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D E C I S I O N
of 27 November 1997

Case Number: J 0011/95 - 3.1.1

Application Number: 90912293.9

Publication Number: 0487578

IPC: C07C 209/68

Language of the proceedings: EN

Title of invention:

Method of producing Tertiary Amine-Sulphur Trioxide Complexes

Applicant:

Cultor Ltd

Opponent:

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Headword:

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Relevant legal provisions:

EPC Art. 87(1), 88(1), 91(3)

EPC R. 38(3), 69, 90(1)(b), 104b(3)

PCT R. 17.1(a), 17.1(c)

Keyword:

"Priority right - Claiming priority - Filing of priority document (no) "

"Loss of right of priority - Interruption of proceedings (no) "

Decisions cited:

J 0001/80, J 0014/82

Catchword:

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Case Number: J 0011/95 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 27 November 1997

Appellant: Cultor Ltd.
Kyllikinportti 2
00240 Helsinki (FI)

Representative: Patentanwälte
Zellentin & Partner
Zweibrückenstrasse 15
80331 München (DE)

Decision under appeal: Decision of the Receiving Section of the European Patent Office dated 3 November 1994 according to which the right of priority for the European patent application No. 90 912 293.9 was lost pursuant to Article 91(3) EPC.

Composition of the Board:

Chairman: J.-C. Saisset
Members: B. J. Schachenmann
G. Davies

Summary of Facts and Submissions

- I. Euro-PCT patent application No. 90 912 293.9 (International publication No. WO 91/00852) was filed by A/S Køge Stormølle on 6 July 1990 claiming the priority of Swiss patent application No. 2672/89-6 the applicant of which was ENCO Engineering Chur AG, a company having its place of business in Switzerland.
- II. On 16 January 1992 A/S Køge Stormølle filed a request for examination and paid the fees for the entry of their Euro-PCT application into the regional phase before the EPO. At the same time they filed papers explaining that the priority document could not be filed as ENCO Engineering Chur AG refused to supply such document. It also followed from these papers that A/S Køge Stormølle had been preparing a court action in Switzerland against ENCO seeking a judgment that they were entitled to the Swiss priority application. However, before opening such proceedings, they had gone bankrupt and a receiver had been appointed.
- III. On 5 October 1993 the European Patent Office issued a notification inviting the applicants to file the priority document within a period of two months informing them that otherwise the right of priority for the Euro-PCT application would be lost under Article 91(3) EPC.
- IV. A/S Køge Stormølle replied that at present they were unable to obtain a certified copy of the previous Swiss application. However, since these circumstances fell within Rule 90(1)(b) EPC, the proceedings should be interrupted in accordance with Rule 90 EPC.
- V. With letter of 30 December 1993 the Legal Division asked for documents establishing that the applicants were prevented by legal reasons from continuing the proceedings before the EPO.

- VI. On 25 January 1994 the EPO issued a notification pursuant to Rule 69(1) EPC according to which the right of priority was lost under Article 91(3) EPC. Thereupon, on 23 March 1994, A/S Køge Stormølle applied for a decision under Rule 69(2) EPC and paid a fee for re-establishment of rights. They requested that the loss of rights as decided by the EPO be reversed.
- VII. In its decision of 3 November 1994, the Receiving Section refused this request. As the priority document had not been filed either within the period prescribed by the Convention or within the grace period following an invitation to do so by the Receiving Section, the right of priority was deemed to be lost pursuant to Article 91(3) EPC. Moreover, A/S Køge Stormølle were not entitled to claim the priority since they did not hold the right to the priority at the date of filing of their application.
- VIII. On 28 December 1994, A/S Køge Stormølle (in bankruptcy) filed a notice of appeal against this decision and paid the appeal fee. In the statement of grounds filed on 10 March 1995, the appellants submitted that they should be granted valid priority from the previous Swiss application to which they had a legitimate claim. Alternatively, the proceedings should be interrupted under Rule 90(1)(b) EPC since A/S Køge Stormølle had gone bankrupt at the end of October 1990 and was thus prevented by legal reasons from conducting the proceedings before the European Patent Office necessary to protect its rights.
- IX. In 1995, Euro-PCT application No. 90 912 293.9 was assigned from A/S Køge Stormølle (in bankruptcy) to Pfizer, Inc. which, in 1996, transferred it to the Finnish company Cultor Ltd. The present appellants are therefore Cultor Ltd., Helsinki.

- X. In a first communication, the Legal Board of Appeal pointed to Article 87 EPC according to which it is the applicant of the previous application or his successor in title who enjoys a right of priority. However, no evidence had been produced showing that the priority right had been assigned to the appellants. But even if this were the case the priority seemed to be lost due to the appellants' failure to file a copy of the previous application in time.

As to the auxiliary request for interruption of proceedings, it was mentioned that A/S Køge Stormølle (in bankruptcy) had continued the proceedings before the EPO until the beginning of 1992. In any case, the conditions under Rule 90(1)(b) EPC had no longer been complied with since 13 November 1995, when the application had been transferred to PFIZER INC.

- XI. On 25 March 1997, the appellants submitted a copy of the priority document Switzerland No. 2672/89 stating that the same had reached WIPO already on 23 July 1990 and should therefore be deemed to have been duly filed.
- XII. In reply, the Board pointed out that the priority document referred to above had not been filed by the appellants with reference to their Euro-PCT application but by a third party in connection with another application. Thus, this filing did not meet the requirements of Article 88(1) EPC with respect to the appellants' Euro-PCT application.

