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D E C I S I O N
of 15 June 2004

Case Number: J 0016/01 - 3.1.1

Application Number: 97951734.9

Publication Number: 0946342

IPC: B28B 1/08

Language of the proceedings: EN

Title of invention:

Viscosity control for molten plastics prior to molding

Applicant:

Stratek Plastics Limited

Opponent:

-

Headword:

Correction of error/Restitutio in integrum/STRATEK PLASTICS
LIMITED

Relevant legal provisions:

EPC Art. 122(5), 157(2), 158(2), 79(2)

PCT Art. 48(2)

EPC R. 69(1), 88, 85a, 107

Keyword:

"Correction of designation of a country (Euro-PCT
application)"

"Re-establishment of rights"

Decisions cited:

J 0027/96, J 0021/84, G 0002/97, G 0005/93

Catchword:

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Case Number: J 0016/01 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 15 June 2004

Appellant: Stratek Plastics Limited
30 Herbert Street
Dublin 2 (IE)

Representative: MacLachlan, Norman William
c/o MacLachlan & Donaldson
47 Merrion Square
Dublin 2 (IE)

Decision under appeal: Decision of the Receiving Section of EPO dated
14 February 2001 refusing correction under
Rule 88 EPC as well as re-establishment of
rights pursuant to Article 122 EPC concerning
EURO-PCT Application No. 97951734.9.

Composition of the Board:

Chairman: J.-C. Saisset
Members: V. Di Cerbo
G. E. Weiss

Summary of Facts and Submissions

I. This appeal has been lodged against the decision of the Receiving Section of the European Patent Office dated 14 February 2001 to refuse a request for correction pursuant to Rule 88 EPC as well as a request for re-establishment of rights pursuant to Article 122 EPC, both requests concerning Euro-PCT application No. 97951734.9 (PCT/US97/23298).

II. The relevant matters regarding said requests can be summarized as follows:

(i) In a letter dated 24 March 2000 the applicant's European patent attorney requested correction pursuant to Rule 88 EPC of an error in EPO Form 1200 (pertaining to entry into the regional phase before the European Patent Office) despatched to the EPO with a letter dated 19 May 1999, the error being the omitted indication in Section 10 of the form that the designation fees were also to be paid in respect of Germany.

The request was based on the allegation that the indication above was omitted due to an error on the part of the applicant's US attorney when instructing the applicant's European patent attorney. The following circumstances in particular were cited:

a. On 8 May 1999 the applicant instructed his US attorney, by fax, to enter his PCT application into the European regional phase designating France, the United Kingdom,

Ireland, Germany, Italy, Spain, Portugal, Switzerland, Belgium, Luxembourg, the Netherlands, Sweden and Austria. Denmark and Finland were subsequently added to the above list in the fax by the applicant's US attorney during a telephone conversation with the applicant;

- b. On 13 May 1999 the applicant's US attorney despatched a letter instructing the European attorney to take the necessary steps before the EPO. This letter included a list of countries to be designated in the European regional phase and mentioned all the countries specified by the applicant except Germany, which was omitted due to an oversight on the part of the US attorney;
- c. On 22 February 2000, in a meeting between the applicant and his US attorney, the applicant became aware, for the first time, that Germany had not been designated in the European application.

In the same letter, correction of the fee voucher (EPO Form 1010) was also requested accordingly (i.e. with reference to the amount of the designation fees).

Furthermore the applicant's representative requested that a communication pursuant to Rule 85a(1) EPC be issued, inviting him to pay the unpaid designation fee (i.e. the fee concerning the designation of Germany) and authorized the EPO

to debit the amount of the fee and any surcharge should the request for correction be allowed.

- (ii) In a letter dated 20 April 2000 the applicant's representative requested in the alternative re-establishment of rights pursuant to Article 122 EPC with reference to the time limits for the payment of the designation fee concerning the designation of Germany.

Such a request was based on the same circumstances described under points (i) a. - c. above. The applicant's representative maintained that, since the non-payment of the designation fee for Germany on entry of the PCT application into the regional phase before the EPO was due to an oversight on the part of the applicant's US attorney, it was evident that the resulting loss of rights was not the fault of the applicant. Hence there was no reason to doubt that the applicant had taken all due care required by the circumstances and that, therefore, his right to the designation of Germany had to be re-established pursuant to Article 122 EPC.

III. In a letter dated 8 August 2000 the Receiving Section of the EPO informed the applicant that neither request was to be considered as allowable.

IV. Following a letter containing comments by the applicant's representative dated 14 September 2000, the Receiving Section, on 14 February 2001, decided as follows: "1. The request for correction by adding the missing designation of Germany is rejected. 2. The

request for *restitutio in integrum* under Art. 122 EPC of the applicant in the right to be notified of a communication under Rule 85a(1) EPC in respect of payment of the designation fee for Germany is rejected".

