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D E C I S I O N
of 17 June 2002

Case Number: J 0003/01 - 3.1.1

Application Number: 97917811.8

Publication Number: 0932563

IPC: B65D 83/62

Language of the proceedings: EN

Title of invention:
Pressure generation system for a container

Applicant:
QUOIN INDUSTRIAL, INC.

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 122(1,5), 150(2,3), 164(2),
RRF Art. 7(2)
PCT Art. 39(1)(a,b)
EPC R. 85a (1,2), 104b (1), 104c (2), 88

Keyword:
"International application" - "Correction of designation" - "Re-establishment of the right to be notified of a Rule 85a(1) EPC commmunication"

Decisions cited:
G 0005/93; J 0005/81; J 0006/91; J 0027/96

Catchword:

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Case Number: J 0003/01 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 17 June 2002

Appellant: QUOIN INDUSTRIAL, INC.
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Golden, Co 80401 (US)

Representative: Lawrence, Malcolm Graham
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Decision under appeal: **Decision of the Receiving Section of the European Patent Office dated 13 September 2002 refusing requests for correction and re-establishment.**

Composition of the Board:

Chairman: J.-C. Saisset
Members: S. U. Hoffmann
B. J. Schachenmann

Summary of Facts and Submissions

I. Euro-PCT patent application no. PCT/US 97/05447 was filed on 1 April 1997 claiming a US priority of 12 April 1996. The international application published under the PCT together with the international search report on 23 October 1997 contained *inter alia* a designation for a European patent in the EPC Contracting States: AT, BE, CH, DE, DK, ES, FI, FR, GB, GR, IE, IT, LU, MC, NL, PT, SE. United Kingdom (GB) was designated only as a part of the EPC designation, but not as a national application.

II. The steps for entry into the regional phase under Rule 104b(1) EPC (in the then valid version) were taken on 5 November 1998. On EPO Form 1200 for entry into the regional phase it was indicated in Section 10.1 that the designation fees were being paid in respect of BE, DE, DK, ES, FR, IE and NL. According to the pre-printed cross in Section 10.2 and the pre-printed text, it was not intended to pay designation fees for EPC Contracting States not marked with a cross in Section 10.1. The pre-printed text of Section 10.2 also mentioned that no communication under Rule 85a(1) EPC in respect of these designation fees needed to be notified and, furthermore, if these fees had not been paid by the time the period of grace allowed in Rule 85a(2) EPC expired, it was requested that no communication should be sent under Rule 69(1) EPC.

III. Seven designation fees were paid on 5 November 1998 and allotted by the Office to the designations for BE, DE, DK, ES, FR, IE and NL according to appellant´s indication in EPO Form 1200.

IV. On 16 April 1999 the appellant filed a request for *restitutio* under Article 122 EPC and/or correction under Rule 88 EPC with the intended effect of restoring the designation of the United Kingdom. A designation fee for UK, plus surcharge, and a fee for re-establishment were paid at the same date.

V. The designations of the Contracting States BE, DE, DK, ES, FR, IE and NL were published in European Patent Bulletin 31/1999 on 4 August 1999.

VI. Appellant´s request for correction concerned the addition of a cross for GB in EPO Form 1200 in section 10.1 filed on 5 November 1998. The appellant submitted that such correction of EPO Form 1200 would thereby cancel the waiver in Section 10.2 of the right to a Rule 85a(1) EPC communication with the result that such communication should now be issued in case of a fee default. The appellant submitted that the GB designation fee paid in April 1999 with surcharge was paid prior to start of any Rule 85a(1) period and thus must, by definition, satisfy any Rule 85a(1) communication issued in future.

Furthermore, the appellant sought re-establishment of its right to be notified under Rule 85a(1) EPC of late payment and the right to enjoy the benefits of such notice (namely the right to pay a designation fee for GB late with surcharge). Restitution of these two rights were not precluded by Article 122(5) EPC.

