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D E C I S I O N
of 5 July 2004

Case Number: J 0010/04 - 3.1.1

Application Number: 00991676.8

Publication Number:

IPC: B01L 3/00

Language of the proceedings: EN

Title of invention:
Multiple analyte assay device with sample integrity monitoring system

Applicant:
Syntron Bioresearch, Inc., et al

Opponent:
-

Headword:
Monitoring system/SYNTRON BIORESEARCH, INC.

Relevant legal provisions:
EPC Art. 150(3)
PCT Rule 82ter.1

Keyword:
"International application - filing date"
"Correction of errors of receiving office"
"Evaluation of evidence - sworn statement"

Decisions cited:
J 0020/89, OJ EPO 1991, 375, T 0162/87, T 0627/88, T 0124/88, T 0482/89 OJ EPO 1992, 646, T 0363/90

Catchword:
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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: J 0010/04 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 5 July 2004

Appellant: Syntron Bioresearch, Inc.
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Decision under appeal: **Decision of the Receiving Section of 2 December 2003 refusing the request to correct the filing date of the application No. 00991676.8 and to recognise the priority claim based on US patent application No. 09/364,277.**

Composition of the Board:

Chairman: J. Saisset
Members: A. Pignatelli
P. H. Mühlens

Summary of Facts and Submissions

I. The appellant (applicant) lodged an appeal, received on 2 February 2004, against the decision of the Receiving Section, dispatched on 2 December 2003, concerning the refusal of a request to correct the filing date of the application No. 00 991 676.8 and to recognise the priority claim based on US patent application No. 09/364,277 filed on 29 July 1999.

II. International application no. PCT/US00/20506 was filed on 28 July 2000 with the US Patent Office as receiving Office.

On 25 August 2000, the USPTO issued a form, which indicated that some application papers had been received on 28 July 2000 but that no description or claims were present in these papers. The appellant adduced evidence to prove that description, claims, abstract and drawings were present when the application was filed. Declarations by the legal assistant employed with the law firm of the attorneys of record for the appellant (applicant) were filed stating that she personally placed in the mail the application in question.

The USPTO held that the evidence adduced was insufficient to establish that the description and the claims were filed on 28 July 2000. It therefore accorded a filing date of 19 September 2000 to the international application, which was the date on which duplicate papers were filed. This had the consequence that the applicant's priority right from US patent

application No. 09/364,277 filed on 29 July 1999 would not longer be valid.

The international application was prosecuted on the basis of a priority date of 29 July 1999. A demand for International Preliminary Examination was filed on 27 February 2001 and entry to the European regional phase was effected on 25 February 2002.

With the request for entry into the European regional phase, the applicant requested under Rule 82ter.1 PCT that the European Patent Office acting as designated or elected Office correct the accorded filing date to 28 July 2000 and reinstate the claimed priority.

In the decision under appeal, the Receiving Section of the EPO was not convinced by the evidence adduced by the appellant that the application No. 00 991 676.8 as filed on 28 July 2000 with the USPTO included claims and a description and that therefore the filing date accorded by the USPTO (19 September 2000) could be corrected. The reason was mainly that the sworn statements given by the legal assistant were not persuasive because the person was not impartial and her statement was based on personal impressions so that her testimony was not credible. Oral proceedings were not held because the Receiving Section considered that a hearing of the witness would not lead to another evaluation of the evidence.

III. In its statement of grounds, the appellant argued essentially as follows:

Sworn statements in writing constitute a form of evidence explicitly recognised by the EPC. This evidence shows that on the balance of probabilities all the papers for the international application were filed on 28 July 2000.

It was not open to the Receiving Section to completely disregard the statements and to call into question the honesty of the witness without at least taking oral evidence from the witness first.

Even in the event that it is held that the available evidence does not suffice to establish that the description, claims, abstract and drawings were correctly filed on 28 July 2000, it should be considered that these documents were incorporated into the application via the cross-reference to the US priority in the PCT request form. In this form it is clearly explained that the description, claims and drawings of the new international application are identical to those of the US priority application. A cross-referred document can be regarded as disclosed in an application which refers to that document. Thus, the PCT request form filed on 28 July 2000 must be regarded as including the description, claims, abstract and drawings of the US priority application.

IV. The appellant requested that the decision under appeal be set aside, the filing date be corrected to 28 July 2000 and the priority right be reinstated.

