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Aktenzeichen / Case Number / N° du recours : J 25/88 - 3.1.1

Anmeldenummer / Filing No / N° de la demande : 87 202 400.5

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

Bezeichnung der Erfindung: Method and apparatus for the moulding of articles
Title of invention: in polyurethane
Titre de l'invention :

Klassifikation / Classification / Classement : B 29 C 67/22

ENTSCHEIDUNG / DECISION

vom / of / du 31 October 1988

Anmelder / Applicant / Demandeur : New Flex S.r.L

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Date of filing/New Flex

EPU / EPC / CBE Articles 79(1), 80(b)

Schlagwort / Keyword / Mot clé : "No explicit designation of Contracting States" - "principle of precautionary designation applied"

Leitsatz / Headnote / Sommaire

I. For the purpose of according a filing date under Article 80(b) EPC, there is no need for an explicit designation of any particular Contracting State. In the absence of such a designation, the documents filed by the Applicant shall be considered to contain a precautionary designation of all Contracting States.

Europäisches
Patentamt

Beschwerdekammern

European Patent
Office

Boards of Appeal

Office européen
des brevets

Chambres de recours



Case Number : J 25/88

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 31 October 1988

Appellant : New Flex S.r.L.
Via Alessandria n. 35
27 029 Vigevano
Pavia
Italy

Representative : Ing. Luigi Coloberti
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Decision under appeal : Decision of the Head of the Receiving Section of Directorate General 1 of the European patent Office dated 2 June 1988 according European patent application No. 87 202 400.5 the filing date of 30 November 1987 and refusing its right of priority.

Composition of the Board :

Chairman : P. Ford

Members : E. Persson
J.C. Saisset

Summary of Facts and Submissions

- I. On 23 November 1987 a letter from the Appellant's representative was filed at the EPO in Munich. The letter referred to "European Patent Application No. 22 472 A/86 filed 27.11.86 in the name: New Flex S.r.L." and was accompanied by a designation of the inventor dated 4 November 1987 (on EPO Form 1002) and a priority document consisting of the Italian patent application No. 22 472 A/86 filed on 27 November 1986.

- II. By telex of 30 November 1987, confirmed by a letter filed with the EPO in Munich on 2 December 1987, the representative, having so far not received any confirmation from the EPO about the filing of documents, related to the present application, referred to "our request for grant of an European patent for all Contracting States except for Italy mailed on 4 November 1987 in the name of New Flex S.r.L." and asked for control and information about time limits for paying certain fees. In order to assist the EPO in checking the situation, a copy of, inter alia, a request for grant of a European patent, made on EPO Form 1001 10.86 and dated 4 November 1987, was attached to the letter. In part 26 of the copy of that form the designation of all Contracting States to the EPC except Italy was indicated by typed crosses in the boxes for the respective States. In part 27, the box indicating "Precautionary designation of all Contracting States" was pre-crossed in print in the form itself. In his letter, the representative further explained that the original request for grant of a European patent had been mailed (in Milano) by express letter on 5 November 1987 and that the delay in delivering of the document was probably due to several strikes which had taken place in

Italy in November (1987). He also made an auxiliary request for restitutio in integrum under Article 122 EPC.

III. In the course of subsequent proceedings before the Receiving Section, the Appellant requested that the application in question be accorded the filing date of 23 November 1987 and the Appellant's right of priority from the Italian patent application No. 22 472 A/86 of 27 November 1986 be confirmed. In support of this request it was argued, in essence, that the documents received by the EPO on 23 November 1987 satisfied all the requirements of Article 80 EPC for according a filing date. Referring also to the possibility under Rule 85(2) EPC for an extension of time limits, the Appellant presented an official letter dated 23 March 1988 from the Postal Administration Office in Milano confirming that during the relevant period of time the postal employees responsible for the incoming and outgoing mail "made a sort of riot, different from strike, but such as to cause inefficiency of the forwarding and delivery of every kind of mail" and stating that the subject express letter (mailed on 5 November 1987) presumably had been lost. In fact, this letter has never been found.

IV. In the decision under appeal the European patent application in question was accorded the filing date of 30 November 1987, and since this date fell outside a period of 12 months from the date of filing of the corresponding Italian application (27 November 1986), no right of priority was recognised for the European patent application. In the reasons for the decision it was stated that the documents received by the EPO on 23 November 1987 made it possible for the EPO to establish that a European patent was sought (Article 80(a) EPC), to identify the Applicant (Article 80(c) EPC) and to establish a description and one or more claims on the basis of the

Italian priority document (Article 80(d) EPC). However, on 23 November 1987 the requirement under Article 80(b) EPC that the documents filed by the Applicant must contain the designation of at least one Contracting State was not met. Nor was it possible to consider that such a designation had been implicitly made on that date. Only on 30 November 1987 (cf. paragraph II above) the requirement under Article 80(b) EPC and thus all the requirements under Article 80 EPC for according a date of filing were met. As to the alleged application of Rule 85(2) EPC it was stated in the decision that this was not possible. Further, the possibility of granting re-establishment of rights was excluded.

