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**Datasheet for the decision  
of 31 August 2009**

**Case Number:** J 0016/08 - 3.1.01

**Application Number:** 03710420.5

**Publication Number:** 1492135

**IPC:** H01G 9/155

**Language of the proceedings:** EN

**Title of invention:**

Electric double-layer capacitor

**Applicant:**

Nissan Diesel Motor Co., Ltd.

**Headword:**

Correction of designation/NISSAN

**Relevant legal provisions:**

EPC Art. 113, 122

EPC R. 139

RPBA Art. 11

**Relevant legal provisions (EPC 1973):**

EPC R. 67, 88

RRF Art. 7(2)

**Keyword:**

"Correction of designation (allowed)"

**Decisions cited:**

J 0008/80, J 0012/80, J 0003/81, J 0021/84, J 0008/89,  
J 0007/90, J 0027/96, J 0016/00, J 0021/00, J 0003/01,  
J 0025/01, J 0006/02, J 0023/03, J 0010/07

**Catchword:**

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Case Number: J 0016/08 - 3.1.01

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.01  
of 31 August 2009

**Appellant:** Nissan Diesel Motor Co., Ltd.  
1, Ooaza 1-chome  
Ageo-shi  
Saitama 362-8523 (JP)

**Representative:** Grünecker, Kinkeldey  
Stockmair & Schwanhäusser  
Anwaltssozietät  
Leopoldstrasse 4  
D-80802 München (DE)

**Decision under appeal:** Decision of the Receiving Section of the  
European Patent Office of 13 May 2008.

**Composition of the Board:**

**Chairman:** B. Günzel  
**Members:** C. Rennie-Smith  
C. Vallet

## Summary of Facts and Submissions

- I. The appeal concerns European patent application No. 03710420.5 (hereafter "the application") of the appellant and applicant, Nissan Diesel Motor Co. Ltd. The application was filed on 19 March 2003 as international application No. PCT/JP2003/03296 and claims a priority date of 19 March 2002 from JP 2002-075963, JP 2002-075967, and JP 2002-075968. The appeal is against the decision of the Receiving Section of 13 May 2008 refusing the appellant's request to replace the designation of France with the designation of Sweden.
- II. In EPO Form 1200 "Entry into the European phase (EPO as designated or elected Office)", the appellant's representative completed section 10 (relating to designation fees) by inserting the contracting states "DE Germany" and "FR France" in the boxes and spaces provided in section 10.2. According to the pre-printed wording of section 10 the appellant thereby declared that it was not intended to pay seven times the amount of the designation fee. The deemed payment of designation fees for all contracting states designated in the international application would therefore not apply, and the applicant requested that no communication under Rule 108(3) EPC 1973 be issued for the remaining contracting states. The international application had designated all the (then) twenty-seven contracting states listed in footnote 1 to section 10 of the completed Form 1200. The Form 1200 was both signed and filed on 14 October 2004 and the designation fees for Germany and France were paid on the same date. The application was published under Article 158(3) EPC

on 29 December 2004 as EP 1492135, both this publication and the European Patent Bulletin showing as designations all the twenty-seven contracting states designated in the international application. All those twenty-seven designations still appear on the Register at the date of this decision.

III. On 19 June 2007 the appellant filed a letter of that date from its representative containing a request for correction of errors under Rule 88 EPC 1973 in the present and three other European patent applications pending in its name. In all four cases the request was to replace the designation of France with the designation of Sweden. Two of the other four cases were also the subject of appeals which have since been withdrawn; in the fourth case (concerning European patent application No. 03708671), a decision has not yet been made on the request.

IV. The submissions in the request were in summary as follows. The explanation for the error was that, although it had always been the appellant's firm intention to designate Germany and Sweden, it gave an erroneous instruction to its Japanese patent attorneys who in turn passed that misinformation to the European representative. The mistake was only noticed during intensive discussions about the pending cases with the appellant and the request had been filed immediately thereafter. The requirement of the case law, that a replacement of a designation is allowable only if the request for correction is submitted without delay after recognizing a mistake, had thus been complied with. Although the decision J 7/90 (OJ EPO 1993, 133) stipulates that the request must be filed at the latest

in time to allow the correction to be indicated when the application is published, no such warning was required in the present case because the application had been published showing all the contracting states as designated (as appeared from the copy of the first page of the application filed with the request). All the requirements of Rule 88 EPC 1973 and the case law had thus been complied with.

