

## Decision of the Legal Board of Appeal dated 8 December 2008

### J 8/07 - 3.1.01

(Translation)

#### COMPOSITION OF THE BOARD:

##### Chairman:

B. Günzel

##### Members:

E. Lachacinski, R. Moufang

##### Applicant/Appellant:

MERIAL

##### Headword:

Language of the proceedings/MERIAL

##### Relevant legal provisions:

Article: 14(2) and (3), 111(1), 112 EPC

Rule: 3, 4 EPC

Article 7 of the Act revising the EPC of 29 November 2000

Article 1.1 and 1.6 of the decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000

Article: 3(4)(i), 11(1)(ii), 12, 21(4), 22(1) PCT

Rule: 12.1, 12.2, 48.3, 55.1 PCT

Notice dated 28 April 1999 of the Vice-President of Directorate-General 2 of the EPO concerning the entrustment to formalities officers of certain duties normally the responsibility of the examining divisions of the EPO

RPBA Art. 11

Treaty of Rome Art. 81 and 86

Agreement on the application of Article 65 of the Convention on the Grant of European Patents, done at London on 17 October 2000 ("London Agreement")

##### Relevant legal provisions (EPC 1973):

Article: 14(1), 14(3), 14(6) (7), 70(1), 150(1) (2) (3), 153, 158(1) (2) (3) EPC

Rule: 1(1) (2), 3, 4, 107(1)(a), 108(1) EPC

##### Keyword:

"Language of the proceedings – choice of language when a PCT application enters the regional phase – use by the EPO in written proceedings of an official language other than that of the proceedings"

#### Headnote

*The following questions are referred to the Enlarged Board of Appeal:*

*1. If an international patent application has been filed and published under the Patent Cooperation Treaty (PCT) in an official language of the European Patent Office (EPO), can the applicant, on entry into the regional phase before the EPO, file a translation of the application into another EPO official language which then becomes the language of all subsequent proceedings before the EPO?*

*2. If the answer to that question is no, can EPO departments use, in written proceedings on a European patent application (or an international application in the regional phase), an EPO official language other than the language of proceedings used for the application?*

3. *If the answer to question 2 is yes, what criteria must be applied to determine the official language to be used?*

*In particular, must EPO departments agree to any such request from a party or parties?*

### **Summary of facts and submissions**

I. On 5 April 2002, MERAL (hereinafter "the appellant") filed in French an international patent application under the Patent Cooperation Treaty (PCT).

This application was published in French on 17 October 2002 as WO 02/081621.

II. On 3 November 2003, the appellant performed the acts for entry into the regional phase. It attached an English translation of the international application, which entered the European phase before the EPO under No. 02 759 818.4.

The appellant's main request was that the language of the future proceedings should be English. It said the European Patent Convention (EPC) did not prohibit such a change on entry into the regional phase, and that under Article 158(2) EPC 1973 an international application could be supplied to the EPO in any of its official languages.

If this request was refused, its auxiliary request, citing decision J 18/90 (OJ EPO 1992, 511), was that the EPO should use English in all written proceedings and decisions.

If neither request was to be granted, it asked for an appealable decision.

In a communication dated 6 July 2004 under Article 113 EPC 1973, a formalities officer informed the appellant on behalf of the examining division that its requests could not be granted.

III. The appellant again requested an appealable decision.

On 13 December 2006, the formalities officer acting on behalf of the examining division issued a decision refusing the appellant's requests for the following reasons:

1. Request that the language of the proceedings be changed from French to English

French was the language in which the application had been filed, and published by the International Bureau. It was therefore the language of the proceedings for the European phase (Articles 14(3) and 158 EPC 1973).

Under Article 14(3) EPC 1973, the EPO official language in which the European patent application was filed had to be used as the language of the proceedings in all proceedings before the EPO concerning the application or the resulting patent, unless otherwise provided in the Implementing Regulations. The deletion of Rule 3 EPC 1973 had removed any possibility of changing the language of the proceedings.

