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D E C I S I O N
of 27 October 2005

Case Number: J 0011/04 - 3.1.01

Application Number: PCT/EP00/007549

Publication Number: -

IPC: C07F 15/02

Language of the proceedings: EN

Title of invention:

Metal complexes comprising a 2,6 diacylpyridine-ligand and their use in the polymerization of ethylene

Applicant:

ENICHEM S.p.A.

Opponent:

-

Headword:

Correction by adding designation/ENICHEM

Relevant legal provisions:

EPC Art. 113-116

EPC R. 88

PCT R. 91

Keyword:

"Correction by adding designation (no)"

"Obvious deficiency (no)"

"Protection of legitimate expectations (not applicable)"

Decisions cited:

G 0002/97, J 0016/84, J 0006/91, J 0003/00

Catchword:

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Case Number: J 0011/04 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 27 October 2005

Appellant: ENICHEM S.p.A.
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Decision under appeal: Decision of the Receiving Section dated
16 December 2003 refusing the request for
correction under Rule 88 EPC to add the
designation EP in the PCT Form, and holding
that the application was not deemed a European
patent application since EP was not designated.

Composition of the Board:

Chairman: J.-C. Saisset
Members: M.-B. Tardo-Dino
S. C. Perryman

Summary of Facts and Submissions

- I. The appeal is from the decision of the Receiving Section dated 16 December 2003 rejecting the request for correction under Rule 88 EPC relating to PCT application EP00/007549 to be treated as also including an application for an EP regional patent.
- II. The PCT application at issue was filed on 3 August 2000 with the EPO as PCT Receiving Office (RO) claiming priority from an Italian application of 5 August 1999. The designation boxes for all national patents were individually marked, but no designation box was marked for any regional patent on the application form.
- III. The international application was published on 15 February 2001 mentioning all the national states as designated marked.
- IV. By fax dated 21 December 2001 confirmed by letters dated 21 December 2001 and 25 January 2002 respectively received on 27 December 2001 and 28 January 2002, the applicant's representative argued in particular that the fee calculation sheet filed with the Request by using the wording "THE INTERNATIONAL APPLICATION CONTAINS ALL DESIGNATIONS" made clear that "the applicant wanted to and had made all designations, although, because of an obvious mistake in the Request, the Regional patents were not crossed. Therefore, in view of the fact that the request is not more relevant than the fee calculation sheet and in view of the clear indication in the fee calculation sheet that the international application contains all designations, the protection of legitimate expectations requires the

EPO, as receiving office, to warn the applicant of any impending loss of rights if such a warning can be expected in all good faith...". It was requested that the European patent application be considered accepted and filing of the European Patent application be accepted.

V. Informed by telephone that such a request could not be considered by the EPO as PCT Receiving Office, but only by the EPO as a designated Office after entry into regional phase, the applicant filed on 1 February 2002 an application for entry into the regional phase before the EPO with designation of all contracting states and paid the relevant fees.

VI. The receiving Section issued a communication on 29 April 2003 informing the applicant that its request for correction under Rule 88 EPC of the international application was not allowable. It stated inter alia that:

- An authorization of the receiving Office for the correction of an (alleged) obvious error pursuant to Rule 91 PCT was not effective if its notification reaches the International Bureau after the expiration of 17 months from the priority date. Even for this reason alone the EPO/RO could not allow the request under Rule 91 PCT. In absence of any further legal basis in the PCT for allowing the request by the EPO as receiving Office, it was being further considered by the EPO as (purported) designated Office.

- It indicated that it was satisfied that the documents on file provided evidence that EP was erroneously not designated in the PCT request form.
 - It set out in detail the applicable case law, and indicated that while in special circumstances a correction might be allowable, here there were no such special circumstances, and in particular no obvious deficiency to which the receiving Office should have drawn the applicant's attention.
- VII. By letter dated 10 June 2003, the applicant maintained its request again arguing that in application of the protection of legitimate expectations, the EPO should have warned the applicant of the inconsistency between the fee calculation sheet and the PCT request form. Consequently, it was submitted that the EPO was partly responsible that a warning was not published.
- VIII. The Receiving Section then issued the decision under appeal, stating inter alia that "since the international application has already been published without warning and no special circumstances are present which could make it possible to allow the correction, the request for correction has to be rejected...."
- IX. With a letter dated 13 February 2004 and received by the EPO on 16 February 2004, the applicant filed a notice of appeal against this decision and paid the appeal fee at the same time. It filed the statement of grounds of appeal with a letter dated 13 April 2004 and received on 14 April 2004. The only aspect of the decision under appeal criticized concerned there being

no "special circumstances". The appellant argued that in the letter accompanying the PCT Request Form and the fee calculation sheet, it was indicated that:

"We authorize you to deduct the official fees of DEM 4770,16.= from our deposit account no. 28 07 00 22. A Voucher setting forth how the amounts have been calculated is herewith enclosed."

