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Boards of Appeal

Chambres de recours

Case Number: J 0003/94

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 28 March 1995

Appellant: MITEL CORPORATION
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Decision under appeal: Decision of the Receiving Section of the European Patent Office dated 28 October 1993 refusing a request for re-establishment of rights with respect to European patent application No. 91 903 569.1.

Composition of the Board:

Chairman: R. Schulte
Members: R. E. Teschemacher
S. C. Perryman

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(B) To Chairmen and Members
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D E C I S I O N
of 28 March 1995

Case Number: J 0003/94 - 3.1.1

Application Number: 91903569.1

Publication Number: -

IPC: H01L 21/316

Language of the proceedings: EN

Title of invention:

Spin-on glass processing technique for the fabrication of semiconductor devices

Applicant:

MITEL CORPORATION

Opponent:

-

Headword:

Election/MITEL

Relevant legal provisions:

EPC Art. 111, 122, 156,

EPC R. 104b

PCT Art. 4, 31, 39

PCT R. 57

Keyword:

"EPO as an elected office"

"Election concerning the grant of a national patent not valid for the European grant procedure"

"Time limit for filing a request for re-establishment"

Decisions cited:

G 0003/91; G 0005/93; J 0027/90

Catchword:

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Facts and Submissions

- I. International application CA91/00041 was filed on 6 February 1991 with the Canadian Patent Office, claiming a priority of 7 February 1990. In Box No. V of the request (form PCT/RO/101, January 1991 issue) as filed, under the heading "Regional Patent" a cross in ink was placed in the box for indicating the European Patent, and under the heading "National Patent" there were placed typewritten crosses against five Contracting States to the PCT, comprising the Contracting States to the EPC Germany and United Kingdom.
- II. A demand for international preliminary examination (form PCT/IPEA/401, January 1991 issue) was filed with the EPO in its capacity as International Preliminary Examining Authority (IPEA) on 4 September 1991. In Box No. V of the demand under the heading "National Patent" there were the same typewritten crosses as in the request under the same heading, but under the heading "Regional Patent" no cross was placed in the box for indicating the European patent.
- III. On 20 September 1991, the Receiving Section of the EPO sent form 1201, containing information on the requirements for entering the regional phase before the EPO as designated or elected Office, including the requirement for appointing a European representative in the case of applicants not resident in a Contracting State to the EPC, to the Canadian attorney appointed as representative by the applicant in the international phase before the receiving Office. A communication pursuant to Rule 85a (1) EPC was sent directly to the applicant on 17 December 1991, informing it that the national basic fee and the designation fees had not been paid in time. The applicant was invited to pay the fees with a surcharge within a period of grace, being told that failure to do this would result in the application being deemed to be withdrawn. By a notification of 13 February 1992, the applicant was

informed pursuant to Rule 69 (1) EPC that the application was deemed to be withdrawn because the said fees had not been paid. The notification contained an express reference to the possibility of applying for a decision if the applicant considered the finding in the notification inaccurate.

- IV. On 5 August 1992, a European representative for the proceedings before the EPO was appointed who filed form 1200 and paid DM 4.180.-- for entering the regional phase. The Receiving Section verified with the International Bureau that no valid election had been made in respect of the EPO and informed the European representative by telephone that the application was already deemed to be withdrawn.
- V. On 8 September 1992, the applicant filed a request for restitutio in integrum in respect of the time limit of Rule 104b EPC for complying with the requirements for entering the regional phase. It was submitted that the failure to elect the EPO resulted from a mistake when the demand was filed. The clerk responsible had been instructed by the Canadian attorney to elect the same States as had been designated. Accordingly, he completed the demand by taking the indications of the file copy of the request form. In this copy, however, the cross for EP was missing. When filing the international application, the request form had been checked by the Canadian attorney who had noticed the missing cross for EP. He had added the cross by hand in the original sent to the receiving Office. This manuscript addition was, however, not copied on to the attorney's file copy. Believing that there was a valid election, the attorney assumed that the letter of 13 February 1992 was a standard letter on the expiry of Chapter I in cases where the EPO had been designated.
- VI. In a communication of 20 January 1993, the Receiving Section informed the applicant that it was intended to take a negative decision, because restitutio was excluded under Article 122(5) EPC for the time limit of Rule 104b EPC according to decision G 03/91. Neither was restitutio allowable for the time limit according to Article 39(1) PCT because non-observance of the time limit for an elec-

tion did not have the direct consequence of a loss of rights such as is referred to in Article 122(1) EPC.

