

Veröffentlichung im Amtsblatt	Ja Nein
Publication in the Official Journal	Yes No
Publication au Journal Officiel	Oui Non

83,127

Aktenzeichen: J 14/82
Case Number:
N° du recours :

ENTSCHEIDUNG / DECISION
vom / of / du 19 January 1983

Anmelder:
Applicant: JOHNSON MATTHEY PLC
Demandeur :

Stichwort: priority declaration / Johnson Matthey
Headword:
Référence :

EPÜ/EPC/CBE Article 88(1); Rules 38(1), 41(2), (3)

Paris Convention Article 4D (1), (2)

"Correction of mistakes" - "declaration of priority" - "public interest" - "substantial procedural violation" - "reimbursement of appeal fee" - "reimbursement of fees for second application filed to safeguard applicant's interests"

Leitsatz / Headnote / Sommaire

- I. If a mistake is made in a declaration of priority, it may be corrected in accordance with Rule 88 EPC, provided that a request has been made for correction sufficiently early for a warning to be included in the publication of the application (cf. Decision of the Legal Board of Appeal in Case J 04/82, Official Journal EPO 1982, 385).
- II. If such a warning is not published, the question must be considered whether the public interest would be adversely affected by allowing the correction, taking into account any special circumstances of the case.
- III. A Board of Appeal has no power to order refund of fees paid in respect of a European patent application which is not the subject of an appeal before that Board.

Europäisches
Patentamt

Juristische
Beschwerdekammer

European Patent
Office

Legal Board
of Appeal

Office européen
des brevets

Chambre de
recours juridique



Case No. J 14/82

DECISION
of 19 January 1983

Appellants: JOHNSON MATTHEY PLC
43 Hatton Garden
London EC1N 8EE
Great Britain

Professional
Representative : Arthur, Bryan Edward
Withers & Rogers
4 Dyer's Buildings
Holborn
London EC1N 2JT
Great Britain

Decision under appeal: Decision of the Receiving Section of the
European Patent Office dated 30 March
1982 rejecting a request to correct a
mistake in the request for grant filed
on European patent application
No. 81 305 433.5 by adding three further
priority dates to the one claimed in
part VII thereof on the date of filing.

Composition of the Board:

Chairman: R. Singer

Member: P. Ford

Member: L. Gotti Porcinari

SUMMARY OF FACTS AND SUBMISSIONS

- I. On 17th November 1981, professional representatives filed European patent application No. 81 305 433.5 on behalf of the appellants. Priority was claimed from a single United Kingdom national application filed on 27 November 1980. In fact the appellants, by letter dated 2 September 1981, had instructed the professional representatives to claim priority from that national application and from three others filed respectively on 18 March 1981, 21 April 1981 and 9 September 1981. The professional representatives had ordered and obtained copies of the relevant priority documents from the United Kingdom Patent Office but, in the absence on holiday of the person who had ordered them, the European patent application was prepared for filing by someone else, and priority was erroneously claimed only from the first of the four national applications.
- II. The error was not discovered until 30 November 1981, when the professional representatives telephoned an official of the Receiving Section of the EPO, by whom they were advised to request correction of the Request for Grant form under Rule 88 EPC.
- III. On 4 December 1981 the appellants' professional representatives filed a request for correction under Rule 88 EPC and the priority documents for all four priority claims.
- IV. By letter dated 8 December 1981, the Receiving Section requested evidence as to the intention of the appel-

lants to claim all the priorities and a declaration by the person or persons responsible for the alleged error.

Declarations made under the English Statutory Declarations Act 1835 by two of the professional representatives concerned, together with letters from the appellants giving relevant instructions, were filed as evidence on 2 March 1982.

- V. On 18 March 1982, the appellants filed, by way of precaution, a second European patent application (No. 82 301 389.1), claiming the remaining three priority dates. This application was published under No. 0 061 304 on 29 September 1982.
- VI. On 30 March 1982, the Receiving Section issued the decision under appeal, rejecting the request for correction under Rule 88 EPC on the ground that at the time of filing the application there was no reference to more than one claim of priority and that therefore the request and the evidence could not be considered.
- VII. Notice of appeal was given by letter dated 27 May 1982. The appeal fee was duly paid and a statement of grounds of the appeal was received on 26 July 1982.
- VIII. Notwithstanding that the present appeal was pending, the EPO published European patent application No. 81 305 433.5, as filed, under No. 0 053 884 on 16 June 1982.
- IX. In their statement of grounds, the appellants contended that the decision under appeal ought to be set aside

