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**D E C I S I O N**  
**of 13 February 2003**

**Case Number:** J 0025/01 - 3.1.1

**Application Number:** 95904370.4

**Publication Number:** 0733113

**IPC:** C12N 15/56

**Language of the proceedings:** EN

**Title of invention:**  
Influenza Vaccine

**Applicant:**  
Vlaams Interuniversitair Instituut voor Biotechnologie, et al

**Opponent:**

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**Headword:**

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**Relevant legal provisions:**

EPC Art. 122(1,5)  
EPC R. 85a(1,2), 104b(1), 104c(2), 88 first sentence  
RRF Art. 7(2)  
PCT Art. 39(1)(a,b)

**Keyword:**

"Euro-PCT application"  
"Correction of designation"  
"Non payment of designation fees within the time limit"

**Decisions cited:**

G 0003/91, J 0021/84, T 0152/85, J 0027/96, J 0003/01

**Catchword:**

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Case Number: J 0025/01 - 3.1.1

**D E C I S I O N**  
of the Technical Board of Appeal 3.1.1  
of 13 February 2003

**Appellant:** Vlaams Interuniversitair Instituut voor  
Biotechnologie  
Rijvisschestraat 120  
BE-9052 Zwijnaarde (BE)

**Representative:** De Clercq, Ann  
De Clercq, Brants & Partners cv.  
Edgard Gevaertdreef 10a  
BE-9830 Sint-Martens-Latem (BE)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office dated 8 May 2001 refusing  
a request for correction under Rule 88 EPC.

**Composition of the Board:**

**Chairman:** J.-C. Saisset  
**Members:** U. J. Tronser  
S. U. Hoffmann

## Summary of Facts and Submissions

I. Euro-PCT patent application No. PCT/BE 95/00002 was filed on 6 January 1995 by the applicant's predecessor, the Rijksuniversiteit Gent, claiming two priorities of 11 and 24 January 1994. In the PCT-application form, among other designation boxes for national patents, the designation box for a regional patent EP was crossed.

International publication took place on 13 July 1995, with regard to the EP- designation mentioning all the then member states according to the so-called precautionary designation provided for in the designation box for the regional patent EP.

II. In a letter received by the EPO on 11 July 1996 the appellant requested entry into the regional phase before the EPO as elected office. On using EPO Form 1200.4 07.94 for this request, in section 10.1 check-boxes were only marked for Greece, Luxembourg, Monaco and Portugal, stating that designation fees were paid in respect of these EPC-Contracting States. According to the pre-printed form box 10.2 was ticked thus indicating that at present it was not intended to pay designation fees for the EPC Contracting States not marked in section 10.1 but designated in the international application and in respect of these designation fees with waiver clause for a communication under Rule 85a(1) EPC and furthermore for a communication under Rule 69(1) EPC after the time limit under Rule 85a(2) EPC had expired. Designation fees for four states were simultaneously paid. The mention of the international publication was published on 25 September 1996 indicating that designations for the EPC-Contracting states Greece, Luxembourg, Monaco and

Portugal were valid.

III. In a letter dated and received on 25 March 1998 the applicant's representatives requested correction under Rule 88 EPC of the erroneous designation of Greece, Luxembourg, Monaco and Portugal instead of Austria, Belgium, Switzerland and Liechtenstein, Germany, Denmark, Spain, France, United Kingdom, Ireland, Italy, Netherlands and Sweden, the EPC-Contracting States the applicant really intended to designate. As evidence copy of a fax from Vlaams Interuniversitair Instituut voor Biotechnologie, legal successor to the applicant, was filed with the instruction to designate EP with the exception of Monaco, Luxembourg, Portugal and Greece. It was explained that the secretary misinterpreted the said instruction when filling in the form and that "although designations are routinely checked by the representative upon signing the form, in this particular case the error was unaccountably not observed". Simultaneously was paid the amount of DEM 4.200 for "additional designation fees"

IV. The EPO rejected the request for correction of the designated States in the contested decision of 8 May 2001. The reasons for the decision can be summarised as follows:

- Although there was no doubt that a mistake in indicating the wrong EP-designation states had occurred, the request for correction under Rule 88 EPC could not be allowed, because the applicant had not asked for correction in due time.
  