2. Request that the EPO use English in all written proceedings and decisions

The provisions of Article 14(3) EPC 1973 were quite clear; there was no regulatory lacuna. So Rule 2 EPC 1973 could not apply, even by analogy. Rule 3 EPC 1973 had been deleted to avoid problems about replacing the language of the proceedings. J 18/90 (OJ EPO 1992, 511) was an isolated decision and EPO departments did not follow it. EPO practice as described in the Guidelines for Examination was that in written proceedings any party could use any EPO official language.

In such proceedings, however, the EPO used the language of the proceedings within the meaning of Article 14(3) EPC 1973.

IV. In a letter dated 6 February 2007 and received at the EPO the same day, the appellant filed an appeal against that decision and paid the fee for appeal.

In its statement of grounds of appeal, dated and received on 2 April 2007, the main supporting arguments for its request that the contested decision be set aside, and French replaced by English as the language of the proceedings, were that:

- nothing in the EPC, and especially not Article 158 EPC 1973, required the EPO official language used for the international application to be used also during the subsequent proceedings before the EPO,
- the restrictive interpretation set out in the contested decision was discriminatory, wrong in law, and likely to be harmful to the interests of international firms which normally used English, if their French subsidiaries filed patent applications in a language other than English,
- filing as the main application, on entry into the regional phase, an English translation of an international application drawn up in French was in line with Article 14(3) EPC 1973,
- on entry into the regional phase it had complied with Article 158(2) and (3) EPC 1973 by providing an English translation of its international application originally drawn up in French,
- there was no need for the PCT application to be republished, because it had already been published in French,
- nothing in Article 158 EPC 1973 required the same EPO official language to be used when an international application entered the regional phase before the EPO as the one in which it had been filed and published,

and subsidiarily, if its main request could not be allowed, that:

- the international application now in the regional phase should be regarded as a European patent application under Rule 1(1) EPC 1973, and that in line with J 18/90 (OJ EPO 1992, 511) and T 788/91 of 25 November 1994 English should be used for all written proceedings and decisions,
- the argument in the contested decision that J 18/90 was an isolated case and now obsolete following the deletion of Rule 3 EPC 1973 was mistaken, because J 18/90 had been handed down after the amendment of Rule 1 had been published and Rule 3 EPC 1973 deleted with effect from 1 June 1991, and because it expressly stated (Reasons point 1.2) that the deletion of Rule 3 EPC 1973 was no obstacle to changing the language of the proceedings with the parties' agreement – as confirmed by Dirk Visser in his commentary "Annotated European Patent Convention", 14th edition, page 355, first paragraph,
- there was no breach of Rule 107(1) EPC 1973 even if English was used instead of French, especially given that changing the language would not affect the subsequent examination proceedings.

Lastly, if English was not used for the proceedings, the appellant requested that in the regional phase the international application be treated as a European one.

V. If its requests were not granted, the appellant requested oral proceedings.

VI. In a communication dated 20 December 2007, the Legal Board of Appeal gave its preliminary opinion: that the appeal against the examining division's decision had to be dismissed because the language of the proceedings was immutable and could not be changed during the proceedings on the parties' or the EPO's initiative.

VII. In a letter dated 10 April 2008, the appellant said that during the oral proceedings it would be citing Articles 81 and 86 of the Treaty of Rome.

VIII. The appellant expanded orally on its written arguments. It added that the need to protect legitimate

expectations required first-instance departments and the boards of appeal to adhere to established case law, with which the departments of both first and second instance had always complied. It also stated that using English as the language of the proceedings was in line with the spirit of the Agreement on the application of Article 65 EPC, done at London on 17 October 2000.

It then briefly discussed Articles 81 and 86 of the Treaty of Rome.

If the board could not agree to change the language of the proceedings, the appellant requested that the following questions be referred to the Enlarged Board of Appeal [appellant's original version in English]:

"1. Upon entry into the EP regional phase of a European patent application from a PCT patent application published in one of the official EPO languages, can the language of the proceedings be any other of the official EPO languages?

