

Decision of 18 July 1980  
J 08/80

80,293

EPC Rule 88

"Correction of mistakes" •

Headnote

1. Rule 88, EPC does not exclude the correction of a mistake in designating States in a European patent application, even if the mistake is not obvious.
2. In cases where the making of the alleged mistake is not self-evident and in cases where it is not immediately evident that nothing else would have been intended than what is offered as the correction, the burden on the person requesting correction of proving the facts must be a heavy one.

Europäisches  
Patentamt

European Patent  
Office

Office européen  
des brevets

Juristische  
Beschwerdekammer

Legal Board  
of Appeal

Chambre de  
recours juridique



Case No: J 08/80

DECISION

of 18 July 1980

Appellant:

Rib Loc Hong Kong Limited,  
1501 Hutchison House,  
HONG KONG.

Professional Representative:

S.R. Opperman,  
Haseltine Lake & Co.,  
Hazlitt House,  
28 Southampton Buildings,  
Chancery Lane,  
LONDON WC2A 1AT  
England.

Decision under Appeal:

Decision of the Receiving Section  
of the European Patent Office  
dated 28 December 1979 rejecting  
a request to correct a mistake  
in the request for grant filed  
on European patent application  
No. 79302097.5 by adding the  
designation of the Federal  
Republic of Germany.

Composition of the Board:

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

SUMMARY OF FACTS AND SUBMISSIONS

- I. The appellant company is a company incorporated under the Laws of the British Crown Colony of Hong Kong, which has its principal place of business there.
- II. On 3 October 1979, a professional representative, resident and practising in England, filed an application for a European Patent on behalf of the appellant company, acting on instructions received from a firm of patent attorneys in Australia. Priority was claimed from a national application filed on 6 October 1978 in Australia.
- III. The application as filed designated four member States of the European Patent Convention and the designation fees for four States were paid on 19 October 1979. However, the appellant company had instructed the firm of Australian patent attorneys to secure designation of five member States, one of which was the Federal Republic of Germany.
- IV. On being informed that only four member States (not including the Federal Republic of Germany) had been designated, the appellant company immediately queried the omission. On 25 October 1979, the designation fee for the fifth State was paid and on 28 November 1979 the professional representative in England applied under Rule 88, EPC, for correction of a mistake in the request for grant form by adding the name of the Federal Republic of Germany. The request to correct the mistake was accompanied by written evidence, in the form of a Declaration made under the Australian Statutory Declarations Act 1959, by the Secretary to the Senior Partner in the firm of Australian patent attorneys.
- V. The Declaration, which is accompanied by some supporting documents, establishes that clear instructions were given

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by telex to designate (inter alia) the missing member State and that the firm of Australian patent attorneys had replied by letter stating that they had prepared application forms for several named countries and for "Europe", designating under the latter heading the five member States individually. A copy of the telex and a copy of the letter have been produced. It is declared that the instruction letter designated only four member States and that the omission was due to confusion between the affairs of several clients in the office of the firm of Australian patent attorneys.

- VI. The Receiving Section of the European Patent Office issued a letter dated 10 December 1979 informing the appellant company's professional representative in England that as the request for grant had not indicated the intention to designate any State other than the States it mentioned, Rule 88, EPC, was not applicable. The Receiving Section subsequently issued a "revised Decision" dated 28 December 1979 stating that the request of 28 November 1979 for correction of the designation of Contracting States was thereby rejected, but without giving additional reasons.
- VII. On 23 January 1980 the appellant company filed an appeal against the Decision dated 28 December 1979 and on 23 April 1980 it filed a written Statement of Grounds of the appeal. The appeal fee was duly paid.
- VIII. In its written Statement of Grounds, the appellant company contends that Rule 88, EPC, does not exclude the correction of designation of States and that the second sentence of Rule 88, EPC, requires a correction to be obvious only in respect of corrections in a description, claims or drawings and clearly does not make it necessary for corrections or

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errors in other documents to be obvious.

- IX. In support of its contentions, the appellant company has produced copies of documents relating to the preparation of the European Patent Convention which, it is submitted, show that it was not intended to exclude the addition of a designation to a request for grant from the scope of a general rule permitting the correction of mistakes in documents.
- X. The first document produced is a proposal from the United Kingdom Delegation to the 9th meeting of Working Party I in October 1971 (Working Document No. 7, 19 October 1971) for an Article in the Rules to the Convention permitting correction of clerical errors or obvious mistakes in a request for a European Patent but expressly excluding addition of designated States.
- XI. The second document produced (Working Document BR/GT I/131/71, 22 October 1971) shows that this proposal was not accepted. A draft Rule "re Article 145 No. 4(a)" was approved, providing that obvious errors or mistakes in any document could be corrected if it was clear that the correction proposed was what was intended. Special exceptions - for example, the subsequent designation of a State - were not included in the new provision and this was noted in the Report of the 9th meeting of Working Party I (BR/135/71, 17 November 1971, page 31).
- XII. Further searches have established that at the Inter-Governmental Conference in Luxembourg (24 January - 4 February 1972), several private international organisations asked for a rule which would make it possible to indicate the date and State of an earlier application from which priority was claimed at any time within 16 months of the priority date. This

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request was not acceptable to the national Delegations but Working Party I was instructed so to re-draft the relevant rule that an incorrect statement in an application could be corrected (Cf. BR/168/72, 15 March 1972, page 36).

