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Bezeichnung der Erfindung: Recorded information vertication system
Title of invention:
Titre de l'invention :

Klassifikation / Classification / Classement : G 11 B23/28

ENTSCHEIDUNG / DECISION
vom / of / du 25 March 1988

Anmelder / Applicant / Demandeur : Mc Whirter Holdings

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : PCT Form/Mc WHIRTER

EPÜ / EPC / CBE Art. 153, R. 88

Kennwort / Keyword / Mot clé : "PCT application- intention to designate Italy and other EPC States" - "application published by International Bureau without designation of Italy - application should be properly interpreted as having designated Italy" - "EPO bound by proper interpretation of application".

Leitsatz / Headnote / Sommaire

I. If, on the proper interpretation of the request for grant of an international application, an applicant has designated a Contracting State to the EPC for which the PCT is in force, the EPO is bound by the provisions of Article 153 EPC to act as the designated office for that Contracting State, even if the international application has been published by the International Bureau without mentioning that Contracting State as a designated State.

II. If, on the proper interpretation of the request for grant of an international application as decided by the EPO, a contracting State to the EPC has been designated, there is no "mistake" in that document, and Rule 88 EPC is inapplicable, even if the receiving office and/or the International Bureau have interpreted the document in a contrary manner.

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Case Number : J 26/87

D E C I S I O N
of the Legal Board of Appeal of 25 March 1988

Appellant : McWhirter Holdings PTY. Limited
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Hornsby, New South Wales 2077
Australia

Representative : Moore, Derek
Jensen & Son
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Decision under appeal : Decision of the Receiving Section of the European Patent Office dated 24 April 1987

Composition of the Board :

Chairman : P. Ford
Members : G. D. Paterson
E. Persson

Summary of Facts and Submissions

I. Euro-PCT application No. 85 902 938.1 (PCT/AU85/00130) was filed at the Australian Patent Office acting as receiving office on 14 June 1985, claiming priority from an Australian application filed on 16 July 1984. The "Request for grant" Form PCT/RO/101 used by the Appellant for filing the international application in Australia was an edition which had been issued in August 1984, at a time when the PCT was not in force in respect of Italy, and this edition was apparently still current in June 1985. The Form used did not therefore include a box which could be crossed in order to designate Italy. The other EPC States each had a box, which could be crossed either under the column headed "European Patent", or under the column headed "National Patent".

The Form also included a special box within Box No. V which could be crossed to designate "all PCT Contracting States for which a European Patent may be requested"; and a note against this box specified that "when that box was checked none of the other boxes in the column "European Patent" should be checked.

By June 1985 (in fact on 28 March 1985) the PCT had entered into force in respect of Italy. Under Article 7 of the Italian Law No. 890 of 21 December 1984, any designation of Italy in an international application has the effect of indicating the wish to obtain a European patent under the EPO, and it is not possible to apply for an Italian national patent by means of an international application (see OJ EPO 3/1985, 91).

II. The Appellant wanted to designate all the European States which are parties to the EPC (including Italy), except Luxembourg. He therefore crossed all these EPC States

except Luxembourg under the column "European Patent". He did not cross the box for "all PCT Contracting States for which a European Patent may be requested", because he did not want to include Luxembourg. However, alongside this box there was a statement reading: "these States are those listed above whose names are preceded by the codes .... and (specify names of any others) _____;" and, in the space there provided, the Appellant typed in "Italy".

The Australian Patent Office issued a filing receipt in the form of a "Notification of Receipt of Record Copy" on 1 July 1985, which listed only eight designated EPC States, and omitted the designation of Italy. This omission from the filing receipt was not detected by the Appellant's Australian representative at the time, and was only detected after the European phase had been entered in March 1986.

Also on 1 July 1985 the International Bureau notified the EPO that it had received the record copy of the application.

The international fee, including a blanket European designation fee and designation fees for the other designated States, was paid to the Australian Patent Office in due time in accordance with Rule 15 PCT.

III. After examination of the application in accordance with Article 10 PCT, the Australian Patent Office duly forwarded the "record copy" of the application to the International Bureau, pursuant to Article 12 PCT, without raising any queries with the Appellant in relation to the contents of the application, for example under Article 14 PCT. No "refusal declaration or finding" was made under Article 25 PCT.

IV. On 30 January 1986, the International Bureau published the application pursuant to Article 21 PCT. The publication was in the form prescribed by Rule 48 PCT, and indicated all the EPC States except Luxembourg and Italy. The International Bureau also duly communicated the application to the EPO, pursuant to Article 20 and Rule 47 PCT.

V. On 27 February 1986, following a telephone conversation with the Australian Patent Office, the Australian representative of the Appellant sent a letter with copies of the publication document WO 86/00745 and of the relevant page of the Request for grant Form PCT/80/101 to the Australian Patent Office and complained that "The Gazette does not indicate that Italy was designated in the European application". A copy of this letter and a copy of the published document were sent to the International Bureau by the Australian Patent Office in March 1987.