- According to the case law of the Boards of Appeal the request for correction under Rule 88 EPC must

be made early enough for a warning to be included in the publication of the application. This time limitation was necessary to safeguard the interests of the public in being able to rely on the correctness of the published data, in particular with regard to the (maximum) territorial scope of protection.

- The applicant's request that alternatively two points of law be referred to the Enlarged Board of Appeal by the President of the EPO was also rejected, since the President may only make a referral where two boards of appeal make different decisions in respect of the same question and a board of appeal may only make a referral when it considers that a decision is required on a question in a pending case. The requirements were not met for either of these alternatives.

V. On 6 July 2001 the applicant lodged an appeal against this decision and paid the appeal fee at the same time.

With the grounds of appeal filed on 13 September 2001 the appellant submitted that

- the EPO failed to correctly interpret the case law on which it based its refusal of the request for correction. Because the actually designated contracting states are four of the five states least likely to be designated in any patent application, it was obvious for every experienced competitor that a mistake in designation had occurred. So the public interest in maintaining legal security had been safeguarded in this case.

- Furthermore the limitation in time of the possibility for a correction under Rule 88 EPC is discriminatory against Euro-PCT applicants and therefore contrary to the provisions of Article 50(3) EPC and Article 11(4) PCT. As the established case law in principle requires a correction under Rule 88 EPC to be requested before publication of the application, and as mistakes in designations in respect of an Euro-PCT application can only be made after publication of the application, Euro-PCT applicants are deprived of a possibility to have erroneous designations corrected. On the other hand, this possibility was available to direct European applicants under the old system of designation being in force before the 1 July 1997.

VI. In reply to the Board's communication dated 17 May 2002 the appellant submitted that:

In EPO Form 1200 filed on 11 July 1996 an error in the designation of EPC-Contracting states had occurred, which could be corrected under Rule 88 EPC. Such a correction had retroactive effect, so that the procedure was restored to the state in which it would have been had the mistake not been made. Therefore, the payment of DEM 4.200 made when filing the request for correction should also be deemed to have been made at the date of filing the original Form 1200, i.e. well before expiry of the time limit of Rule 104(1)(b)(ii) EPC.

With reference to Article 122 EPC, as mentioned in the Board's Communication, it should be noted that the exclusion in this paragraph 5 had been abolished in the

new wording of Article 122 EPC as drawn up at the Diplomatic Conference of 20 to 29 November 2000 and adopted by the Administrative Council on 28 June 2002.

Furthermore the EPO was partly responsible for the fact that no warning was published before the publication, because the way in which EPO Form 1200 is worded, does not allow an applicant any possibility of detecting a mistake in the designations before publication. By designating contracting states in section 10.1 of Form 1200 the pre-checked section 10.2 of the same form forces the applicant to surrender his right to a Communication under Rule 85a(1) EPC, which would constitute the only opportunity to check whether the designations as filed were correct or not.

On the other hand the international publication mentioned all EPC Contracting states and after correction as requested the application will actually cover only twelve of these sixteen states, so that the public will not be faced with any unforeseen designations.

VII. Oral proceedings took place on 13 February 2003.

In addition to their written submissions the Appellant's representatives observed that the case law of the Boards of Appeal developed more and more in the direction of striking a balance between the applicant's interests and the interests of the public. These requirements for a correction under Rule 88 EPC were clearly met in the present case.

Furthermore, if a retroactive correction under Rule 88 EPC of EPO Form 1200 dated 10 July 1996 were allowed,



in section 10.1 designation fee boxes would then be deemed ticked for the twelve EPC-Contracting states the appellant really intended to indicate although designation fees were paid only for four Contracting States. As a consequence the EPO would need to issue a communication under Rule 85a(1) EPC to point out the failure to observe the time limit for payment of 8 out of 12 designation fees and to invite the applicant to pay these 8 fees, or at least that the EPO would need to send out a communication under Article 7(2) Rules Relating to Fees to require the applicant to indicate for which 4 of the designated states the payment was made for, or that the amount of 4 designation fees was to be applied to the four designations appearing first on the corrected form showing the 12 designations the appellant really wanted to indicate.

VIII. The appellant requested:

Main request

The decision under appeal be set aside and the request for correction under Rule 88 EPC be allowed on the basis that a mistake exists because the designations ticked on Form 1200 do not reflect the true intention of the person on whose behalf it was filed and that the application be remitted to the Receiving Section with the order to send out a Communication under Rule 85a(1) EPC to point out the failure to observe the time limit for payment of 8 out of 12 designation fees and to invite the applicant to pay these 8 fees.