Reasons for the Decision

1. The appeal is admissible

According to Rule 82ter.1 PCT, any designated or elected Office shall rectify an error made by the receiving Office concerning the international filing date, if that error could be rectified under the national law or national practice of that designated or elected Office and if the applicant proves that the filing date is incorrect.

Since the EPO is acting as elected Office for this application it has the power according to Rule 82ter.1 PCT to correct the filing date if the necessary conditions are fulfilled.

Under Article 150(3) EPC, an international application for which the EPO acts as designated or elected Office is deemed to be a European patent application. Consequently, there is no obstacle to making use of appeal procedures provided for under the EPC to supplement the provisions of the EPC in such cases (cf. J 20/89, OJ EPO 1991, 375). Therefore, the Board of appeal has the power to decide on the appeal against the decision of the Receiving Section.

2. The first condition required by Rule 82ter.1 PCT in order to correct the filing date is that the error made by the receiving Office is such that, had it been made by the designated or elected Office itself, that Office would rectify it under the national law or national practice.

(a) If papers filed in connection with an European patent application were found to be incomplete when they reached the EPO, the EPO would have jurisdiction to accord an appropriate filing date if evidence was adduced of the date on which documents were filed.

(b) The legal basis for correcting a wrong filing date would be the recognised practice of the boards of appeal that parties to proceedings before the EPO can cite failure to meet their legitimate expectations if the EPO had not exercised the due care required by the circumstances.

If the EPO had lost papers filed with it, the party should not suffer any disadvantage because of the failure of the EPO. Consequently the EPO would have to correct the filing date in such cases.

The first condition of Rule 82ter.1 PCT is therefore fulfilled.

3. The second condition required by Rule 82ter.1 PCT is that the applicant proves to the satisfaction of the designated or elected Office that the international filing date is incorrect due to an error made by the receiving Office.

The applicant maintains that the papers deposited with the Express Mail facility, which under the provisions of the US receiving Office are deemed to be an extension of the USPTO, included a transmittal letter, a PCT request form, a description, a set of claims, an abstract and a set of drawings. He therefore concludes

that the description and the claims must have got lost in the USPTO.

The appellant adduced sworn statements by the legal assistant of the legal firm representing the appellant that she positively remembered having placed the description and the claims personally into the mail.

The Receiving Section considered this evidence not persuasive because the legal assistant was not impartial as she was personally involved in the filing of the request and employed in the representative's office. Moreover, the Receiving Section considered that the sworn statement was based on personal impressions which are subjective and not always reliable particularly regarding a routine task. The Receiving Section did not invite the witness to hear her personally.

The Board does not share the view of the Receiving Section for the following reasons.

A sworn statement is a form of evidence with a high probative value especially if it is given, as in the present case, with the awareness that wilful false statements are punishable by fine or imprisonment or both under the applicable law.

Strong reasons are therefore necessary to disregard this kind of evidence. These reasons could be a set of circumstances which make the statement very unlikely so that the credibility of the witness would become decisive. The credibility of a person can only be evaluated by oral evidence. If the Receiving Section

considered the circumstances described in the statement as very unlikely to have happened, it should have heard the witness personally in order to evaluate the credibility of the witness.

As to the circumstances of the case, the present case differs from the "ordinary" lost-mail cases in that the application reached the USPTO and only a part of the filed papers was not present. Thus, it is at least possible that a part went missing in the USPTO.

Description and claims form a considerable large stack of paper within the documents filed for an application. It is not credible that an experienced secretary who is familiar with assembling patent applications would forget to enclose these papers or would not notice that the papers are missing.

Thus, the objective circumstances of the case do not contradict the sworn statement but on the contrary support it.

Furthermore, the Board sees no reason to question the credibility of the statement. In particular, the credibility of witnesses cannot be impugned merely because they had a business relationship with a party. The jurisprudence of the boards of appeal has recognised this principle in many decisions (see eg T 162/87, T 627/88, T 124/88, T 482/89 OJ EPO 1992, 646, and T 363/90).

The fact also that the statement is based on personal impressions of the witness cannot be a reason to disregard it, because evidence is often based on

personal recollection of a person. If evidence based on personal impression was not credible per se, evidence via witnesses could never be credible.

The Board is therefore satisfied that the description and the claims were filed with the application of 28 July 2000, that the USPTO therefore made an error in refusing the filing date of 28 July 2000 and that this error can be corrected by the EPO.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The request to correct the filing date of the application No. 00 991 676.8 to 28 July 2000 and to reinstate the priority right is allowed.

The Registrar: The Chairman:

S. Fabiani J. Saisset