XIII. At the oral proceedings held on 27 November 1997, the appellants in principle accepted this view. However, in their opinion, it was unduly formalistic since it did not take into account that A/S Køge Stormølle was indeed the rightful owner of the invention disclosed in the previous Swiss application and that a certified copy of that application was present within the Office in time. The appellants therefore requested that the decision under appeal be set aside and that they be granted the priority from Swiss patent application No. 2672/89-6. The auxiliary request for interruption of the proceedings was maintained.

Reasons for the Decision

1. The appeal is admissible.
2. The first question to be considered is whether, in the circumstances of the present case, the requirements provided under the PCT and/or the European Patent Convention for claiming a priority were complied with.
 - 2.1 Rule 17.1(a) PCT prescribes that, where the priority of an earlier national application is claimed, a certified copy of the national application has to be submitted by the applicant to the International Bureau not later than 16 months after the priority date, unless already filed with the receiving Office. If this requirement is not complied with, any designated State **may disregard** the priority claim (Rule 17.1(c) PCT).
 - 2.2 The EPC did not make use of the option referred to above. Pursuant to Rule 104b(3) EPC, where the priority document provided for in Article 88(1) and Rule 38 EPC has not yet been submitted at the expiry of the 21 or 31 months period for entry into the regional phase, the European Patent Office shall invite the applicant to furnish the same within

such period as it shall specify. The failure to comply with this invitation leads, pursuant to Article 91(3) EPC, to a loss of the right of priority.

- 2.3 In the circumstances of the present case, it is not disputed that, upon the invitation of the EPO dated 5 October 1993, the appellants failed to furnish a certified copy of the previous application within the set period. Thus, the Receiving Section was correct in noting, based on Article 91(3) and Rule 69 EPC, the loss of the right of priority for the present patent application (See also J 1/80, OJ EPO 1980, 289).

Even if the appellants' request for a decision under Rule 69(2) EPC were understood as an application for further processing (Article 121 EPC) or an application for *restitutio in integrum* (Article 122 EPC), the loss of the priority right could not be reversed since the omitted act, i.e. the filing of the priority document, had not been completed within the periods provided for in the provisions referred to above.

3. This finding was criticized by the appellants as overly formalistic since, as they submitted, the priority document had reached the Office in time, even though for another application. The Board does not share this opinion. The requirements laid down in Article 88, Rule 38 and Rule 104b(3) EPC for the claiming of priority cannot be considered as mere formalities. As pointed out by the Boards of Appeal in connection with the declaration of priority, the particulars of the claimed priority are of importance for the information of third parties (J 14/82, OJ EPO 1983, 122). The same is true for the priority document. There is a public interest in knowing whether and to what extent a priority claim is justified. In this context, the provisions of Rule 38(3) and 104b(3) EPC ensure that a certified copy of the previous application is available

to third parties requesting an inspection of files in due time after publication or entry into the regional phase of the European patent application.

In the circumstances of the present case, these objectives were not achieved through the filing of a certified copy of the previous Swiss application by ENCO Engineering Chur AG with reference to their own international application. Obviously, the files of the appellants' application would not have revealed this document, included in a completely unrelated file, to a third party inspecting the files.

4. As the priority claim was lost already for the reasons given above, it is not necessary for the Board to examine the appellants' further submissions concerning the main request. Even if the appellants consider themselves to be the true owners of the previous Swiss application, they did not produce any assignment or other official document to the effect that they were successors in title of the applicants of the previous application as required, pursuant to Article 87(1) EPC, in order to make a valid claim to the priority. Instead, it appears that their right to claim the priority was always contested by the applicants of the previous Swiss application. However, such a dispute cannot be solved within the framework of the EPC since the European Patent Office has no jurisdiction to decide claims to the right to national patent applications or priority rights derived therefrom.
5. Since the appellants' main request cannot be allowed for the reasons set out above, the auxiliary request for interruption of the proceedings (see points VIII and XII, supra) has to be considered.
- 5.1 The auxiliary request refers to interruption of proceedings which, in the appellants' view, should be effective from the time A/S Køge Stormølle went bankrupt (i.e. October 1990) until a judicial solution to the conflict with ENCO

Engineering Chur AG has been reached.

5.2 According to Rule 90(1)(b) EPC, proceedings before the EPO shall be interrupted "in the event of the applicant (...), as a result of some action taken against his property, being prevented by legal reasons from continuing the proceedings before the European Patent Office".

5.3 In the circumstances of the present case, A/S Køge Stormølle (in bankruptcy) continued the proceedings before the EPO even after they had gone bankrupt in October 1990. In particular, they filed a request for entry into the regional phase before the EPO on 16 January 1992 and paid the corresponding fees. From these facts and since no evidence to the contrary has been filed it has to be concluded that A/S Køge Stormølle (in bankruptcy) was not prevented by legal reasons from continuing the proceedings before the EPO.

It rather appears that the failure to file a certified copy of the previous application was due to the appellants' difficulties in enforcing the asserted right to the Swiss application before the national Swiss courts. This, however, is clearly no reason for interruption of proceedings under Rule 90(1)(b) EPC.

5.4 In any case, the conditions for interruption of proceedings have not been met from the time when the present Euro-PCT application was first transferred to another company (see point IX., supra). The appellants never submitted that this company was prevented by legal reasons from continuing the proceedings before the European Patent Office.

5.5 For these reasons, the appellants' auxiliary request for interruption of proceedings cannot be granted.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

M. Beer

J.-C. Saisset