludes that the applicant is entitled to a filing date of 24 July 2003. It is equally clear, however, that in view of Art. 14(2) EPC, the applicant would not be entitled to a further processing of the application.

As the applicant with the application at issue already relies on an Italian priority, allocating a filing date of 24 July 2003 would not serve any meaningful purpose in this case.

15. The Board is aware that its interpretation of Article 80 EPC differs from the interpretation made by the legal Board in **J 06/05**, but is in line with decision **J 15/98** as far as the allocation of a filing date is concerned. This, in ordinary circumstances and pursuant to Article 112(1) EPC would suggest a referral to the Enlarged Board of Appeal in order to ensure the uniform application of the law. Yet, in view of the fact that the issue discussed in both **J 06/05** and the current decision will cease to exist once the revised EPC 2000 enters into force in December 2007, a referral to the Enlarged Board of Appeal does not seem appropriate. The Enlarged Board of Appeal would have to deal with a question that could no longer arise in future. It should be the task of the Enlarged Board of Appeal to interpret the EPC in order to give guidance to its application in future cases rather than to decide upon issues for which a need for the uniform application of the law under Art. 112(1) EPC could no longer arise.

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 allocate the European application a filing date of 24 July 2003.

The Registrar

The Chairman

S. Fabiani

H. Preglau