2. In written proceedings before the EPO, are the organs of the EPO obliged or entitled to use an official language other than the language of the proceedings if requested by the applicant?"

## Reasons for the decision

### Re the main request that English be the language of the proceedings in the regional phase

#### 1. Law applicable

1.1 This case confronts the Legal Board of Appeal with a language problem requiring the application of both the Patent Cooperation Treaty (PCT) in the text in force with effect from 1 April 2002 – because the PCT application was filed on 5 April 2002 – and the European Patent Convention (EPC) – because it entered the European phase on 3 November 2003.

1.2 Some EPC 1973 provisions governing the language arrangements on entry into the regional phase before the EPO were amended in the new text of the Convention adopted by the Administrative Council's decision of 28 June 2001 (OJ EPO 2001, special edition No. 4, 55). Under Article 3(2), second sentence, of the EPC Revision Act of 29 November 2000, this new text has become an integral part of that Act.

Article 7 of the said Act contains transitional provisions, on which the Administrative Council took a further decision dated 28 June 2001 (OJ EPO 2001, special edition No. 4, 139).

Under Article 1.1 of the Council's decision on the transitional provisions under Article 7 of the EPC Revision Act, Articles 14(3) to (6), 70 and 90 EPC, which relate in particular to the EPO's official languages, apply to European patent applications pending at the time of their entry into force.

Similarly, Article 1.6 of the said decision provides that Articles 150 to 153 EPC apply to international applications pending at the time of their entry into force.

Under Article 2, first sentence, of the decision of the Administrative Council of 7 December 2006 amending the Implementing Regulations to the European Patent Convention 2000 (OJ EPO 2007, 8), the Implementing Regulations to EPC 2000 apply to all European patent applications, European patents, decisions of EPO departments and international applications, in so far as they are subject to the provisions of EPC 2000.

1.3 The present international application entered the regional phase on 3 November 2003, i.e. under EPC 1973.

The Legal Board of Appeal takes the view, Articles 1.1 and 1.6 of the Council's above-mentioned decision on the

transitional provisions notwithstanding, that the new provisions of EPC 2000 do not apply in the present case as regards the language arrangements governing an international application's entry into the regional phase before the EPO.

Such entry must occur within specified time limits, and both compliance and non-compliance with them give rise to immediate legal consequences.

Under Rule 108(1) EPC 1973, a European patent application is deemed withdrawn if certain specified conditions for entry into the regional phase are not fulfilled before the time limits expire.

Applying the law as amended after the date for complying with the conditions for entry into the regional phase would create legal uncertainty.

Therefore, the Legal Board of Appeal is following the principles set out in decision J 10/07 dated 31 March 2008 (OJ EPO 2008, 567), Reasons point 1.2.

Accordingly, the appellant was subject on 3 November 2003 to the provisions of EPC 1973 and the Implementing Regulations thereto – which same provisions the Legal Board of Appeal must also apply to the decision taken after EPC 2000 entered into force.

1.4 So the question is whether, under the PCT and EPC 1973, the appellant, by filing on entry into the regional phase a translation into one EPO official language of an international application drawn up and published in another, could have the language of the proceedings for the European phase changed to that of the translation, i.e. English in this case.

## **2. Re the observations made in proceedings before the Legal Board of Appeal**

2.1 In a communication dated 20 December 2007, the Legal Board of Appeal gave a provisional negative opinion on the request to change the language of the proceedings, mainly on the grounds that:

- it appeared from the PCT provisions that the language of filing predominates, being the language for the subsequent PCT proceedings except in cases expressly defined during those proceedings under special language provisions,

- the language to be used during international proceedings was prescribed by Articles 3(4)(i), 11(1)(ii), 21(4) and 22(1), first sentence, and Rules 12, 48.3 and 55.1 PCT. The international patent application had been filed in French, which would therefore appear to be the language for the PCT proceedings,

