

Decision of the Legal Board of Appeal dated 17 December 2007

J 3/06 - 3.1.01

(Translation)

COMPOSITION OF THE BOARD:

Chairman:

B. Günzel

Members:

W. Sekretaruk, C. Rennie-Smith

Applicants:

Heitkamp Rail GmbH, et al

Appellant 1:

Heitkamp Rail GmbH

Appellant 2:

Dieter Heiland

Headword:

Transitional provisions/HEITKAMP

Relevant legal provisions:

Article: 80, 90 EPC

Rule: 40, 55, 56 EPC

Article 7(1) of the Act revising the EPC

Article 1(1) of the Administrative Council's decision of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the EPC

Article 2, first sentence, of the Administrative Council's decision of 7 December 2006 amending the Implementing Regulations to EPC 2000

Article: 5 PLT

Relevant legal provisions (EPC 1973):

Article: 87 EPC 1973

Rule: 43(1), 43(2), 69 EPC 1973

Keyword:

"Applicability of Rule 56 EPC to filings made before its entry into force - no" - "Valid claiming of priority - no"

Headnote:

Rule 56 EPC applies only to European patent applications filed after the entry into force of EPC 2000.

Summary of facts and submissions

I. This appeal concerns the Receiving Section's decision of 15 November 2005 to reject the applicants/appellants' request for accordane of the filing date of 10 January 2004 and their request for the setting aside of the finding of loss of priority from German patent application 103 01 231.1.

II. The appellants filed their request for the grant of a European patent on 10 January 2004 and submitted the description, claims and four pages of drawings. Those four pages contained Figures 1, 2 (twice) and 4, but, as the formalities examination established, no Figure 3. The Receiving Section informed the appellants that if they submitted the missing drawing within a month, the application would be re-dated to the filing date of that drawing (so the claimed priority date might not then be within the 12-month priority period). The missing Figure 3 was thereupon filed in due time.

III. In the proceedings before the Receiving Section, the appellants asserted that the Receiving Section should have applied Rule 43(1) instead of Rule 43(2) EPC 1973, and that they had not made the necessary request to have the application re-dated under the former provision. Had that been the case, all references to the missing

drawing in the European patent application would have been deemed to be deleted, but the filing date would then have been the date on which the documents were received, i.e. 10 January 2004.

IV. The Receiving Section rejected that request and the request for the setting aside of the subsequently noted loss of priority from German patent application 103 01 231.1.

V. In their letter of 4 January 2006, the appellants filed a reasoned appeal against that decision (posted on 15 November 2005) and paid the appeal fee the same day.

VI. In their grounds for appeal, the appellants at first took issue once again with the Receiving Section's correct application of Rule 43(2) EPC 1973, but later dropped this objection in response to a board communication. They based their requests exclusively on Rule 56 EPC in the version applicable since 13 December 2007.

VII. They contended that, under the transitional provisions, the current version of Rule 56 EPC also applied to European patent applications filed with the European Patent Office before that rule entered into force on 13 December 2007. The Administrative Council of the European Patent Organisation had exercised its power under Article 7(1) of the Act revising the EPC and issued transitional provisions. In Article 1 of its decision of 28 June 2001 on transitional provisions under Article 7 of the Act revising the EPC, the Council had *inter alia* ruled that the new Article 90 EPC should apply to European patent applications pending at the time of its entry into force. That was a general principle: new procedural law always applied to open cases. Furthermore, the transitional provisions prescribed the application of the new legal text in such circumstances. Article 2 of the Administrative Council's decision of 7 December 2006 amending the Implementing Regulations to EPC 2000 stipulated *inter alia* that the Implementing Regulations to EPC 2000 should apply to all European patent applications in so far as they were subject to the provisions of EPC 2000. Rule 56 EPC referred expressly to Article 90 EPC, which was why in the present appeal proceedings only the new provisions applied. This meant that under Rule 56(3) EPC the filing date would remain 10 January 2004 because the drawing which was missing but contained in the priority application had been filed subsequently within the prescribed two-month period.

VIII. In its communication of 13 September 2007, the board indicated that it did not share the appellants' view.

There was no general principle of law whereby new procedural law necessarily applied to open cases. When provisions were amended, they could be made to apply to old cases, or, as in the present case, other rules in the form of transitional provisions could be established.

