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**D E C I S I O N**  
**of 25 November 1997**

**Case Number:** J 0031/96- 3.1.1  
**Application Number:** 96303031.7  
**Publication Number:** 0 742 277  
**IPC:** C10G 75/02

**Language of the proceedings:** EN

**Title of invention:**

Use of sulfiding agents for enhancing the efficacy of phosphorus in controlling high temperature corrosion attacks

**Applicant:**

NALCO CHEMICAL COMPANY

**Opponent:**

-

**Headword:**

Correction of mistake/NALCO

**Relevant legal provisions:**

EPC Art. 60(3), 61  
EPC R. 88

**Keyword:**

"Correction substituting the name of the real applicant"  
"Sufficient evidence of proof"

**Decisions cited:**

J 0007/80, J 0008/80, J 0018/93, J 0017/96, T 0219/86,  
T 0493/88, T 0522/90, T 0360/91, T 0808/94

**Catchword:**

A correction substituting the name of the applicant is allowable under Rule 88 EPC if there is sufficient evidence to support the request for correction.



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Boards of Appeal

Chambres de recours

Case Number: J 0031/96 - 3.1.1

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.1  
of 25 November 1997

**Appellant:** NALCO CHEMICAL COMPANY  
One Nalco Center  
Naperville, Illinois 60563-1198 (US)

**Representative:** Harrison, David C.  
Mewburn Ellis  
York House  
23 Kingsway  
London WC2B 6HP (GB)

**Decision under appeal:** Decision of the Receiving Section of the European  
Patent Office dated 28 August 1996 refusing a  
request for correction under Rule 88 EPC with  
respect to European patent application  
No. 96 303 031.7.

**Composition of the Board:**

**Chairman:** J.-C. Saisset  
**Members:** A. Lindqvist  
S. Perryman

## Summary of Facts and Submission

- I. European Patent Application No. 96 303 031.7 was filed with the UK Patent Office on 30 April 1996 by a professional representative in the name of NALCO CHEMICAL COMPANY. Three inventors were named.
  
- II. By a letter dated 17 May 1996, the representative requested correction of the applicant's name pursuant to Rule 88 EPC to Nalco/Exxon Energy Chemicals, L.P.

It was argued that the application was mistakenly filed in the name of NALCO CHEMICAL COMPANY for the following reasons. Instructions had been given to the representative by that company to file the application in their name. At the same time they sent, as announced in the instructing letter, a copy of the assignment from the inventors of the basic US application. Both the representative and his clients failed to notice that the assignee was not NALCO CHEMICAL COMPANY but an associated body, Nalco/Exxon Energy Chemicals, L.P. - Copies of the letter of instruction and the assignment from the inventors were filed as evidence.

In a communication dated 8 July 1996 the Receiving Section informed the representative that Rule 88 EPC was not intended to allow the substitution of the applicant and that this could only be done by means of an assignment of rights under Article 72 and Rule 20 EPC.

In a reply of 10 July 1996 the representative contested the Receiving Section's view and referred to decision J 0007/80 (OJ EPO 1981, 137). He asked for an appealable decision if the request for correction was not allowed.

III. By a decision of 28 August 1996 the Receiving Section refused the request on the ground that Rule 88 was not intended to allow the substitution of one applicant for another. According to Article 60(3) EPC a person named as an applicant is deemed to be entitled to exercise the right to the European patent. Thus, the applicant's entitlement is not verified but is accepted by the EPO solely on the basis of his identification as applicant in the request so that he may not be replaced or substituted by way of correction, even if his entitlement is disputed. In the latter case the Convention provides for a special procedure, which cannot be circumvented by applying Rule 88 EPC, especially in view of the fact that Articles 60(3) and 61 EPC have precedence over Rule 88 EPC (Art. 164(2) EPC).

Furthermore, no indication of exceptional circumstances could be derived from the documents on file as was the case in decision J 0007/80 in which the correction of the name of the applicant had been allowed and where doubts as to whether the right firm had been named as applicant had been raised even at the time of filing.