VII. With subsequent submissions dated 10, 14, 17, 24, 26 June 1999, 19 November 1999 and 21 February 2000 these requests were mainly substantiated as follows:

Due to a misleading communication between the appellant´s national representative and its administrative assistant erroneous instructions were given to the European patent attorney and therefore contrary to appellant's true intentions, GB had not finally been designated in the entry to the EPC regional phase. Affidavits by Mr Michael A. Goodwin and Ms Sharyn Hathaway referring to various exhibits were produced in order to provide evidence for these facts and for the fact that a normally effective system for monitoring procedural acts prescribed by the case law concerning Article 122 EPC was established in the office of the appointed representative.

VIII. By a decision of the Receiving Section dated 13 September 2000 both the request for correction by adding the missing designation of the United Kingdom and the request for *restitutio in integrum* under Article 122 EPC of the appellant in the right to be notified of a communication under Rule 85a(1) EPC in respect of payment of the designation fee for the United Kingdom were rejected.

IX. As regards the main request it was pointed out in the reasons of the decision under appeal that Rule 88 EPC was not applicable in the present case since the omission to indicate GB under section 10.1 in EPO Form 1200 was not an error in the designation of states but rather related to a failure to pay the designation fee for this Contracting State. An omitted payment does not fall within Rule 88, first sentence, EPC since it is neither a linguistic error, nor an error of transcription, nor a mistake in any document. The omission of the payment although possibly related to the failure to indicate the intention to pay a

designation fee for the United Kingdom, is a separate fact that cannot be remedied. It was stated that the possibility for re-establishment of rights in respect of the time limit for payment of the designation fees was expressly excluded by Article 122(5) EPC and that this express provision could not be set aside by Rule 88 EPC as confirmed *inter alia* by decision J 27/96.

X. As regards the auxiliary request it was pointed out in the reasons for the decision under appeal that non-notification of a communication under Rule 85a(1) EPC was not a loss of rights within the meaning of Article 122(1) EPC since it was based on the appellant's waiver in Section 10.2 of EPO Form 1200 and that the time limit provided by Rule 104b(1)(b)(ii) EPC for payment of the designation fees was excluded from *restitutio in integrum* under the provisions of Article 122(5) EPC.

XI. The applicant appealed by fax received on 22 November 2000 against this decision, seeking as main request that the decision be set aside and that the applicant's main request dated 10 June 1999 be allowed or , if not allowed, that the applicant's auxiliary request dated 10 June 1999 be allowed. At the same time, the appeal fee was paid by debiting the deposit account of the representative.

XII. The appellant's submissions can be summarised as follows:

As regards the main request a correction under Rule 88 EPC places the applicant in the same position it would have been in had the error not been made which follows

from the retroactive (*ab initio*) effect of a Rule 88 correction well recognised by the case law. The appellant stressed that the situation in decision J 27/96 was entirely different from the present case since the appellant's requests did not include a request to retake the decision on how to apply the fees already paid and assigned but asked for restoration of the appellant's position to the one in which it would have been in under Rule 85a(1) EPC had it not made the error in EPO Form 1200. This position would restore a right previously not exercised and would not reverse an election already made. The appellant emphasised that it did not assert that non-payment of a designation fee for GB was an error capable in itself of correction under Rule 88 EPC and that it did not request payment of the designation fee as a correction under Rule 88 EPC.

As regards the auxiliary request the appellant stated that all prerequisites of Article 122 EPC were fulfilled in the present case. The appellant had lost its right to be notified by a Rule 85a(2) communication as a direct consequence of failure to exercise its right to elect to pay a further fee for the United Kingdom within the prescribed period according to Rule 104(1)(b)(iii) EPC as extended by Rule 85a(2) EPC. Therefore, the auxiliary request sought reinstatement of that "notification right" as another right in the sense of Article 122(1)EPC. The appellant emphasised that it did not assert that the loss of rights for the UK was in itself capable of re-establishment under Article 122 EPC and that it did not request reinstatement of the designation of GB by way of re-establishment of rights under Article 122 EPC.