V. On 13 May 2008 the Receiving Section issued a letter in the following terms:

"Refusal of a request for correction

The request of 19.06.07 tending to replace the designation of France with the designation of Sweden in the above mentioned European patent application is not admissible for the following reasons:

On 14.10.04 the representative waived the applicant's rights to receive a communication under Rule 108(3) EPC 1973 and the designation fees for Germany and France were validly paid. These designations were mentioned in the European Patent Bulletin 2004/53 on 29.12.04.

The period for a valid designation of any other State specially Sweden under Rule 108(4) EPC expired on 21.12.04.

Therefore, the partial loss of right became final at that date and could not be remedied by a correction under Rule 88 EPC 1973 or under any other legal remedy (See Decision J 21/00)."

VI. On 15 July 2008 the appellant filed in one document a notice of appeal and a statement of the grounds of appeal, and also paid the appeal fee. The appellant's arguments in the grounds of appeal were as follows. The communication of 15 July 2008 was a final decision on the request of 19 June 2007. The decision J 21/00 cited therein did not apply to the present case. That decision concerned a possible **additional** designation which was not allowed because designation fees cannot be paid after the expiry of relevant time limits, whereas the present case concerns the **correction** of an erroneous designation which requires no payment of a designation fee. According to the relevant case law, for example J 7/90 (OJ EPO 1993, 133), such a correction is allowable if:

(a) it complies with the applicant's initial intention,

(b) the request is made without undue delay after the error is discovered, and

(c) the request is received in sufficient time to enable publication of a warning together with the European patent application.

The third of those requirements should not apply in the present case because all contracting states were shown as designated in the application as published. Thus all the relevant requirements were fulfilled and the request for correction was justified.

VII. On 9 April 2009 the Board issued a communication containing its preliminary and non-binding opinion

which was in essence as set out in the Reasons below but subject to the provision by the appellant of satisfactory evidence of the relevant facts. After referring to the heavy burden of proof mentioned in the case-law relied on by the appellant, the communication observed that the appellant had so far supplied no formal evidence at all. Even if such factual information as was in the appellant's request of 19 June 2007 could be viewed as informally deposited to by the representative, the Board did not consider that sufficient to discharge the heavy burden of proof required in cases such as the present. To discharge that burden the appellant needed to file evidence falling within one or more of the categories in Article 117(1) EPC. While it was of course for the appellant to ascertain what evidence was available and the form in which it should be filed, the key issues requiring proof were:

- (a) the appellant's original intention as regards the states to be designated,
- (b) the manner in which the mistake occurred, and
- (c) how and when the mistake was discovered.

The communication concluded by setting a time limit of two months from the deemed date of receipt of the communication for filing such evidence.

VIII. On 9 June 2009 the appellant filed a letter of that date enclosing a signed statement dated 4 June 2009 of Mr. Kazuo Kasuya, a clerk in the intellectual property

section of the appellant company. The pertinent passages of the statement read as follows:

"When we decided to file this PCT international application, I received from Mr. Shigeru Okuyama, manager of intellectual property section, of my superior an instruction concerning designation of the filing states, as for Europe, to designate a couple of states as designated contracting states, which were Germany and Sweden....

When I commissioned Gotoh & Partners [the appellant's Japanese patent attorneys who in turn instructed the European representatives] to file the PCT application, I mistakenly filled out the request form with Germany and France as the designated contracting states. Such a mistake should not occur, but at that time, I was also handling another case, and it just happened that the designated contracting states were Germany and France. For this reason, I inadvertently wrote "Germany" and "France" as the designated contracting states of the subject application.

At the time of making the request to Gotoh & Partners, I did not notice that I had made a mistake at all. With the mistake unnoticed, the national phase entry into Europe was filed on October 14, 2004.... After that, we paid the annuities several times. Then we were notified from Gotoh & Partners that the payment of the fifth annuity was completed on March 28, 2007. On that occasion I happened to check our files in our company of the subject application, and discovered and realized a wrong instruction letter in which Germany and France



had been designated as the designated contracting states and Sweden had not been designated.

Thus, I consulted Mr. Okuyame of my superior, and he ordered me to ask Gotoh & Partners for taking a correction procedure to correct the designated contracting states of the subject application."

- IX. The appellant requests that the decision under appeal be set aside and that the designation of France be replaced with the designation of Sweden. As an auxiliary request, if the communication of 13 May 2008 is considered to be a communication under Rule 112(1) EPC, the appellant requests a decision under Rule 112(2) EPC. As a further auxiliary request, the appellant requests oral proceedings: according to its letter of 9 June 2009, this request only applies if the Board should intend to refuse the appeal.

## **Reasons for the Decision**

### *Formal matters*

1. The appeal is admissible.
2. The appellant refers to the Receiving Section's letter of 13 May 2008 as a decision although that word does not appear in the document in question. However, the letter does constitute a decision within the meaning of Articles 21 and 106 EPC, inasmuch as it constitutes a clear rejection of the appellant's request of 19 June 2007 for correction of an error under Rule 88 EPC 1973 and it also gives reasons as required by Rule 111(2)

EPC. In accordance with usual EPO practice, it ought to have been identified as a decision in order to distinguish between decisions and communications (for example, as do Rules 111 and 113 EPC), and it ought also to have drawn attention to the possibility of appeal and the provisions of Articles 106 to 108 EPC (see Rule 111(2) EPC). However, the failure to comply with formal requirements of the EPC does not mean that the letter was merely a communication. Whether a document issued by the European Patent Office constitutes a decision or a communication depends on the substance of its contents, not upon its form. The appellant was correct to treat the letter as a final decision subject to appeal. (See J 8/81, OJ EPO 1982, 10 and generally, "Case Law of the Boards of Appeal of the European Patent Office", 5th edition 2006, section VI.M.5.1, pages 464 to 465).

3. In the EPC revision, Rule 88 EPC 1973 has been renumbered as Rule 139 EPC. While a slight "drafting change" (see Revision of the European Patent Convention (EPC 2000), Synoptic presentation EPC 1973/2000 - Part II: The Implementing Regulations, OJ EPO 2007, Special edition 5) has been made to the second sentence of the rule, the text of its first sentence, which is the only sentence applicable in the present circumstances, has remained unamended. Therefore, for the purposes of the present decision it is unnecessary to decide whether, formally, the decision - taken after the entry into force of the EPC 2000 on the appellant's request for correction filed before that date - is to be taken on the basis of Rule 88, first sentence, EPC 1973 or of Rule 139 EPC.

*Jurisprudence relating to correction of designations*

4. The Board agrees with the appellant (see section VI above) that the Receiving Section decided the request without considering the appropriate case law. The case referred to by the Receiving Section, decision J 21/00 (of 5 July 2001, unpublished), concerned the non-observance of a time limit for paying several fees and states that, where relevant fees have not been paid within the period of grace pursuant to Rule 85a EPC 1973, after a final loss of rights there is no longer any legal basis for considering circumstances of any kind which were or may have been the cause of the non-observance, as there is no further legal remedy provided for in the EPC. Particular reference is made to re-establishment being excluded. However in the present case the issue is not an omitted payment of fees to which Rule 88 EPC 1973 (Rule 139 EPC) does not apply but the correction of a declaration in a document, and the precise question is whether the requirements of Rule 88 EPC 1973 (Rule 139 EPC) for correction of that declaration have been fulfilled.

