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**Datasheet for the decision
of 30 July 2010**

Case Number: J 0001/10 - 3.1.01

Application Number: 08106006.3

Publication Number: 2100676

IPC: B22D 7/12

Language of the proceedings: EN

Title of invention:
Continuous cast method

Applicant:
Kováč, Peter

Opponent:
-

Headword:
Designation of inventor/KOVAC

Relevant legal provisions:
EPC Art. 81, 90(3)(4)(5), 93(1)(a)(b), 113(1)
EPC R. 19(1), 20(1), 60(1), 103(1)(a)

Relevant legal provisions (EPC 1973):
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Keyword:
"Designation of inventor - 16-month period - reduced by
earlier publication of the application (no)"
"Right to be heard - substantial procedural violation (yes)"

Decisions cited:
J 0020/85, J 0003/90, T 0669/90, T 0892/92

Catchword:

An applicant's request under Article 93(1)(b) EPC to publish the application as soon as possible does not affect the time period foreseen in Rule 60(1) EPC for filing the designation of the inventor.



Case Number: J 0001/10 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 30 July 2010

Appellant: Kováč, Peter
75
SK-044 42 Kosické Ol'sany (SK)

Representative: Bauer, Dirk
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Decision under appeal: Decision of the Receiving Section of the
European Patent Office of 13 October 2009.

Composition of the Board:

Chairman: B. Günzel
Members: G. Weiss
C.-P. Brandt

Summary of Facts and Submissions

- I. The appeal lies from the decision of the Receiving Section dated 13 October 2009 refusing European patent application No. 08106006.3 under Article 90(5) EPC on the grounds that the designation of the inventor had not been filed within the time limit specified under Rule 60(1) EPC.
- II. The application was filed on 17 December 2008. No priority was claimed.
- III. In its communication dated 29 January 2009, the Receiving Section informed the appellant that the designation of the inventor was missing from the request for grant. It invited him to remedy that deficiency within the prescribed time limit (Rule 60(1) EPC).
- IV. After having been sent the extended European search report, the appellant requested (by letter dated 27 July 2009) that the application be published as soon as possible (Article 93(1)(b) EPC).
- V. On 19 August 2009 the Receiving Section informed the appellant that the application would be published on 16 September 2009.
- VI. Since the designation of the inventor had not been filed, on 13 October 2009 the Receiving Section issued a decision refusing the European patent application on the grounds that the prescribed time limit had not been observed. In two telephone conversations on 23 and 26 October 2009 with Receiving Section staff, the

appellant was informed on 23 October 2009 that "... a request for early publication means that before starting the technical preparations for publication the applicant should have filed the designation of inventor. Thus the 16-month time limit ceases to exist ...", and on 26 October 2009 that ".... Rule 60 EPC was interpreted in a way that the designation of inventor would have to be filed in any case before the termination of the technical preparations for publication, since it was clear that the designation of inventor is considered part of the application."

VII. With letter dated 30 November 2009 and received on 2 December 2009 the appellant filed a notice of appeal and statement of grounds, paid the appeal fee and designated the inventor. He requested that the decision be set aside and that reimbursement of the appeal fee be ordered due a substantial procedural violation. In the alternative, he requested further processing under Article 121 EPC.

VIII. The appellant's grounds for appeal are as follows:

- (a) The time limit for designating the inventor ended on "17.04.2010" (sic). Thus, loss of rights could occur only after the expiry of that time limit.
- (b) The wording of Rule 60 EPC made it clear that the time limit for filing the designation of the inventor was extended up to the completion of technical preparations for the publication of the European patent application. This followed from the *travaux préparatoires*. Conversely, it could not be concluded from this that the period for

filing the designation of the inventor could be reduced in any way.

(c) No direct connection between filing the designation of the inventor and publishing the application was apparent from the relevant regulations. In particular, there was no provision requiring the designation of the inventor to be filed prematurely if the application was published early. The EPO had published the application without sending a communication to the effect that publication was only possible if the designation of the inventor had been filed. The application had been published with the remark "The designation of the inventor has not yet been filed", which should not be a problem since subsequent changes in the inventor could be recorded in the European Patent Register (Rule 21(2) EPC).

(d) The decision under appeal had no legal basis. It should be rectified and the appeal fee reimbursed.

IX. Oral proceedings are not requested.

Reasons for the decision

1. The appeal is admissible.

2.1 Article 81 EPC stipulates that European patent applications must designate the inventor. This must be done in the request for grant or a separate document (Rule 19(1) EPC). Failure to file the designation of

the inventor together with the European patent application is a deficiency which may be rectified within 16 months of the filing or priority date, this period being deemed to have been observed if the designation of the inventor is filed before completion of the technical preparations for publication, Rule 60(1) EPC). The Receiving Section advises the applicant of the deficiency (Article 90(3) and (4) EPC). The 16-month period is thus a time limit for performing a specific action, i.e. in this case for the applicant to rectify the deficiency brought to his attention. If he fails to do so before completion of the technical preparations for publication, the application must be refused pursuant to Article 90(5) EPC.

2.2 The Rule 60(1) EPC time limit was set at 16 months (or before completion of the technical preparations for publication of the application if later) to enable the applicant to provide the information about the designated inventor in the European patent application as published; under Article 93(1)(b) EPC publication occurs at 18 months as from the filing date. Rule 20(1) EPC duly provides that the designated inventor must be mentioned in the published application. The reason for that is that this information needs to be available to the public as well as the EPO. It is therefore entered in the European Patent Register (Article 127, Rule 143(1)(g) EPC) and also published in the European Patent Bulletin (Article 129(a) EPC).