XIII. The report of the meeting of Working Party I (BR/177/72, 13 April 1972, page 24) clearly shows that the Working Party accordingly deliberately limited the requirement that only corrections that were obvious could be made to correction of mistakes in the description, the claims and the drawings. Thus, the wording of what is now Rule 88; EPC, reached its final form. At the same time, the procedure for notifying the applicant of deficiencies concerning the date and State of first filing and inviting him to remedy them (Cf. Rule 41, paragraphs 2 and 3, EPC) was settled.

XIV. The Washington Diplomatic Conference (1970) had adopted a different approach. Rule 91 of the Regulations under the Patent Co-operation Treaty, provides, in part, as follows:

"Obvious errors of transcription

91.1 Rectification

(a) Subject to paragraphs (b) to (g), obvious errors of transcription in the international application or other papers submitted by the applicant may be rectified.

(b) Errors which are due to the fact that something other than what was obviously intended was written in the international application or other paper shall be regarded as obvious errors of transcription. The rectification itself shall be obvious in the sense that anyone would immediately realise that nothing else could have been intended than what is offered as rectification.

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(c) Omissions of entire elements or sheets of the international application, even if clearly resulting from inattention, at the stage, for example, of copying or assembling sheets, shall not be rectifiable.

(d) Rectification may be made on the request of the applicant. The authority having discovered what appears to be an obvious error of transcription may invite the applicant to present a request for rectification as provided in paragraphs (e) to (g)."

#### 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. It is the first appeal concerning Rule 88, EPC, to come before the Legal Board of Appeal and, therefore, it is desirable that the Board should explain the law and the procedure to be followed in cases of requests under Rule 88, EPC.
3. It can be said at once that Rule 88, first sentence, 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. This is clear from the language of Rule 88, EPC, itself and that it was intended that this should be the law under the Convention is also clear from the legislative history summarised in paragraphs X-XIII above.
4. For the purposes of Rule 88, EPC, a mistake may be said to exist in a document filed with the European Patent Office if the document does not express the true intention

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of the person on whose behalf it was filed. The mistake may take the form of an incorrect statement or it may result from an omission. Correction, accordingly, can take the form of putting right an incorrect statement or adding omitted matter.

5. Before the Office can accede to a request for correction of a mistake, however, it must be satisfied that a mistake was made, what the mistake was and what the correction should be. This is the necessary safeguard against abuse of the provisions of Rule 88, EPC.
6. It is the responsibility of the person requesting correction to put evidence as to the relevant facts fully and frankly before the Office. In cases where the making of the alleged mistake is not self-evident and in cases where it is not immediately evident that nothing else would have been intended than what is offered as the correction, the burden of proving the facts must be a heavy one. If the evidence put forward is incomplete, obscure or ambiguous, the request for correction should be rejected. In particular, there should be no reasonable doubt as to the true intention of the person on whose behalf the document was filed. A mere statement of his intention which is not supported by evidence as to what he said and did is almost certain to be insufficient. Provisions designed to facilitate correction of mistakes cannot be allowed to be used to enable a person to give effect to a change of his mind or a subsequent development of his plans.
7. In a case such as the present one, an applicant for a European patent who wishes to add designations he did not originally intend to make or to replace one by another cannot be permitted to use Rule 88, EPC, to evade the requirement of Article 79, EPC, that the request for the grant of a European patent shall contain the designation of the State or States in which protection for the invention is desired.



8. In the present case, the evidence filed shows that clear instructions had been given by the appellant to its Australian patent attorneys and that it was due to their error that incorrect instructions were given to the professional representative in England. It is clear from the copy telex and copy letter produced that the appellant intended five member States to be designated and that it was intended to include the Federal Republic of Germany. The person responsible for the error has herself given written evidence about the making of the error, in a form which is in accordance with the laws of the State in which it was given.
9. The Legal Board of Appeal sees no reason to reject this evidence and finds it sufficient to justify the appellant's application under Rule 88 EPC.
10. It has not been necessary to consider in this appeal whether there are any inherent limitations on the right of a person to seek correction of a document under Rule 88, EPC, where there is significant delay in making the request for correction. In the present case, the appellant acted promptly.
11. The decision under appeal was based on an incorrect interpretation of Rule 88 EPC and must be set aside.
12. No application has been made for reimbursement of appeal fees in accordance with Rule 67 EPC in the present case and it is not considered that the circumstances of the case would have justified such an order.

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For these reasons,

it is decided that:

- (1) The Decision of the Receiving Section of the European Patent Office dated 28 December 1979 is set aside.
- (2) It is ordered that the request for grant form filed on European patent application No. 79302097.5 is to be corrected by the addition thereto of the designation of the Federal Republic of Germany.