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D E C I S I O N
of 13 May 2004

Case Number: J 0006/02 - 3.1.1

Application Number: 99911419.2

Publication Number: 1063915

IPC: A61B 1/12

Language of the proceedings: EN

Title of invention:
Anchoring and positioning device and method for an endoscope

Applicant:
Boston Scientific Corporation

Opponent:
-

Headword:
Correction of error/BOSTON SCIENTIFIC CORPORATION

Relevant legal provisions:
EPC Art. 79(2), 93(1), 122, 150(3)
EPC R. 85a(2), 88, 107(1), 108(2)
PCT Art. 39(1)

Keyword:
"Correction of designation of a country"
"Procedural effects"

Decisions cited:
J 0021/84, J 0007/90, J 0006/91, J 0027/96, J 0016/00, J 0025/01, T 0152/85

Catchword:
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Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: J 0006/02 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 13 May 2004

Appellant: Boston Scientific Corporation
One Boston Scientific Place
Natick
Massachusetts 01760 (US)

Representative: Davies, Gregory Mark
Urquhart-Dykes & Lord
Alexandra House
1 Alexandra Road
Swansea
Wales SA1 5ED (GB)

Decision under appeal: **Decision of the Examining Division posted 4 March 2001 refusing a correction under Rule 88 EPC concerning application No. 99 911 419.2 (EUROPCT).**

Composition of the Board:

Chairman: J. Saisset
Members: H. Preglau
S. U. Hoffmann

Summary of Facts and Submissions

I. International application No. PCT/US99/05685 was filed on 17 March 1999 claiming priority from an earlier US application dated 20 March 1998.

II. International publication took place on 17 March 1999, 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.

III. In a letter received by the EPO on 25 September 2000 the appellant requested entry into the regional phase before the EPO as elected office. On using EPO Form 1200 (12.96) for this request, in section 10.1 check-boxes were only marked for BE,DE, FI, GB, IE and NL 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 six states were simultaneously paid.

IV. The bibliographic data of the above mentioned international publication was mentioned in the European Patent Bulletin of 3 January 2001 (publication number

EP 1063915) together with the indication that the States BE,DE, FI, GB, IE and NL were designated.

V. With letter dated 5 January 2001 and faxed the same day the applicant's representative explained that France rather than Finland should have been designated and submitted a further designation fee together with the surcharge. As an alternative request he asked for a correction of error, namely to change the designation Finland into France.

VI. By communication of 24 January 01 the Receiving Section informed the representative that due to the elapse of the time limit under Rule 85a(2) EPC no additional state could be designated nor could the designation of Finland be changed into a designation of France.

VII. In a further letter dated and faxed 28 February 2001 the representative reiterated his request for correction of an error. He argued that the request was already presented two days after publication. If the request would have been accepted there would have been only two days of misinformation of the public. In any case the public would be much more likely to consult other means of information from the European Patent Office than the European Patent Bulletin. A formal decision was requested as well as an amendment of the European Patent Office's database to show that designation of France had been requested but was disputed.

VIII. In order to prove that the designation of Finland was erroneously made the instructing correspondence of the US-attorneys of the applicant was submitted.

IX. The Examining Division issued a decision rejecting the request for correction of an error. It accepted that Finland was designated erroneously instead of France but because of the already published application no correction was allowable. Reference was made to the decisions J 7/90 (OJ EPO 1993,133) and also to J 6/91 (OJ EPO 1994,349) both decisions underlining the necessity of a time limitation when applying Rule 88, first sentence EPC.

X. Against this decision an appeal was lodged on 30 October 2001. The appeal fee was received on 6 November 2001 and the statement of grounds on 11 January 2002.

XI. The following requests were made:

- correction of the designation of Finland to designation of France (main request)

- referral to the Enlarged Board of Appeal (auxiliary request)

- oral proceedings.

XII. The arguments of the appellant can be summarised as follows:

The representative received the instructions from the applicant to designate the countries Belgium, France, Germany, Ireland, Netherlands and United Kingdom when initiating the regional phase. Erroneously the check-box for Finland instead for France was crossed in the

EPO-form 1200. This error therefore appeared in the publication of the bibliographic data in the European Patent Bulletin on 3 January 2001. The firm of the US instructing attorneys noticed the error and requested correction of the error. Already on 5 January 2001 a request for correction of an error under Rule 88 EPC was sent to the Office.

Originally (in the PCT publication) all European countries were shown as designated. Third parties who were interested in the exact territorial coverage of an application later on would get their information no longer from the European Patent Bulletin but much more likely from other sources such as internet and on-line versions of the European Patent Office register extracts or even the public file of the application.

The jurisprudence, developed in the 1980's, was appropriate to the information sources of that time but now the development of other available information means should be considered.

If the request for correction of the error had been acted already immediately after receipt of the representative's letter, the European Patent Register would have reflected the intended situation (designation of France instead of Finland) two days after the publication of the wrong designation in the European Patent Bulletin. The damage to the public interest would have been minimal.

When considering correction of errors the special circumstances of a particular case needed to be taken into account. The application in suit is rather

sophisticated and so are the competitors. When detecting that France was not among the designated countries they would have immediately started further investigations and would have found out quickly that an error had occurred.

As to the referral to the Enlarged Board of Appeal the appellant argued that the question be referred concerned whether, in view of technological developments and the readily accessible data sources now made available by the European Patent Office, the time limit of the publication date being a cut-off time limit for correction of designations was still justifiable in all circumstances.

XIII. In the course of the oral proceedings the appellant repeated his arguments already on file and handed over to the Board the copy of an information of the EPO available on the internet, entitled "Time Schedule for the Payment of Designation Fees and related Publications", explaining a new publication practice of the Office. Information on the payment during the grace terms would be reported in the European Patent Register (within 3 to 4 weeks) and in the printed European Patent Bulletin 7 weeks after the fee control. This information ends up with the statement, that it might take up to one year and more following the Search Report Publication before the information on the payment of designation fees was final.

Reasons for the Decision

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

Main request (correction of an error)

2. The 31-month period for entry into the regional phase before the EPO as elected office (Article 39(1) PCT in conjunction with the then valid Rule 107(1) EPC ended with respect to the Euro-PCT application under consideration on 20 October 2000 and the period for validly paying additional designation fees under Rule 85a(2) EPC expired on 20 December 2000. Therefore, the payment of the designation fee for France together with a surcharge on 5 January 2001 was belated and could not reverse the legal fact that the application was deemed to be withdrawn in respect of the Contracting State France according to Rule 108(2) EPC.

In order to remedy this legal situation, the main request is directed to a correction of the designation of Finland to France on the basis of Rule 88, first sentence EPC.

Rule 88, first sentence EPC deals with the correction of errors which occurred in documents other than descriptions, claims or drawings filed with the Office. According to the EPO jurisprudence Rule 88 EPC also applies to correction of a request for designation of a State if it was clear indication that the mistake was based on an error and a corresponding request was promptly made (cf. J 4/80). Correction under Rule 88 EPC, if allowed, would have a retroactive effect with

the consequence that the document containing the error has to be regarded as if it was filed in the corrected form.

3. In the present case it was admitted by the first instance that under certain conditions the correction of a designation of countries is possible and that the indication of Finland instead of France among the designated countries was made erroneously and did not reflect the true intention of the applicant. However, the first instance did not consider that when the appellant filed the request for entry into the regional phase before the EPO the designation of all EPO-Contracting States according to the international application was still valid (Article 150(3)EPC). The ticking of the check boxes for BE,DE, FI, GB, IE and NL in section 10.1 of the Form 1200 was not a designation of States but only an indication of the intention to pay designation fees for these States, not excluding a change of appellant's mind or payment of additional designation fees for other countries according to the designation of all EPC-Contracting States in the international application. However, this statement had the legal effect that the six designation fees paid by the appellant on 29 September 2000 were dedicated to the States mentioned in this section. With regard to this legal effect, the Board is of the opinion that the declaration of intent for paying fees for a certain State can be subject to an error which can be corrected under Rule 88, sentence 1, EPC in the same way as a designation as such because this indication constituted an error in a document. Therefore, appellant's request for correction of the designation of Finland into France has to be read as a request for correction of

the erroneous declaration in section 10.1 of the Form 1200 to the effect that it was intended to pay a designation fee for France instead of Finland. In the event of correction allowed by the Board, the retroactive effect under Rule 88 EPC would result in the legal effect that from the beginning one designation fee paid by appellant on 29 September 2000 was to be assigned to France instead to Finland.