First auxiliary request

The decision under appeal be set aside and the request

for correction under Rule 88 EPC be allowed on the basis that a mistake exists because the designations ticked on Form 1200 do not reflect the true intention of the person on whose behalf it was filed and that the application be remitted to the Receiving Section with the order to send out a Communication under Article 7(2) RRF to require the applicant to indicate for which 4 of the 12 designated countries the payment was made.

Second auxiliary request

The decision under appeal be set aside and the request for correction under Rule 88 EPC be allowed on the basis that a mistake exists because the designations ticked on Form 1200 do not reflect the true intention of the person on whose behalf it was filed and to apply the amount of 4 designation fees to the four designations appearing first on the corrected form showing the 12 designations for AT, BE, CH/LI, DE, DK, ES, FR, GB, IE, IT, NL and SE.

Third auxiliary request

The following point of law be referred to the Enlarged Board of Appeal:

"Is a limitation in time on the possibility of correction under Rule 88 EPC, which allowed direct European applicants - under the old version of Art. 79 (2) EPC - a possibility of correction that was not available to Euro-PCT applicants, allowable in view of Art. 150 (3) EPC in combination with Art. 11 (4) PCT ?"

and that a decision on the request for correction be deferred until the Enlarged Board of Appeal has decided.

#### Fourth auxiliary request

The following point of law be referred to the Enlarged Board of Appeal:

"1. May the EPO as a general rule force an applicant for a European patent, through use of a form as prescribed by Rule 26 (1) EPC, to relinquish a right provided for in the EPC to receive a notification pointing out a failure to observe a time limit ?

2. If the answer to question 1 is in the affirmative, may the EPO force an applicant to relinquish this right if the time limit in question is excluded from the possibility of re-establishment under Art. 122 EPC ?

3. If the answer to question 1 is negative, may the failure to provide such notification be invoked by an applicant wishing to redress a loss of rights resulting from the failure to observe the time limit?"

and that a decision on the request for correction be deferred until the Enlarged Board of Appeal has decided.

#### Fifth auxiliary request

The following point of law be referred to the Enlarged Board of Appeal:

"1. In view of the "ab initio" effect of corrections

made under Rule 88 EPC, are the time limits under Rule 85a EPC applicable to a request for correction of designations under Rule 88 EPC when allowance of such correction would result in a greater number of designations than that for which designation fees have been paid ?

2. If the answer to question 1 is in the affirmative can designation fees already paid for the incorrectly designated contracting states be reassigned to the correct designations ?

3. If the answer to question 2 is in the affirmative, should Article 7 (2) RRF or Article 9 (2) RRF apply ?"

and that a decision on the request for correction be deferred until the Enlarged Board of Appeal has decided.

### **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*

2. It is the purpose of the main request to change the territorial scope of protection from Greece, Luxembourg, Monaco and Portugal, which the Euro-PCT application presently encompasses, into Austria, Belgium, Switzerland and Liechtenstein, Germany, Denmark, Spain, France, United Kingdom, Ireland, Italy, Netherlands and Sweden, the EPC Contracting states the appellant really intended to designate.

As the Board has already pointed out in its communication dated 17 May 2002, 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 with respect to the Euro-PCT application under consideration on 11 August 1996. Designation fees were paid on 11 July 1996 for the four EPC Contracting states Greece, Luxembourg, Monaco and Portugal. The period for validly paying additional designation fees under Rule 85a(2) EPC expired on 11 October 1996 without any further contracting state having been designated through payment of designation fees. According to Rule 104c(2) EPC in the then valid version this has the consequence that the other EPC Contracting states indicated with the so-called precautionary designation provided for in the PCT application form, i.e. Austria, Belgium, Switzerland and Liechtenstein, Germany, Denmark, Spain, France, United Kingdom, Ireland, Italy, Netherlands and Sweden were deemed to be withdrawn since the designation fees for these EPC Contracting states had not been paid in due time.

The payment of designation fees for 12 contracting states with surcharge carried out on 25 March 1998 together with the request for correction under Rule 88 EPC could not reverse the legal effect of Rule 104c(2) EPC. Therefore, the loss of rights for designations after expiration of the time limit under Rule 104b(1)b EPC in connection with Rule 85a(2) is not based on the failure to indicate designations but on the failure to pay the designation fees for these states in due time. The latter cannot be remedied by a correction under Rule 88 EPC.

