

Europäisches
Patentamt
Beschwerdekammern

European Patent
Office
Boards of Appeal

Office européen
des brevets
Chambres de recours



Case Number: J08 / '82

DECISION of 22 November 1983
correcting errors in the decision of the Legal Board of Appeal
of 8 November 1983

Appellant:

FUJITSU LIMITED
1015 Kamikodanaka
Nakahara-ku
Kawasaki
Japan

Representative:

Sunderland, James Harry
Haseltine Lake & Co
Hazlitt House
28 Southampton Buildings
Chancery Lane
London WC2A 1AT
England

Composition of the Board:

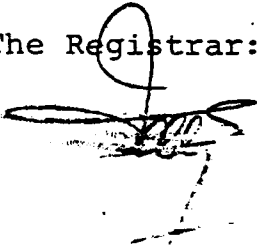
Chairman: R. Singer
Member: P. Ford
Member: O. Bossung

In application of Rule 89 EPC the Decision given on 8 November 1983 is hereby ordered to be corrected as follows:

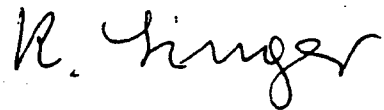
page 6, paragraph 3, third line: insert after "request" - "for rectification before the request"

page 11, second line: delete the apostrophe after "Patents".

The Registrar:

A handwritten signature in black ink, appearing to be "J. H. ...", written over a horizontal line.

The Chairman:

A handwritten signature in black ink, appearing to be "R. Singer", written in a cursive style.

Veröffentlichung im Amtsblatt	Ja/Nein
Publication in the Official Journal	Yes/No
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Aktenzeichen / Case Number / N° du recours : J 08/82

Anmeldenummer / Filing No / N° de la demande : 81302677.0

Publikations-Nr. / Publication No / N° de la publication :

Bezeichnung der Erfindung:

Title of invention:

Titre de l'invention :

ENTSCHEIDUNG / DECISION

vom / of / du 8 November 1983

Anmelder / Applicant / Demandeur : FUJITSU LIMITED

Stichwort / Headword / Référence : Designation of Inventors/Fujitsu

EPO / EPC / CBE Articles 16, 20, 62, 81. Rules 19(1), 42(1).

Vienna Convention on the Law of Treaties

"designation of inventors" - "consent to rectification" -

"respective responsibilities of Receiving Section and
Legal Division in cases of rectification"

Leitsatz / Headnote / Sommaire

- I. Rule 19(1) EPC requires consent to the rectification of a designation of inventor to be given by a "wrongly designated" person. A person already named whose name is not to be cancelled from the designation is not a "wrongly designated" person within the meaning of the Rule and his consent to the addition of the name of another person is not required.
- II. If a request to amend the designation of inventors is made at an early stage during the period in which the Receiving Section is still responsible for examination of the European patent application as to formal requirements and for publication of the application, the Receiving Section is obliged to make a decision concerning the request and remains competent to issue its decision even after responsibility for the further examination of the application has passed to the Examining Division.



Case Number: J 08 / 82

DECISION
of the Legal Board of Appeal
of 8 November 1983

Appellant: FUJITSU LIMITED
1015 Kamikodanaka
Nakahara-ku
Kawasaki
Japan

Representative: Sunderland, James Harry
Haseltine Lake & Co
Hazlitt House
28 Southampton Buildings
Chancery Lane
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England

Decision under appeal: Decision of the Receiving Section of the European Patent Office dated 22 February 1982 rejecting a request for rectification of the designation of inventors filed in respect of European patent application No. 81302677.0.