- V. The Appellant duly filed an appeal against this decision, requesting that the European patent application be accorded the filing date of 23 November 1987 and the Italian priority of 27 November 1986 be recognised. Alternatively, oral proceedings were requested. In his statement of grounds of appeal the Appellant submits, inter alia, that all the requirements for according a filing date, included the one covered by Article 80(b) EPC (designation of at least one Contracting State), were met on 23 November 1987 and it is argued that the interpretation of that paragraph in the decision under appeal was too narrow and based only on its wording without taking into account any other means of interpretation. It is also submitted that the EPO, by providing for a precautionary designation of all Contracting States in Form 1001, acknowledges that there is a need for such a measure which need is said to be just the same in cases where this form is not being used.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.

2. According to Article 79(1) EPC the request for a grant of a European patent shall contain the designation of the Contracting State or States in which protection for the invention is desired. It is further prescribed by Article 80 EPC that the date of filing of a European patent application shall be the date on which documents filed by the Applicant contain, inter alia, the designation of at least one Contracting State. The point of law to be decided first by the Board in this case is whether or not the documents filed by the Applicant/Appellant on 23 November 1987 can be considered to satisfy the said requirement of containing the designation of at least one Contracting State. The answer to this question is obviously decisive for the priority matter involved.

3. The documents filed on 23 November 1987 (see paragraph I above) did not contain any explicit designation of any Contracting State for the obvious reason that these documents were never intended to form the application for a European patent but were only aiming at supplementing the application in respect of providing the priority document and the designation of the inventor. Nevertheless, they referred apparently to a European patent application and the Receiving Section considered that the documents as such satisfied all the requirements of Article 80 EPC except the one concerning the designation of at least one Contracting State. It appears from the decision under appeal that the Receiving Section was of the opinion that the wording of Article 80(b) EPC excluded the possibility of considering such a designation as being made by implication.

4. The Board considers that the Appellant is right in submitting that the way the Receiving Section interpreted Article 80(b) EPC in this case was too narrow and not in accordance with generally recognised principles of interpretation of rules of law. Any such interpretation has to be based not only on the wording of the provision concerned but also on other factors, such as the purpose of the provision seen in the light of its legal history and the consequences in various respects of the one or the other way of interpreting it.

5. The main purpose of the obligation to designate Contracting States under Article 79(1) in conjunction with Article 80(b) EPC can be assumed to be to make it clear at an early stage of the proceedings before the EPO to what extent protection for the invention is sought in the individual Contracting States, which it is of importance to know for various reasons (cf. inter alia Articles 54(4) and 66 EPC). Thus, the point is not to establish whether or not such protection is sought at all in any Contracting State, which is almost self evident in case of a European patent application, but rather to provide information in how many and in which Contracting States protection is sought. Since experience had shown that it is not always so easy for Applicants to decide on this matter already at the stage of filing the European application, the EPO introduced some years ago (cf. OJ EPO 1980, 395) the practice of "precautionary designation", which (as from 1986) means that in application Form 1001 all Contracting States are "automatically" designated. This gives the Applicants some further time to reflect on the matter of designation, i.e. a final decision may be postponed until the payment of the designation fees falls due under Article 79(2) EPC. The system is self regulating in the sense that if the designation fee for a Contracting State is not paid, the designation of that State shall be deemed

to be withdrawn (Article 91(1)(e) and (4) EPC) and only those States remain designated in respect of which the fees have been duly paid. In the unlikely event that no designation fee is paid at all, the European patent application shall be deemed to be withdrawn (Article 79(3) EPC).

6. The said practice of "precautionary designation" can be legally classified as a presumption of a general wish of Applicants to designate all Contracting States in the initial stage of the filing of a European patent application. There are in the Board's view no objections against such a practice, which is advantageous for Applicants and creates no harm to any public interest. So far, this practice has been confined to applications made on EPO Form 1001. However, there is hardly any valid reason to consider that the said legal presumption should be less strong in respect of applications made in another way, i.e. without making use of EPO Form 1001 (cf. Bossung in Münchner Gemeinschaftskommentar, 8. Lieferung, Art. 80, p. 31-32). The Board therefore takes the view that for the purpose of according a filing date under Article 80(b) EPC there is no need for an explicit designation of any particular Contracting State. In the absence of such a designation, the documents filed by the Applicant shall be considered to contain a precautionary designation of all Contracting States.

7. It follows from the above conclusion that in the present case, given the fact that the requirements under Article 80(a), (c) and (d) were considered to be fulfilled on 23 November 1987, that date shall be deemed to be the proper filing date irrespective of the lack of an explicit designation of any particular Contracting State in the documents filed on that date. Consequently, the Appellant is entitled to the claimed Italian priority of 27 November 1986.

8. In these circumstances, there is no need for the Board to deal with any other issue raised in the course of the proceedings of this case.

Order

For these reasons, it is decided:

1. The decision under appeal is set aside.
2. European patent application No. 87 202 400.5 shall be accorded the filing date of 23 November 1987 and is entitled to claim priority from Italian patent application No. 22 472 A/86 filed on 27 November 1986.

The Registrar:

J. Rückerl

The Chairman:

P. Ford