2.3 Under Rule 60(1) EPC, the 16-month period is deemed to have been observed if the information is communicated before completion of the technical preparations for publication of the European patent application. That

extra clause is a "quasi-extension" of the period; it does not change its nature, i.e. that of a time limit for performing a specific action. If the designation of the inventor is filed after the 16-month period but still before completion of the technical preparations for publication, the time limit is deemed to have been observed. This extra clause was included in Rule 60(1) EPC as part of the 2006 revision of the Implementing Regulations without any detailed explanations, as it was modelled on several PCT provisions (see CA/PL 17/06, pages 186 and 187, and the minutes of the 30th meeting of the Committee on Patent Law, CA/PL PV 30, page 18). It enables the information about the inventor to be included in the European patent application as published, because publication occurs slightly later (18 months after filing), and the fiction that the 16-month period has been observed means that no decision refusing the application can then be issued.

2.4 In the present case, no priority was claimed, so the 16-month time limit expired on 19 April 2010 (Monday) (filing date: 17 September 2008; expiry of the 16-month time limit: 17 April 2010, Saturday, extended under Rule 134(1) EPC to Monday, 19 April 2010). The communication under Rule 60(1) EPC is dated 29 January 2009 and was sent by registered mail. The statement of the grounds for appeal indicates that the communication was validly notified. The appellant filed the designation of inventor on 2 December 2009, i.e. well before the end of the 16-month period.

3.1 The issue arising in this case is whether the legal position regarding designation of the inventor is changed by early publication of the European patent

application at the applicant's request under Article 93(1)(b) EPC, which can mean that the European patent application as published does not tell the public who the inventor is. In the board's judgement, early publication under Article 93(1)(b) EPC has no effect on the provisions governing designation of the inventor. If it did, it would be to shorten the 16-month period for filing the designation of the inventor. But there is no legal basis for assuming any connection between early publication and a reduction in the 16-month period. Nor can this be inferred from Rule 60(1) EPC or the provisions governing the procedure for rectifying deficiencies (Article 90(3) and (4) EPC).

- 3.2 Also, the board can see no reason why the provisions concerning publication of the European patent application (Article 93(1) and Rule 20(1) EPC) should take precedence over those governing filing of the designation of inventor. It is desirable - and was indeed the legislator's intention - that the application when published should contain the information about the inventor. The periods for publication and for filing the designation of inventor (18 and 16 months respectively) are therefore synchronised and run in parallel. But the public can also be informed **after** publication as to who the inventor is, in the form of - for example - announcements in the European Patent Register (Article 127, Rule 143(1)(g) EPC and the European Patent Bulletin (Article 129(a) EPC). Therefore, the information about the designated inventor would be available to the public in the sense intended by the legislator.

3.3 Another potential scenario in which the application cannot be refused is that for some reason the Receiving Section issues the communication under Rule 60(1) EPC only shortly before or indeed after the 16-month period expires, and it is thus despatched or notified after the application's publication under Article 93(1)(a) EPC. Notification of this communication is the sole condition triggering a loss of rights and possibly a decision refusing the application. Hence, from a legal point of view, the already published application is of no significance as regards the missing designation of inventor.

3.4 For the reasons outlined above, the appeal is to be allowed. The decision under appeal is wrong in its interpretation that the 16-month time limit for filing the designation of the inventor is shortened if the European patent application is published early.

4. Reimbursement of the appeal fee

4.1 Reimbursement of the appeal fee is ordered where a board of appeal deems an appeal to be allowable and reimbursement is equitable by reason of a substantive procedural violation (Rule 103(1)(a) EPC).

4.2 According to Article 113(1) EPC, EPO decisions may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. This provision is a guarantor for the parties that proceedings before the EPO will be conducted openly and fairly (cf. decisions J 20/85, OJ EPO 1987, 102, point 4(a) of the reasons and J 3/90, OJ EPO 1991,

550). The right to be heard is intended to ensure that the parties to proceedings are not taken by surprise by grounds mentioned in a decision adversely affecting them (cf. e.g. decisions T 669/90, OJ EPO 1992, 739 and T 892/92, OJ EPO 1994, 664).

4.3 The reasons for refusing the application under Article 90(5) EPC were not put to the appellant first, to enable him to comment on them. Nor does the decision itself give him the reasons why he was considered not to have observed the 16-month period for filing the designation of the inventor. Quite the contrary: the appellant was informed of them only after notification of the decision and after he telephoned the Receiving Section to ask about it. Accordingly, the decision under appeal is based on grounds on which the appellant did not have the opportunity to present comments; it thus contravenes the requirements of Article 113(1) EPC. Therefore, a substantial procedural violation occurred in the first-instance proceedings.

4.4 Since the decision of the first instance contravenes Article 113(1) EPC and the appeal is allowed, it is equitable to reimburse the appeal fee pursuant to Rule 103(1)(a) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The designation of the inventor filed on 2 December 2009 was filed within the 16-month period under Rule 60(1), first sentence EPC.
3. The fee for further processing and the appeal fee are to be reimbursed.

The Registrar:

The Chairwoman:

C. Eickhoff

B. Günzel