3. The appellant argues that a correction under Rule 88 EPC of the indications in section 10.1 of EPO Form 1200 filed upon entry into the regional phase before the EPO on 11 July 1996 would lead to the indication of the twelve EPC Contracting states he really intended to designate. With regard to the acknowledged retroactive effect of such a correction under Rule 88 EPC this would have the consequence that the EPO has to issue a communication under Rule 85a(1) EPC since designation fees were paid only for four contracting states (this situation not falling within the effect of the waiver clause in section 10.2 of the EPO Form 1200) thus triggering the one month time limit for payment of eight additional designation fees.

4. Rule 88 EPC concerns the correction of errors in documents filed with the EPO. According to the first sentence a correction is restricted to linguistic errors, errors of transcription and mistakes in any documents filed with the EPO. Therefore a correction under Rule 88 EPC is an instrument available only to rectify misleading information caused by such an error in documents. But such a correction cannot have any effect on the procedural situation that has already ensued in direct or indirect consequence of a written error. To cancel procedural effects which have already occurred would be to apply Rule 88 EPC beyond its clear and unambiguous wording.

5. This conclusion is confirmed by Article 122(5) EPC.

Article 122 EPC provides for a re-establishment of rights where the applicant or proprietor of a European patent was unable to observe a time limit vis-à-vis the EPO and in consequence a loss of rights occurred. If

the requirements of this provision are met - other than by a correction under Rule 88 EPC - the procedural effect is cancelled, and the former procedural situation reinstated, that is the applicant's rights are re-established. Thus such a request for restitutio in integrum is the appropriate instrument for - certain - procedural situations to be rectified. But according to Article 122(5) EPC the provisions of this Article are not to be applicable to the time limits referred to in Article 79, Rule 85a and Rule 104b(1)(b) EPC (see G 3/ 91 OJ EPO 1999, 8). Thus the instrument of restitutio in integrum is not available to remedy a loss of rights that has occurred as a consequence of an applicant's not having observed the time limits for payment of designation fees.

As the appellant has correctly submitted, Article 122(5) EPC was deleted by the Diplomatic Conference 20 - 29 November 2000 (see Special Edition 4 of OJ EPO 2001, page 33). But this amendment had not yet entered into force. Thus according to Article 8(2) EPC amended version (see Special edition 4 OJ EPO 2001, page 50) the valid text of the EPC is the unamended one.

6. The conclusion that the so-called retroactive effect of a correction under Rule 88 EPC does not set aside the previous procedural effects, but only causes the document corrected to be considered from the time of correction and for future as filed ab initio in the corrected version is already stated in the Board's decision J 03/01 (see particularly point 10 of the reasons for the decision), which was sent to the appellant as an annex to the summons to the oral proceedings dated 2 October 2002. Furthermore in

decision J 27/96 (which is cited in decision J 03/01) the Board stated that a correction by the 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 a correction of a mistake is an isolated procedural measure and not a case of re-establishment into a defined procedural phase as a whole. The same conclusion was reached by the Legal Board in its decision J 21/84 (OJ EPO 1986, 75; see also T 152/85 OJ EPO 1987, 191).

7. Remitting the application to the department of the first instance with the order to send out a communication under Rule 85a(1) EPC and to invite the applicant to pay eight additional designation fees, as intended by the main request, would restore the application to the procedural situation it enjoyed upon entry into the regional phase before the EPO, thus not only cancelling the procedural fact of the payment for the four contracting states Greece, Luxembourg, Monaco and Portugal, that took place on 11 July 1996 but also cancelling the legal effect prescribed by Rule 104c(2) EPC (in the then valid version).
  
8. The question whether or not the application under consideration meets the requirements developed by the jurisdiction of the Boards of Appeal with respect to an allowable correction under Rule 88 EPC safeguarding the interests of the public is not decisive for the case under consideration.

As the Board has already stressed above (see points 4



and 5), a correction of the misleading information in section 10.1 of the EPO Form 1200 filed on 11 July 1996, that the appellant intended to pay designation fees for the contracting states Greece, Luxembourg, Monaco and Portugal would not cancel the legal effect determined by Rule 104c(2) EPC (in the then valid version) that occurred after expiry of the 33 month time limit on 11 October 1996. Therefore the instrument of correction under Rule 88 EPC is not applicable at all in the present case.

