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**D E C I S I O N**  
of 18 December 2000

**Case Number:** J 0014/98 - 3.1.1

**Application Number:** 96910503.0

**Publication Number:** WO 96 29170

**IPC:** B23B 31/177

**Language of the proceedings:** EN

**Title of invention:**  
Fluid actuated chuck

**Applicant:**  
R.S.R. Adtec Ltd.

**Opponent:**  
-

**Headword:**  
PCT chapter II demand/ADTEC

**Relevant legal provisions:**  
EPC Art. 106, 122, 125, 150(3) 155(3)  
EPC R. 88, 104b, 104c  
PCT Art. 22, 26, 31(7), 34, 39(1), 48(2)  
PCT R. 60.1, 82bis, 91.1

**Keyword:**  
"PCT chapter demand - jurisdiction of the Boards of Appeal to review decisions of the IPEA (no)"

**Decisions cited:**  
J 0008/81, J 0020/89

**Catchword:**  
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Case Number: J 0014/98 - 3.1.1

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.1  
of 18 December 2000

**Appellant:** R.S.R Adtec Ltd.  
Rehov Katzir 2A  
Tel Hashomer  
52656 Ramat Gan (IL)

**Representative:** Gold, Tibor Z.  
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**Decision under appeal:** Communication of the Receiving Section of the  
European Patent Office dated 19 March 1998  
confirming deemed withdrawal of European patent  
application No. 96 910 503.0 pursuant to  
Rule 104c EPC.

**Composition of the Board:**

**Chairman:** J.-C. Saisset  
**Members:** B. J. Schachenmann  
P. H. Mühlens

## Summary of Facts and Submissions

- I. The present appeal was filed against a communication of 19 March 1998 of the Receiving Section of the European Patent Office confirming a prior notification of deemed withdrawal (EPO form 1205) issued on 23 April 1997 in connection with Euro-PCT application 96910503.0 (publication No. WO 96/29170) for which a priority of 22 March 1995 was claimed.
- II. The notification of 23 April 1997 was based on the fact that, despite the issuance of a communication under Rule 85a EPC, the applicant had not paid the fees for entry into the regional phase before the EPO within the twenty-one month period laid down in Rule 104b(1) EPC.
- III. In a letter dated 16 October 1997 the applicant pointed out that the EPC Contracting States had been elected under Article 39 PCT and that, therefore, the thirty-one (instead of the twenty-one) month period under Rule 104b(1) EPC applied in the present case. In fact, a demand for international preliminary examination (PCT chapter II demand) was filed in due time but, owing to a series of errors including a wrong application number in the demand, it went astray in the US Patent Office (USPTO) acting as International Preliminary Examination Authority (IPEA) under the PCT.

The applicant requested an opportunity to correct the PCT chapter II demand under Article 26 PCT and further requested that any delay be excused under Article 48(2) and Rule 82bis PCT. In the alternative the applicant requested restitutio in integrum under Article 122 EPC to allow correction of the PCT chapter II demand and the application to proceed under Article 39(1) PCT or,

in the further alternative, restitutio in integrum of the application as if it had entered the regional phase under Article 22 PCT. On 17 October 1997 the fees for entry into the regional phase before the EPO were paid.

IV. The communication under appeal was in response to these submissions and requests. It ended with the statement that: "Consequently, no legal remedy having been applied for within the two-month period specified in the communication dated 23 April 1997 (...) the loss of rights has become final".

V. In the notice of appeal and the statement of grounds the applicant (appellant) maintained the requests referred to above. Moreover, the principle of good faith was invoked as both the appellant and the US agents had a legitimate expectation that the PCT chapter II demand would be handled by the USPTO in a way that would not be detrimental to the applicant and that the European Patent Office would be notified by the USPTO of its election under Article 31(7) PCT.

VI. In a communication issued on 19 October 2000 as annex to the summons to oral proceedings the Legal Board of Appeal indicated that neither of the appellant's requests appeared to have any prospect of success. Rectification of the PCT chapter II demand under Rule 91.1 PCT was not possible without the express authorization of the IPEA (here the USPTO). Article 26 PCT only referred to corrections in the "international application" not including PCT chapter II demands. Correction under Rule 88 EPC referred to documents filed with the European Patent Office which was not the case with the present PCT chapter II demand. Restitutio in integrum within the time limits under Rule 104b EPC was excluded by Article 122(5) EPC. The principle of

good faith deriving from Article 125 EPC only applied to proceedings before the European Patent Office. Thus, there was no legal basis for allowing the appellant's requests.

VII. By a letter dated 1 December 2000 the Legal Board of Appeal was informed that the appellant would not attend the oral proceedings. The Board was invited to decide the appeal on the papers in front of it. In this connection the appellant referred to a judgment of the United States Court of Appeals for the Federal Circuit (CAFC) of 14 April 2000 dealing with the rejection of the appellant's request for correction of the PCT chapter II demand by the Commissioner of the USPTO. In its decision the CAFC first confirmed its jurisdiction over the matter. It went on to set out that, pursuant to Rule 60 PCT, the IPEA (USPTO) should have invited the applicant to correct the obvious errors in the demand and should have allowed the requested correction under Rule 91.1 PCT. The CAFC therefore remanded the case to the first instance with instructions to set the Commissioner's rulings aside and to return the case to the Commissioner for further proceedings, i.e. allowing the correction of errors in the PCT chapter II demand without loss of its October 21, 1996 filing date.