On the basis of the evidence submitted by the appellant before the first instance the Board follows the reasoning of the impugned decision that the indication of Finland among the indicated States in Form 1200 did not conform to the true intention of the appellant who wanted to pay designation fee for France.

4. Although Rule 88 EPC does not contain any direct restriction for its application, the EPO case law developed functional and temporary limitations whether or not correction of an error was allowed either in respect of the legal purpose of this rule or in order to safeguard the interests of the public.

Firstly, a failure to pay designation fees cannot be corrected pursuant to the wording of Rule 88, first sentence, EPC (cf. J 21/84, EPO OJ 1986, 75; T 152/85, EPO OJ 1987, 191) which only concerns errors in documents but not omissions of a payment of fees. In the present case, the belated payment of designation fee and surcharge for France on 5 January 2001 cannot be corrected in that way that the payment has to be regarded as effected within the time limit under Rule 85a(2) EPC.

Secondly, correction under Rule 88 EPC does not allow to set aside 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 (cf. J 25/01, not published in the EPO OJ). This principle is further explained in respect of the case under consideration in point 15 below.

Thirdly, Rule 88 EPC does not contain an explicit reference to the time when and how long corrections of errors in documents could be requested. But the wording "...may be corrected" means clearly that there is no obligation of the Office to allow corrections in every case. Over the years the jurisprudence of the Boards of Appeal has established a further requirement to allow corrections of errors concerning designation of States, namely a limitation of the time during which those requests can be made (see points 2.2 and 2.3 of the reasons of decision J 16/00 not published in the OJ EPO).

5. The idea behind a time restriction ("Zeitgrenze") was to safeguard the interests of the public (see Case Law of the Boards of the Boards of Appeal of the European Patent Office, 4th ed.2001,Chapter VII.A.6, p.414). As a balance between the interest of third parties to rely upon information given by the Office and the applicant's interest to have an error corrected, the limitation up to a point in time sufficiently early to allow a reference at least to the requested correction of an error in the publication of an application, was found quite adequate over many years of practice. The same idea was applied to Euro-PCT cases so that the

time restriction was seen as being the date of publication of the bibliographic data by the EPO because this publication only contained the indication of those Contracting States designated by the prior designation in the international application which were finally validated by payment of the respective designation fees.

6. Following the change of publication policy of the EPO in 1997 brought about by the deferral of the date for paying designation fees for European Patent applications (see EPO OJ 1997, 79) and the introduction of a system of express designation of all EPC contracting states instead of a combination of express and precautionary designation it seems to be worth examining whether the prevailing case law still meets the requirement of protecting legitimate expectations of the public, namely to trust exclusively the content of the publication of a patent application in the Bulletin. In other words: is it still justified to understand the requirement of the jurisprudence, that correction of an error can be accepted at the latest (providing all other preconditions are met) so that a warning concerning the correction can still be included in the publication of the application, as a requirement to find this warning already in the very first publication of this patent application although there is even an information of the Office that full information on designated countries can only be obtained later due to the change of the information practice of the Office?

7. According to the Ancillary Regulation to Article 93(1) EPC (OJ 1997, 479) the publication system of the EPO

has changed insofar as European patent applications are firstly published with the indication that all contracting states are validly designated. After the expiry of the basic period under Article 79(2) EPC, about seven month after publication of the European search report, the countries expressly designated by dedicating the respective fees to them, are published in the Register of European Patents. About seven weeks later these states will be published in a "positive list" in the Bulletin.