XIII. Oral proceedings took place on 6 May 2002.

During the oral proceedings the appellant stated that the present case complied with all requirements for Rule 88 EPC correction mentioned in decision J 6/91. After correction the applicant should be in the same position as if the error had not occurred. Reference to the case law concerning the *ab initio or retrospective* effect of a correction under Rule 88 EPC was made in detail. In particular the appellant argued that in not recognizing the *ab initio* effect, decision J 27/96 was at variance with other decisions cited. Even if one accepted the reasoning in this decision, the present case would differ from it, since in that case the applicant had asked for re-instatement into a better position than the one he would have enjoyed had no mistake been made. The appellant stressed that its present main request, quite contradistinctively, pointed to an error in EPO Form 1200 regarding the applicant's intention and asked for correction with *ab initio* effect only of that error and the making available *de novo* of the Rule 85a(1) EPC procedure.

The appellant submitted the following final requests:

Main request:

Correction of EPO Form 1200 under Rule 88 EPC so that it appears as shown in Exhibit A to the applicant´s statement of Grounds of Appeal, with an order that a Rule 85a(1) communication be notified to the applicant pointing out the failure to observe the time limit for payment of a designation fee in respect of the United Kingdom and subject to such conditions (if any) as the Board shall consider appropriate.

First auxiliary request:

Referral to the Enlarged Board of Appeal of the following question:

Does an allowable correction of Box 10.1 of Form 1200 (in the version applicable at 5 November 1998) to indicate an intention to pay a designation fee for a further EPC state not previously mentioned in that Box 10.1, give rise, an allowance of that correction under Rule 88 EPC, to a right of the applicant to be notified of a Rule 85a(1) communication informing him of the failure to observe the time limit for payment of that designation fee.

Second auxiliary request:

Restitution under Article 122 EPC of the applicant´s lost right to be notified of a Rule 85a(1) communication informing him of the failure to observe the time limit for payment of a designation fee in respect of the United Kingdom, subject to such conditions (if any) as the Board shall consider appropriate.

XIV. At the end of the oral proceedings the Chairman declared the debate closed with the consequence that no further submissions were to be made and announced that the decision would follow in writing.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rules 1(1) and 64(b) EPC and is, therefore, admissible.

Main request (correction under Rule 88 EPC)

2. As regards the main request it was already correctly stated in the reasons for the appealed decision (A. Relevant facts, 1.), that with respect to the PCT-application under consideration, the 31-month period for entry into the regional phase before the EPO as elected Office (Article 39(1)(a,b) PCT in conjunction with Rule 104b(1)ii) EPC in the then valid version) ended on 12 November 1998 and designation fees were paid on 15 November 1998 only for the EPC Contracting States BE, DE, DK, ES, FR, IE and NL. The period under Rule 85a(2) EPC expired on 12 January 1999 without any further Contracting States having been designated through payment of fees. According to Rule 104c(2) EPC (in the then valid version) the designations of Contracting States other than BE, DE, DK, ES, FR, IE and NL were deemed to be withdrawn since the designation fees had not been paid in due time. Therefore, the payment of the designation fee with surcharge received on 16 April 1999 for the Contracting State GB as such could not remedy the legal effect provided for in Rule 104c(2) EPC. The appellant did not contest this conclusion.

3. However, the appellant requested correction under Rule 88 EPC to indicate the designation of United Kingdom in box 10.1 of EPO Form 1200 filed on 5 November 1998 so as to cancel the so-called "waiver" in section 10.2 for the designation of United Kingdom. It submitted that if this were allowed, the EPO would have to issue a communication pursuant to Rule 85a(1) EPC setting a period of grace of one month within which the appellant could still validly pay the designation fee for GB.

The question to be answered is whether a correction under Rule 88 EPC can be allowed if as consequence the EPO is obliged to issue a communication under Rule 85a(1) EPC setting or re-setting the period of grace according to this provision?

4. There is no objection against the application of Rule 88 EPC to so-called Euro-PCT-proceedings, since an international application, for which the European Patent Office acts as designated Office pursuant Article 150(3) EPC is deemed to be a European patent application. Furthermore, Article 150(2) EPC states that "*International applications filed under the Cooperation Treaty may be the subject of proceedings before the European Patent Office. In such proceedings, the provisions of that treaty shall be applied, supplemented by the provisions of this Convention*". Finally, Article 26 PCT allows correction of an international application to the extent provided by the national law for comparable situations. Under these provisions of the PCT and EPC, Rule 88 EPC is applicable to Euro-PCT-applicants in the regional phase.

5. Correction under Rule 88, first sentence, EPC is allowable in case of linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office. There is ample jurisprudence of the Boards of Appeal with respect to omitted designations of States and to omitted priority claims according to which Rule 88 EPC also applies to erroneous omissions in documents filed with the EPO (i.e. J 06/91, OJ 1994, 349). However, the Board must point out that the jurisprudence prior to the amendment of Rule 85 a EPC in 1989 and the introduction of the

so-called precautionary designation under the PCT concerning omitted designations of states does not directly apply, since in the case under consideration all Contracting States are designated *ab initio* and this effect is only cancelled with respect to a state for which the designation fee is not duly paid regardless of whether or not a state was crossed in section 10.1 of Form 1200.

6. The Board accepts the appellant's assertion of an erroneous omission to cross GB in section 10.1 contrary to the applicant's instructions. The evidence submitted shows the clear intention of the appellant on entry into the European phase also to obtain a European patent for the United Kingdom.

7. However, pursuant to the established case law of the Boards of Appeal (J 6/91, OJ 1994, 349, point 5.3), Rule 88, first sentence, EPC in no way compels the EPO to permit the correction of errors of any kind at any time. All three texts of this rule ("können" - "may" - "peuvent") give the EPO the authority to permit certain types of correction at its discretion, which also means that corrections can be made dependent on conditions or may not be allowed with regard to other, compelling principles of the Convention. Thus, for instance the Legal Board recognised a need for a time limitation for the allowability of a correction of designations only up to the date of the mention of the international publication in the European Patent Bulletin. In decision J 27/96 (not published in OJ EPO) the Board stated that a correction by addition of a designation does not mean - despite its *ab initio* effect- that the applicant is reinstated into the procedural phase where designations can be made and fees paid, meaning that

the whole procedure of that phase becomes available to the applicant again. The Legal Board stressed that correction of a mistake is an isolated procedural measure and not a case of re-establishment into a defined procedural phase as a whole (point 3.2, last paragraph).

8. The appellant contested that the *ratio decidendi* of J 27/96 was applicable to the present case because - although the facts were comparable- the requests were different. It submitted that the reasoning of J 27/96 was based on the fact that the applicant had asked for correction by addition of states in order to achieve the possibility to make a new designation pursuant to Article 7(2), first sentence, of the Rules relating to Fees for saving the most important states according to the number of designation fees paid in due time. If this request had been allowed the applicant would have gained a better position than it had without the error since it would have had a second opportunity to decide how fees should be distributed and a chance to review payment decision already implemented and decide differently.

9. With regard to case J 27/96, the Board cannot share appellant's conclusion.

Contrary to the appellant's submissions, the present request under Rule 88 EPC and the situation underlying decision J 27/96 are not entirely different but concern the same problem in that both requests aimed at a reinstatement into an earlier procedural phase by means of a correction under Rule 88 EPC.

10. However, the so-called retrospective effect of a

correction under Rule 88 EPC does not cancel previous procedural events, but only causes the document corrected to be considered from the time of correction and for the future as filed *ab initio* in the corrected version. Correction under Rule 88 EPC does not reverse the effect of decisions already taken on the basis of the uncorrected document and does not re-open a procedural phase already terminated or a time limit already expired. In other words, a procedural loss of right only **indirectly** caused by the incorrect document will not be remedied by a later correction of the document pursuant to Rule 88 EPC. This principle also characterises the functional and essential difference between a correction under Rule 88 EPC on the one hand and *restitutio in integrum* pursuant to Article 122 EPC on the other hand.

11. In the case under consideration, the appellant lost its right to a European patent for the United Kingdom through failure to pay the designation fee by 12 January 1999 and not because it waived notification, in section 10.2 of Form 1200, under Rule 85a(1) EPC. According to Rule 104c(2) EPC the designation of GB was deemed to be withdrawn and the loss of this designation was final as from 13 January 1999 due to the expiration of the period (pursuant to Rule 85a(2) EPC). Thus, the claimed correction under Rule 88 EPC, if allowed, would not merely restore the appellant´s right to receive a Rule 85a(1) EPC communication but would additionally be directed to restore the appellant´s right for territorial protection for GB, otherwise such a communication issued after the final loss of right would be pointless.

The applicant's request for correction cannot result in

an effect equivalent to that of re-establishment of the time limit pursuant to Rule 85a EPC as this would be a clear circumvention of Article 122(5) EPC which applies in Euro-PCT proceedings to the time limits under Rule 104b(1)(b) and Rule 85a EPC as decided by the Enlarged Board of Appeal (G 5/93, OJ EPO 1994, 447). Rule 88 EPC cannot prevail over Article 122(5) EPC as follows from Article 164(2)EPC. The Appellant's counterargument that its request for correction of EPO Form 1200 only means that the appellant had not dispensed with the right to receive a Rule 85a(1) communication *ab initio* does not change the fact that the effect of issuing a Rule 85a(1) communication resulted in re-establishment of the right to pay a designation fee for GB within a **reopened** time limit.

Therefore, the Board concludes that the correction under Rule 88 EPC requested as main request is not allowable since it violates Article 122(5) EPC according to which re-establishment into periods for payment of designation fees is not allowable.

First auxiliary request

12. A question "involving an important point of law" does not need to be referred to the Enlarged Board of Appeal if the Board of Appeal hearing the case considers itself competent to answer the question with certainty by reference to the Convention (J 5/81, OJ 1982, 155). The Board has no doubt that with respect to the *ab initio* effect of a correction of a document under Rule 88 EPC, the reasons given above and in decision J 27/96 (supra) are in line with the previous case law of the Boards of Appeal. The conclusion of the Board that a request under Rule 88 EPC is not allowable if it is not

only aimed at removing the error but amounts to a request for *restitutio* with regard to a time limit excluded from re-establishment, lies within the discretion of the Board applying Rule 88 EPC in conjunction with Article 122(5) EPC.

Therefore, the request for referral a point of law to the Enlarged Board of Appeal is refused.

Second auxiliary request (restitutio in integrum)

13. Article 122(1) EPC states that *"The applicant for or proprietor of a European patent who in spite of all due care required by the circumstances having been taken, was unable to observe a time limit vis-à-vis the European Patent Office shall, upon application, have his rights re-established if the non-observance in question has the direct consequence, by virtue of this Convention, of causing the refusal of the European patent application, or of a request, or the deeming of the European patent application to have been withdrawn, or the revocation of the European patent, or the loss of any other right or means of redress"*

14. The appellant submitted that the "lost right" caused by failure to refer to GB at Section 10.1 of EPO Form 1200 was the right to be notified of a so-called Rule 85a(1) EPC communication and that this right could be exercised by the appellant within a time limit covered by Article 122(1) EPC namely within the 31 month period pursuant to Rule 104b(1)(b)(ii) as extended by Rule 85a(2) EPC.

16. Contrary to the appellant's submission, the Board holds

that the requirement of Article 122 EPC that the non-observance of a time limit vis-à-vis the EPO must have the direct consequence of causing the loss of a particular right is not fulfilled. The loss of the right to be notified by a Rule 85a(1) EPC communication was directly based on appellant's waiver filed with EPO Form 1200 and was therefore not a direct consequence of the expiration of the time limit pursuant to Rule 104b(1)(b)(ii) as extended by Rule 85a(2) EPC. Even if the Board considered the appellant's factual possibility to withdraw the said waiver as another right within the meaning of Article 122(1)EPC, then this right was not to be exercised vis-à-vis the EPO within a time limit. The time limit pursuant to Rule 104b(1)(b)(ii) as extended by Rule 85a(2) EPC referred only to the payment of the designation fee for GB and not to the possible withdrawal of the waiver in Form 1200.

In conclusion, the appellant's second auxiliary request is not allowable.

Order

For these reasons it is decided that:

1. The request for referral to the Enlarged Board of Appeal is refused.

2. The appeal is dismissed

The Registrar: The Chairman:

S. Fabiani J.-C. Saisset