- Articles 14(3), 14(6) and (7), 70(1) and 158(1), (2) and (3) and Rules 1(1) and (2), 4 and 107(1) EPC 1973, which had applied when the contested decision had been taken, seemed collectively to establish the principle that the official language used for the application or for its translation into an EPO official language under Article 14(2), first sentence, EPC was immutable and must be the language of the proceedings,

- that immutability seemed to apply to the boards of appeal as well as to parties to the proceedings, and to be a choice taken, when the application was filed (or translated into an EPO official language), by the applicant or his representative, who were best placed to know which language of the proceedings was their preferred medium for disclosing and defending the invention,

- Rule 3 EPC 1973, allowing the language of the proceedings to be replaced by another EPO official language at the applicant's or patentee's request and after consultation of the other parties to the proceedings, had been deleted with effect from 1 June 1991,

- filing an English translation of an international application drawn up in French appeared at odds with Article 158(2) and (3) EPC 1973, which did not require international applications to be translated into an EPO official language if they were already drawn up in one,

- it did not seem feasible for an English translation of an international application to have the same legal authority as the French original.

2.2 The appellant took issue with the board's provisional opinion.

In particular, it continued to maintain that it was within its rights to request that, following the international application's entry into the regional phase, the examination proceedings be conducted in English using the English translation it had filed of the French original.

Also, nothing in Article 150(3) EPC 1973 prohibited the filing of an English translation of the international application, in compliance with Rule 107(1)(a) EPC 1973 which provided for a translation of it to be supplied pursuant to Article 158(2) EPC 1973.

Nor had it infringed any of the provisions of EPC 1973, having supplied the EPO with a translation of the international application in one of its official languages.

2.3 The legal issue raised by the appellant's arguments may be summarised as follows:

If an international application has been filed in a language prescribed by Article 3(4) and Rule 12.1 PCT, which however is not an EPO official language, the language arrangements established by Article 14(1) EPC should not apply in view of Article 150(2), third sentence, EPC 1973, which provides that in case of conflict the PCT prevails over the EPC.

In that case, the language of proceedings for the European phase is determined only when the international application is supplied to the EPO in an EPO official language under Article 158(2) EPC 1973.

So the question is whether, as the appellant contends, Article 158(2) EPC 1973 contains a general principle covering all international applications (see also Article 150(1) EPC 1973), including those already filed in an EPO official language (see also point 7.3 below).

### **Re the auxiliary request that the EPO use English in all written proceedings and decisions**

#### **3. Re the appellant's arguments**

Should the Legal Board of Appeal refuse its main request, the appellant has asked that the EPO use English in all written proceedings and decisions.

It took issue with the examining division's arguments, in the decision under appeal, that following the deletion of Rule 3 EPC 1973 one official language could no longer be replaced by another, and that J 18/90 was an isolated decision with no legal effect.

Rather, J 18/90 aptly analysed the EPC 1973 provisions on the use of official languages by EPO departments, and the Legal Board of Appeal should follow it.

#### **4. Re the law applicable**

The request that the EPO use English in the written proceedings relates to their future conduct before the EPO, and is not intended to affect the legal validity of an act performed before EPC 2000 entered into force.

For that reason, the board's comments in point 1.3 above about the language of the proceedings and the possibility of changing it on entry into the regional phase do not apply to this auxiliary request.

Under Article 1.1 of the Administrative Council's decision of 28 June 2001, Article 14(3) EPC 2000 applies to pending European patent applications. That means that under Article 2, first sentence, of the Council's decision of 7 December 2006 amending the Implementing Regulations to EPC 2000, Rules 3 and 4 of the new Implementing Regulations also apply.

## 5. Re the legislative history

EPC 2000 did not redefine what is to be understood by "language of the proceedings" or the circumstances in which the EPO can use another official language during the proceedings.

Thus the considerations which led the legislator to delete Rule 3 EPC 1973 remain relevant for the interpretation of the new EPC.

Under Rule 3 as adopted in EPC 1973, the EPO could, at the applicant's or patentee's request and after consulting the other parties to the proceedings, allow the language of the proceedings to be replaced by one of its other official languages as the new language of the proceedings.