- VII. In a reply dated 22 February 1993, it was argued on behalf of the applicant that decision G 03/91 did not apply to the present case because the nature of the facts was different. Alternatively, it was argued that the time limit of Rule 104b EPC had actually been observed because the election of Contracting States to the EPC (GB and DE) had the consequence that the EPO became an elected Office.
- VIII. In its decision of 28 October 1993, the Receiving Section rejected the request for re-establishment in respect of the time limits of Rule 104b EPC and Article 39 (1) (a) PCT for the reasons already stated in the preceding communication. It did not accept the new argument, alleging a valid election for the regional route by the election of Contracting States for the national route, because the EP-designations in the request form corresponded to the EP-elections in the demand form. If only states for the national route were indicated in the demand form the election was only effective for the subsequent national route.
- IX. The applicant filed an appeal on 22 December 1993, paying the appeal fee at the same time.

The arguments put forward in the statement of grounds, received on 2 March 1993, and in a reply to a communication of the Board, may be summarized as follows:

- X. While it was clear that a clerical error had been made in not marking the EP box in the demand, this error was not fatal because the applicant's actions were sufficient to cause the EPO to be deemed an elected Office by operation of law. It was not necessary for the applicant to indicate in the demand his preference for the EPC or national route. According to the PCT and the EPC, the applicant could only elect states not offices. Whereas Article 4 (1) (ii) PCT contained a requirement that the request for grant should indicate if the applicant wished to obtain a regional patent, there was no corresponding requirement

for the demand. In order for the time limit of 19 months to be extended under Article 39 PCT, it was merely necessary that the election of a Contracting State had been effected in due time. Corresponding with the PCT, the EPC required in Article 153 the applicant to apply for a European patent in the designated States, whereas Article 156 did not contain any equivalent provision. Therefore, the EP indication in the request form of all Contracting States to the EPC and the indication of Germany and the United Kingdom in the demand established that the applicant actually fulfilled the requirements prevailing at the time.

- XI. A requirement to distinguish in the election of states between the regional and national routes was only introduced when Rule 53.7 PCT was amended, which amendment entered into force on 1 July 1992, i.e. after the demand had been filed in the present case. Whereas the amended version stipulated that states which had been designated for the purpose of obtaining a regional patent had to be elected "by an indication of the regional patent concerned" together with the respective states, no such requirement had existed before.
- XII. Furthermore it was denied, that the indication of Germany and the United Kingdom in the demand was to be interpreted as an election for any particular purpose. The EP box in the demand merely provided a convenient way of permitting the applicant to elect each and every one of the EP States with a single stroke of the pen, although in view of Article 156 EPC such election of all the states might not have been necessary. The states following the heading "National Patent" were merely those states that offered a national patent. There was no express statement that the applicant elected the states following this heading only for the purposes of a national patent. What would happen in the reverse case, i.e. if an applicant marked only the EP box and then tried to obtain a national patent in a Contracting State, was irrelevant because the result would depend on national law.
- XIII. With regard to the request for re-establishment of rights,

it was submitted that this was one of the first PCT applications handled by the Canadian patent attorney in view of Canada's recent accession to the PCT. There were many new procedures to learn at the national and international level. The attorney interpreted the information from the EPO in the communication of 13 February 1992 as an informative advice that the fees were not paid within the prescribed time limit under Article 22 (1) PCT. Thinking that no fees were necessary because it was Article 39 (1) PCT that governed in this case, he had good reason to believe that no further action was necessary. The notice from the EPO was not ignored; it was acted on, but unfortunately misinterpreted by the Canadian attorney who could not be expected to be familiar with detailed EPC regulations. He had actually pulled the file which showed the good standing of the application. Only with the benefit of hindsight in the light of later experience could he have been expected to come to a different conclusion.

