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D E C I S I O N
of 2 July 2001

Case Number: J 0017/00

Application Number: PCT/IB...

Publication Number: -

IPC: ...

Language of the proceedings: EN

Title of invention:
...

Applicant:
N.N.

Opponent:
-

Headword:
Designation of the EPO in PCT-Application; correction of omission

Relevant legal provisions:
EPC Art. 122(6)
EPC R. 88

Keyword:
"No correction of an erroneously missing designation of the EPO in a PCT - application after publication except in exceptional cases"

Decisions cited:
J 0003/81, J 0008/89, J 0007/90, J 0005/81, T 0198/88

Catchword:
-

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: J 0017/00

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 2 July 2001

Appellant: N.N.

Representative: N.N.

Decision under appeal: **Decision of the Receiving Section of 17 December 1999.**

Composition of the Board:

Chairman: J.-C. Saisset
Members: P. Mühlens
M. B. Tardo-Dino

Summary of Facts and Submissions

I. The international patent application PCT/IB... was filed on 11 March 1997 with the USPTO. The applicant N.N. designated on sheet No. 2 of the Request Form (PCT/RO/101) the following states: CA, JP, CN and KR. The application was published on 2 October 1997 with the designated states as above and without any warning under Rule 91.1(f) PCT.

II. The applicant's European representative requested by letter dated 4 March 1998 that the EPO be regarded as designated office and submitted that the applicant erroneously failed to tick the respective box in the PCT Form. In this context it has to be mentioned that a request for rectification previously filed with the International Bureau had been rejected.

III. The Receiving Section rejected the "request for correction of the PCT request by adding the designation of the European Patent Office for a European Patent" by the contested decision of 17 December 1999. The reasons for the decision can be summarized as follows:

- The EPO could not establish that the applicant made a mistake in not designating the EPO on PCT Form RO/101.

- Furthermore, the request for correction was not made early enough for a warning to be included in the publication of the application, this warning being necessary to safeguard the interests of the public in being able to rely on the correctness of the published application, in particular with respect to the exact limits of the territorial

scope of protection.

IV. On 2 February 2000, the applicant lodged an appeal against the decision of the Receiving Section and paid the appeal fee.

With the grounds of appeal filed 14 April 2000, the appellant submitted that the statements of the Receiving Section implied that the applicant intentionally decided not to designate the EPO, but that this statement was totally inconsistent with the presented facts. He also submitted two written declarations explaining in detail how the error had occurred. If interests of third parties were affected by broadening the territorial scope of the application as a consequence of a correction, these interests could be protected by application of Article 122(6) EPC *mutatis mutandis*, provision available to users in good faith in cases where *restitutio in integrum* had been granted.

V. In a communication dated 7 February 2001, the Board made the following observations:

Although the Board was inclined to establish - in particular with respect to the two written declarations filed during the appeal procedure - that a mistake had been made by the applicant, that would not necessarily mean that the appeal could be allowed. The Board drew attention to the established case law that a request for correction of a designation must be made, at least in absence of special reasons, at a point in time where a warning could still be published together with the application. The Board pointed out that the problem of protection of third parties in this respect could not

be solved by application *mutatis mutandis* of Article 122(6) EPC.

VI. In his response to the communication, the appellant expressed his view that the Board's concern for the interests of unidentified competitors was not well founded as those competitors could not rely on the lack of a European designation as a basis for further activities as the original PCT- application was filed by a European company.

Furthermore, it appeared that the EPO was imposing on the applicant a higher standard than on its own personnel, as the EPO had procedures for the correction of errors.

The appellant requested the Board to reconsider its position towards "the manifest harm to the applicant in contrast to the hypothetical harm to a hypothetical competitor."

VII. Oral Proceedings were held on 2 July 2001.

In addition to his written submissions, the representative of the appellant referred to the relevant case law of the Boards of Appeal which was in his view inconsistent: Whereas the correction of mistakes made by the EPO was allowed in several cases (see *inter alia* J 08/80, OJ 1980, 293; J 26/ 87, OJ 1989, 329; J 12/ 80, OJ 1981, 143), correction was in general refused in cases where the mistake had been made by the applicant (see *inter alia* J 03/ 81, OJ 1982, 100; J 07/ 90, OJ 1993, 133).

VIII. The appellant requested that the decision under appeal

be set aside and that the PCT request form be corrected so as to designate the EPO.

As a subsidiary request, he requested that the case be referred to the Enlarged Board of Appeal.

Reasons for the Decision

1. The appeal is admissible.

2. The Board accepts that it was the intention of the applicant to designate the EPO in the international application. The appellant has submitted with the grounds of appeal two written declarations of J. T. S. and C. S. who both declared that it happened as a result of an error that the EPO was not designated in the PCT - form.

The Board has no reasonable doubts as to the correctness of these declarations. In addition, the fact that the applicant is a European (Swedish) company makes it even appear likely that it was the intention to designate the EPO. However, the Board wants to stress that it cannot be directly deduced from this circumstance that the designation was erroneously omitted. It is up to the applicant alone to decide which states he wishes to designate. Thus, the office has to accept the form as it is submitted and has not even the right to question the reasons behind the applicant's decision. At least in cases where the contents of a form are clear - as in the present case - there is no possibility of interpretation.