Rule 56 EPC in the version that came into force on 13 December 2007 did not apply here. Regarding the requirements for the accordancy of a filing date, Rule 56 EPC implicitly referred to Article 80 EPC. Article 90 EPC, cited by the appellants, governed the scope of the examination on filing and the examination as to formal requirements. Under Article 90(1) EPC this also included the examination as to whether the application satisfied the requirements for the accordancy of a filing date, but that article did not stipulate what the actual requirements were. These were set out in Article 80 EPC, which applied only to applications as from 13 December 2007.

IX. At the oral proceedings before the board on 17 December 2007, the appellants dropped their argument about the legal principle of new procedural law being generally applicable to pending cases.

They expanded on their written submissions on the applicability of Rule 56 EPC, arguing that its express reference to Article 90(1) EPC illustrated the connection between the two provisions. The appellants also maintained that, in the present context, Article 90 EPC was to be regarded as a *lex specialis* with respect to Article 80 EPC, which was another argument for the applicability of Rule 56 EPC.

X. The appellants requested that the Receiving Section's decision of 15 November 2005 be set aside and that patent application 04000386.5 with the subsequently filed drawing (Figure 3) be accorded the filing date of 10 January 2004.

Reasons for the decision

1. The appeal is admissible.

2. The revised version of the European Patent Convention (EPC 2000) entered into force on 13 December 2007. Articles and rules cited below refer to that version, unless explicitly referred to as being "EPC 1973" provisions applicable until the aforementioned date.

2.1 Article 7(1) of the Act revising the EPC reads:

"The revised version of the Convention shall apply to all European patent applications filed after its entry into force, as well as to all patents granted in respect of such applications. It shall not apply to European patents already granted at the time of its entry into force, or to European patent applications pending at that time, unless otherwise decided by the Administrative Council of the European Patent Organisation."

2.2 Article 1(1) of the Administrative Council's decision of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the EPC reads:

"In accordance with Article 7, paragraph 1, second sentence, of the Revision Act, the following transitional provisions shall apply to the amended and new provisions of the European Patent Convention specified below:

Articles ... 90 ... shall apply to European patent applications pending at the time of their entry into force and to European patents already granted at that time."

2.3 Article 2, first sentence, of the Administrative Council's decision of 7 December 2006 amending the Implementing Regulations to EPC 2000 reads:

"The Implementing Regulations to the EPC 2000 shall apply to all European patent applications, ..., in so far as the foregoing are subject to the provisions of the EPC 2000."

3. Rule 56 EPC applies only to applications filed after the entry into force of EPC 2000.

The Administrative Council's decision does not specify the conditions under which the Implementing Regulations to EPC 2000 apply to a European patent application filed before the entry into force of EPC 2000; this is a matter of interpretation. There is nothing in writing on the original intention of the wording "subject to the provisions of the EPC 2000", but guidance is obtained by putting it into the context of the system as a whole.

The board shares the appellants' view that applications filed before 13 December 2007 can be seen to be subject to EPC 2000 as regards the applicability of the Implementing Regulations when the article corresponding to the rule in question also applies to patent applications filed prior to 13 December 2007 under Article 1 of the Administrative Council's decision of 28 June 2001. Anything else would create irresolvable and unintended contradictions and loopholes between the applicable EPC 1973 articles and the applicable provisions of the Implementing Regulations to EPC 2000. This interpretation of Article 2, first sentence, of the aforementioned decision of the Administrative Council in the German language is given further credence by the provision's even clearer wording in the equally binding English and French versions ("The Implementing Regulations to the EPC 2000 shall apply to all European patent applications, ..., in so far as the foregoing are subject to the provisions of the EPC 2000."; "Le règlement d'exécution de la CBE 2000 s'applique à l'ensemble des demandes de brevet européen, ..., dans la mesure où ils sont soumis aux dispositions de la CBE 2000.").

In an assessment of which article relates to a particular rule, it should be noted that a rule in the Implementing Regulations can affect different EPC articles in very different ways. Within the meaning of the provision, a rule does not apply to an article purely by virtue of mentioning that article. However, a rule in the Implementing Regulations can be assumed to apply to a particular EPC 2000 article when it puts a more detailed construction on that article, in keeping with the purpose of "implementing" the EPC.