5. The Board agrees with the appellant that the correct approach to the request is to consider the case law relating to the correction of designations. The decision relied on by the appellant, J 7/90 (OJ EPO 1993, 133), contains the following summary (with appropriate minor editing by the Board) of the substantial body of earlier case law on this subject:

"The Legal Board of Appeal, however, since its decision in case J 8/80 dated 18 July 1980 (OJ EPO 1980, 293) has generally

allowed such correction [*of designations*] by application of Rule 88, first sentence, EPC. It has developed this case law since and, in the process, made the correction of designations dependent on certain conditions. Even in decision J 8/80 the burden on the person requesting correction of proving the facts was a heavy one. Decision J 10/87 (OJ EPO 1989, 323) required a certain "excusable oversight" and confirmed earlier decisions that called in particular for an "immediate" request for correction....[*One*] further condition, which will be referred to here as the "time limitation", ...was required to be met in decisions J 12/80 (OJ EPO 1981, 143), J 3/81 (OJ EPO 1982, 100), J 21/84 (OJ EPO 1986, 75) and, most recently, J 8/89 (1990 EPOR 57). The "time limitation" condition requires that, in general, a request for correction must be refused in the public interest if it is not made early enough to enable publication of a warning together with the European patent application."

As well as the earlier decisions referred to in J 7/90, the same principles have been adhered to subsequently (see J 16/00 of 8 January 2002, points 2.2 et seq. of the Reasons).

6. Furthermore, in more recent case law (see J 6/02, J 25/01, J 3/01, J 27/96, referring to earlier decision

J 21/84, OJ EPO 1986, 75) the Board has clarified that correction of an error in a document filed with the EPO under Rule 88 EPC 1973 is an isolated procedural measure which causes the corrected document to be considered in the corrected version ab initio. It does not, however, mean that the applicant is thereby reinstated into a defined procedural phase as a whole with the consequence that the applicant can take or change procedural steps which had to be undertaken in that earlier procedural phase. Thus, in the decision J 25/01 of 13 February 2003, the Board expressed the view that, while an allowable correction under Rule 88 EPC 1973 has the effect of correcting misleading information, it does not cancel the legal effect of the provision that, where the designation fee is not paid in due time in respect of any contracting state, the designation of that state shall be deemed to be withdrawn. Therefore, the failure to pay the designation fees in time cannot be remedied by a correction under Rule 88 EPC 1973 (see point 2 et seq. of the Reasons). The same had already been held in decisions J 3/01 of 17 June 2002 and J 27/96 of 16 December 1998. As a consequence, in J 25/01 the appellant was not permitted to make a correction under Rule 88 EPC 1973 to replace the four states erroneously indicated by the representative in box 10.2 of Form 1200 by the twelve other designated states to which the applicant's instructions actually related. (The applicant's instruction to the representative had been to designate all the then EPC states except the four states erroneously indicated in box 10.2). Since the time for paying further designation fees had expired without fees being paid for the remaining group of twelve states, the designation of those twelve

states was thereafter deemed to be withdrawn and a correction to Form 1200 could not change that deemed withdrawal. Replacing the four contracting states originally indicated in box 10.2 by the first four contracting states appearing on the form as corrected to show the twelve designations was also not allowed. Article 7(2) RRF, under which the applicant would be required to identify in writing the purpose of a payment (i.e. to specify which four of the twelve contracting states the four fees were to be allocated to), was not complied with at the time the original payment of four designation fees was received by the EPO. However, no communication under Article 7(2) RRF asking the applicant to identify the purpose of the payment could be required as a result of the appellant's request for correction of designations. Furthermore, indicating four out of the twelve contracting states the appellant really intended to designate would not correct the error that really occurred when completing section 10.2 in EPO Form 1200 (see point 11 of the Reasons).

7. The facts of J 25/01 were thus clearly removed from those of the present case in that the applicant in that case would have needed, in addition to correction of Form 1200, reinstatement into an earlier procedural phase in order to allow it either to pay further designation fees after the time for payment had expired or to identify in accordance with Article 7(2) RRF four states from among the twelve originally intended to be designated. However, reference to J 25/01 was also made in J 6/02 of 13 May 2004, the facts of which were somewhat closer to those of the present case. In J 6/02 the appellant designated six contracting states, one of