V. Notice of appeal against this decision was filed in a letter dated 20 April 2001, received at the EPO on the same date. The appellant requested that the request for correction by adding the missing designation of Germany and/or that the request for *restitutio in integrum* under Article 122 EPC be granted. On the same date the appeal fee was paid.

VI. In a letter dated 22 June 2001 and received at the EPO on 25 June 2001 the statement of grounds was filed. The grounds of appeal are summarized as follows:

(i) The statement in the decision under appeal, according to which the means of redress provided by Rule 88 EPC is not available for correction of EPO Form 1200, since this contains only a declaration of intention on the part of the applicant, cannot be accepted. The wording of the EPO form shows that it contains a positive declaration and not merely an indication of intention. Moreover, since EPO form 1200 and the fee sheet are to be considered as documents, Rule 88 applies also to them, given that according to its wording mistakes in any document filed with the European Patent Office may be corrected on request.

(ii) The argument in the appealed decision that indications relating to the purpose of fee payment

are not normally subject to correction under Rule 88 EPC must be considered as erroneous, since Article 7(2) of the Rules relating to fees applies only to the different situation whereby the purpose of a payment that has been made cannot be established. Nor does Article 79(3) EPC apply to the case in suit, since no request for refund or change of purpose in respect of any fees that have already been paid has been filed. On the contrary all the applicant's payments were effected in accordance with his intentions. The non-payment of the designation fee for Germany was contrary to the applicant's intention.

- (iii) The further statement in the decision under appeal that the request for correction is not allowable since an omitted payment does not fall under Rule 88 first sentence EPC is also contested. What has been requested is correction of EPO Form 1200 and the fee sheet filed with the application. Since these documents contain a clerical error, correction of them is possible pursuant to Rule 88 EPC.
- (iv) Should correction of Form 1200 be allowed as requested, the issue of a communication pursuant to Rule 85a(1) EPC would be possible.
- (v) The request for re-establishment of rights in relation to the designation of Germany has to be considered as allowable. The consequence of not paying the designation fees is a loss of rights. The time limit provided for by Rule 104(1)(b)(ii) EPC (replaced by Rule 107(d) EPC as from 1 March

2000) for payment of designation fees is not specifically excluded from *restitutio in integrum* pursuant to Article 122(5) EPC. Instead, Article 122(5) EPC refers to Article 79(2) EPC in relation to the payment of the designation fees. The latter article does not apply in the present case where the time limit for payment of designation fees is governed by Rule 104(1)(b)(ii) EPC (replaced by Rule 107(d) EPC).

(vi) In order to avoid any possible prejudice to the public in the event that a designation of Germany is allowed, the appellant is prepared to relinquish any rights conferred under Article 67 in relation to Germany.

VII. With the statement of grounds the appellant requested that oral proceedings be convened under Article 116 EPC prior to any decision to dismiss the appeal either in part or in its entirety.

VIII. On 25 September 2002 the rights concerning the application in suit were transferred from the former applicant Mr Jean Pierre Iribar to Stratek Plastics Limited, an Irish corporation.

IX. On 5 March 2004 the board of appeal issued a communication pursuant to Article 11(1) of the Rules of Procedure of the Boards of Appeal.

X. At the oral proceedings held on 15 June 2004 the appellant's representative requested that the decision under appeal be set aside and that the request for correction by adding the missing designation of Germany

be allowed with the consequence that a communication pursuant to Rule 85a(1) EPC be issued (main request) and/or that the request for *restitutio in integrum* under Article 122 EPC be admitted (subsidiary request).

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rules 1(1) and 64 EPC and is therefore admissible.
2. *Main request*
 - a. According to the documents on file it is evident that in the PCT application Germany was mentioned as a designated state (see PCT application, page 1 of the pamphlet). On entry into the regional phase before the EPO the applicant's European representative filled in EPO Form 1200. Section 10.1 of this form lists the contracting states (designated in the international application) in respect of which designation fees are to be paid. The applicant's representative omitted to mark Germany with a cross in this section. The appellant's representative maintains that said omission was due to a mistake and requests correction pursuant to Rule 88 EPC.
 - b. As already mentioned in the communication sent to the appellant on 5 March 2004, the board is satisfied that, as a matter of principle, Rule 88 EPC can be applied for the correction of mistakes in Form 1200, Section 10.

However, with reference to the case in point, the requirements provided for in Rule 88 EPC for a correction to be allowed cannot be considered as fulfilled. According to the first sentence of said rule, "Linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request". The fact that the applicant's representative omitted to mark Germany with a cross in Section 10.1 of Form 1200 can clearly be considered neither as a linguistic error nor as an error of transcription.

In the statement of grounds the appellant's representative made reference only to the last expression provided for in the first sentence of Rule 88 EPC in that he maintained that the omitted indication was to be considered as a "mistake in a document".