XIV. The Appellant requested that the decision under appeal be set aside.

Reasons for the Decision

1. The appeal is admissible.
2. The first question that requires consideration is the contention that the election of Germany and the United Kingdom made the EPO an elected Office by operation of law.
 - 2.1. In support of his position the Appellant correctly starts from Article 4 (1) (ii) PCT dealing with designations. With regard to a state for which a regional patent is available, an applicant may obtain under this provision a national patent, unless this is excluded by national law, or a regional patent. If the applicant wishes to obtain the latter one, "the request shall so indicate" (Article 4

(1) (ii) PCT). Further detail is now contained in Rule 4.9 PCT which entered into force on 1 July 1992, i.e. after the request and the demand were filed in the present case. Article 4 (1) (ii) PCT is implemented by the form for the request which is prescribed under the Administrative Instructions (Rule 3.4 PCT). The request has to be made on the prescribed form (PCT/RO/101) and the form gives the proper way in which designations have to be made. The form contains two groups of designations by listing the respective states, the first under the heading "Regional Patent", subdivided in "EP European Patent" and "OA OAPI Patent", and the second under the heading "National Patent". This makes quite clear that for any state listed under "European Patent" as well as under "National Patent" there are two types of designations with regard to one and the same state, the designation for obtaining a European patent and the designation for obtaining a national patent. This seems not to be contested by the Appellant.

2.2 In respect of the demand, Article 31 PCT does not mention how elections are to be made regarding a state for which a European and a national patent is available in parallel. From this fact the Appellant derives that it is not necessary for an election to distinguish between the regional and the national route. Rather it is alleged to be sufficient for the EPO to become an elected Office in respect of a Contracting State to the EPC if this state has been elected in the demand under the heading "National Patent".

2.3 The Board cannot agree with this opinion. As explained above, a state which allows a regional patent and a national patent to be obtained via the PCT in parallel may be designated in respect of two different grant proceedings. Precisely, both designations have to be made in separate declarations in the request form by marking two different boxes under the headings "European Patent" and "National Patent". Article 31 (4) (a), last sentence, PCT stipulates that an election may relate only to Contracting States already designated under Article 4 PCT. With regard to a state providing for national and regional patents, this means that an election concerning the national grant

procedure is only possible if there was a designation indicating that the applicant wished to obtain a national patent. Vice versa an election concerning the regional grant procedure is only possible if there was a designation indicating that the applicant wished to obtain a regional patent. Otherwise, the distinction in Article 4 (1) (ii) PCT would be meaningless. Since both types of elections have effects on different grant proceedings, it seems obvious that the declaration to use the results of the international preliminary examination in the national grant proceedings is different from the declaration to use it in the European grant proceedings.

2.4 The correspondence of designations and elections, as laid down in Article 31 (4) (a), last sentence, PCT implements two principles. First, an election must not cover a designation which was not made when the application was filed. Second, it is the choice of the applicant for which office he intends to use the results of the international preliminary examination (Records of the Washington Diplomatic Conference on the PCT, Geneva 1970, Doc. PCT/PCD/2, Summary and Advantages of the PCT, para. 24; PCT Applicant's Guide, Geneva, Loose-leaf ed., Vol 1, para. 253). The applicant may decide whether he makes use of Chapter II and which office he wants to receive the international preliminary examination report ("optional character of chapter II"). These principles apply to all designations made by the applicant, whether they are designations for national or regional patents. It would run counter to the optional character of chapter II and restrict the applicants' procedural options substantially if they were forced to use the results of the international preliminary examination in the proceedings before the EPO only because they intend to use them in the proceedings before a national patent office. An applicant may have many reasons why he wants to have the results used in one office but not in another one, one reason being that he wants to speed proceedings up before one office and to delay it before another one. There is apparently no reason in the PCT to restrict the applicant in this direction.