VIII. On 18 December 2000 oral proceedings were held in the absence of the appellant.

## **Reasons for the Decision**

### **1. *Admissibility of the appeal***

1.1 According to Article 106 EPC an appeal shall lie from decisions of the Receiving Section, Examining Divisions, Oppositions Divisions and the Legal

Division. Whether a document constitutes a decision or a (non appealable) communication depends on the substance of its contents, not on its form (see e.g. J 8/81, OJ EPO 1982).

1.2 In the circumstances of the present case, the document under appeal is a communication issued by the Receiving Section on 19 March 1998 in response to the applicant's letter of 16 October 1997 (see point III, supra). The communication contains detailed reasons why the requests of the applicant could not be allowed. It ends with the statement that: "Consequently, (...) the loss of rights has become final" (see point IV, supra). It clearly constitutes a reasoned rejection of the applicant's requests and, irrespective of its formal appearance, has therefore to be considered as a decision of the Receiving Section terminating the proceedings before it.

1.3 The appeal also complies with the other provisions mentioned in Rule 65(1) EPC. It is therefore admissible.

## 2. *Jurisdiction of the Legal Board of Appeal*

2.1 Under the provisions of the PCT it is the Office acting as IPEA (here the USPTO) which is responsible for deciding on the question of whether a PCT chapter II demand complies with the formal requirements laid down in the PCT (see Article 34 in combination with Rule 60.1 PCT, in particular Rule 60.1 (c) PCT). With the exception of Article 155(3) EPC concerning protest cases, the Board is not aware of any provision conferring jurisdiction to review legal acts of the IPEA on the Boards of Appeal (see also J 20/89, OJ EPO 1991, 375). Thus, neither the European Patent Office (if not acting as IPEA) nor the Boards of Appeal have jurisdiction concerning PCT chapter II demands.

- 2.2 The question of whether or not the effects of Article 39(1)(a) PCT apply in the proceedings before the European Patent Office is therefore to be decided on the basis of the conclusions of the IPEA responsible for the application. The same must be true if the IPEA (here the USPTO) acts under the orders of a final decision of a court (here the CAFC) binding on it. In any case the Legal Board cannot, for the reasons set out in point 2.1, question the jurisdiction of the CAFC in the present circumstances. Nor can the Board review the decision of the CAFC as to the merits.
- 2.3 Hence, the finding in the CAFC decision that the requested correction of errors in the PCT chapter II demand is allowable without loss of its October 21, 1996 filing date (see point VII, supra) constitutes the factual basis for the further proceedings before the European Patent Office in its capacity as designated or elected Office.
- 2.4 As far as decisions of European Patent Office in connection with the entry of PCT applications into the regional phase are concerned, the jurisdiction of the Boards of Appeal clearly derives from Article 150(3) EPC in combination with Rule 104b and c EPC (versions prior to the revision of 1998). Thus, in the present circumstances, the Legal Board of Appeal has jurisdiction to examine the decision of the Receiving Section of the EPO issued in the form of a communication dated 19 March 1998.
3. It follows from the above that the finding of the CAFC, according to which the PCT chapter II demand for the present application was validly filed on 21 October 1996, forms the factual basis for the present proceedings. Taking this into account, the election of the EPC Contracting States was effected on that date, i.e. prior to the expiration of the 19th month from the

priority date. In these circumstances, the provisions of Article 39(1) (a) and (b) PCT apply with the effect that the fees due under Rule 104b EPC for the entry into the regional phase could be paid within 31 months from the priority date, i.e. until 22 October 1997. In fact, the appellant paid the fees on 17 October 1997 (see point III, supra). Thus, no loss of rights pursuant to Rule 104c EPC (version prior to the revision of 1998) occurred.

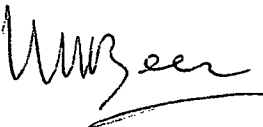
4. As the notification of deemed withdrawal of 23 April 1997 therefore lacks legal basis, it must be withdrawn. The proceedings are to be continued on the basis of the fact that the requirements for the entry into the regional phase before the European Patent Office were met.

#### Order

**For these reasons it is decided that:**

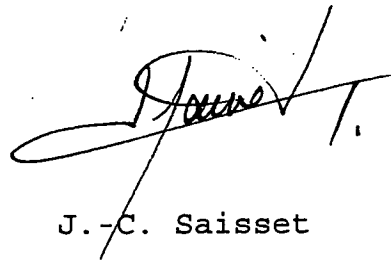
1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:



M. Beer

The Chairman:



J.-C. Saisset