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**D E C I S I O N**  
**of 21 October 2004**

**Case Number:** J 0002/03 - 3.1.1

**Application Number:** 99941029.3

**Publication Number:** 1023579

**IPC:** G01J 5/20

**Language of the proceedings:** EN

**Title of invention:**

Compact all-weather electromagnetic imaging system

**Applicant:**

RAYTHEON COMPANY

**Opponent:**

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**Headword:**

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**Relevant legal provisions:**

EPC R. 67, 88, 104b(j)

PCT R. 17.1(b)

**Keyword:**

"Correction of priority number (yes)"

**Decisions cited:**

J 0006/91, J 0002/92

**Catchword:**

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Case Number: J 0002/03 - 3.1.1

**D E C I S I O N**  
**of the Legal Board of Appeal 3.1.1**  
**of 21 October 2004**

**Appellant:** RAYTHEON COMPANY  
141 Spring Street  
Lexington  
Massachusetts 02173 (US)

**Representative:** Jackson, Richard Eric  
Carpmaels & Ransford  
43 Bloomsbury Square  
London WC1A 2RA (GB)

**Decision under appeal:**

**Composition of the Board:**

**Chairman:** J.-C. Saisset  
**Members:** M. J. Vogel  
U. J. Tronser

## Summary of Facts and Submissions

- I. European Patent application 99941029.3 was filed on 10 August 1999 as an International Application under the PCT No. US 9918155 claiming US priority No. 60/095,942. In the international application the appellant requested the Article 25(1) PCT Receiving Office to transmit the priority document to the International Bureau pursuant to Rule 17.1 b PCT by crossing the respective section in box No. VI of Form PCT/R0/101. The pertinent priority document was transmitted from the US PTO to the International Bureau on 24 September 1999, i.e. before the international publication of the application on 24 February 2000.
- II. On 2 June 2000 (with letter dated 31 May 2000), i.e. after entry into the regional phase before the EPO, the applicant filed a request pursuant to Rule 88 EPC to correct the serial number of the US priority application from 60/095,942 to 60/095,941. After a communication from the EPO informing him that the request could not be granted the applicant submitted with letters dated 10 August and 13 September 2000 that it would have been immediately obvious for third parties inspecting the EPO file of the present case that the serial number 60/095,942 indicated on the front of the PCT publication was incorrect, since the application with this priority number concerns "Genetically modified Mosaic Animals" and is therefore clearly not related in any way to the invention in suit. Furthermore he referred to the decision in case J 2/92 where in a similar case the correction of the wrong filing date and the wrong file number of the priority document were allowed. To the former letter of the

applicant a copy of the correct priority document was attached and to the latter a copy of the US-application 60/095,942.

III. After a further communication the Receiving Section of the EPO decided on 10 July 2002 to refuse the request for correction for the following reasons: Pursuant to the established case law of the Legal Board of Appeal the correction of errors under Rule 88 EPC is only allowable, if the request for correction is made early enough for a warning to be included in the publication of the application or if special circumstances are present justifying the correction at a later stage (J 6/91). This would be the case where the interest of the public in being able to rely on information officially published is weaker than the interest of the applicant in being allowed to correct mistakes in data erroneously indicated. Such circumstances are present for example if the mistake is obvious on the face of the application or if the office itself is responsible for the incorrect data published. However, in the present case special circumstances within the meaning of the relevant case law cannot be recognised. In contrast to J 2/92 no apparent discrepancy exists because only the priority document corresponding to the (wrong) file number indicated in the priority declaration and the priority date matching it are on file. This would not amount to an apparent discrepancy. Pursuant to decision J 2/92 it must be clear that the wrong priority document on file is irrelevant both as to the subject and to the priority date or the priority state. Here however, the date of priority and the state would not appear to be incorrect.

- IV. The applicant filed an appeal on 10 September 2002 and paid the appeal fee at the same time. He requested that the contested decision be set aside and that the correction of the priority number from 60/095,942 to 60/095,941 be allowed. Furthermore he requested that the appeal fee be reimbursed.
- V. In his statement of grounds dated 5 November 2002 he argued as follows: Contrary to case J 6/91 he does not seek to add a first priority claim but merely to correct the number of the priority application wrongly indicated on the cover sheet of the international publication. Moreover all conditions allowing corrections under Rule 88 EPC pursuant to that decision are fulfilled. It is true that contrary to the requirements of the established case law of the Legal Board of Appeal the priority number has been published without a warning to the public. But even under such circumstances the Board had held that correction is allowable in particular if the public interest is not seriously affected. This would be the case here, because any member of the public during file inspection studying a copy of the wrongly indicated document could discover that the serial number of the application given in the priority declaration cannot possibly be correct, even if a person would not immediately be able to determine the correct priority number. But the same is true regarding those cases dealt with under Rule 111(2) EPC in which the file number of the priority document is not provided at all.

With regard to the request to reimburse the appeal fee he referred to the case of the application No. 97933393.7 in which it has come to his attention that the EPO allowed a priority number to be corrected.