VI. By telex date 13 March 1986, through his UK representative the Appellant requested the European phase processing of the application. By letter dated 24 March 1986 the UK representative of the Appellant filed Form 1200 at the EPO which confirmed that he was the representative for the European application. In paragraph 11.1 of this Form he detailed the designated States by crossing the boxes against all the named European States except Luxembourg, and by typing "Italy" in the space provided. Designation fees and other required fees were duly paid.

VII. On 23 July 1986 the Receiving Section of the EPO notified the UK representative that one designation fee was to be refunded, and when this was queried, the Receiving Section explained by telex dated 6 August 1986 that in the International application PCT/AU 85/00130, all European States were designated except Luxembourg and Italy. Various communications then took place between the Appellant and the Receiving Section, mainly concerning the possible

correction of the application so as to include Italy as a designated State. The Appellant maintained that the intention to designate Italy was clearly shown.

By letter dated 17 February 1987 the Appellant stated

"we hereby apply for a decision to be issued, in relation to the loss of Italy as a designated state as shown on the International Application, in accordance with Rule 69(2) EPC".

In response, the Receiving Section issued a document dated 24 April 1987, which was regarded by the Appellant as a decision. A Notice of Appeal in respect of this document was filed on 17 June 1987 and the appeal fee paid, and a statement of grounds of appeal was filed on 31 August 1987.

The Notice of Appeal also contains a request for re-establishment of rights under Article 122 EPC, and the appropriate fee was paid.

VIII. The main finding of the Receiving Section in the document dated 24 April 1987 is that

"Contrary to the opinion expressed by the applicant, Italy was not requested as a designated State in the PCT request form (Form PCT/RO(101)".

The reason for this finding is stated to be that

"The addition of Italy to the group of PCT/EPC Contracting States which can be designated by crossing one single box for all of them was not a valid designation because that box was not crossed".

The Receiving Section also suggests that the request for grant form was understood in this way by the Australian

Patent Office and by the International Bureau. Reference is made to the fact that the International Bureau never informed the EPO the Italy was a designated State, and that the published application does not mention Italy.

The Receiving Section also held that the only possible way of correcting the application so as to designate Italy was under Rule 88 EPC. Such a correction was not possible in this case under the jurisprudence of the Board of Appeal because the application had been officially published without the designation of Italy, and because the omission of Italy was an omission by and therefore the fault of the Appellant.

IX. In his grounds of appeal the Appellant maintains that the publication in the international phase was erroneous, due to no fault of the Appellant. He also submits that in such circumstances, previous decisions of the Boards of Appeal in which correction of mistakes have been refused under Rule 88 EPC if the mistake has been officially published before the application for correction was made, should be distinguished from the present case.

Reasons for the Decision

1. The question arises whether the document dated 24 April 1987 issued by the Receiving Section constitutes a "decision" within the meaning of Article 106(1) EPC.

1.1 In Decision J 08/81 (OJ EPO 1982, 10), the Legal Board of Appeal previously held that a letter issued by the Receiving Section which was not headed as a decision and which did not draw attention to Articles 106 to 108 EPC in accordance with Rule 68(2) EPC second sentence, nevertheless constituted an appealable "decision", as in substance it constituted a clear rejection of the

Appellant's request and was also reasoned as required by Rule 68(2) EPC.

The document in the present case also was not identified as a decision, nor did it conform with the second sentence of Rule 68(2) EPC, but it similarly constituted a clear and reasoned rejection of all the Appellant's submissions.

It is true that it ended with a paragraph in which pursuant to Article 113 EPC, the Appellant was "invited to file observations" within a period of two months from the notification of "this communication". But for this paragraph it could scarcely be questioned that the "communication " constituted a decision. However, it was sent by the Receiving Section in response to a very clear express written request from the Appellant's representative for "a decision" and both the Appellant and the Receiving Section have subsequently treated the document as if it was a properly constituted decision. Thus, the Appellant duly filed a "notice of appeal against the decision dated 24 April 1987", and the Receiving Section considered the case in accordance with Article 109 EPC, before sending it to the Board of Appeal. In addition, the Receiving Section wrote to the Australian Patent Office stating that on 24 April 1987 it had taken "a decision" and that "You will be informed about the outcome of the appeal".

1.3 In all the circumstances of this case, the Board has no doubt that the Appellant was fully justified in treating the document as an appealable decision, and furthermore that the document should be regarded by the Board as a decision for the purpose of Articles 106 and 107 EPC.

In all other respects this appeal complies with Article 106 to 108 and Rule 64 EPC. It is therefore admissible.

2. The substantive issue in the appeal is governed by Article 153 EPC, which states:

"The EPO shall act as a designated Office within the meaning of Article 2(XIII) PCT for those Contracting States to the EPC in respect of which the PCT has entered into force and which are designated in the international application if the applicant informs the receiving office in the international application that he wishes to obtain a European Patent for these States".

Now at the date of the international application Italy was a Contracting State to the EPC in respect of which the PCT had entered into force. The question to be decided is therefore whether or not Italy was designated in the international application, i.e. whether or not the Appellant informed the receiving office (the Australian Patent Office) in the international application that he wished to obtain a European Patent for (inter alia) Italy. The answer to this question depends entirely upon the proper interpretation of the "request for grant" form (Form PCT/RO/101). As stated in paragraph VIII above, the Receiving Section have held that Italy was not requested as a designated State in this form.