IV. An appeal against the decision was lodged in due order. The representative stated that he was acting as representative both for Nalco/Exxon Energy Chemicals, L.P. and for NALCO CHEMICAL COMPANY who were wrongly named as the original applicants. The principal grounds relied on are the following. The application for correction was filed within three weeks of the filing of the application. In its decision The Receiving Section accepted that a mistake had occurred. However it refused to allow a correction under Rule 88 EPC and discussed matters under Articles 60(3) and 61 EPC which are not relevant to the case. No problem whatsoever arises under Article 61 EPC in the present case: there

is no dispute about entitlement between the two companies involved. The Receiving Section also said in the decision that the present situation was distinguishable from that of J 0007/80 because the parties there were related companies. That is however the case also here, and the Receiving Section had material before them which showed this and apparently accepted that this was so (see "an associated body" in paragraph I.2 of the decision).

- V. The appellant also submitted that the appeal fee should be reimbursed, because the decision under appeal was so unreasoned that its issuance amounted to a serious procedural error, relying on decisions T 0493/88 (OJ EPO 1991, 380), T 0522/90 and T 0362/91. (The appellant in fact cited T 0362/91, but no such decision exists, so that the citation is presumed to be an error for T 0360/91 where reimbursement of the appeal fee was ordered.) He further argued that interlocutory revision should have been granted by the Receiving Section, and that this amounted to a further substantial procedural violation justifying reimbursement, relying on decision T 0808/94 (unpublished in the OJ EPO).

- VI. The appellant requested:

that the decision under appeal be set aside and that the named applicant be changed to Nalco/Exxon Energy Chemicals, L.P., under Rule 88 EPC;

that the appeal fee be reimbursed.

## Reasons for the Decision

1. The Board states that the reasons for refusing the appellant's request are the same as in, inter alia, the Receiving Section's decision of 18 August 1993 with respect to European patent application No. 92 303 280.9 filed in the name of Cardiac Pacemakers. This decision was set aside by Decision J 0018/93 of 2 September 1994 (OJ EPO 1997, 326), allowing the requested correction substituting the name of the applicant. A later decision by which a request for substitution under similar circumstances was allowed is J 0017/96 of 3 December 1996 (unpublished in the OJ EPO). The Legal Board can now only repeat what has already been explained clearly in the previous decisions and in particular in J 0008/80 (OJ EPO 1980, 293) i.e.:

"In Article 60(3) EPC the principle is established that the EPO assumes the applicant to be entitled to the European patent. This fiction only relieves the EPO from any need to investigate the existence of the entitlement. However, when a person referred to in Article 60(1) EPC, other than the applicant, disputes the entitlement to the grant of a European patent, the entitlement may be modified under the conditions provided for in Article 61 EPC.

A modification as to the identity of an applicant is also allowable under Rule 88 EPC concerning the correction of errors in documents filed with the European Patent Office. Indeed this Rule, which is not in conflict with the provisions of Article 61 EPC, which concerns ownership disputes, provides that mistakes in any such document may be corrected on request, the only additional condition according to the second sentence of that

Rule being that, if the request concerns a description, claims or drawings, the correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as a correction. This condition does not apply in the present case. Here it is only necessary to verify whether there is sufficient evidence to support the request under Rule 88 EPC, as was decided in decision J 0007/80 (see reason 3) which allowed the correction substituting the name of the applicant in the absence of any "exceptional" circumstances (cf. also T 0219/86, OJ EPO 1988, 254 concerning the correction of the name of the opponent).

Where the correction of a mistake is requested and the second sentence of Rule 88 is not applicable, the Board must be satisfied that a mistake was made, what the mistake was and what the correction should be. In order to avoid any abuse of the provisions of Rule 88 EPC, the burden of proving the facts must be a heavy one."

2. In the present case the Board considers the following circumstances. There is no reason to doubt that the two companies involved are related. The companies are represented here by the same professional representative. The request for a correction of the applicant's name shall consequently be regarded as filed at the wish of both of the companies.

The original United States application, which is the priority document for the present application, was filed on 10 May 1995, with serial number 08/435,405. Applicants were the inventors, as is the procedure in the United States. NALCO CHEMICAL COMPANY was

mentioned on the first page of the application. On 31 May 1995 the applicants assigned to Nalco/Exxon Energy Chemicals, L.P., the right to the invention and to apply for patents in all countries outside the United States. In the deed of assignment the applicants further authorized the company to claim the priority of the filing date of the United States application.

In a letter of 18 March 1996 from the Patent and Licensing Department of NALCO CHEMICAL COMPANY to the office of the professional representative instructions were given to file an application for a European patent based on the US application. With the letter there were sent copies of the US application, the inventors' declaration (for the US patent application) and their assignment of the US patent application and of the right to file equivalent applications abroad to Nalco/Exxon Energy Chemicals, L.P.. The letter did not expressly state who the applicant for the European patent should be: the mention of Nalco Chemical Company in the letter would be consistent both with its patent department handling the case on behalf of its associated company, Nalco/Exxon Energy Chemicals, L.P. mentioned in the assignment, or with Nalco Chemical Company being the intended applicant.

The legal representative of the two companies has asserted that NALCO CHEMICAL COMPANY was named by mistake as applicant in the European patent application. In the light of the circumstances of the case, and in particular of the fact that the inventors had assigned the invention and the right to apply for a patent to Nalco/Exxon Energy Chemicals, L.P., the Board concludes that the true intention was that an application should be made in the name of the latter



company. The Board is therefore satisfied that the evidence needed has been provided to allow the appellant's request for correction.

3. In asking for reimbursement of the appeal fee the appellant relied on decisions T 0493/88, T 0522/90 of 8 September 1993 and T 0360/91 of 1 June 1993.

However these three decisions all relate to cases where the Board concerned found that the first instance had not dealt with a particular aspect at all, and this amounted to a violation of Rule 68(2) EPC requiring decisions to be reasoned, and this violation justified repayment of the appeal fee pursuant to Rule 67 EPC. Here the situation is different, the Receiving Section considered all aspects of the case, but came to the wrong conclusion. In accordance with the established jurisprudence of the Boards, see for example decisions J 0018/93 and J 0017/96, such an error in applying the law is not regarded as being related to procedure, and so cannot amount to a substantial procedural violation, which would allow reimbursement of the appeal fee under Rule 67 EPC. The appellant also relied on decision T 0808/94 of 26 January 1995, in which there had been found a substantial procedural violation in that a request pursuant to Article 116 EPC for oral proceedings had been ignored, and the board there found it a further substantial procedural violation that the opportunity for interlocutory revision pursuant to Article 109 EPC had not been taken by the first instance. However in the present case there is no substantial procedural violation involved in arriving at the decision under appeal. The Board must assume that when considering the possibility of interlocutory revision, the first instance were still of the same opinion on the law involved, and the Board can see no procedural violation in the first instance not

rectifying its decision pursuant to Article 109 EPC. The request for reimbursement of the appeal fee has to be rejected. Although the Receiving Section, which is regularly faced with correction problems, should have been aware of the Decision J 0018/93 and should have considered it in its decision, its error remains an error of judgment and was not a substantial procedural violation (Rule 67 EPC).

**Order**

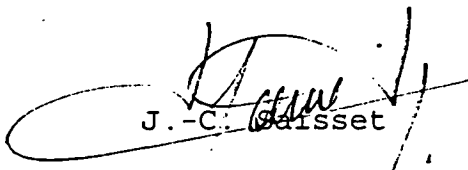
**For these reasons it is decided that:**

1. The decision under appeal is set aside.
  
2. It is ordered that the name of the applicant in European patent application No. 96 303 031.7 (request for grant and designation of inventors) be corrected to that of Nalco/Exxon Energy Chemicals, L.P. (7701 Highway 90-A, Sugarland, TEXAS, United States of America).
  
3. The request for reimbursement of the appeal fee is rejected.

The Registrar:

  
M. Beer

The Chairman:

  
J.-C. Saisset