

Decision of Technical Board of Appeal 3.4.2 dated 17 April 1997

T 382/94 - 3.4.2

(Translation)

Composition of the board:

Chairman: E. Turrini

Members: B. J. Schachenmann

S. Steinbrener

R. Zottmann

M. Lewenton

Applicant: Carl Zeiss et al.

Headword: Documents as filed/CARL ZEISS

Article: 14, 70, 80, 90, 91, 123(2) EPC

Rule: 32(2)(j), 39, 43, 67, 88 EPC

Keyword: "Accordance of date of filing" - "Documents as filed" - "Languages of the EPO" - "Text matter in the drawings" - "Authentic text of a European patent application"

Headnote

I. The Convention does not make the accordance of the date of filing dependent on whether text matter in the drawings is in the same language as that of the description

and claims in accordance with Article 14(1) and (2) EPC.

II. If the drawings are filed in full on the date of filing, they form part of the application as filed, even if they contain text matter in an official language other than the language of the proceedings. There is nothing to prevent the application being amended on the basis of a translation of this text matter into the language of the proceedings.

Summary of facts and submissions

I. European patent application No. 87 104 961.5 was filed on 3 April 1987 with a description, ten claims and an abstract all in the German language, as well as drawings (Figures 1 to 25). Of these, Figures 18, 19 and 25 contained so-called flow sheets with text matter in English. The application was published in this form on 11 November 1987.

II. In a communication of 21 April 1992 the examiner dealing with the case (the primary examiner) informed the applicants (appellants) for the first time that because of the English-language text matter in the drawings the application did not satisfy the requirements of Article 14(1) EPC, according to which European patent applications must be filed in **one** of the official languages. Moreover, under Rule 32(3) EPC flow sheets were considered drawings which, with the exception of a single word or words, should not contain text matter (Rule 32(2)(j) EPC). There was no apparent way of dealing with this problem other than deleting the figures concerned, as the use of another official language for this part of the application was inadmissible under Article 14(3) EPC.

III. With their reply of 21 August 1992 the appellants submitted amended Figures 18, 19 and 25, in which the English-language text matter had been replaced by short catchwords in German. The description had been amended to include the text matter which had been removed from the drawings and translated into German. The appellants were of the opinion that, regardless of Article 14(3) EPC, the English-

language text matter in the drawings formed part of the content of the application as filed. The changes made did not therefore infringe Article 123(2) EPC.

IV. In a communication of 24 November 1992, the primary examiner asked the appellants to retract these changes and to delete Figures 18, 19 and 25. Under Article 123(2) EPC the changes were inadmissible because Article 70 EPC implied that only what was disclosed in the language of the proceedings was part of the content of the application as filed.

V. In two further submissions of 11 May and 3 September 1993 as well as in a consultation with members of the examining division on 3 June 1993 the appellants insisted on their point of view and requested that the said changes be admitted as a correction under Rule 88 EPC.

VI. In its decision of 9 December 1993 the examining division refused the application on the basis of Article 97(1) EPC, as it infringed Article 123(2) EPC.

According to the grounds for the decision, the provisions of the EPC which are central to legal certainty and the enforcement of patent protection, such as Articles 2(2), 69, 70 and 123 EPC for example, depend in their function on Article 14(1) EPC in that the latter stipulates that only one official language may be used. This can also be derived from Article 80 EPC. The legal consequences of non-observance of this requirement can only be that text matter not in the language of proceedings selected by the applicant cannot be deemed to be part of the documents as filed.

In particular, this deficiency cannot be remedied by way of a correction under Rule 88 EPC. However, no such request was made in the first place.

VII. The appellants lodged an appeal against this decision on 11 February 1994 and paid the appeal fee. They requested that the contested decision be set aside and that the patent be granted on the basis of the amended documents submitted on 21 August

1992, taking into account the changes made to claim 3 during the consultation on 3 June 1993.

VIII. In their written reasons of 7 April 1994 the appellants reaffirmed their position with reference to the following arguments:

(i) The contested decision failed to appreciate that in the present case the description and claims had actually been filed in one official language, such that the application satisfied the requirements of Article 80 EPC, as was confirmed by the accordane of a date of filing by the European Patent Office. The consequence of this was that the totality of the documents as filed counted as the disclosure.

(ii) On the other hand, neither Article 14 EPC nor Article 70(1) EPC said anything about the content constituting disclosure of an application which had been accorded a date of filing. The contested decision was based on too narrow an interpretation of these provisions and thus contradicted decision J 15/88 (OJ EPO 1990, 445). According to the latter decision, an applicant normally has the right to derive subject-matter from any part of the description, claims or drawings as originally filed. Any limitations of this right must be construed narrowly.

(iii) Furthermore, the significance of decision J 7/80 (OJ EPO 1981, 137) had not been recognised. This decision related to a case in which an application was filed in two different languages, ie the description and claims in accordance with Article 14(2) EPC in Swedish and a request for grant in English. It was decided that components of an application which were not submitted in the language of the description and claims, ie in this case the request for grant, could be corrected under Rule 88 EPC. This was in line with decisions G 3/89 and G 11/91 (OJ EPO 1993, 117, 125) by the Enlarged Board of Appeal. Moreover, a request for correction had in fact already been made in the proceedings before the department of first instance.

By way of addition, a request for reimbursement of the appeal fee was submitted.

Reasons for the decision

1. The appeal is admissible.

2. The point of law which arises in connection with the rejected European patent application is whether text matter in drawings which is in an official language other than the language of the proceedings is part of the content of the application as filed and whether in this respect it is possible to correct the application. According to the contested decision, this is not possible.

