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**D E C I S I O N**  
**of 16 December 1998**

**Case Number:** J 0027/96 - 3.1.1

**Application Number:** 94923124.5

**Publication Number:** 0708600

**IPC:** A22B 7/00

**Language of the proceedings:** EN

**Title of invention:**  
Method and plant for separating a part from a carcass

**Applicant:**  
Norling, Lars-Erik

**Opponent:**  
-

**Headword:**  
Correction of designations/NORLING

**Relevant legal provisions:**  
EPC Art. 91(4)  
EPC R. 85a(2), 88

**Keyword:**  
"Designations - correction of"

**Decisions cited:**  
J 0003/81, J 0032/82, J0021/84, J 0007/90

**Catchword:**  
-



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Boards of Appeal

Chambres de recours

Case Number: J 0027/96 - 3.3.1

**D E C I S I O N**  
**of the Legal Board of Appeal 3.1.1**  
**of 16 December 1998**

**Appellant:** Norling, Lars-Erik  
Valhallsvägen 49  
Ångelholm (SE)

**Representative:** Akerman, Märten  
c/o Albihn Holmqvist AB  
P.O. Box 4289  
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**Decision under appeal:** Decision of the Examining Division of the EPO  
dated 18 September 1996 refusing the correction  
of designations.

**Composition of the Board:**

**Chairman:** J.-C. Saisset  
**Members:** A. C. G. Lindqvist  
B. Günzel

## Summary of Facts and Submissions

- I. The Euro-PCT patent application was filed on 15 July 1994 claiming Swedish priority of 16 July 1993. The international application published under the PCT on 26 January 1995 contains a designation for a European patent of the European Contracting States AT, BE, CH/LI, DE, DK, ES, FR, GB, GR, IE, IT, LU, MC, NL, PT, and SE.
- II. On entry into the regional phase before the EPO the following states were expressly designated on EPO Form 1200: AT, CH/LI, DE, DK, ES, GB, LU, NL, PT, and SE. Ten designation fees were paid on 19 December 1995.
- III. On 7 June 1996 the Applicant's representative filed another page 4 of EPO Form 1200, on which the at that time remaining six Contracting States of the EPC, were added: BE, FR, GR, IE, IT and MC. A request for correction under Rule 88 EPC was made. The designation fees for the six additional states, plus surcharges, were paid on 7 June 1996. The ground for the request for correction was that, due to a misinterpretation of fax instructions from the applicant, the representative had not ticked all the EP states on the originally filed Form 1200.
- IV. When informed by the EPO Examining Division that the request for designation of additional states had been received after the expiry of the time limit under Rule 85a(2) EPC which ended on 16 April 1996, the Applicant stated that his request concerned not a late designation but the correction of a timely designation.

V. By a decision dated 18 September 1996 the EPO Examining Division refused the request on the ground that loss of rights had occurred according to Article 91(4) EPC because designation fees for the six additional states had not been paid in time, a loss which could not be remedied by correction under Rule 88 EPC.

VI. The applicant appealed against this decision, seeking as main request that the decision be set aside and that the additional states BE, FR, GR, IE, IT and MC be included as designated states.

As an auxiliary request, the appellant requested that AT, BE, CH/LI, DE, DK, FR, GB, IE, IT and NL be designated in the application.

VII. In support of the requests the Applicant submitted that due to a misinterpretation the designation instructions by the Applicant were construed by the Representative as comprising fewer states than intended, and therefore designation fees for these states only were paid. It is evident that the Applicant all the time had a clear intention of designating all possible EP states. This is also clear from the fact that the Applicant is doing or planning to do business in these states. - The missing states are exactly those states that do not allow a national PCT route. The public or a third party would immediately recognise this and suspect an error, especially since a big state like France is missing. - The request does not concern a late designation but a correction of a timely designation. There is no statutory limit on corrections under Rule 88. The "time limitation" established by case law can be after the publication of the application (see case J 7/90) if an experienced practitioner could have noticed an obvious discrepancy, as is the case there. - Furthermore, it should be noted that the misinterpretation of instructions had as a consequence that the wrong number

of designation fees were paid. However, if the requested correction is allowed, then the corrected situation would be that there were more designated countries than fees paid. In this situation the EPO would have been obliged to ask the applicant for which states the fees were intended (Articles 7(2) and 9(2) RFEES), and applicant could have remedied the situation, e.g. by designating AT, BE, CH/LI, DE, DK, FR, GB, IE, IT and NL, and thus managed to save the most important states.