### **Reasons for the Decision**

1. The appeal is admissible.
  
2. In the contested decision the Receiving Section ruled that pursuant to Rule 88 Sentence 1 EPC it is within the discretion of the EPO to allow the requested correction of the file number and consequently to replace the priority document in the application documents. Exercising its discretion under Rule 88 EPC the Receiving Section did not ignore that it has to weigh up the interests of third parties in having reliable published patent information and the interest of the applicant to avoid the loss of the claimed priority. Moreover it referred correctly to the criteria established by the Legal Board and summarised in J 6/91 under which corrections of priority data can be permitted.
  
3. The Board also agrees with the reasoning of the contested decision in so far as it is stated that in the present case correction of priority data after the publication of the application is only allowable under limited conditions since the request was not filed early enough to enable publication of a warning together with the patent application. This conclusion is in line with the established case law of the Board. Such circumstances justifying the correction of

priority data at a later stage may be that the patent granting authorities are themselves responsible for the fact that no warning was mentioned in the publication or that the error is apparent on the face of the published application.

4. However, contrary to the opinion of the Receiving Section expressed in the decision under appeal, the Board, balancing the interests of the public and those of the applicant, comes to the conclusion that, in the present case the interests of the applicant have to prevail because no substantial interest of third parties can be recognised justifying refusal of the requested correction of the file number.
  - 4.1 The Board admits that looking at the particulars of the international publication of this patent application, the mistake concerning the erroneously indicated number of the priority document is not apparent on the cover page. However, the mere file number of the priority document has no relevance for third parties since this indication within a priority declaration serves only to provide the competitor with the way to study the priority document but is as such of no interest for the public to rely on. If third parties consider it necessary to evaluate the patentability of the invention they should inspect the file to investigate this.

At that moment at the latest it would be apparent that the priority document on file concerns completely different subject matter (biotechnology) than the subject matter of the application (electronic) and completely other inventors and is therefore not a

reliable document on which the evaluation of the patentability can seriously be based. Hence, by inspecting the file third parties become aware that the file number on the face of the publication is obviously wrong. It must be expected that third parties interested in the correct priority document will investigate the discrepancy and thus will try to ascertain the correct document by further searches. Hence, it is not urgently in the public interest to refuse the requested corrections, despite the fact that the international application has been published without any warning of the need for correction.

5. Subsequent to its request for correction under Rule 88 EPC with letter dated 31 May 2000 (received by the EPO on 2 June 2000) the appellant had filed a copy of the correct priority document (i.e. US 60/095,941) enclosed with its letter dated 10 August 2000 (received by the EPO on 14 August 2000).
6. As a matter of course a correction of the file number concerning the document of a claimed priority only makes sense if the replacement of the wrong document was still admissible after the international publication.

In the case under consideration the international publication took place on 24 February 2000, i. e. about half a year ago.



The time limit under Rule 104b(3) EPC for submitting a copy of the priority document expired on 10 March 2001 (i.e. 10 August 1998 + 31 months), the replacement of the priority document on 14 August 2000 thus being within the prescribed time limit.

Moreover the appellant asked for transmittal of the priority document pursuant to Rule 17.1(b) PCT when filing the international application, i.e. within the time limit prescribed by the PCT.

Thus the time limits the appellant is obliged to observe with regard of the transmittal of the priority document are complied with.

The board finds that a loss of the right of priority would be unjust in the circumstances of the present case. The wrong file number was erroneously indicated by mistake of the applicant. The mistake in the request for transmittal as well as in the priority declaration of the international application emerged from a clerical error. From the outset there was no doubt which priority document the appellant intended to submit. In line with J 2/92 (see reasons 6.2) the board is of the opinion that third parties cannot be misled by a replacement of the wrong document after publication of the international application. They could easily find out from a file inspection that document US 60/095,942 was completely irrelevant and that there was a discrepancy with regard to the indicated inventors. Thus, it was clear from the file that the relevant document concerning the claimed priority of 10 August 1998 was not yet on file.

7. The request for reimbursement of the appeal fee under Rule 67 EPC has to be refused. The arguments submitted by the appellant with regard to this request are rather vague and do not justify a finding that the Receiving Section committed a substantial procedural violation in its decision. The submission that the EPO allowed a priority number to be corrected under "similar" circumstance without specifying any concrete facts does not allow the Board to consider the decision of the Receiving Section as based on a substantial procedural violation. A negative decision of the first instance as such does not lead to reimbursement of the appeal fee.

## Order

### For these reasons it is decided that:

1. The decision of the Receiving Section dated 10 July 2002 is set aside.
2. It is ordered that the request filed in accordance with Article 4 PCT in international application PCT/US99/18155 (later European patent application No. 99941029.3) be corrected in so far as the European Patent Office is concerned as designated Office, as follows:
  - the application number of the national (US) priority application filed on 10 August 2000 shall be replaced by No. 60/095,941.
3. The replacement of (US) priority document 60/095,942 by (US) priority document No. 60/095,941 is allowed.
4. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

S. Fabiani

J.-C. Saisset