Under Rule 1 EPC 1973, on the other hand, the possibility of filing documents in any of the EPO official languages was confined to opponents and to third parties intervening in opposition proceedings.

These provisions were amended by an Administrative Council decision of 7 December 1990 (OJ EPO 1991, 4), which came into effect on 1 June 1991.

Under Rule 1 EPC 1973 as amended, any party could use any EPO language in any written proceedings before the EPO.

In contrast, Rule 3 EPC 1973 was deleted on the basis that doing so whilst at the same time amending Rule 1 EPC 1973 would "*simplify and liberalise the present procedure with regard to the use and change of the language of the proceedings. EPO practice has shown the application of Rule 3 to be fraught with problems, ranging from the drafting of an examining division communication in the wrong language to the publication of European A and B documents with title pages in the wrong language*" (see page 3 of CA/52/90 Rev. 1 of 31 August 1990, "Amendment of the Implementing Regulations to the European Patent Convention and of the Rules relating to Fees", and the notice dated 3 June 1991 concerning amendment of the EPC Implementing Regulations and the Rules relating to Fees, OJ EPO 1991, 300).

The above paper (CA/52/90 Rev. 1 of 31 August 1990) on amending the EPC Implementing Regulations *inter alia* by deleting Rule 3 EPC 1973 also stresses that whilst any party to proceedings before the EPO may file documents in any EPO official language, the EPO however will continue to conduct them only in the language of the proceedings under Article 14(3) EPC 1973.

To accede to the appellant's request that in written proceedings, and especially decisions, it again be made possible to replace the language of the proceedings with either of the two other EPO official languages would be to re-introduce a rule which has been expressly deleted.

In the light of the above, it is not certain that the EPC permits parties or EPO departments to determine as they please the language to be used by the EPO during the proceedings.

## **6. Re the case law**

J 18/90 (OJ EPO 1992, 511) appears to be at odds with Article 14(3) EPC 1973, which corresponds to the spirit of Article 14(3) EPC stipulating that, unless the Implementing Regulations provide otherwise, the EPO official language in which the European patent application is filed or into which it is translated must be used in all proceedings before the EPO concerning that application or the resulting patent.

T 788/91 dated 25 November 1994 (Reasons point 2) does not indicate at which stage or on what legal basis the decision to use German instead of English was taken, and seems to have been based exclusively on J 18/90.

As regards point 1.1 of J 18/90 referring to G 1/83 (OJ EPO 1985, 60), G 5/83 (OJ EPO 1985, 64) and G 6/83 (OJ EPO 1985, 67), decisions on "second medical indication" handed down at a time when Rule 3 EPC 1973 had yet to be deleted, these decisions do not seem to the Legal Board of Appeal to be necessarily applicable in the present case.

However, in J 30/90 (OJ EPO 1992, 516, Facts and submissions point VIII), J 34/90 dated 26 November 1991 (Facts and submissions point IX), J 4/91 (OJ EPO 1992, 402, Facts and submissions point V), J 5/91 (OJ EPO 1993, 657, Facts and submissions point IV, second paragraph), J 8/94 (OJ EPO 1997, 17, Reasons point 1), J 20/96 dated 28 September 1998, Facts and submissions point XII, last paragraph), T 1102/00 dated 1 June 2004 (Reasons point 1), T 1125/00 dated 29 April 2003 (Reasons point 1), T 1443/04 dated 16 September 2007 (Reasons point 1) and D 27/97 dated 18 August 1999 (Reasons point 1), various boards including the Disciplinary Board of Appeal have agreed, with the consent of the party or parties, to decisions being drawn up in an EPO official language other than the language of the proceedings.

All these decisions refer expressly to J 18/90 and seem, at least implicitly, to follow its line of reasoning.

This would seem to imply that EPO departments, in their written communications with the parties, including decisions, can express themselves in an EPO official language other than that constituting the language of the proceedings.