This letter clearly pointed out that the fee calculation sheet or voucher had been filed in order to explain how the official fees had to be used by the Receiving Office, and in view of the fact that the fee sheet stated "The international application contains all designations" this was a very clear indication of the fact that the Applicant wanted to and had made all designations. Relying on decision J 16/84 of 6 August 1985, reason 7, it was argued in the words of that decision that "...the use of fees in a way which conflicts with the intention of the person making the payment, however easy it may seem to explain and excuse, is always a substantial procedural violation because it can have detrimental legal consequences for the person making the payment...", and that in this case the Receiving Office should have seen from the voucher that the fees were to be used for all designations, including for the Regional patents not crossed in the application form, and that therefore the applicant could legitimately have expected to receive a warning of the existence of at least an inconsistency between the fee calculation sheet and the PCT Request form. Thus the EPO as Receiving Office could be considered (partly) responsible for the missing warning in the International publication, so special

circumstances existed which made the correction allowable. The EP regional patent should thus be considered as designated in the PCT application.

- X. The appellant requests that the decision under appeal be set aside and that the EP regional patent be considered to be designated in the PCT application in re, namely that a correction of the PCT Request form under Rule 88 EPC be granted.

Reasons for the Decision

1. The appeal is admissible since the requirements of Articles 106 to 108 EPC and Rule 64 EPC are met.
2. The appellant did not request oral proceedings. Its submissions setting out its arguments do not raise new legal issues so that the Board can consider that due regard has been accorded to the Appellant's rights to be heard in accordance with Articles 113 and 116 EPC.
3. The legal principles that need to be applied in the present case are in the view of the Board correctly given in the decision under appeal (set out in point VIII above), and these principles have not been challenged by the Appellant, who seeks only to establish that on the facts of the case there are special circumstances which make the requested correction allowable despite the absence of a warning in the publication of the application.
4. The Appellant argues that because the EPO as PCT Receiving Office should have noticed an alleged

discrepancy between the PCT application form and the accompanying fee voucher, and should under the principle of the protection of legitimate expectations have warned the appellant of this, the EPO was (partly) to blame for the PCT application being published without a warning at least that the EP regional patent also was to be considered as designated.

5. According to the established case-law and as confirmed by the Enlarged Board (G 2/97 OJ EPO 1999, 123) the protection of legitimate expectations requires the EPO to warn the applicant of any loss of rights if such a warning can be expected in all good faith. This presupposes that
 - the deficiency can be readily identified within the framework of the normal handling of the case at the relevant stage of the proceedings and that
 - the user is in a position to correct it within the time limit (see for instance J 3/00 not published).
6. For the principle of the protection of legitimate expectations to apply in this case there must be some evident deficiency or discrepancy that the Receiving Office could have been expected to notice. In this case the number of states actually designated already required the maximum fee (equivalent to eight designations) to be paid, so that the amount paid was consistent with the PCT application form. The way the fee voucher has been completed to read "The international application contains all designations" thus gave rise to no queries as to the amount to be paid and there was no deficiency. The fee voucher is

not part of the PCT application form, and there can be no duty on the officials of the Receiving Office to study and compare the official and unofficial documents submitted to find some possible potential discrepancy. Accordingly the Board cannot here find any evident deficiency or discrepancy that the EPO as Receiving Office could have been expected to notice or query.

7. That the doctrine of legitimate expectations applies only where there is an obvious deficiency or discrepancy which requires to be queried to find out the true intention of the applicant, is also illustrated by decision J 16/84 (OJ EPO 1985, 357), relied on by the Appellant, where a cheque explicitly submitted for the filing, search and designation fees of one application referred to by mistake only by the number of the prior Italian application, was applied by the EPO without querying the purpose of the payment, to paying the fees on another application filed at the same time as the cheque. In that case there was an obvious discrepancy relating to the application number which needed to be queried, but this is not true in the present case. There can be no legitimate expectation that a Receiving Office, whether the EPO or some other office, look through all the documents submitted to see if some mistake might not have been made. The PCT application form is a document of legal importance, and the assumption must be that it has been completed with due care to reflect the applicant's intentions.

8. As there are no special circumstances which permit allowance of the requested correction of the PCT application form to designate an EP regional patent, the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

J.-C. Saisset