This is not true of the relationship between Article 90 and Rule 56 EPC because Rule 56 EPC does not elucidate Article 90 EPC. In the context of the system as a whole, Rule 56 EPC relates to Article 80 EPC (filing date). Article 80 EPC is one of the provisions that were amended to implement Article 5 PLT. The EPC 1973 principle that a filing date could only be accorded on the basis of documents available to the European Patent Office was superseded by the structurally different principle that extensive references are permitted in respect of the documents required for the accordance of a filing date.

Article 80 EPC no longer lists the requirements for the accordance of a filing date but refers instead to the Implementing Regulations. The provision in question is Rule 40 EPC, which reproduces the international standard

set out in Article 5 PLT for the minimum content of an application for the accordane of a filing date. Rule 56(3) EPC is another provision amended in line with the PLT and also refers to the principle that the documents required for the accordane of a filing date do not have to be physically available at the outset but become part of the procedure by being contained in the priority application. This implements Article 5(6)(b) PLT, under which it is *inter alia* possible to file missing drawings without loss of priority if they are in the priority application.

Obviously as a result of this change in the system, Article 80 EPC is not in the catalogue of provisions stated to be applicable also to pending procedures as soon as EPC 2000 was to enter into force. Consequently, the rules relating to it do not apply either.

4. Moreover, the appellants' reasoning is unconvincing:

4.1 General legal principle of applying new procedural law to open procedures

No such principle exists. When legal provisions are changed, they may be made to apply to old or new cases, or other rules may be established in the form of transitional provisions. The Administrative Council opted for the latter. The board expressed an opinion on this question in its communication and the appellants have not referred to this legal principle since.

4.2 Article 90 EPC und Rule 56 EPC

Article 90 EPC is a procedural provision governing the scope of the examination on filing and the examination as to formal requirements, including, under Article 90(1) EPC, the examination as to whether the application satisfies the requirements for the accordane of a filing date. Rule 55 EPC, which explains the examination on filing in greater detail, develops the substance of that article, which Rule 56 EPC does not. Accordingly, the wording "If the examination under Article 90, paragraph 1, reveals that ... drawings referred to in the description or in the claims, appear to be missing, ..." does not in itself imply the applicability of Rule 56(1) EPC to patent applications filed before its entry into force. Stating that an examination takes place as to whether a filing date can be accorded provides no details of the conditions under which this can occur.

Article 80 EPC sets out the substantive requirements, but since the new provisions are not applicable the EPC 1973 version in conjunction with Rule 43(2) EPC 1973 applies here.

The date of filing is therefore – as the Receiving Section duly established – 18 February 2004.

Nor does the board subscribe to the appellants' view that Article 90 EPC is to be regarded as a *lex specialis* in respect of Article 80 EPC. The relationship between the two provisions is not such that Article 90 EPC would take absolute precedence. The articles govern different things: the requirements for the accordane of a filing date (Article 80 EPC) and the scope and details of the examination as to formal requirements (Article 90 EPC).

5. The Receiving Section's decision not to meet the appellants' requests was therefore correct.

5.1 Refusal of the request to accord the filing date of 10 January 2004 to the documents submitted originally

The requested filing date of 10 January 2004 could not be accorded. That was the date on which the original but incomplete documents were received. On being advised of the repercussions, the appellants submitted the missing drawing on 18 February 2004; under Rule 43(2) EPC 1973 that date was unquestionably the filing date. The appellants' request to have 10 January 2004 accorded as the filing date was therefore unsuccessful.

5.2 Refusal of the request to set aside the finding of loss of priority right

Under Rule 69 EPC 1973 the European Patent Office will issue, on request, a decision that a right has been lost if this occurs without any decision concerning the refusal of a European patent application. Under Article 87 EPC 1973, the applicants had the opportunity to claim the priority of German patent application 103 01 231.1, filed on 15 January 2003, within twelve months of its filing. The appellants failed to observe the deadline of 15 January 2004, since the filing date duly accorded to their European patent application was 18 February 2004. They therefore lost their priority right, as the Receiving Section established.

6. The request to have the contested decision set aside could therefore not be met.

Order

For these reasons it is decided that:

The appeal is dismissed.