2.1 The views of the Board are as follows:

(a) An international application must comply inter alia with Articles 3 and 4 PCT. In particular, in accordance with Article 4 and Rule 3.1 PCT, the request for grant shall contain "the designation of the Contracting States in which protection for the invention is desired on the basis of the international application", and the request "shall be made on a printed form". Furthermore, in accordance with Rule 4.9 PCT, "Contracting States shall be designated

in the request by their names".

(b) In the present case, the Appellant clearly complied with all the relevant requirements of the PCT. Furthermore, in the "request" filed at the Australian Patent Office as receiving office, the Appellant's intention to designate Italy, as well as all the other EPC States except Luxembourg, was really very clear. There can have been no other reasonable purpose in typing "Italy" in the space in Box No. V of the Form. In this connection:-

(i) The only other possible interpretation of the typed word "Italy" is that the applicant wanted a national Italian patent, not by the EPC route. However, as is clear from paragraph II above the word "Italy" was typed into a space provided in the context of a list of the other EPC countries. Moreover, under the Italian law as explained in paragraph I above, it was not possible to apply for an Italian patent except by the EPC route.

(ii) In the Board's view there was no better way of indicating the designation of Italy as an EPC state, at the same time as excluding Luxembourg, using the form which was used. Thus putting a cross in the box marked "EP" would have failed to exclude Luxembourg. The typing of Italy under the heading "space reserved for designating countries which became party to the PCT after the issuance of the present form (August 10, 1984)" would have been inappropriate, because this space is provided in the context of non-EPC countries.

(c) It follows that for the purpose of Article 153 EPC, Italy was designated in the international application, and the Appellant did so inform the receiving office

in the application. Consequently, Article 153 EPC requires that the EPO shall act as the designated Office for Italy. In other words, the Euro-PCT application includes Italy as a designated State.

2.2 In relation to the above finding the Board makes the following comments:

(a) It cannot be expected that an up-to-date edition of every official form, modified to take account of every new international development, is printed and made available to every applicant throughout the world at the moment when he wishes to file such a form. In the present case, the form which was available to the appellant had not been updated to take account of the fact that the PCT was in force in respect of Italy. The form was therefore not exactly appropriate for the countries which the Appellant wished to designate.

In such a situation the obligation of an applicant must be to make his intentions as clear as possible having regard to the edition of the printed form which is available to him. In the present case the Appellant fulfilled this obligation. He accordingly made no mistake when he completed the "Request to grant" form.

(b) Having regard to what is said in paragraphs 2.1(b) and 2.2(a) above, in the Board's view the fact that the Appellant's representative did not notice that the Receipt dated 1 July 1985 issued by the Australian Patent Office omitted to refer to Italy as a designated state should not be regarded as a mistake by the Appellant. The Australian Patent Office has accepted that it should have referred any ambiguity regarding the designation of Italy to the Appellant before it forwarded the record copy to the International Bureau, and it has written letters to

this effect both to the International Bureau and to the EPO, in support of the Appellant's case.

(c) Since there was no "mistake" in the request for grant form which was filed at the Australian Patent Office and subsequently at the EPO, Rule 88 EPC is inapplicable and irrelevant. Similarly, the previous jurisprudence of the Boards of Appeal in relation to Rule 88 EPC is not directly relevant to the circumstances of this case, in which no mistake has been made "in a document filed with the EPO".

(d) The Board takes note of the fact that the International Bureau officially published the international application on 30 January 1986 without including any reference to Italy as a designated EPC State. However, having regard to its finding in paragraph 2.1(b) above, in the Board's view this official publication does not represent the true intention of the Appellant as set out in the request for grant form. In any event, having regard to the Board's finding, the EPO is bound by the provisions of Article 153 EPC. What the International Bureau has published is a matter for the International Bureau, not for the EPO.

(e) Correction of the international application as published is not a matter within the competence of this Board of Appeal or the EPO.

(f) The Board is aware that there is a risk that a third person who has read the international application as published by the International Bureau may have started to use the invention the subject of the application in Italy in reliance upon the official publication. As

previously pointed out in Decision J 12/80, OJ EPO 5/1981, 143 at paragraph 9, and in Decision J 10/87 dated 11 February 1988, the solution to any such problem in relation to third party rights is not within the competence of the EPO, and must be left to the national courts of competent jurisdiction.

3 In the circumstances of the present case, the application for re-establishment of rights was not needed and therefore the fee for re-establishment may be refunded to the Appellant.

Order

For these reasons it is decided that:

1. The contested Decision of the Receiving Section dated 24 April 1987 is set aside.

2. Euro-PCT application No. 85 902 938.1 (PCT/AU 85/00130) includes Italy as a designated European State.

3. The fee for re-establishment of rights is to be refunded to the Appellant.

The Registrar The Chairman

J. Rückerl P. Ford