Composition of the Board:

Chairman: R. Singer
Member: P. Ford
Member: O. Bossung

SUMMARY OF FACTS AND SUBMISSIONS

- I. On 16 June 1981, the appellants filed European patent application No. 81302677.0, claiming priority from a Japanese national patent application filed on 16 June 1980. The designation of inventors filed with the European patent application named eight inventors. The Japanese national patent application had named also a ninth inventor.
- II. On 28 September 1981, the appellants filed a certified copy of the priority documents with an English translation and an amended designation of inventors in which they had added the name of the ninth inventor. It was alleged that his name had been inadvertently omitted from the designation of inventors originally filed.
- III. On 30 September 1981, the Receiving Section of the EPO wrote to the appellants' representatives advising them that Rule 19(1) EPC applied and that rectification of the designation of inventors could not be effected without the consent of each of the originally designated inventors.
- IV. On 9 October 1981, the appellants' representatives replied to the Receiving Section's letter, asserting that they had never filed an incorrect designation of inventors but only one which was incomplete and that the only relevant requirement of the EPC and the Implementing Regulations was that all inventors should be named within a period of 16 months from the priority date.
- V. By letter dated 28 October 1981, the Receiving Section replied that a designation of inventors was incorrect if not all the inventors were named and that an addition to an incomplete designation constituted a rectification. Accordingly, Rule 19(1) EPC applied and the written consent of the originally designated inventors was required before the designation could be rectified.

- VI. The European patent application was published on 23 December 1981, naming only the originally designated eight inventors.
- VII. On 29 December 1981, the appellants' representatives wrote to the Receiving Section saying that even if Rule 19(1) EPC did apply to the case, there was nothing in the Minutes of the Munich Diplomatic Conference to support the view that that Rule required that inventors who had been correctly designated must consent to the addition of an inventor. The appellants' representatives therefore requested "a decision under Article 20" regarding the Receiving Section's "refusal to enter the name of the ninth inventor in the Register."
- VIII. On 6 January 1982, the appellants paid the fee for examination, thereby rendering effective a request for examination filed with the European patent application.
- IX. On 22 February 1982, the Receiving Section issued the decision under appeal. The appellants' request for a decision concerning refusal to enter a name in the Register was interpreted as relating to the request for rectification of the designation of inventor. Such a decision was within the competence of the department processing the application. It was compulsory for a designation of all inventors to be filed with the European patent application. In accordance with Rule 42(1), EPC, only deficiencies noted by the Receiving Section could be corrected within the 16 months period provided for by Article 91(5) EPC. Rule 19(1) EPC applied to the present case. Rectification of the designation of inventor by the addition of a name requires the consent of inventors already named, since the right to be designated of each inventor already named has to be shared with the newcomer. As no consents had been filed, the request for rectification must be rejected.

X. On 1 April 1982, the appellants filed a notice of appeal, seeking withdrawal or reversal of the decision and a refund of the appeal fee. The appeal fee was duly paid.

XI. In their Statement of the Grounds of the Appeal, filed on 9 June 1982, the appellants contended that:

(a) The Receiving Section was not competent to make a decision affecting an entry in the Register.

(b) Alternatively, Rule 19(1) EPC only requires consent to be given to the rectification of a designation of inventor by a "wrongly designated" person. The eight inventors originally named were correctly designated persons even if the overall designation was incorrect as a result of being incomplete. An inventor does not require the consent of anyone in order to be designated, which is his right vis-à-vis the applicant for or proprietor of a European patent: cf. Article 62 EPC. If anyone else is designated the inventor already named does not lose anything from his right.

The appellants sought the withdrawal of the Receiving Section's decision on the ground of lack of competence. Alternatively, they sought reversal of the decision on the ground that it was wrong in law. They repeated their request for repayment of the appeal fee.

XII. By letter dated 23 March 1983, the appellants' representatives requested an oral hearing and asserted that the appellants had confirmed that the eight inventors originally named would consent, if necessary, to the naming of the ninth inventor.

XIII. The Legal Board of Appeal invited the appellants to file evidence of consent of the eight inventors, if it was available, without prejudice to the appellants' argument that no consent was required. A copy of a document

relating to their consent, signed only by the Manager of the appellants' Patent Section, was filed with the Registrar of the Boards of Appeal on 21 April 1983.

- XIV. In a communication prior to the Hearing, the Legal Board of Appeal indicated that it was likely that the Board would consider that the Receiving Section was competent to make the decision under appeal, and that, on the basis of the arguments on file, the Board would support the view that Rule 19(1) EPC applied in the case of incomplete designation of inventors. The document signed only by the Manager of the appellants' Patent Section might not be regarded as "the consent of the wrongly designated person" within the meaning of Rule 19(1) EPC.
- XV. At a Hearing held on 13 July 1983, the appellants' representative maintained the arguments on file and additionally contended that, in accordance with recognised principles of international law relating to the interpretation of treaties (as reflected in the Vienna Convention on the Law of Treaties of 23 May 1969), a treaty had to be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose. The ordinary meaning of "wrongly designated person" in Rule 19(1) EPC, in the context of Article 62 EPC, and in the light of the purpose of that provision was that it referred to a person who had been designated as an inventor, without having the right to be designated under Article 62 EPC. Rule 19(1) EPC protected a person who had been designated from being deprived of his designation without his previous consent. It did not entitle a person who had been designated to prevent any other person from being designated by refusing his consent to that person's designation. Accordingly, in the present case, no consents were required.

XVI. Following the Hearing, the appellants' representative submitted a memorandum in which he further argued that the right of an inventor to be designated was not a property right and, therefore, the idea that the value of the right could be diminished by the designation of further inventors was erroneous. He also drew attention to items, which had not previously been referred to, in the Minutes of the Munich Diplomatic Conference, which appeared to show that the primary intended purpose of compulsory designation of inventors was to ensure that inventors were duly notified that European patent applications had been made in respect of their inventions. Furthermore, there was nothing in the Minutes which suggested that any meaning should be given to the expression "wrongly designated person" other than the ordinary meaning of those words in their context. The representative also contended that asking one inventor to consent to the naming of another inventor might give rise to the idea that he should confirm that the other person had made an inventive contribution, which, in practice, he might not be able to do, through lack of personal knowledge of the relevant facts. Finally, he submitted that the question of the competence of the Receiving Section was relevant to the request for reimbursement of the appeal fee.

REASONS FOR THE DECISION

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. In the opinion of the Legal Board of Appeal, the Receiving Section was competent to give the decision under appeal because, at the very early stage at which the request to amend the designation of inventors was made, the Receiving Section was still responsible for examination of the European patent application as to formal requirements and it was also responsible for the publication of the application, in accordance with Article 16 EPC. The Receiving Section was obliged to decide whether it could accept the request for rectification of the designation of inventors which it had received and no provision of the EPC obliged or enabled the Receiving Section to defer such a decision to the Legal Division.
3. The Board has considered of its own motion (cf. Article 114(1) EPC) whether, as the Receiving Section had made no decision on the request for examination became effective, the matter had to be transferred to the Examining Division at that date (cf. Article 18(1) EPC). In the Board's opinion, the Receiving Section remained competent to issue its decision even after responsibility for the further examination of the European patent application has passed to the Examining Division. Any interpretation of Articles 16 und 18 EPC which compelled the Examining Division to consider the request for rectification de novo in circumstances such as those of the present case would be pointlessly wasteful of time and money.
4. The appellants themselves sought to have the question of rectification decided by the Legal Division under the provisions of Article 20 EPC, by way of correction of an entry in the Register of European Patents. The combined effect of Article 127 EPC and Rule 92(1) (b) is that after (but not before) publication of the European patent application, particulars of the designated inventors have to be entered in the Register. However, as the Receiving Section is responsible for formalities

and publication (Article 16 EPC) it must also be responsible for questions concerning designation of inventors which arise before publication - as was the situation in the present case. It follows that the Receiving Section acted rightly when it regarded the appellants' representatives' letter dated 29 December 1981 as a request for a decision on an application under Rule 19(1) EPC. It is unnecessary in the present case to decide the general question whether there are situations in which the Legal Division has exclusive or concurrent competence under Article 20 EPC, when a European patent application or a granted European patent is the subject of procedures before another department of the European Patent Office.