which (Finland) was mistakenly designated instead of another (France). However, unlike the present case, the six designations were the only ones mentioned when the application was published in the European Patent Bulletin, so the subsequent request to make a correction under Rule 88 EPC 1973 would have entailed changing information already given to the public. The Board accepted that the evidence showed an error had been made when section 10 of Form 1200 was completed but observed that case law placed certain limits on the correction of such errors under Rule 88 EPC 1973. First, Rule 88 EPC 1973 could not be used to make payment out of time of a designation fee (in that case, the fee for France). Second, a correction under Rule 88 EPC 1973 does not cancel the procedural effect of the original error so that, as was said in J 25/01, the non-payment in time of a designation fee for France meant that the designation of that state was deemed to be withdrawn; to allow Rule 88 EPC 1973 to cancel out such procedural effects would be to allow the re-establishment of rights in a situation not covered by Article 122 EPC 1973. Third, the jurisprudence had placed a limitation of time on the use of Rule 88 EPC 1973 to correct errors of designation, namely that the request must be made in time to allow at least a reference to the request in the publication of the application. After a review of changes in EPO publication practice and public access to information about patent applications, the Board concluded that there was no reason to deviate from the constant jurisprudence of the Boards of Appeal and to give up the requirement that a request for correction must be filed sufficiently early that the public can be informed of it when the application is published.

8. As can be seen from that summary, while the Board in J 6/02 addressed several arguments which could have been reasons for refusing the request before it, the Board's eventual conclusion that the request had to be refused was based on the need to file a request for correction before publication. This requirement, which was not fulfilled in the case underlying J 6/02 since the application had been published without mention of the contracting state concerned, is characterized by the Board in J 6/02 as having been a constant requirement of the Board's jurisprudence.

*Facts of the present case*

9. The unusual facts of the present case - all publications of the EPO after entry into the regional phase mentioned and still today mention all contracting states as designated states (as to which see points 13 and 14 below) - distinguish this case from J 6/02. The present case is also distinguished from that addressed in decision J 25/01. In the present case no payment of a further fee after expiry of the time limit for doing so and no further procedural act are required if the requested correction of the declaration of intent to pay designation fees for "France" so as to read for "Sweden" is allowed: As has been acknowledged in decision J 23/03 of 13 July 2004 (see point 2.2.3 of the Reasons), a correction of a declaration contained in section 10.2 of Form 1200 to a different contracting state than the one originally inserted in that box has the effect that the payment of a designation fee actually made is allocated with effect ab initio to that other contracting state. The fee which would, as a



result of the correction, be allocated to "Sweden" has not only been paid but paid in time. Hence, the legal situation is not the same as in the case of the addition of a designation which would necessitate the acceptance - out of time - of payment of a further fee for the added designation to become valid. Therefore, the principle contained in the constant jurisprudence of the Legal Board and also endorsed by this Board, namely that a correction of a declaration under Rule 88 EPC 1973 does not reinstate the applicant into the procedural phase in which the procedural acts concerned had to be performed, does not affect the present case.

10. As a consequence, for the purposes of the present decision, the Board sees no need to go beyond the principles considered in the well-established jurisprudence summarized in J 7/90 (see point 5 above) and also endorsed in J 6/02. That summary corresponds to the three conditions to be met by a request for correction of a designation posited by the appellant in its statement of grounds of appeal (see section VI above). The Board must next consider whether the appellant's evidence is sufficient to prove the facts relied on.
  
11. First, there is the question of how the mistake arose and whether that could be treated as an "excusable oversight". Mr. Kasuya's statement is quite straightforward in this respect. When the application was filed as a PCT application in March 2003, he was given instructions by his superior that Germany and Sweden were to be designated. However, when he in turn instructed the company's Japanese patent attorneys, he inadvertently told them in writing to designate Germany

and France because he was at the same time handling another case in which those were in fact the designated states. The Japanese attorneys in their turn instructed the European representatives to designate Germany and France. Thus the statement clearly describes both the appellant's original intention (to designate Germany and Sweden) and how, by a simple human error, that original intention was mistakenly implemented (by designation of Germany and France). The mistake appears to be one capable of classifying as an "excusable oversight".