2.5 The amendment to Rule 53.7 PCT, which entered into force

on 1 July 1992, did not change the law in respect of the different character of the elections for a regional patent and for a national patent. This amendment aimed at facilitating designations and elections, not at creating new formal requirements for them, as alleged by the Appellant. In particular, the amended Regulations provided for the further option of marking a single box in the demand form to indicate election of all those states which were designated in the request and which were bound by chapter II (Report on the 18th meeting of the PCT Assembly, Ind. Prop. 1991, p. 314, at p. 315). Since the individual checking, used so far, was not to be excluded, the legislator described both types of indications in the amended Rule. A corresponding amendment concerning designations was made in Rule 4.9 PCT, which shows that the legislator did not intend to introduce a formal requirement for elections in the Regulations which existed for designations in the Treaty itself.

2.6 The Board cannot share the Appellant's position concerning the interpretation of its declaration in the demand form, as prescribed under the Administrative Instructions on the basis of Article 31 (3) and Rules 53.1 (a), 89 PCT. This declaration corresponds exactly to the declaration in the request. The lay out of the forms is identical and the meaning of the terms used is to be interpreted in the same way. The heading "National patent" means in the request and in the demand that the declaration concerns the national grant procedure, whereas the heading "European Patent" means in both cases that the declaration concerns the European grant procedure. The requirements laid down in these forms are not mere technicalities, rather they implement the optional character of chapter II of the PCT. In fact, the evidence is that the Canadian attorney was aware that the box "EP European Patent" required to be marked on the form for the demand, and it was only by error that this was not done in the form filed.

2.7 Contrary to the Appellant's submissions, it is not only a matter for the national law to decide whether an election made for the regional route is also valid in respect of a national office. Correspondingly, it is not only a matter

for the EPC to decide whether an election made for the national route is also valid for the EPO. The validity of an election has to be decided during the international phase in order to give effect to the election. The IPEA has to examine the demand and the international authorities have to fulfil their obligations resulting from a valid election (cf. Articles 31 (7), 36 (3), Rules 61, 71, 73 PCT). In particular, the results of the international preliminary examination have to be kept secret (Article 38 PCT) which means i.a. that the report must not be transmitted to an office which has not been elected. Therefore the validity and scope of an election must be clear not only for the applicant and the elected Office but also for the Authorities in the international phase. The validity of the election has to be assessed on a uniform basis by the Authorities concerned. The Board does not hesitate to share the approach taken by the IPEA and the International Bureau of WIPO which is apparently in agreement with the consistent practice to the PCT (see PCT Applicant's Guide, op. cit.).

- 2.8 The Appellant's argument based on Article 156 EPC also fails, as this says "The European Patent Office shall act as an elected Office ... if the applicant has elected any of the designated States referred to in Article 153 (1) ... ". By referring back to Article 153 (1) EPC, the provision refers to all requirements indicated there. This means that a state has to be elected which is indicated for a European patent since Article 153 (1) deals only with states for which a European patent is requested. Otherwise the election would not correspond to the designation. The exclusion of a designation for a national patent in Article 153 (1) EPC has the consequence that an election for a national patent is different from an election for the purposes of Article 156 EPC.
- 2.9 It follows from the preceding that the EPO did not become an elected Office in the present case and that the time limit of 21 months was applicable for performing the acts under Rule 104b EPC.
3. The applicant has not complied with the time limit under

Rule 104b EPC. Therefore, his request for re-establishment of rights has to be dealt with.