In this context it should be emphasized that after the introduction of the so-called precautionary designation under the PCT and the amendment of Rule 85 a EPC in 1989 the designation system depends not only on the respective indications that have been made in a Euro-PCT application but also on the observation of the time limits referred to in Rule 104b(1)(b)(ii) (the then valid version), Article 79(2) and Rule 85a EPC.

9. The amended designation system imposes an obligation on the applicant not only to fill in the application form correctly but also to check the time limit provided for supplementary payment of designation fees with surcharge. If the appellant's representatives had checked this time limit on the basis of their application file, they would have detected the fax from Vlaams Interuniversitair Instituut voor Biotechnologie with the correct instruction for designation and thus had the possibility to correct their error by supplementary payment of designation fees in due time.

Therefore it was not the use of EPO Form 1200 with a pre-printed waiver clause in section 10.2 that caused the loss of rights to a European patent for the

contracting states the appellant really intended to designate.

10. In this context it is to be pointed out that an Euro-PCT applicant is not compelled to use EPO Form 1200 upon entry into the regional phase before the EPO as it is clear from Rule 49.4 PCT and as was mentioned in the letter of the Receiving Section dated 18 August 1995 addressed to the appellant's representatives (see supplement 1 to OJ EPO 12/1992 Introduction A, 2).

Therefore the main request for correction under Rule 88 EPC is not allowable since it is aimed not merely at correcting an error in the documents but also at reversing a procedural effect that has already taken place and at cancelling a legal effect prescribed by Rule 104c(2) EPC.

*First auxiliary request*

11. From the observations above (see points 4, 5 and 7) it follows that the correction under Rule 88 EPC as requested with the first auxiliary request cannot effect the procedural situation already occurred when the appellant paid four designation fees with the indication that the payment was in respect of the contracting states Greece, Luxembourg, Monaco and Portugal. Thus the requirement of Article 7(2) RRF that the purpose of the payment cannot immediately be established was not fulfilled at the time the payment of designation fees was received by the EPO. Correction under Rule 88 EPC does not reinstate the procedural phase at which the original payment was received by the EPO and therefore, no communication under Article 7(2) RRF could be required by the appellant's request for

correction of designations. Additionally the Board states that indicating four out of the twelve Contracting states the appellant really intended to designate would not correct the error that really occurred when completing section 10.1 in EPO Form 1200 dated 10 July 1996.

Therefore the first auxiliary request is also not allowable.

*Second auxiliary request*

12. The same reasons as set out under point 11 apply to the second auxiliary request which is therefore also not allowable.

*Third auxiliary request*

13. The question submitted by the appellant to be referred to the Enlarged Board of Appeal is not relevant to the case under consideration because it is aimed at the requirements for a time limit for a correction under Rule 88 EPC developed by the jurisdiction of the Boards of Appeal. But this jurisdiction is not decisive for this case because, as set out above under point 8, the failure to pay the designation fees required in due time cannot be corrected on the basis of and in conjunction with the correction of an error according to Rule 8 first sentence EPC (cf. J 21/84 supra).

*Fourth auxiliary request*

14. As set out above under point 10, referring to Rule 49.4 PCT and supplement 1 to OJ EPO 12/1992, a Euro-PCT applicant is by no means legally obliged to use EPO Form 1200 upon entry into the regional phase before the EPO. Therefore the question submitted by the appellant to be referred to the Enlarged Board of Appeal with its fourth auxiliary request is also not relevant to the case under consideration.

*Fifth auxiliary request*

15. The question submitted by the appellant with its fifth auxiliary request and intended to be referred to the Enlarged Board of Appeal is as irrelevant to the case under consideration as the question submitted with its third auxiliary request. The core of these questions is aimed at the question of whether or not the "ab initio effect" of a correction under Rule 88, first sentence EPC has the additional effect of re-establishment of the right to pay designation fees after the time limit set by Rule 104b(1)(b) EPC, which is, according to the consistent case law (J 21/ 84; J 27/96; J 03/01 supra), to be denied. As there is no jurisdiction to the contrary the requirements under Article 112(a) EPC are not fulfilled and the Board considers that a decision of the Enlarged Board of Appeal is not required.

**Order**

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

1. The requests to refer questions to the Enlarged Board of Appeal are refused.
2. The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

J.-C. Saisset