It is also mentioned, that countries, for which designation fees are paid during the period of grace under Rule 85a EPC, these states will be entered without delay in the Register and in the Bulletin under Section I.12 ("Alterations and corrections).

8. This practice has been in force since December 1997 and all European applications filed as from 1 June 1997 are now published under the new system.

After the change of the publication practice of the Office it is clear, that the interested parties cannot rely exclusively upon the information given by the publication of the European patent application, because one will find all member countries of the EPO indicated there. They would have to keep themselves informed continuously by searching the Register or reading carefully the Bulletin, to find out which countries might be designated definitely or if changes took place.

9. The same information can be obtained from the internet ("Time Schedule for the Payment of Designation Fees and related Publications"). This information is available on the homepage of the EPO under "toolbox for applicants" which finishes with the warning "In other words it can take up to one year and more following the Search Report Publication before the information on the payment of designation fees is perfect.

10. Under point 10 of the above mentioned Ancillary Regulation it is indicated that this new publication practice does not affect Euro-PCT-applications.

This restriction of the applicability of the new practice to European patent applications cannot be found in the information given to the public via internet.

11. Due to the change in the publication system the public had to learn that they cannot trust exclusively the publication of the European patent application because only a smaller number of applicants will wish to designate all member states of the EPO so that a later change in the selection of states will be the most likely outcome. It cannot be ignored that this practice has an enormous impact on the information habits of the public. They were explicitly informed by the Office that the final information about designated states can only be expected within one year (after the publication of the Search Report) or even later.

12. In the view of the party it might seem to be unfair to inform the public in a way, which makes clear that the correct information about the scope of the territorial

protection cannot be found in the publication of the application alone but at a later stage in the Register and the Bulletin and at the same time restrict the possibility of correction of an error still to a point "early enough" to indicate the correction already in the very first publication of the patent application. But it has to be pointed out that the information given in the OJ of the EPO concerning the new publication practice excludes the applicability of the new practice to EURO-PCT-applications.

It is regrettable that the internet information does not correspond completely to the text of the Ancillary Regulation published in the OJ of the EPO and particularly does not mention that the changes in EPO publications do not affect Euro-PCT applications.

13. The different treatment of (direct) European patent applications and EURO-PCT-applications as far as publication practice is concerned cannot be seen as a contradiction to the legal provision of Article 150(3) EPC because such a restriction of the applicability of the new practices of the Office as far as publications are concerned derives from the different time limits resulting from the different steps which take place after the publication of the search report in European patent applications and EURO-PCT applications after entering into the regional phase.

14. In the light of the foregoing considerations the Board comes to the conclusion that there is no reason to deviate from the constant jurisprudence of the Boards of Appeal (see point 4 of the decision) and to give up in general the requirement that a request for

correction under Rule 88 EPC has to be filed sufficiently early so that the public can be informed about when publishing the bibliographic data of the international application under the EPC for the first time.

The Board furthermore sees no particular circumstances in the case in suit which might justify treating the request for correction as exceptional and to allow the correction despite of the publication of the application, as was done in J 6/91 (OJ of the EPO 1994,349). The divergence of information given by the Office via the official instrument (the Patent Bulletin) and as a customer service via internet cannot be interpreted as special situation, as it is still the Patent Bulletin which has the necessary official character to be relied upon.

The sophisticated character of the invention and the competitors (as it was argued by the appellant) cannot be accepted as creating extraordinary circumstances which would allow the correction of an error even after publication of the bibliographic data. The public always is taken as a whole and differences according to different fields of technology have never been made as far as their right to reliable information from the Office is concerned.

15. When regarding a request for correction under Rule 88 EPC the Board has furthermore to consider the limited function of this Rule in the system of legal remedies provided for in the EPC (see above point 4, functional restriction). As already mentioned above, Rule 88 EPC concerns the correction of errors in documents filed

with the EPO. According to the first sentence a correction is limited to linguistic errors, errors of transcription and mistakes in any documents filed with the EPO.