3.

3.1 According to Rule 88 EPC, mistakes in documents filed with the EPO may be corrected on request. Rule 88 EPC does not provide for a time limit for filing the request. Thus, the request for correction , although filed about six months after publication, was filed in due time.

3.2 As far as the correction of wrong or missing designations in European or Euro - PCT applications is concerned, it is established case law of the Board that the request for correction must be made at a point in time where the publication of a warning together with the application is still possible (cf J 03/ 81, OJ EPO 1982, 100; J 08/ 89, EPOR 55; J 07/ 90, OJ EPO 1993, 133). Publication is one of the cornerstones of the patent system as a whole. The public in general and possible competitors of the applicant in particular must have the possibility to take note of the contents and the scope - including the geographical scope - of future or existing patents, these being exclusive rights which have to be respected by anybody. This leads to the conclusion that a correction of wrong or missing designations after publication of an application is, in general, not allowable.

3.3 The present case does not give raise to the question under which circumstances, in exceptional cases, a correction could be deemed allowable even after publication of the application. The employees of the applicant's then representative simply missed ticking the right box in the PCT - form. This type of error is not at all exceptional.

The Board admits that those forms are complicated and that it may be easy to make mistakes when ticking the

boxes for the designations; however, the Board holds that it is as easy to fill in these forms in a correct way. Knowing the utmost importance, this part of the form in particular has to be filled in with great care and has to be carefully checked.

3.4 As a result, it has to be established that in the absence of any exceptional circumstances, the interest of the public in being protected against surprising exclusive rights prevails over the interest of the applicant to have the geographical scope of protection extended by adding the designation of the EPO.

4. The Board is not convinced by the argument that, in case of correction of wrong or missing designations, the interest of the public and of competitors could be safeguarded by application of Article 122(6) EPC *mutatis mutandis,* because this article is designed to solve a different problem. In a case where *restitutio in integrum* is granted under Article 122 EPC, the applicant has his rights re - established because, *in spite of all due care required by the circumstances having been taken,* he was unable to observe a time limit. Thus, Article 122 does not allow for the correction of mistakes contrary to Rule 88 EPC. Because the situation addressed by Rule 88 EPC is entirely different from the situation addressed by Article 122 EPC, it is impossible to apply this provision *mutatis mutandis.* In addition to that, it has to be kept in mind that Article 122(6) EPC can only be applied by the national courts and not by the Boards of Appeal as the problem which is addressed by that provision is not within the jurisdiction of the EPO.

5. The case law of the Boards concerned with the

correction of incomplete designations after publication of the application does not introduce a time limit into Rule 88 EPC. Although this case law might appear to create an inherent time limit in Rule 88 EPC (see J 08/80, J 03/81), the case law is actually based on weighing up the interests of the public and the interests of the applicant (see 3.3 above).

6. The Board does not share the applicant's view that there is a divergence in the respective case law. As the decision whether to allow the correction of designations even after publication depends on weighing up the interests of the public and those of the applicant, it is clear from this fact that the outcome depends on the merits of each individual case. Without making a general rule from this it can be said that in cases where the office had mistaken something in the procedures and thereby caused the problem, it could be easier to hold that the interests of the applicant prevail, rather than in cases where the problem arises from the applicant's mistakes. This is why correction after publication was in the past only allowed in cases where the error had been committed by the office.

7. The applicant submitted in the oral proceedings the following questions for referral to the Enlarged Board:

1. Does the wording "may be" in Rule 88 EPC mean that time limitations may be imposed on a request for correction of an error in the designation of individual states of the EPC or of the EPO as a whole in a European patent application?

2. If the answer to question 1 is "yes", is the time limitation in any case the publication of the

application without warning to third parties, irrespective of whether the error occurred by the applicant or by an official authority, like the EPO?

3. If the answer to question 2 is "no", what are the criteria for the balance of interests between the applicant and its competitors relying on the publication, and can the competitors' interests be safeguarded by an application of Article 122(6) EPC mutatis mutandis by national authorities?

Under Article 112(1) EPC it is within the discretion of the Boards of Appeal to refer a question to the Enlarged Board of Appeal if it appears necessary for ensuring uniform application of the law or if an important point of law arises.

7.1 The Board cannot see any need for ensuring uniform application of the law in this respect. As far as the decisions of the Board resulted in cases where requests for correction were dealt with differently, the reason for this was that the underlying facts were different.

7.2 Even if the questions submitted by the applicant involved an important point of law, the Board would not refer them because it can resolve the questions itself without any doubt (see J 5/ 81; OJ 1982, 155; T 198/88; OJ 1991, 254), because they are not relevant for the decision of the case or because a general answer is not possible.

7.3 Following the same line, the first question is not relevant for the case, as the Board's case law actually does not impose time limits on a request for correction

of errors in the designations of states (see point 5. above). Thus, the second question is not relevant either. As far as the question addresses the role of publication of the application in that respect and the relevance of the author of the error, these questions have already been discussed above. Finally, the third question cannot be answered in a general manner as the criteria for the balance of interests depends on the merits of each individual case. The question of the applicability of Article 122(6) *mutatis mutandis* in these cases has already been discussed above (see 4.above) and can be answered by the Board itself without any uncertainty.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

M. Beer J.-C. Saisset