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D E C I S I O N
of 22 March 2001

Case Number: J 0024/99 - 3.1.1

Application Number: PCT/US97/03583

Publication Number: WO 97/33161

IPC: G01N 25/18

Language of the proceedings: EN

Title of invention:
Heat Flow Meter Instruments

Applicant:
Holometrix, Inc.

Opponent:
-

Headword:
Jurisdiction of the Boards of Appeal

Relevant legal provisions:
EPC Art. 106, 154, 155
EPC R. 69(2)
PCT Art. 34(3), 39(1)a, 48(2)
PCT R. 57.4(a), 58.2(a), 61.1(b), 68.3

Keyword:
"Jurisdiction of the Legal Board of Appeal during the international phase of PCT applications"
"Administrative or judicial answer to a request"

Decisions cited:
J 0020/89, J 0015/91, W 0003/93

Catchword:
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Case Number: J 0024/99 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 22 March 2001

Appellant: Holometrix, Inc.
25 Wiggins Avenue
Bedford, MA 01730 (US)

Representative: Altenburg, Udo, Dipl.-Phys.
Patent- und Rechtsanwälte
Bardehle - Pagenberg - Dost - Altenburg -
Geissler - Isenbruck
Galileiplatz 1
D-81679 München (DE)

Decision under appeal: Communication of the European Patent Office
acting as International Preliminary Examination
Authority (IPEA) dated 16 November 1998 refusing
requests concerning a demand for international
preliminary examination concerning international
application PCT/US 97/03583.

Composition of the Board:

Chairman: J.-C. Saisset
Members: B. J. Schachenmann
R. T. Menapace

Summary of Facts and Submissions

- I. The applicants filed a PCT application for which the European Patent Office (EPO) acted as the International Searching Authority (ISA). Before the end of the 19 month period of Article 39(1)(a) PCT a demand for international preliminary examination was filed choosing the EPO as International Preliminary Examining Authority (IPEA) under Article 155 EPC and PCT Chapter II.

- II. On 21 November 1997 the IPEA informed the applicants of the fact that the preliminary examination fee and handling fee had not been paid and invited them, in accordance with Rule 57.4(a) PCT and Rule 58.2(a) PCT in the then valid version, to pay the fees within one month. On 22 January 1998 the IPEA issued a notification under Rule 61.1(b), second sentence, PCT according to which the demand was to be considered as not having been submitted since the applicants had not complied with the invitation referred to above.

- III. On 30 March 1998 the applicants paid the outstanding fees and a fee for restitutio and applied for a decision of the EPO under Rule 69(2) EPC. They requested that the fees referred to above be declared to have been paid in time and the international preliminary examination be proceeded with. As auxiliary request they applied for restitutio with respect to the time limits in question. According to their submissions the preliminary examination fee and handling fee had been paid to the US Patent Office on Monday, 22 December 1997, which constituted a timely payment of the due amount.

- IV. By letter of 6 May 1998 the IPEA (EPO) replied that there was no legal remedy in the international phase with respect to the time limits in question. Even if Article 48(2) PCT allowed any Contracting State to excuse, for reasons admitted under its national law, any delay in meeting any time limit, this provision did not apply to the EPO acting as IPEA. Thus, Article 122 EPC could not be applied in respect of the 19 month time limit according to Article 39(1)(a) PCT. The appellants, however, insisted on an appealable decision according to Rule 69(2) EPC.
- V. In a "communication" of 16 November 1998 the IPEA (EPO) pointed out that an appealable decision could not be issued under Rule 69(2) EPC. Nevertheless, the applicants' submissions were considered in detail. Finally, it was concluded "that the main request cannot be allowed" and that "the auxiliary request cannot be allowed either". It was added that the "communication", although not an appealable decision, was "final" and that the applicants, if they were of the opinion that there should be a means of redress, "may request a review by the Boards of Appeal of the EPO".
- VI. By letter of 17 December 1998 the applicants requested "review of this communication by the Boards of Appeal". No appeal fee was paid. On an auxiliary basis re-establishment with respect to the time limit for paying the preliminary examination fee and handling fee was requested. On 27 May 1999 reasons for these requests were filed. In the applicants' opinion it was a necessary consequence of the existence of Article 48(2) PCT that the International authorities must be competent to re-examine any of their findings relating to non-observance of time limits.

