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Aktenzeichen / Case Number / N° du recours : J 10/84

Anmeldenummer / Filing No / N° de la demande : 83103437.6

Publikations-Nr. / Publication No / N° de la publication : 0092121

Bezeichnung der Erfindung: Methods and compositions for treating
Title of invention:
Titre de l'invention : gastro-intestinal ulcer disease

ENTSCHEIDUNG / DECISION

vom / of / du 29 November 1984

Anmelder/Patentinhaber: THE UNIVERSITY OF TEXAS SYSTEM Board
Applicant/Proprietor of the patent: of Regents
Demandeur/Titulaire du brevet :

Stichwort / Headword / Référence :

EPO / EPC / CBE Articles 52(4)
Rule 86(2)

Submission of amendments to applications - Publication
of such amendments - Good faith in procedural matters

Leitsatz / Headnote / Sommaire

Principles of good faith govern the relations between the European Patent Office and applicants for European patents over procedural matters laid down in the Implementing Regulations.



Case Number: J 10/84

DECISION
of the Legal Board of Appeal
of 29 November 1984

Appellant: THE UNIVERSITY OF TEXAS SYSTEM Board of Regents
201 West 7th Street
Austin
Texas 78701 (US)

Representative: Howden, Christopher Andrew
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Decision under appeal: Decision of the Receiving Section of Directorate General I of the European Patent Office dated 21 February 1984 refusing to include amended claims in the publication of European patent application No. 83103437.6.

Composition of the Board:

Chairman: R. Singer
Member: P. Ford
Member: F. Benussi

SUMMARY OF FACTS AND SUBMISSIONS

- I. On 8 April 1983, the appellant filed a European patent application under No. 83103437.6, claiming priority based on a United States national patent application filed on 12 April 1982.
- II. On 20 June 1983, by letter dated 15 June 1983, before receipt of the European search report, the appellant's representative submitted amended claims, stating that he was aware that it is not possible to file officially new claims until the search report is received but asking that these amended claims be incorporated in the application immediately the European search report was sent to him. In his letter he expressly drew attention to the provisions of Article 52(4)EPC and Rule 86(2) EPC.
- III. On 18 August 1983, the European search report was despatched to the appellant's representative.
- IV. On 30 August 1983, a communication was sent to the appellant's representative informing him that the technical preparations for publication of the application had been completed and that the application would be published on 26 October 1983. No reference was made to the appellant's request for incorporation of the amended claims in the application.
- V. By letter dated 6 September 1983, received on 8 September 1983, the appellant's representative stated he presumed that the amended claims had been incorporated in the application and would be published with the application.
- VI. By a communication dated 21 September 1983, the Receiving Section replied that:
 - (a) the amended claims could not be accepted, since they were filed prior to receipt of the search report;
 - (b) it was impossible for the EPO to comply with requests for such amendments to be made, if they were filed before that moment;
 - (c) after receipt of the search report, the applicant or his representative has to take action himself to bring about incorporation of the desired amendments;
 - (d) the new claims would not be published, since technical preparations for publication had been completed before receipt of the letter dated 6 September 1983;
 - (e) the new claims would be submitted to the competent Examining Division during the examination procedure.

VII. By letter dated 22 November 1983, the appellant's representative answered the communication, asserting that the Receiving Section's attitude was unreasonable in the circumstances and that it would be reasonable for the Receiving Section to act on a request received before it could be acted on, immediately it became possible to act on it. An appealable ruling was requested.

VIII. By a further communication dated 30 December 1983, the Receiving Section declined to give an appealable ruling because the application had already been published and there was, for the same reason, no basis for giving an appealable decision under Rule 69(2) EPC. An appealable decision could only be taken if the appellant's representative would file a clear statement as to the subject matter upon which a decision would be based.

IX. By duly confirmed telex dated 5 January 1984, the appellant's representative again asked for an appealable decision. He asserted that the fact that the publication of the application in question had already taken place was no reason to refuse to give a decision and he cited two decisions of the Legal Board of Appeal (Case J 05/81, OJ EPO 1982, 155 and Case J 03/82, OJ EPO 1983, 171).

X. By letter dated 1 February 1984, received on 7 February 1984, the appellant requested a decision formally refusing to publish the claims with the European patent application.

XI. By the decision under appeal, dated 21 February 1984, the Receiving Section refused the request filed on 7 February 1984. In the decision, it was stated that it would be possible to publish a corrigendum if the request were allowed. However, Rule 86 EPC only allowed amendments to be accepted if they were requested after issuance of the search report. It was not the duty of the EPO to undertake steps which had to be taken by an applicant. Refiling of amendments submitted too early could be effected by a simple instruction to the Office. In the present case the instruction was considered as having been given on 8 September 1983, i.e. after technical preparations for publication had been completed. Therefore, there could be no publication of the amendments: Rule 49(3) EPC.

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XII. A Notice of Appeal accompanied by a Statement of Grounds of the Appeal was filed against the decision of the Receiving Section on 16 April 1984. The appeal fee was duly paid. In the Statement of Grounds of Appeal the appellant's representative stated that as no reply was received to the letter of 15 June 1983 it was assumed that it was going to be acted upon at the appropriate time. If the appellant's representative had been told that the request was not going to be acted on, he could have made a request for the inclusion of the new claims immediately the search report was received. The possibility of amending claims before publication of the European patent application was a very important matter because of the rules of national law relating to "provisional protection".

REASONS FOR THE DECISION

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. Both the title of the invention in the European patent application as filed and the first eight claims as filed refer to methods for treating gastro-intestinal disease, so that the application could be seen on its face to relate, in part, to something which is not susceptible of industrial application within the meaning of Article 52(1) EPC (cf. Article 52(4) EPC, first sentence). The appellant's representative realised this before the European search report was issued and attempted to correct the application at the earliest possible opportunity, by his letter of 15 June 1983.
3. For the purposes of the present decision, it is not necessary to decide whether the request for amendment could have been acted on when it was received, or whether it is possible to submit an amendment to be made under Rule 86(2) EPC before receipt of the European search report, with the clear under-

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standing that the amendment should take effect the moment it is allowable.

4. The general purpose of Rule 86(2) EPC is to permit the applicant for a European patent to make voluntary amendments in order to take the results of the European search report into account, but in the present case the amendments sought had no connection with the results of that search and they were urgently needed so that the appellant should not lose any rights of "provisional protection" in designated Contracting States. It was, therefore, reasonable for the appellant's representative to assume that the Receiving Section had accepted his request, as he received no reply to his letter, in which he had expressly drawn attention to Article 52(4) EPC and Rule 86 EPC. It would be contrary to the principles of good faith which govern the relations between the Office and applicants for European patents over procedural matters laid down in the Implementing Regulations to consider that the Office was free to disregard the request made in the circumstances of this particular case.
5. It follows that the decision under appeal must be set aside and that the claims 1 to 8 as received on 20 June 1983 must be published by way of correction.
6. Since the Board has not found any substantial procedural violation to be the ground for allowing the appeal, the request for reimbursement of the appeal fee must be refused.

O R D E R

For these reasons, it is decided that:

1. The decision under appeal of the Receiving Section dated 21 February 1984 is set aside.

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2. A correction to the European patent application is to be published as follows:

Claims 1 to 8: as received on 20 June 1983.

3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman: