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Aktenzeichen: J 03/82
Case Number:
N° du recours :

ENTSCHEIDUNG / DECISION
vom / of / du 16 February 1983

Anmelder:
Applicant: TAISHO PHARMACEUTICAL CO. LTD.
Demandeur :

Stichwort:
Headword: Correction/Priority/Taisho
Référence :

EPO / EPC / CBE Article 93(1); Rule 88
"Correction of mistakes" - "Declaration of priority"

Leitsatz / Headnote / Sommaire

Europäisches
Patentamt

Juristische
Beschwerdekammer

European Patent
Office

Legal Board
of Appeal

Office européen
des brevets

Chambre de
recours juridique



Case No.: J 03/82

DECISION
of 16 February 1983

Appellants:

Taisho Pharmaceutical Co. Ltd.
24-1 Takata 3-chome
Toshimaku
Tokyo, 171
Japan

Representative:

Evans, David Charles
F.J. Cleveland & Company
40-43 Chancery Lane
London WC2A 1JQ
Great Britain

Decision under appeal:

Decision of the Receiving Section of the European Patent Office dated 24 March 1982 rejecting a request for amendment of the Request for Grant filed on European patent application No. 81304096.1 by the insertion in Part VII thereof of a reference to Japanese patent application No. 134814/80, by way of correction.

Composition of the Board:

Chairman: R. Singer

Member: P. Ford

Member: L. Gotti Porcinari

SUMMARY OF FACTS AND SUBMISSIONS

- I. By letter dated 29 August 1981, the appellants' patent department in Japan instructed their European professional representatives to file European patent application No. 81304096.1, claiming priority from Japanese national patent application No. 134814/80, filed on 27 September 1980.

- II. On about 1 September 1981, the representative responsible for the European patent application instructed his typist to prepare the necessary documents. On checking the Request for Grant form which she had completed, he found a minor typing error on the first page. He instructed her to correct this but, instead of doing so, she decided to re-type the entire form, as she thought the result would be neater. She did not say that she had re-typed the form and the representative did not re-check the entire document before signing it and despatching it to the EPO. The fact that Part VII of the Request for Grant form had been accidentally left blank in the process of re-typing thus went unnoticed.

- III. On 8 September 1981, the European patent application was, therefore, filed without any priority being claimed, although the appellants' representatives believed that priority had been claimed, advised the appellants by letter dated 14 September 1981 that it had been and, on 24 December 1981 sent the priority documents relating to the Japanese national patent application to the EPO.

- IV. By letter dated 7 January 1982, the Receiving Section of the EPO acknowledged receipt of the priority documents but pointed out that no priority existed as none had been claimed.

- V. By letter dated 11 January 1982, the appellants' representatives requested correction of the Request for Grant form under Rule 88 EPC. In support of their request, they stated that

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it had always been intended to claim priority and that the failure to do so was the result of an oversight in their office. They submitted copies of the letters dated 29 August and 14 September and relied also on the filing of the priority documents as proof of intention to claim priority.

- VI. On 24 March 1982, the Receiving Section of the EPO issued the decision under appeal, refusing the request for correction on the ground that at the time of filing the application there was no reference to a claim of priority.
- VII. By letter dated 13 April 1982 the appellants' representatives gave notice of appeal. The appeal fee was duly paid on 19 April 1982.
- VIII. On 27 April 1982, the appellants' representatives sent the certified translation of the priority documents to the EPO.
- IX. On the same day, they also sent a Statement of Grounds of the appeal and a Declaration under the English Statutory Declarations Act 1835 made by the professional representative concerned, in support of their case.
- X. On 26 August 1982, in response to an invitation from the Legal Board of Appeal, they submitted a second Statutory Declaration, made by the typist concerned, and some original documents relating to the application (but not including the Request for Grant form containing the typing error on the first page, which has apparently been destroyed).
- XI. In their Statement of Grounds, the appellants contend that Rule 88 EPC permits correction of an error in the Request for Grant form even if it is not obvious and they rely on the decision of the Legal Board of Appeal in Case J 08/80. They ask for the decision of the Receiving Section to be set aside and for the amendment of the Request for Grant form to be allowed.

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REASONS FOR THE DECISION

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC, and is, therefore, admissible.
2. It is clear from the Declarations and documents submitted that the omission of the claim to priority from Part VII of the Request for Grant form was a mistake and that it was always intended that priority should be claimed from the filing of the Japanese national patent application. It is also clear that the professional representatives acted promptly when the error came to light.
3. In two decisions dated respectively 21 July 1982 (J 04/82, Official Journal EPO, 1982, 385) and 19 January 1983 (J 14/82 not yet published) the Legal Board of Appeal has already considered and allowed requests for correction of declarations of priority, holding that such a mistake may be corrected under Rule 88 EPC, first sentence, provided that correction has been requested sufficiently early for a warning to be included in the publication of the application.
4. Both of these decisions concerned multiple priorities and in each case the earliest priority had actually been claimed in the uncorrected Request for Grant. It followed that the timetable for publication of the application in accordance with Article 93(1) EPC, as soon as possible after the expiry of a period of eighteen months from the date of priority, was unaffected by the acceptance or refusal of the request for correction.
5. In the present case, as no priority was claimed in the Request for Grant form as originally filed, the appellants' request for correction might have had the effect of delaying publication of the application until long after the expiry of the period of eighteen months prescribed in Article 93(1) EPC, which might have been against the public interest.

6. However, the appellants' request for correction of the mistake was in fact received by the EPO in sufficient time for the publication of the European patent application to have taken place on the appropriate date, including the necessary warning to the public that the request for correction had been made.

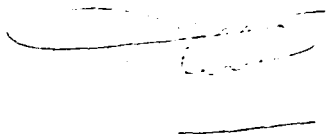
The only reason that such publication did not take place is that the Receiving Section wrongly considered that the request for correction could never be allowed. In these circumstances, it is just to allow the correction with delayed publication as it is no fault of the appellants that the Receiving Section did not make the correct decision and thus ensure that the European patent application would be published as soon as possible after the expiry of a period of eighteen months from the date of priority, in conformity with Article 93(1) EPC.

For these reasons,

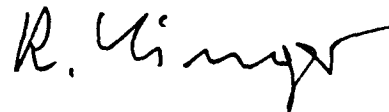
it is decided that:


- (1) The Decision of the Receiving Section of the European Patent Office dated 24 March 1982 is set aside.
- (2) It is ordered that the Request for Grant form filed on European Patent Application No. 81304096.1 is to be corrected by adding a reference to Japanese patent application No. 134814/80, filed on 27 September 1980, in Part VII on page 2 thereof.

The Registrar:



The Chairman:



*See Enclosure for list
date 17/12/83*


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