VII. By a communication of 30 March 2000 the present Board informed the applicants that, according to the constant jurisprudence of the Boards of Appeal of the EPO, the Boards had no jurisdiction to examine appeals against actions taken by the EPO in its capacity as International Preliminary Examination Authority (IPEA), with the exception of protests against additional fees charged by the IPEA under Article 34(3) PCT. *A fortiori* the same applied to the requested "review" by the Boards of Appeal of a communication of the IPEA.

Reasons for the Decision

1. *Administrative or judicial answer*

1.1 The requests of the applicants are aimed at a review by the Boards of Appeal of a communication issued by the EPO in its capacity as IPEA within the meaning of PCT Chapter II (see point V, *supra*). In the communication it was pointed out that no appealable decision under Rule 69(2) EPC could be issued by the IPEA since this was not compatible with the PCT system during the international phase of a PCT application. Nevertheless, it ended with the statement that the applicants, if they were of the opinion that there was a means of redress, "may request a review by the Boards of Appeal of the EPO". No legal basis for such a "review" was indicated.

1.2 Indeed, it is the IPEA alone which, under the provisions of the PCT, is responsible for deciding on the legal consequences following from the payment or non-payment of the fees due for PCT Chapter II demands (see Article 34(1) in combination with Rules 57.4 and 58.2 PCT in the then valid version). The PCT does not contain any provision allowing for a review of the

findings of an IPEA by a second instance **during the international phase**, with the exception of protests under Rule 68.3 PCT against invitations of an IPEA to pay additional fees (see Gall, *Der Rechtsschutz des Patentanmelders auf dem Euro-PCT-Weg*, GRUR Int.1981, p. 417 ff, para. 6). This is confirmed by the jurisprudence of the Boards of Appeal of the EPO according to which the Boards lack jurisdiction to examine actions taken by the EPO in its capacity as IPEA, with the sole exception of the protests referred to above (see decisions J 20/89, J 15/91).

- 1.3 Thus, the question arises whether, in these circumstances, a decision can be issued at all by a Board of Appeal of the EPO. In this connection it is to be considered that the IPEA, in its communication, invited the applicants to request a review by the Boards of Appeal. The applicants thus merely followed this advice. The issuance of a decision of a Board of Appeal therefore appears to be appropriate in accordance with the principle of good faith, as the applicants could legitimately expect to receive an answer from a Board.

In these circumstances the present Board of Appeal is satisfied that the requests of the applicants deserve a judicial rather than a purely administrative answer.

2. *Lack of jurisdiction of the Boards of Appeal*

- 2.1 The applicants' requests do not constitute an appeal under Article 106 EPC nor a protest under Rule 68.3(c) PCT, but aim at a review, by the Boards of Appeal, of the findings of the IPEA contained in the communication referred to above. According to the applicants'

submissions it is a necessary consequence of the existence of Article 48(2) PCT that the International authorities are competent to re-examine any findings of theirs relating to non-observance of time limits.

2.2 The present Board needs not consider this argument, as it is not acting as an International authority under the PCT. The jurisdiction of the Boards of Appeal is limited by the provisions of the EPC, in particular by Articles 21 and 106 EPC, which do not confer any jurisdiction on them to review actions taken by the EPO in its capacity as International Preliminary Examination Authority (IPEA). As mentioned above, the only exception to this principle concerns protest cases for which the responsibility of the Boards of Appeal explicitly derives from Articles 154(3) and 155(3) EPC. Thus, it is only in connection with the protest procedure that the Boards, based on their limited jurisdiction, can consider applications for restitutio with respect to time limits to be complied with during the International phase of PCT applications (W 3/93, OJ EPO 1994, 931).

2.3 However, in the circumstances of the present case, no action of the IPEA falling within the ambit of Articles 154(3) and 155(3) EPC is at issue. The Board therefore has no jurisdiction to consider the applicants' requests for review and for restitutio referred to above and cannot, for this reason, consider their submissions as to the substance.

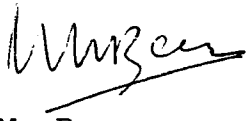
3. Since the fee for restitutio in integrum was therefore paid without reason, it must be reimbursed.

Order

For these reasons it is decided that:

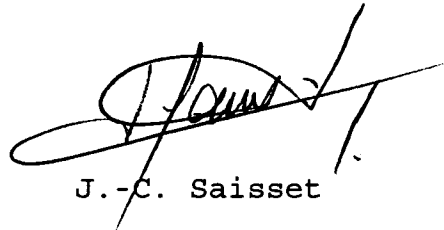
1. The Board has no jurisdiction to examine the present requests.
2. The fee for restitutio in integrum must be reimbursed.

The Registrar:



M. Beer

The Chairman:



J.-C. Saisset