and the request for correction granted on the grounds: that there was sufficient evidence of the applicants' intention and of the error; that there was nothing in Rules 38 or 41 EPC which could exclude correction of the error; that for an error in the Request for Grant to be corrected under Rule 88 EPC it did not have to be an obvious error and that previous decisions of the Legal Board of Appeal on the question of adding omitted designations of States could be relied upon by the appellants. They further complained that the Receiving Section had issued its decision without giving the appellants any opportunity to comment on these matters. They asked for reimbursement of the appeal fee and for an order that they should be refunded the filing, search, designation and excess claims fees paid in respect of European patent application No. 82 301 389.1 when they abandon that application, which they intend to do if they succeed in the present appeal. At the request of the Legal Board of Appeal, the appellants have filed a letter which has been placed in the file of application No. 82 301 389.1 stating that it is intended to withdraw that application if the present appeal is allowed.

REASONS FOR THE DECISION

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC, and is, therefore, admissible.
2. In a decision dated 21 July 1982 Case No. J 04/82 (Official Journal EPO 1982, 385) the Legal Board of Appeal has already considered and allowed a request for correction of a declaration of priority, holding that such a mistake may be corrected under Rule 88 EPC, first sentence, and that there are no other provisions in the EPC, and no overriding principles in the Paris Convention (Articles 4 D(1),(2)), which might conflict with retrospective correction under Rule 88 EPC of a mistake in a declaration of priority.
3. Contrary to the view expressed by the Receiving Section in the decision under appeal in the present case, the fact that according to Rule 38(2) EPC priority must be claimed on filing is no reason for not allowing correction. The mistake to be corrected is an omission and the Legal Board of Appeal has consistently held that a mistake in a document filed with the European Patent Office may result from an omission and that correction can take the form of adding omitted matter. This point was first considered in Case No. J 08/80 (Official Journal EPO 1980, 293), in which a designation of a Contracting State had been omitted, and again in Case. No. J 04/82 (ubi supra), in which a claim to priority had been omitted.
4. In Case No. J 04/82, the European patent application had been published while the appeal was pending. However, in the published application and in the European Patent

Bulletin the priority, the addition of which was asked for had been inserted together with a note that the question of allowing the addition had not been finally decided. In those circumstances, the Legal Board of Appeal held that there could be no danger to the public interest if the correction were allowed.

5. In the present case, the situation is similar to that in Case No. J 04/82, insofar as additional priorities are requested having a later date than the priority claimed on filing. But in this case the application has been published without any warning being included in the publication. The Board must consider, therefore, whether the public interest would be adversely affected by allowing the correction.
6. A European patent application is published early, in accordance with Article 93 EPC, in order to inform the public about the existence of a potential European patent. Not only the technical content and the designated States concerned are of importance for the information of third parties but also the filing date and any priority date. In principle, the public should be entitled to rely on the published information as being both accurate and complete.
7. On the other hand, the applicant for a European patent is also entitled to fair treatment by the EPO. He can rely on correct application of the provisions of the EPC if he himself acted correctly. In the present case, by asking for correction of the mistake within a very short period of time after filing the application, the applicants did all they could do. As a request for correction had been made and was still pending, the EPO should not have published the application without including a warning to the public.

8. Fortunately, in the present case third parties have been informed about the full scope of European protection sought, by way of European patent application No. 82 301 389.1, published on 29 September 1982, for which the three priorities in question have been claimed in relation to the same subject matter. As noted in paragraph IX above, the appellants have declared that they intend to withdraw this application if the present appeal is allowed.

In these special circumstances it is possible for the Board to decide that the public interest would not be adversely affected by allowing the present appeal.

9. It is clear that the decision of the Receiving Section was given on grounds on which the appellants had not had an opportunity to present their comments. This was a contravention of Article 113(1) EPC and, accordingly, the Legal Board of Appeal considers that the circumstances of the case justify an order for reimbursement of the appeal fee in accordance with Rule 67 EPC.
10. The Board has no power to order refund of any fees paid in respect of European patent application No. 82 301 389.1, which is not the subject of the present appeal.

For these reasons,

it is decided that:

- (1) The Decision of the Receiving Section of the European Patent Office dated 30 March 1982 is set aside.

.../...

- (2) It is ordered that the Request for Grant form filed on European Patent Application No. 81 305 433.5 is to be corrected by adding references to United Kingdom Patent Applications 8108392, 8112331 and 8127289, filed respectively on 18 March 1981, 21 April 1981 and 9 September 1981, in field VII of page 2 thereof.

- (3) It is ordered that the appeal fee be reimbursed to the appellants.

- (4) No order is made concerning the refund of any fees paid in respect of European patent application No. 82 301 389.1.

The Registrar:

The Chairman: