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D E C I S I O N
of 6 June 2002

Case Number: J 0008/01 - 3.1.1

Application Number: 98967133.4

Publication Number: -

IPC: A61K 7/48

Language of the proceedings: EN

Title of invention:
Serine protease and topical retinoid compositions

Applicant:
Johnson & Johnson Consumer Companies, Inc.

Opponent:
-

Headword:
Correction/JOHNSON & JOHNSON

Relevant legal provisions:
EPC Art. 150(3), 153(1), 158
EPC R. 88
PCT Art. 2(xiii), 4(1), 11(3), 24(2), 26, 48(2)
PCT R: 4.9, 91.1

Keyword:
"International patent application - correction under Rule 88 EPC"
"Jurisdiction of the EPO as a (purported) designated office to decide on a request for correction"
"Balancing rights of third parties with those of the applicant"

Decisions cited:

J 0003/81, J 0014/82, J 0017/99

Headnote:

1. The jurisdiction of a (purported) designated Office according to Article 26 PCT covers the issue of whether an omitted designation can be validly added or not.

2. Publication of a correction concerning designations should address the same public as the publication of the wrong data to safeguard the interest of the public.

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: J 0008/01 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 6 June 2002

Appellant: Johnson & Johnson Consumer Companies, Inc.
Grandview Road
Skillman
New Jersey 08558 (US)

Representative: Fisher, Adrian John
CARPMAELS & RANSFORD
43, Bloomsbury Square
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Decision under appeal: **Decision of the Receiving Section of the European Patent Office dated 15 December 2000 refusing a request for correction of designation in international application Form.**

Composition of the Board:

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

Summary of Facts and Submissions

I. The appellant, Johnson & Johnson Consumer Companies, Inc., filed an international patent application PCT/US98/02618 with the USPTO as Receiving Office on 6 February 1998 claiming two US priorities of 12 February 1997 and 29 January 1998.

On page 3 of the Request Form (PCT/RO/101; July 1997 USPTO) as filed, the designation boxes for all national patents were marked but none for a regional patent.

II. Publication of the international application (WO 98/48775) took place on 5 November 1998 indicating all national states as marked in the application Form mentioned above and without any warning published under Rule 91.1(f) PCT.

III. By fax-letter of 15 October 1999 received by the European Patent Office on 18 October 1999, the appellant's European representative requested correction of the PCT Form filed with the USPTO to indicate designation of the European Patent Office in the international application and requested that the international application be treated as entering the regional phase in the European Patent Office under Chapter II PCT. In this letter, the representative submitted that the fact that none of the boxes for regional patents were marked with a cross was the result of a clerical error. A number of facts would indicate that applicant's clear intention was to designate the European Patent Office, namely:

(a) Almost every PCT application which was filed by Johnson & Johnson subsequently entered the

regional phase before the European Patent Office. It was inconceivable that the applicant in this case intended to designate countries such as St. Lucia and Lesotho, but not the European Patent Office.

(b) The European Patent Office was chosen by the applicant as the International Searching Authority and the International Preliminary Examining Authority.

(c) The applicant believed that the European Patent Office had been designated. As evidence of this, reference was made to a copy of a letter received by the European representative on 5 August 1999 stating that “the subject PCT application has been filed in the US Receiving Office with the European Patent Office named as a designated office".

On 20 October 1999 the appellant filed EPO Form 1200.1 (EPA/EPO/OEB, 04 99) for entry into the regional phase before the EPO indicating that designation fees were paid in respect of the Contracting States AT, CH/LI, DE, DK, ES, FI, PT and SE.

IV. By a decision of the Receiving Section dated 15 December 2000 both the request to process the international application in the regional phase before the EPO as elected Office and the request for correction of the PCT request by adding the missing designation EP were rejected.

In the reasons for the decision it was stated that in the absence of a proper designation in the

international application the EPO could not act as a designated or elected Office. In the present case, Article 26 PCT and Rule 88 EPC could not be applied to correct the fact that the “EP” box, by mistake, was not checked in the PCT request. Failure to have designated EP in the request was not a case for non-compliance with the PCT provisions and therefore the requirements of Article 26 PCT were not fulfilled. Moreover, no statement of facts had been filed by the applicant in respect of the circumstances under which the error occurred. Applicant’s letter received by the European representative on 5 August 1999 did not provide adequate evidence of the applicant’s true intention on filing. Furthermore, according to the established case law of the Boards of Appeal the correction of mistakes concerning the designation must be made sufficiently early to allow at least a warning to be included with the publication of the international publication and no special circumstances had been submitted indicating that the interest of the public was safeguarded if the correction had been allowed after the publication.

V. The applicant appealed by fax-letter received on 21 February 2001 against this decision, requesting that the decision be set aside and that the application proceed as requested by letter of 15 October 1999 (cf. point III supra). The appeal fee was paid by debiting the deposit account of the representative on the same date.

In the grounds of appeal the appellant submitted that Article 26 PCT and Rule 88 EPC were applicable and pointed out that the EPO had jurisdiction to decide on the request for correction since, if the error was corrected, the request Form would be deemed to have

included the European Patent Office as a designated office *ex tunc*.

Together with the grounds of appeal the appellant filed a copy of a declaration of appellant's patent attorney and a so-called affidavit of her secretary both dealing with the circumstances of filing the international application to provide evidence of their intention to designate EP as a regional patent in the international application. The appellant contested that the burden of proof in an application for correction of an error under Rule 88 EPC was a “heavy one” and claimed that the standard of proof in the present case, as in any civil proceedings, was the “balance of probabilities”.

VI. In reply to the Board’s communication dated 18 December 2002 the appellant submitted that the national designations in the published international application warned the public that patent protection of some sort might be obtained in the designated territories and that third parties were not in any way disadvantaged if such protection was finally obtained through the European Patent Office, rather than through the national Patent Offices.

VII. At the oral proceedings held on 6 June 2002 the appellant reiterated the arguments presented in writing and additionally referred to the Legal Board decision J 14/82 stressing that the jurisprudence had developed to balance the rights of the applicant against the rights of third parties. The balance had to be weighted similar to the principles laid down in Article 69 EPC according to which the interpretation shall combine an appropriate protection for the applicant with sufficient certainty for third parties. In the present

case the risk for third parties was very small compared with appellant's interest for protection since the national applications published under PCT had the same effect for third parties as the designations now requested by correction. The scope of protection under the different patent laws was substantially the same and the remaining differences were so small that no third party could rely on these. Any practitioner interested in the field of the invention would check the EPO-register and would be informed if the correction requested was granted.

VIII. At the end of the oral proceedings the appellant requested that the decision under appeal be set aside and that the application be proceeded with as requested in appellant's letter of 15 October 1999.

Reasons for the Decision

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

2.1 Article 4(1)(ii), second sentence PCT requires an applicant who wishes to obtain a regional (in this case European) patent to indicate so in the request. To facilitate compliance with this requirement, the PCT Request Form - Box No. V - contains a separate check-box to be marked in such cases. By marking the EP check-box, the applicant empowers the EPO to act as a designated Office under the PCT (Article 2(xiii) PCT in conjunction with Article 153(1), first sentence EPC). In the present case the applicant omitted -as purported- erroneously to mark the EP check-box. The Receiving Section concluded that in the absence of a

proper EP designation in the international application the EPO could not act as a designated or elected Office with regard to applicant's request for correction of the international application Form. Furthermore, the Receiving Section denied in the present case the applicability of Article 26 PCT since the EPO was not a designated Office and had not issued any decision to reject the international application.

2.2 In cases in which such correction of a Form of an international application filed with the Receiving Office is requested, the competence of the Receiving Office according to Rule 91.1(e)(i) PCT does not exclude the application of Article 26 PCT allowing correction under regional law in proceedings before the EPO after entry of the application into the regional phase. The jurisdiction of a (purported) designated Office according to Article 26 PCT covers the issue of whether an omitted designation can be validly added or not since the examination of the validity of the designation is one of the requirements both of the PCT (Article 4(1)(ii) PCT) and of the EPC (Art. 153 EPC). The EPO has to decide on the addition of a designation by correction in the same way as on the same requirement under the EPC since a correction would have a legal effect *ab initio* from the filing date. This non-discriminating approach is a fundamental principle of the PCT (see e.g. Articles 26 and 48(2)(a)PCT) and a direct consequence of Article 150(3) EPC considering the international application as a European one.

2.3 International application Form PCT/RO/101 contains a pre-printed text at the bottom of Box No. 5 for designation of States constituting a so-called precautionary designation of all States which could be

designated under the PCT. Therefore in the present case, a precautionary designation for obtaining a European Patent was made on the basis of the pre-printed text. Decision J 17/99 (not published in the OJ EPO) points out that even if -as in the present case- no confirmation through payment of the prescribed fee for this precautionary designation was made within the 15 months time limit under Rule 4.9(b)(ii) PCT the EPO kept its function as a designated office which was authorised by Article 24(2) PCT to maintain the effects granted under Article 11(3) PCT.

2.4 Therefore, contrary to the Receiving Section, the Board finds that in the present case the EPO has jurisdiction to decide on the request for correction of the international application Form under Rule 88 EPC.

3.1 If a mistake is made in designating States in a European or international application the jurisprudence of the Boards of Appeal under certain conditions allows the addition of a designation by means of correction under Rule 88, first sentence EPC.

On the basis of the evidence provided by the appellant, the Board is fully convinced that the omission to mark the check-box for a European Patent was a mistake and did not correspond to applicant´s true intention.

3.2 However in accordance with the established jurisprudence of the Boards of appeal, the correction of mistakes concerning a designation must be made sufficiently early to allow at least a warning to be included with the publication of the European application (Article 93 EPC). This requirement is in accordance with the wording of Rule 88 EPC indicating

that a correction *may* be allowed and was introduced in order to safeguard the interests of third parties relying on information officially published.

According to Article 158(1) EPC, publication under Article 21 of the Cooperation Treaty of an international application in an official language of the European Patent Office - i.e. English as in the present case- for which the European Patent Office is a designated Office takes the place of the publication of a European patent application and is to be mentioned in the European Patent Bulletin. In the present case the international application, to be treated as European patent application according to Article 150(3) EPC for the purpose of making a decision on the request for correction, was published as the international publication (WO 98/48775) on 5 November 1998 without any warning of possible correction. Where an international application filed under the PCT is deemed to be a European patent application (Article 150(3) EPC), the jurisprudence referred to above applies *mutatis mutandis*, even though publication of the international application by the international Bureau necessarily precedes the time at which the applicant can request the EPO to correct any mistake in the application(cf. J 3/81, OJ EPO 1982, 100). Therefore the request for correction of designation filed on 15 October 1999 was made nearly one year after the international publication.

3.3 Referring *inter alia* to decision J 14/82 (OJ EPO EPO 1983, 121) of the Legal Board the appellant argued that the Boards of Appeal allowed correction under Rule 88 EPC under special circumstances even after the publication of the application, in particular, if the

interest of the public is not seriously affected because the mistake was so obvious that the public was also aware of it. The Board had to balance the interests of the appellant and possible third parties probably concerned. Furthermore, in the present case, no such public interest issue arose simply because the published PCT application indicated that all of the Contracting States of the EPC, which should be designated in the present application (namely Austria, Switzerland, Germany, Denmark, Spain, Finland, Portugal and Sweden), had originally been designated, albeit as national applications. The general public had therefore been warned that protection was sought in any or all of these countries. The fact that such protection was obtained through the European Patent Office, rather than through the national patent offices, did not disadvantage the public in any way.

3.4 The Board holds that the latter argument is not convincing since it does not take into consideration that the warning needs not only to have effect on the date of its publication but also during the whole period between its publication and the decision on the request for correction. The EPO has no competence and factual means to examine the status of national patent applications in order to assess whether and how long the warning by the publication of the international application had effect. In the meantime a third party could have been informed by file inspection at any national patent office that the corresponding national patent application had been withdrawn or lost its validity due to non-compliance with requirements under the national law and could rely on this information. Such a party clearly would be taken by surprise if the Board now allowed the requested correction.

Moreover, even if the requested correction had been published in the European Patent Bulletin, there is no certainty whether and when third parties interested in the status of the international patent application would take note of such information since they could expect that any correction would be published in the same way as the wrong data (i.e. under PCT or the national patent laws and not under EPC). Thus, the fact that the EPO has no means to publish a correction under PCT also adversely affects the interests of third parties if the requested correction were to be allowed.

3.5 The appellant submitted that the requested correction concerned applicant's interest in easier management of patent proceedings before the EPO instead of before several national patent offices and in saving the costs for these proceedings.

Having in mind its observations made above under 3.2 and 3.4, the Board finds that the interest of the public in being correctly informed by official publications prevails over appellant's interest referred to above. The appellant's disadvantages are limited and of tolerable magnitude without endangering the exploitation of the invention whereas, on the other hand, the Board is not in a position to assess the economic risks for third parties with regard to the uncertainty of the facts of this case. The mere possibility that the public reading the international publication could conclude that it was odd that the applicant designated Lesotho but not EP, has no weight, since it did not appear on the face of the publication what was wrong and the applicant might well have had special reasons to do so. Therefore, the Board concludes that the circumstances of the present case

are not appropriate to deviate from its jurisprudence according to which a correction of designation of States is not allowable after the publication of the application unless a warning to third parties has been included.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

S.Fabiani J.-C. Sassiet