12. Second, as regards how and when the mistake was discovered, Mr. Kasuya's statement is equally straightforward. The mistake was not noticed until, on receiving notification that the fifth annual renewal fee had been paid on 28 March 2007, Mr. Kasuya happened to check his files and discovered his own earlier error. He brought that to his superior's attention and the appellant then gave instructions to take steps to correct the designation. The exact date or dates of these events is not given but they must have all occurred in the period beginning shortly after 28 March 2007, when Mr. Kasuya received notification that the fifth renewal fee had been paid, and ending shortly before 19 June 2007, when the appellant's European representatives filed the request for correction - a period of at most just over two months from discovering the mistake to taking action to correct it.
  
13. Thus, of the three conditions which according to the case-law must be satisfied by a request for a change of designation, two appear to be satisfied by the appellant's account of how the mistake came about and

how it was discovered. First, it appears that a mistake was made, that this was an excusable oversight, and that the correction would give effect to the appellant's original intention. Second, the request was made without undue delay after the error was discovered. This requirement is clearly designed to ensure that, so far as possible, requests for corrections are made before publication (cf. "made early enough to enable publication of a warning together with the European patent application" - see the last sentence of the passage from J 7/90 quoted in point 5 above). Thus whether or not there has been delay must reflect the facts of the particular case. In the present case there is the highly unusual fact that, due apparently to an oversight on the part of the EPO, all publications of the application or of its data showed and still show today **all** contracting states as designated. The consequence of this is that a change in the published information will not, as regards the correction sought, show the published information to have been misleading (see point 14 below). Thus, while the request for correction could probably have been filed more speedily than in fact it was, it cannot be said it was done with undue delay.

14. The question which then arises is whether the remaining condition - the "time limitation" condition (see point 5 above) - has been met or, as the appellant submits (see sections IV and VI), whether it need not be met in this case. The requirement that a request for correction must in the public interest be made early enough to enable publication of a warning together with the European patent application is both reasonable and necessary. It balances the protection of, on the one

hand, applicants who wish to correct genuine mistakes and, on the other hand, third parties who rely on published information. In the present case it appears that, regardless of the applicant's wishes as expressed in section 10 of Form 1200 to confine the designations to two contracting states, the application when published showed all possible contracting states as designated and the European Patent Register still shows that today. Thus, third parties will not be prejudiced by the correction since up to the date of this decision no publication has ever indicated that the territorial scope of the claimed invention was limited to two contracting states. The fact that after the correction one of those states will be different from one originally but erroneously indicated by the appellant in box 10.2 of Form 1200 will therefore make no difference. Accordingly, in the unusual circumstances of this case, the third condition of the case law need not - indeed cannot - apply.

15. The appeal is therefore to be allowed with the result that the designation of France will be replaced with the designation of Sweden. Although not forming an issue as such in these appeal proceedings, presumably the other twenty-five designations, which still appear on the Register, will be removed from the application.

*Substantial procedural violation*

16. The Board also notes that the decision under appeal was issued without affording the appellant any opportunity to comment on the approach to the request for correction which the Receiving Section took. As is apparent from the above, this approach was quite

different from any arguments put forward by the appellant and could not have been expected by the appellant. This amounted to a failure to allow the appellant to be heard contrary to Article 113 EPC which in turn constituted a substantial procedural violation. Notwithstanding that procedural violation, there are special reasons for the Board to decide the case and not remit it to the Receiving Section (see Article 11 RPBA), namely the saving of time and the similar case (concerning European patent application No. 03708671) apparently following it. Further, the Board considers it equitable to order re-imbusement of the appeal fee pursuant to Rule 67 EPC 1973 (J 10/07, OJ EPO 2008, 567, point 7 of the Reasons; and see generally "Case Law etc", *op cit*, section VII.D.15, pages 650 to 664 and in particular section VII.D.15.4.3, pages 655 to 657).

*Request for oral proceedings*

17. Although not expressed in so many words, it appears clear from the notice of appeal, and confirmed by the appellant's letter of 9 June 2009, that its auxiliary request for oral proceedings was conditional on its main request not being granted in written proceedings. Since the main request has been granted in written proceedings, that condition has not been fulfilled and oral proceedings are not necessary.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The designation in European patent application No. 03710420.5 of the Contracting state "France" is replaced with the designation of the Contracting state "Sweden".
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:

S. Fabiani

B. Günzel