## **Re referral to the Enlarged Board of Appeal**

7. Under Article 112 EPC, to ensure uniform application of the law or if a point of law of fundamental importance arises, the board of appeal, either of its own motion or at the request of a party, refers questions to the Enlarged Board if it considers that a decision is required for the above purposes.

The Legal Board of Appeal is in that position in the present case.

The question before it has not been answered by any Enlarged Board decision.

### *7.1 Re the fundamental importance of the language issue, and the position of languages in international institutions in general and at the EPO in particular*

The status of languages in the workings of international organisations has always been a sensitive issue, and often a stumbling block in constructing European institutions, including the EPO.

This was borne out by the intergovernmental conference held in London on 17 October 2000 (OJ EPO 2001, 549) on the application of Article 65 of the Convention on the Grant of European Patents ("London Agreement") and on implementation of the Community Patent Convention ("Luxembourg Convention" of 15 December 1975).

### *7.2 Re the uniform application of the law*

The above discussion and review of the case law show that the Legal Board faces a major difficulty.



Firstly, as regards the auxiliary request, the large majority of board of appeal decisions are evidently drawn up in the language of the proceedings without any discussion about its use.

However, if the Legal Board were to refuse the appellant's request that all EPO communications, including decisions, be drawn up in an official language other than that used for the application, it would be going against case law made up of a substantial number of decisions taken over the years and giving users of the system the impression that this is an established practice.

### *7.3 Re the need for referral to the Enlarged Board*

Secondly, as regards the main request, although the issue of requesting the replacement of an international application drawn up in one EPO official language by its translation into another one on entry into the regional phase does not seem hitherto to have given rise to controversial decisions on the part of EPO departments, on a literal reading at least Article 158(2) EPC 1973 could indeed be construed as the appellant would wish.

The Legal Board therefore takes the view that an Enlarged Board decision is called for on whether an international patent application filed and published under the PCT in an EPO official language can be replaced on entry into the regional phase before the EPO by a translation into another one, the language of the translation then being regarded as the language of the proceedings.

### *7.4 Re the need for referral despite a procedural violation*

The Legal Board notes that in the present case a problem exists as regards the power of the EPO department concerned to take the contested decision.

That decision was taken by a formalities officer on the examining division's behalf, but the notice dated 28 April 1999 from the Vice-President Directorate-General 2 concerning the entrustment to formalities officers of certain duties normally the responsibility of the examining divisions of the EPO contains no provision transferring the powers in question.

That may be because on 28 April 1999, the date of the Vice-President's notice, changing the language of the proceedings and using another official language in EPO communications was not considered possible, following the deletion of Rule 3 EPC 1973.

Thus the formalities officer had no power to take such a decision on the examining division's behalf.

However, exercising its discretion under Article 111(1), second sentence, EPC and Article 11 of the boards' rules of procedure, the Legal Board of Appeal takes the view that despite the above-mentioned procedural violation it should exercise the powers of the department which should have taken the contested decision.

The strictly legal nature of the issues to be considered, the duration of the first-instance proceedings, and the need for the issue of language use by EPO departments to be settled to enable examination proceedings on the patent application to get under way at last, together form a cogent argument against remitting the case to the department of first instance.

### *7.5 Conclusions*

The appellant's request therefore justifies referral to the Enlarged Board of Appeal for consideration of the questions set out below in the order.

## Order

### **For these reasons it is decided that:**

The following questions are referred to the Enlarged Board of Appeal:

1. If an international patent application has been filed and published under the Patent Cooperation Treaty (PCT) in an official language of the European Patent Office (EPO), can the applicant, on entry into the regional phase before the EPO, file a translation of the application into another EPO official language which then becomes the language of all subsequent proceedings before the EPO ?

2. If the answer to that question is no, can EPO departments use, in written proceedings on a European patent application (or an international application in the regional phase), an EPO official language other than the language of proceedings used for the application?

3. If the answer to question 2 is yes, what criteria must be applied to determine the official language to be used?

In particular, must EPO departments agree to any such request from a party or parties?