- 3.1 The Receiving Section has not considered this request in substance. The request was rejected because it had been held in the decision of the Enlarged Board of Appeal G 03/91 (OJ EPO 1993, 8) that reinstatement into this period was excluded by Article 122 (5) EPC, overturning the previous case law. Subsequently, the Enlarged Board of Appeal decided that reinstatement could still be granted in cases where it had been applied for before decision G 03/91 was made available to the public (G 05/93, OJ EPO 1994, 447). This is the case here, so the request requires examination.
- 3.2 In exercising its discretion under Article 111 (1), first sentence, EPC, the Board considers that it would not be appropriate to refer this case back to the first instance. The request for re-establishment has obvious admissibility defects and in the interest of a streamlined procedure the Board prefers to take an immediate decision.
- 3.3 An application for re-establishment of rights must be filed within two months from the removal of the cause of non-compliance with the time limit (Article 122 (2), first sentence, EPC). According to the established case law, the cause of non-compliance is removed on the date on which the person responsible for the application is made aware of the fact that a time limit has not been observed (see J 27/90, OJ EPO 1993, 422, with further citations). In the present case, the applicant was informed by notification of 13 February 1992 (form 1205) that the application was deemed to be withdrawn because no national basic fee and no designation fee had been paid.
- 3.4. The cause of non-compliance can be regarded as the Canadian attorney's erroneous belief that the time limit of 31 months applied. The attorney received form 1205 on 3 March 1992, and at the very latest on this date there were no longer reasonable grounds for a belief on his part that the application was in order and that all necessary steps for a valid demand in respect of a European patent had

been taken, which was a condition for the time limit of 31 months to apply. A communication that the application has been deemed to be withdrawn puts the applicant and his attorney on notice that something has gone wrong and puts them on enquiry to find out what this is. If no such enquiry is made there are no longer reasonable grounds for believing that nothing requires to be done (cf. J 27/90, pt. 2.4 of the reasons) and the cause of non-compliance cannot be regarded as continuing. Yet re-establishment of rights was not requested until 8 September 1992, many months longer than the two month time limit.

3.5 The facts relied on provide no reason to deviate from the rule that the receipt of an information on the loss of rights removes the cause of non-compliance with the relevant time limit. It was submitted that the attorney checked the file and then conjectured that the communication was "essentially an advisory letter warning them from a division in the EPO dealing with Phase I entries that the basic and designation fees had not been paid within the twenty month period" and that the attorney therefore believed it could be ignored. The conjecture that the application was not deemed to be withdrawn, contrary to the clear wording of the notification, is not sufficiently inherently plausible to be regarded as a reasonable ground for the belief that nothing needed doing, in the absence of any appropriate attempt to verify that the conjecture corresponded to the true situation. A conscientious check of the attorney's own file would have revealed that the file copy of the demand was not marked in the box "EP European Patent".

3.6 Even without this information, the attorney had the opportunity to clarify the situation and to ask the EPO for an acknowledgement that it had made a mistake, and that nothing needed doing. On the evidence, the attorney making the conjecture knew that he had very little practical experience of an admittedly complicated procedure, and yet did not verify whether a mistake had been made in the EPO or in his own office.

- 3.7 In the circumstances the cause of non-compliance with the time limit must be regarded having been removed at the latest by 3 March 1992. For this reason, the request for re-establishment of rights was filed outside the time limit under Article 122 (2), first sentence, EPC and is, therefore, not admissible.
4. The Receiving Section has also examined a request for re-establishment of rights in respect of the time limit of Article 39 (1) (a) PCT, although such a request had not been submitted originally by the applicant. The Receiving Section decided that re-establishment was not possible in the absence of a loss of rights resulting from the non-observance of the time limit. The Appellant has not taken up this question in appeal proceedings. Therefore, the Board sees no reason to deal with this question. Such a request would raise the same objections to admissibility as the request concerning the time limit under Rule 104b EPC.
5. On the above basis the appeal must be dismissed. This means that the decision of the Receiving Section takes effect. Under the last point of the order of that decision all fees paid after 7 November 1991 are to be refunded. This does not apply to the fee for re-establishment of rights and the fee for appeal.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:



M. Beef

The Chairman:



R. Schulte

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