As already explained in the communication dated 5 March 2004, the board cannot share this argument. The only interpretation of this expression which is consistent with the ratio legis and, in particular, with the protection of the public interest, is that the provision under consideration relates only to mistakes which are contained in the document and can be identified in the context of the document itself. The wording used by the legislator in the three official languages ("mistakes in any document filed with the European Patent Office", "Unrichtigkeiten in den beim Europäischen Patentamt eingereichten Unterlagen" and "erreurs contenues dans toute

pièce soumise à l'Office européen des brevets") seems to support the above interpretation. In other words, contrary to the appellant's submissions, mistakes deriving from the wrong intention of the person who wrote the document cannot be considered as mistakes in the document since, in this case, the document mirrors exactly such (wrong) intention. It follows that the wider interpretation proposed by the appellant, according to which the erroneous omission in Form 1200, being the consequence of a wrong instruction given by the inventor's US patent attorney to the European representative, can also be corrected under Rule 88 EPC, cannot be accepted, since this is a mistake relating to the (wrong) intention of the author and not a mistake in the document. It has to be pointed out that the wider interpretation proposed by the appellant could have the effect that the public could hardly trust a document filed by an applicant, knowing that such document could be corrected at any time if the applicant proved that the intention of its author was erroneous.

- c. Moreover it must be stressed that the appellant not only omitted the designation of Germany in Section 10.1 of Form 1200, but also omitted to pay the designation fee relating to this contracting state. According to the case law of the boards of appeal (see J 27/96, paragraph 2 of the reasons; J 21/84, paragraphs 7 and 8 of the reasons), failure to pay a fee in due time is not a mistake that can be corrected under Rule 88 EPC, and is therefore a failure which cannot be remedied.

- d. At the oral proceedings the appellant's patent attorney referred to the principle of protection of legitimate expectations and emphasised that the omitted designation was a result of a mistake made in good faith.

The principle of protection of legitimate expectations requires the EPO to warn the applicant of any loss of rights if such a warning can be expected in all good faith; this presupposes that the deficiency can be readily identified by the EPO within the framework of the normal handling of the case at the relevant stage of the proceedings and that the user is in a position to correct it within the time limit (G 2/97, paragraph 4.1 of the grounds). In the case in suit this principle does not apply since a readily identifiable deficiency is missing and hence no warning by the EPO could be expected. Reference is made to Section 10.2 of Form 1200, according to which: 1) the applicant declares that he does not intend to pay designation fees for the EPC contracting states not marked with a cross under Section 10.1 but designated in the international application; 2) the applicant declares that no communication under Rule 85a(1) EPC in respect of these designation fees needs to be notified. If such fees have not been paid by the time the period of grace allowed in Rule 85a(2) EPC expires, the applicant requests that no communication be sent under Rule 69(1) EPC. By signing the form the applicant has also signed the above declarations and accepted them.

- e. The request for correction being rejected for the above reasons, the dependant request for the issue of a communication pursuant to Rule 85a(1) EPC cannot be granted.

3. *Auxiliary request*

The appellant requested re-establishment of rights on the assumption that, since the non-payment of the designation fee for Germany was due to an oversight on the part of the applicant's US attorney, it was evident that the resulting loss of rights was not the fault of the applicant. Hence there was no reason to doubt that the applicant had taken all due care required by the circumstances. He further maintained that the time limit for payment of designation fees provided for by Rule 104(1)(b)(ii) EPC (replaced by Rule 107(d) EPC as from 1 March 2000) is not specifically excluded from *restitutio in integrum* pursuant to Article 122(5) EPC.

In the board's view, already expressed in the communication of 5 March 2004, the appellant in the case in suit cannot be re-established in his rights with reference to the omitted payment of the designation fee, whatever the reasons for this omission.

Reference is made to the principle set out in G 5/93 (OJ EPO 1994, 447, also quoted in the decision under appeal), according to which the provisions of Article 122(5) EPC apply to the time limits provided for in Rule 104b(1)(b)(i) and (ii) in conjunction with Articles 157(2)(b) and 158(2) EPC. In other words, the

Enlarged Board of Appeal pointed out in this decision that the possibility of re-establishment of rights is excluded for direct European applicants in a case where the time limits provided for, in particular, in Article 79(2) EPC (concerning payment of the designation fee) have not been respected; and that therefore, pursuant to Article 48(2)(a) PCT (according to which any contracting state for reasons admitted under its national law, and therefore also the European Patent Office for reasons admitted under European law, shall excuse any delay in meeting any time limit), the EPO is not obliged to give a Euro-PCT applicant the possibility of being re-established in the time limits for paying Euro-PCT fees, and in particular the designation fees provided for in Rule 104b(1)(b)(ii) EPC, now Rule 107(1)(d) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

P. Martorana

J.-C. Saisset