3. Article 14 EPC prescribes the languages in which European patent applications must be filed, namely in one of the official languages of the European Patent Office (Article 14(1) EPC) or one of the other languages permitted under Article 14(2) EPC. The official language in which a European patent application is filed or into which it is translated under Article 14(2) EPC forms the language of the proceedings according to Article 14(3) EPC. The text of the application or patent in this language of proceedings is according to Article 70(1) EPC the authentic text in proceedings before the European Patent Office and in the contracting states.

4. These provisions give rise to the principle that the European patent grant procedure is carried out in one language only, that is in whichever one of the three official languages of the European Patent Office was selected by the applicant (see *J. B. van Benthem*, "Die Lösung der Sprachenfrage im Europa-Patentübereinkommen I", Mitt. der deutschen Patentanwälte, 1973, 129). However, this principle cannot be applied without restriction to the European patent application documents as filed. This is clear from Article 70(2) EPC, according to which if a language as referred to in Article 14(2) EPC is used, the original text of the application in a non-official language shall constitute the basis for determining the content of the application.

The Convention does not contain a provision such as Article 126 of the German Patent Law, under which submissions in a language other than the official language are

generally not taken into consideration. A corresponding legal consequence is provided for under Article 14(5) EPC only for documents other than those making up the European patent application.

5. In establishing the minimum requirements to be placed on an application on the filing date, under the system of the Convention it is primarily Article 80 EPC which is the determining factor (see *Teschemacher*, "Münchener Gemeinschaftskommentar", Article 83 EPC, note 6).

According to Article 80(d) EPC accordance of the date of filing depends on whether the documents filed by the applicant contain "a description and one or more claims" in one of the languages referred to in Article 14(1) and (2) EPC. As far as the choice of the language of proceedings is concerned, these are the significant parts of the application (see J 7/80, OJ EPO 1981, 137). If an application does not satisfy the above-mentioned requirements, the filing date is deemed in accordance with Article 90(2) and Rule 39 EPC to be the date on which the corresponding deficiency was remedied within the time limit. Otherwise the application will not be dealt with as a European patent application.

The same must also apply where **parts** of the description or claims do not meet the provisions of Article 80(d) EPC, eg because they are drafted in another language. However, this is not the case here. In the present application, both the description and the claims were submitted in accordance with the provisions in one official language (German). There is therefore no need to look any further into issues connected with this aspect.

6. On the other hand, however, the Convention does not make the accordance of the date of filing under Article 80 EPC dependent on whether any text matter in the drawings is in a language in accordance with Article 14(1) and (2) EPC. In this connection it should be remembered that, according to Rule 32(2)(j) EPC, drawings, which according to Rule 32(3) EPC include flow sheets, may contain text matter (see

Guidelines for Examination in the EPO, Part C-II, 5.1).

If the drawings are submitted in full on the date of filing, the establishment of the filing date cannot as a result be dependent on whether they contain text matter in a language other than the language of proceedings. The special provision under Article 91(1)(g) and Rule 43 EPC (re-dating of the filing date where drawings are filed late) relates exclusively to the question of whether any drawings were filed at all on the date of filing. For this reason the Receiving Section correctly accorded the present application the filing date of 3 April 1987.

7. The accordane of a date of filing can by its very nature relate only to the whole of the application documents filed in accordance with Article 80 EPC. The Convention does not contain any provision which prescribes that the filing date can be accorded to only a part of these documents. As a result, according to Article 123(2) EPC the limits for changing or correcting the parts of an application affecting the disclosure (ie the description, claims and drawings) are defined by "what a skilled person would derive ... from the whole of these documents as filed" (G 3/89, reasons, 3 (OJ EPO 1993, 117)).

It would therefore appear to be alien to the Convention, despite the accordane of a filing date, not to recognise certain parts of the description, claims or drawings actually filed on the date of filing as part of the documents as filed. The content of the European patent application as filed is established with the description, claims and, where appropriate, the drawings (G 2/95, reasons, 4 (OJ EPO 1996, 555)).

8. In the present case there is no doubt that the flow sheets filed with the English-language text matter are drawings within the meaning of the Convention. This is evident not only from their designation as figures, but also in particular from the fact that flow sheets are deemed to be drawings under the Implementing Regulations (Rule 32(3) EPC).

For the reasons set out in 4 to 7 above, the board therefore concludes that Figures 18,

19 and 25 as filed on the date of filing are part in their entirety of the present application as filed. There is thus nothing to prevent the application being changed on the basis of a translation into the language of the proceedings of the English-language text matter in these figures. In particular, this does not represent an infringement of Article 123(2) EPC. The extent to which the translated text matter may remain in the drawings or must be moved to the description is to be determined in accordance with Rule 32(2)(j) EPC and is not the subject of the present procedure.

9. The decision of the examining division to refuse the application was based solely on its view that the inclusion in the description and drawings of the German translation of the above-mentioned English-language text matter represented an infringement of Article 123(2) EPC. As to whether or not the other requirements of the Convention have been satisfied, no final statement or decision has as yet been issued by the examining division. The board is therefore making use of its authority in accordance with Article 111 EPC to remit the case to the examining division for further prosecution.

As the appellants are not adversely affected by this remission to the examining division, there was no need to set a date for oral proceedings (see T 166/91, T 924/91).

10. The case law of the boards of appeal cited by the appellants in the examination procedure does not contain a direct answer to the point of law decided in the present case. The examining division duly exercised its discretion in applying and interpreting the relevant provisions of the Convention. No procedural violation has been found. There is thus no reason to reimburse the appeal fee under Rule 67 EPC.

Order

For these reasons it is decided that:

1. The contested decision is set aside.

2. The case is remitted to the examining division for further prosecution.

3. The request for reimbursement of the appeal fee is rejected.