

Decision of 17 September 1980

J 04/80

80,351

EPC Articles 79 (1), 111 (1), 114 (1). Rule 88.

"Examination by a Board of Appeal of its own motion" -

"Exercise of power within the competence of the department responsible for the decision appealed" - "Correction of mistakes"

Headnote

- I. Where the decision appealed interprets the Convention in a manner which a Board of Appeal considers to be incorrect, the Board, acting of its own motion, can hold the decision to be wrong and exercise a power within the competence of the department concerned, even though the appellant did not challenge the department's decision in that respect.
  
- II. Correction of a request for grant by adding a designation of a State which was omitted from the request for grant by mistake may be allowed if satisfactory evidence is put before the Office (cf. Decision of 18 July 1980 in Case No. J 08/80).

Europäisches  
Patentamt

European Patent  
Office

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des brevets

Juristische  
Beschwerdekammer

Legal Board  
of Appeal

Chambre de  
recours juridique



Case No: J 04/80

DECISION

of 17 September 1980

Appellant:

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Decision under appeal:

Decision of the Receiving Section of the European Patent Office dated 4 January 1980 whereby it was held that the appellant's designation of the United Kingdom in respect of European patent application No. 79301925.8 was invalid and that it was not possible to correct the request for grant.

Composition of the Board:

- Dr. R. Singer, Chairman
- P. Ford, Member
- L. Gotti Porcinari, Member

FACTS AND SUBMISSIONS OF THE APPELLANT

- I. On 18 September 1979, the appellant filed a European patent application, designating nine member States, but not the United Kingdom.
- II. On 28 September 1979, the filing fee, the search fee and designation fees for ten member States were paid, the payment voucher specifically mentioning the United Kingdom as well as the nine other member States designated in the request for grant.
- III. On 18 October 1979, the Receiving Section of the European Patent Office wrote notifying the appellant that the designation of the United Kingdom was not valid and that the designation fee for that State would be refunded.
- IV. On 2 November 1979, the appellant applied for a decision under Rule 69, paragraph 2, EPC, that the designation was valid.
- V. On 4 January 1980, the Receiving Section delivered the decision under appeal, giving as grounds therefor that the designation sought was being sought later than the making of the request for grant, which was contrary to Article 79, paragraph 1, EPC, and that the request for grant could not be amended in accordance with the provisions of Rule 88, EPC, because at the date of filing the documents filed with the Office contained nothing about a mistake.
- VI. On 25 February 1980, the appellant filed a reasoned appeal against the decision of 4 January 1980, contending that by virtue of Article 79, paragraph 2, EPC, the designation in the payment voucher was an effective designation and that Article 91, EPC, required the appellant to be given an opportunity to correct a deficiency in the request for grant. The appellant did not challenge the Receiving Section's

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interpretation of Rule 88, EPC. The appeal fee was duly paid.

- VII. On 6 May 1980, the Legal Board of Appeal advised the appellant in writing that it might take, of its own motion, a different view of the interpretation of Rule 88, EPC, to that taken by the Receiving Section. The Board accordingly invited the appellant to comment on this matter and to file any evidence that the appellant might wish to adduce relating to the making of the alleged mistake.
- VIII. On 19 June 1980, the appellant submitted comments in writing, together with three statutory declarations duly made under the English Statutory Declarations Act, 1835. Copies of relevant internal documents of the appellant organisation were exhibited to two of the declarations and the original documents were submitted for comparison with the exhibited copies, with the request that the originals might be returned to the appellant in due course. In its comments, the appellant observed that Rule 88, EPC, permitted corrections to any document other than a description, claims or drawings, to be non-obvious.
- IX. The evidence filed establishes that the responsible Executive of the appellant organisation recommended in writing the inclusion of the United Kingdom in ten States to be designated in a European patent application and that this recommendation was duly approved by the Group Manager before being passed to the Patent Department. The person in the Patent Department who had to prepare the draft request for grant omitted from it the required designation of the United Kingdom by what can fairly be regarded as a mistake in following his written instructions, which mistake clearly went unnoticed at the time, and in due course he prepared and duly sent a cheque for the fees and the fee voucher referred to in paragraph II above.

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REASONS FOR THE DECISION

1. The appeal complies with Articles 106 to 108 and Rules 1, paragraph 1, and 64 EPC, and is, therefore, admissible.
2. The Legal Board of Appeal has recently held (in Case No. J 08/80, 18 July 1980) that Rule 88, EPC, does not exclude the correction of mistakes concerning designation of States even if the corrections are not "obvious" in the sense defined in Rule 88, second sentence, EPC. The Board also there held that such a mistake may result from an omission.
3. The Board further held that before the Office can accede to a request for correction of a mistake, it must be satisfied that a mistake was made, what the mistake was and what the correction should be. It is the responsibility of the person requesting correction to put evidence as to the relevant facts fully and frankly before the Office.
4. For the reasons given in Case No. J 08/80, the Legal Board of Appeal can, if satisfied on the evidence adduced, allow correction of a request for grant by adding a designation of a State which was omitted by mistake.
5. Furthermore, the Legal Board of Appeal is not restricted to considering arguments provided by an appellant or to the relief sought: Cf. Articles 114, paragraph 1, and 110 paragraph 1, EPC. Having given the appellant an opportunity to present comments on the Receiving Section's decision that Rule 88, EPC, was not applicable in this case, the Board can, of its own motion, hold that the Receiving Section's decision was wrong insofar as it related to that Rule and examine the question whether the correction should be allowed (Article 111 paragraph 1 EPC).
6. The Board does find that the Receiving Section's decision was wrong insofar as it held that Rule 88, EPC, was inapplicable.

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It is satisfied that the evidence clearly shows that it was always intended to designate the United Kingdom, that this evidence is in documents that existed prior to the filing of the European application and that the failure to designate was the result of a mistake.

7. In these circumstances, the correction of the request for grant will be ordered by the Board.
8. No application has been made for reimbursement of appeal fees in accordance with Rule 67, EPC, and it is not considered that the circumstances of the case would have justified such an order.

For these reasons,

it is decided that:

1. The Decision of the Receiving Section of the European Patent Office dated 4 January 1980 is set aside.
2. It is ordered that the request for grant form filed on European patent application No. 79301925.8 is to be corrected by the addition thereto of the designation of the United Kingdom.