### **Reasons for the Decision**

1. The appeal complies with Articles 106 to 108 and Rules 1(1) and 64(b) and is therefore admissible.
  
2. As regards the main request it was correctly stated already in the reasons of the appealed decision (II. Reasons for the decision, 2. and 3.), that any designation of additional EPC contracting states, and payment of designation fees for them, should have been made at the latest - as follows from Rule 85a(2) EPC - on 16 April 1996. Fees for additional states were, however, paid on 7 June 1996, i. e. after the expiry date of the time limit under Rule 85a(2) EPC. According to Article 91(4) EPC the designation of a state for which the designation fee has not been paid in due time shall be deemed to be withdrawn.

Correction of a mistake pursuant to Rule 88 1st sentence EPC (by adding the designation of a state has in principle been allowed in the case law of the Legal Board of Appeal, see e.g. decision J 3/81, OJ EPO 1982, page 100. In the present case it may remain undecided whether Rule 88 EPC could have been applied to the designations which are purported to be missing. As the

Examining Division has correctly pointed out in its decision the lack of fee payment in due time is not a mistake that comes within the correction possibilities under Rule 88 EPC and therefore is a failure which cannot be remedied (J 21/84, OJ EPO 19986, 75, 7. of the reasons).

3.1 Appellant's auxiliary request filed with his notice of appeal is in substance a request to replace the states ES, LU, PT and SE, expressly indicated as being states for which designation fees were paid upon entry into the regional phase, by the designations of BE, FR, IE and IT, not designated at that time, by way of correction under Rule 88. However, as far as the designation of ES, LU, PT and SE is concerned no error or mistake has been made by the Appellant. On the contrary according to the Appellant's submission in his notice of appeal, it was always the true intention of the Appellant to designate all EP states. The mistake made consisted in the omission of the states BE, FR, IE and IT upon entry into the regional phase before the EPO. The Appellant has never contended so far nor submitted any proof that the designation of ES, LU, PT and SE was made erroneously. Thus the basic requirement of Rule 88, 1st sentence EPC for the requested correction to be allowable, that the declaration made upon entry into the regional phase to pay designation fees for ES, LU, PT, SE, constituted an error or a mistake, is not met.

3.2 In this context the Appellant has put forward the following: If the correction by addition of states requested as main request was allowed then the corrected situation would be that there were more designated states than fees paid. In this situation the

EPO would have been obliged to ask the applicant for which states the fees were intended and the applicant could have remedied the situation by indicating the states mentioned in his auxiliary request and thus managed to save the most important states.

It is correct that it has been held by the Legal Board of Appeal (J 32/82, OJ EPO 1983, 127) that if the amount paid in respect of designation fees within the time limits is not sufficient for all the Contracting States designated at the time of payment the payer must first be requested pursuant to Article 7(2) first sentence of the Rules relating to Fees to select the States he wishes to designate before the EPO can allocate the money according to Article 9(2) Rules relating to Fees.

If, with this submission, the Appellant wants to argue that because of the retroactive effect of any correction of designations once granted the EPO also had the obligation to let the Appellant retroactively choose to which of the designated states the fees paid were to be allocated according to the above mentioned case law, this argument must fail.

Even if it is accepted that the correction by addition of a designation has retroactive effect in the sense that the corrected designation is deemed to have been made as from the filing date of the application that does not mean that the applicant is reinstated in the procedural phase when designations have to be made and fees to be paid with the consequence that the whole procedure of that phase must be available to him again. Correction of a mistake is an isolated procedural measure and not a case of re establishment into a defined procedural phase as a whole.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

  
M. Beer

The Chairman:

  
J.-C. Saisset