5. The substantive issues in this appeal concern the applicability and interpretation of Rule 19(1) EPC. On the general question of the applicability of Rule 19(1) EPC to the circumstances of the present case, the Legal Board of Appeal has no hesitation in confirming the opinion of the Receiving Section that the Rule applies. The idea that there is a general principle that all inventors should be named within a period of 16 months from the priority date, is not in accordance with the provisions of the EPC and the Implementing Regulations.

6. In conformity with Article 81 EPC, the European patent application must designate the inventor. Rule 17(1) EPC requires that the designation shall be filed in the request for the grant itself or, if the applicant is not the inventor or is not the sole inventor, in a separate, but necessarily accompanying, document. The accuracy of the designation is not verified by the European Patent Office (Rule 17(2) EPC) but, in accordance with Article 91(1)(f) EPC, the Receiving Section must examine whether the designation of the inventor has been made in accordance with Article 81 EPC. Where the Receiving Section notes that there are deficiencies which may be corrected, it is required to give the applicant an

opportunity to correct them in accordance with Rule 42 EPC (cf. Article 91(2), (5) EPC). It is only in such a case that there is a period of 16 months for correction (cf. Article 91(5), Rule 42(1) EPC).

7. Furthermore, by its terms, Rule 19 EPC applies to all cases in which rectification of the designation of the inventor is sought. A request filed by, or with the consent of, the applicant for or proprietor of the European patent is always necessary.
8. Rule 19(1) EPC provides that an incorrect designation of an inventor may not be rectified save upon request "accompanied by the consent of the wrongly designated person". Assuming that the ninth inventor should have been designated, the designation was clearly "an incorrect designation of an inventor" within the meaning of Rule 19(1) EPC. The problem in the present case is to determine the true meaning of the words "wrongly designated person" in that Rule, which forms part of an international treaty.
9. According to the appellants' argument, the eight inventors originally named in the present case were not "wrongly designated" persons. Persons would be "wrongly designated" only if they were not entitled to be designated in accordance with Article 62 EPC and their consent to rectification should only be required if the request made is for the cancellation of their designation. In the appellants' view, this is the plain meaning of the language of Rule 19(1) EPC and nothing in the context of the EPC or in the light of its object and purpose requires the words "wrongly designated" to be interpreted as requiring that persons who have been rightly designated must consent to the addition of the name of any other person.

.../...

10. Since it applies only to treaties concluded after it came into force, the Vienna Convention on the Law of Treaties does not apply to the interpretation of the European Patent Convention. Nevertheless, it is well recognised that what the Vienna Convention says in its Articles 31 and 32 about interpretation of treaties does no more than codify already-existing public international law. (Cf., e.g., the speech of Lord Diplock in Fothergill v. Monarch Airlines [1981] A.C. 251 and the paper of Judge Bruchhausen "Interpretation and application of European patent law and harmonised national patent law" given at the Symposium for European Patent Judges held at the EPO Munich, 20-22 October 1982 : in German in GRUR Int. 1983, 205.)

11. One of the fundamental principles of interpretation of treaties codified in Article 31 of the Vienna Convention is that the ordinary meaning is to be given to the terms of a treaty in their context and in the light of its object and purpose. The present appellants, therefore, rely on the ordinary meaning of the expression "wrongly designated" in Rule 19(1) EPC. They are entitled to do this if there is no indication that the Contracting States intended that a special meaning should be given to "wrongly designated". Both the appellants and the Board have carefully studied the material in the Minutes of the Munich Diplomatic Conference and in the other preparatory documents for the EPC but nothing therein indicates that the Contracting States intended that "wrongly designated" should have a special meaning. It is clear from the Minutes (paragraphs Nos 2047 - 2064, 278 - 280 and 323 - 325) that the Diplomatic Conference envisaged that the addition of inventors to designations would be possible by way of rectification under Rule 19(1) EPC (see especially paragraphs Nos 2059 - 2062) but there is no suggestion that the Diplomatic Conference intended that those inventors already named would have to consent.

12. The context of Rule 19(1) EPC includes the provisions of Articles 62 and 81 EPC and those of Rules 17 and 18 EPC. Taken together, these provisions give an inventor: the right vis-à-vis the applicant for or proprietor of a European patent to be mentioned as such before the EPO; the right to be designated in the European patent application; the right to be notified of
.../...

the designation; the right to be mentioned as inventor in the published European patent application and the European patent specification; and, in the event of a dispute with the applicant or proprietor of the patent, the right to be mentioned even against the wishes of the applicant or proprietor if he has a final decision of a national court whereby the applicant or proprietor is required to designate him as inventor. These are important rights and clearly it should not be possible for third parties to interfere easily with their exercise. It is to be noted that the cited provisions give an inventor rights vis-à-vis the applicant or proprietor but they do not give him rights vis-à-vis any designated co-inventors.

The context, therefore, serves to justify the appellants' interpretation of the word "wrongly" in the expression "wrongly designated" in Rule 19(1) EPC.

13. So far as the object and purpose of the Convention are concerned, in respect of inventors the intention of the Munich Diplomatic Conference was to give inventors a clear and strong legal position. If an inventor's right to public recognition could be defeated by the action or inaction of another inventor already named, this could lead to substantial injustice to an inventor who had not been named, although the applicant for or proprietor of the European patent consented to his being named, where, for example, an inventor already named was dead or could not be traced, arbitrarily refused his consent or simply neglected to answer correspondence requesting his written consent. The Legal Board of Appeal considers that there is also some force in the appellants' argument that one of a number of inventors simply may not know who all the possible co-inventors were.

14. Examination of the national laws of contracting States as amended following the signing of the European Patent Convention shows that there is no harmonisation of these laws in the matter of requiring the designation of inventors and, in particular, consent of designated inventors to the naming of additional inventors. At least one contracting State provides for investigation by the national Patent Office of

claims for further designation of inventors: cf. United Kingdom Patents' Act 1977, section 13, Patents Rules 1978, Rule 14. Other States explicitly require consent of already designated co-inventors: cf. Austrian Patent Law of 1970, Article 20(4); Italian Patent Law (Ordinance No 1127 of 29 June 1939 as amended by Ordinance No. 338 of 22 June 1979), Article 39. Yet others require consent of the person wrongly designated (cf. French Patent Ordinance of 19 September 1979, Article 62; Swiss Industrial Property Law of 19 October 1977, Article 37). It is, therefore, not possible to draw any relevant conclusion as to the intention of the contracting States from their subsequent action in amending their national laws. Furthermore, as there is no uniformity of approach, there is nothing the Board can do to harmonise the law of the EPC with national laws of the contracting States.

15. For all these reasons, therefore, the Receiving Section's interpretation of Rule 19(1) EPC must be rejected and the decision under appeal must be set aside. In these circumstances, it is unnecessary to consider the legal effect of the document relating to consent filed on 21 April 1983 (cf. paragraph XIII above).
16. For the reasons set out in paragraphs 2 to 4 above there was no procedural violation by the Receiving Section and it follows that the request for reimbursement of the appeal fee in accordance with Rule 67 EPC must be rejected.

ORDER

For these reasons,

it is ordered that:

1. The Decision of the Receiving Section of the European Patent Office dated 22 February 1982 is set aside.
2. The designation of inventors filed in respect of European patent application N°. 81302677 shall be amended in accordance with the request filed by the appellants on 28 September 1981.
3. The request for reimbursement of the appeal fee is rejected.