Therefore a correction under Rule 88 EPC is a procedural means available to rectify misleading information caused by such an error. The established case law of the Boards of appeal also allows correction under Rule 88 EPC of the content of a document filed with the EPO even if the correction leads to an amendment or to a revocation of the procedural declaration or act relative to this document, whereby rights of the party concerned can arise or a waiver of rights can be rescinded.

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 by failure to meet a time limit during the pending proceedings. In the present case, appellant's request for correction is aimed at cancelling the legal effect under Rule 108(2) i.e. at reversing the legal effect that the designation of France was deemed to be withdrawn since there was no designation fee dedicated to France and no additional fee was paid within the period of grace under Rule 85(a) by 20 December 2000.

To cancel procedural effects after failure to meet a time limit would be to apply Rule 88 EPC beyond its clear and unambiguous wording (cf. J 25/01 supra) and would violate the scope of application of Article 122 EPC which stipulates specific requirements for grant of re-establishment of rights. This conclusion is

confirmed by Article 122(5) EPC which strictly forbids re-establishment of rights after failure to meet the time limit under *inter alia* Article 79(2) 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, so that the applicant's rights are re-established. Thus, such a request for *restitutio in integrum* is the appropriate means to restore the procedural situation before the failure to meet a time limit. But according to Article 122(5) EPC restitutio in integrum is excluded after failure to meet a time limit under Article 79 or Rule 104(1)(b) in conjunction with Rule 85a EPC (see G 3/ 91 OJ EPO 1999, 8). In other words, the remedy of *restitutio in integrum* is not available to redeem the applicant’s loss of rights that has occurred as a consequence of the failure to pay the designation fee for France at the end of the period of grace under Rule 85a(2) on 20 December 2000.

The strict provisions of Article 122(5) EPC must not be circumvented by the so-called retroactive effect of a correction under Rule 88(1) EPC. 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).

Furthermore in decision J 27/96 (not published in OJ EPO) 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).

All these decisions clarify that a correction under Rule 88 EPC is a procedural act leading to the strictly limited legal effect of correction of a mistake in a document filed with the EPO and that Rule 88 EPC does not constitute means of re-establishment of rights after failure to meet a time limit as it is exclusively regulated by Article 122 EPC.

In the present case, Rule 88 EPC cannot be applied to setting aside the legal effect according to Rule 108(2) EPC, namely that the designation of the Contracting state France for which no designation fee had been dedicated by 20 December 2000 shall be deemed to be withdrawn.

16. As already mentioned above, Rule 88(1) EPC confers a discretion of power to the Board for allowing or not-allowing a correction of an error since it is stated in this rule that a respective error only "may be corrected". Therefore as a result of the foregoing

consideration concerning the protection of the public interests and the limited function of Rule 88 EPC, the Board decides in the present case that a correction under Rule 88(1) EPC cannot be allowed and appellant's respective request is to be rejected.

17. For the sake of completeness, the Board points out that in the case under consideration the right for correction under Rule 88 EPC cannot be re-established as there is no time limit in Rule 88 EPC which has to be observed and therefore could be missed which is a precondition for a request for *restitutio in integrum* according to Article 122 EPC (a time limit which the party was unable to observe for special circumstances) is not fulfilled. There is only a factual time period (as long as no definite procedural effects have occurred) during which a request for correction of an error under Rule 88 EPC is possible. This factual period, sometimes called "Zeitgrenze" by the jurisprudence, has not to be understood as a formal time limit with a legally defined beginning and end. Once this factual time period has expired because a procedural effect has taken place no legal remedy exists to set aside this effect.

Auxiliary request (Referral to the Enlarged Board of Appeal)

18. The preconditions for a referral to the Enlarged Board of Appeal are not given. The impact of technical development on the information habits of the public might be worth to consideration in the future by the competent administrative authorities of the EPO as this is a practical question which might one day led to

amended rules or regulation. It is clearly not a legal question. And the Enlarged Board of Appeal is only competent to decide on points of law.

As the Board in its decision follows existing case law and the question to be decided can be answered by the Board itself with no uncertainty, the auxiliary request has to be refused.

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