Internal distribution code:

(A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [-] To Chairmen
(D) [X] No distribution

Datasheet for the decision of 22 May 2019

Case Number: J 0015/18 - 3.1.01

Application Number: 11827111.3

Publication Number: 2619737

IPC: G08B13/14, H01Q1/44

Language of the proceedings: EN

Title of invention:
DISPLAY FOR HAND-HELD ELECTRONICS

Applicant:
Mobile Tech, Inc.

Relevant legal provisions:
EPC R. 139 sentence 1
EPC Art. 87(1)

Keyword:
Correction of error (no) - omission of priority declaration - after publication - detection of the mistake in the priority document

Decisions cited:
J 0006/91, J 0011/92, J 0002/03, J 0003/91, J 0002/92

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Juristische Beschwerdekammer

Legal Board of Appeal

Chambre de recours juridique

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: J 0015/18 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 22 May 2019

Appellant: (Applicant)	Mobile Tech, Inc. 5665 Meadows, Suite 150 Lake Oswego, OR 97035 (US)
Representative:	Mewburn Ellis LLP City Tower 40 Basinghall Street London EC2V 5DE (GB)
Decision under appeal:	**Decision of the Receiving Section of the European Patent Office posted on 27 March 2018 refusing the request for correction of the PCT / US2011/037235 request form (later European application No.11827111.3) pursuant to Rule 139 EPC.**

Composition of the Board:

Chairman	W. Sekretaruk
Members:	A. Jimenez
	B. Müller

Summary of Facts and Submissions

I. This is an appeal against the decision of the Receiving Section, sent with reasons on 27 March 2018, to refuse the request dated 6 July 2017 pursuant to Rule 139 EPC to correct the PCT request form with respect to international application PCT /US2011/037235 (later European application No.11827111.3) by adding a second priority application US12/819,44 of 21 June 2010.

II. A notice of appeal was filed on 21 May 2018, the appeal fees being paid the same day. A statement setting out the grounds of appeal was received on 3 August 2018. The appellant requested that the decision under appeal be set aside and a claim for the priority of US12/819,944 dated 21 June 2010 (P1) be added to the present application.

III. In a communication pursuant to Article 15(1) RPBA, the board informed the appellant of its preliminary opinion that the request for correction under Rule 139 EPC did not appear to be allowable.

IV. In a response to the summons, by letter dated 17 April 2019, the appellant reiterated its request for correction.

V. Oral proceedings were held on 22 May 2019. At the end of the oral proceedings, the chairman announced the board's decision.

VI. The decision of the Receiving Section can be summarised as follows.

It could be accepted that a mistake had been made and that the requested correction reflected the true intention of the applicant.

However, no special circumstances justified the addition of the omitted priority claim, despite the fact that the application had been published without a warning that a request for correction had been made.

- There were no apparent discrepancies on the face of the published PCT application.

- Even taking into account the possibility of consulting the priority documents as filed, third parties would not realise that a second, earlier priority application had been omitted erroneously.

- The simple fact that the priority application P2 was a divisional application did not in itself indicate to the public that a second priority claim was in fact missing.

VII. The arguments of the appellant relevant for the decision were as follows.

The Receiving Section correctly decided that a mistake had been made and that the requested correction reflected the true intention of the applicant.

However, the Receiving Section was wrong to consider that it must be possible for third parties to identify the error from the publication itself. In reality, it was rarely possible to identify an error in a priority claim from the bibliographic data provided on the publication alone. Any assessment of the validity of a

priority claim must include a review of the priority document.

Any third party interested in the patentability or scope of the application would then consult the priority document P2.

- This document was readily available for consultation at the time the subject PCT application was published.

- Third parties would be further encouraged to consult P2 because they would see, from the details of the priority claim in the published PCT application, that the application was filed only eight months after the priority date, i.e. before the expiry of the 12-month period.

The error was obvious in the relevant priority document.

- Any interested third party would ask a qualified person, typically a patent attorney to carry out this inspection of P2. The patent attorney would seek, among other things, to verify that P2 was indeed the first application for the invention. They would therefore inspect the filing details of P2, as set out on pages 37-42. The patent attorney would then see from this section that P2 was in fact a divisional application of P1. This would immediately ("obviously") lead the patent attorney to conclude that an error had been made in the priority claim and that the application should have been filed with a priority of P1.

- P1 was published and thus available for consultation on the publication date.

- The timing error was even more evident given that the PCT application was filed close to the anniversary date of P1. This would establish the intended priority claim for P1 in addition to P2.

The interest of the public would not be adversely affected by the addition of the priority claim to P1.

- The timescale for entry into the regional phase of the PCT patent application was not affected, since the request to enter the EP regional phase was filed precisely 31 months from the priority date of P1.

- No intervening prior art had been cited during the search and examination proceedings.

- Only those who relied on the priority data were likely to be affected by the correction. But they would have consulted the priority document first and ascertained the error.

Reasons for the Decision

Admissibility of the appeal

1. The appeal is admissible. It complies with the requirements of Articles 106 to 108 and Rule 99 EPC.

Request for correction under Rule 139 EPC

2. European patent application No 11827111.3 was filed on 19 May 2011 as international application under the Patent Cooperation Treaty No. PCT/US2011/037235. It claims priority to US application No 12/888,107 (P2) of 22 September 2010. The international application No PCT/US2011/037235 was published on 29 March 2012 under publication No WO2012/039794, and the request for entry into the European regional phase was filed on 21 January 2013.

3. The request for correction relates to the addition of an earlier priority claim to US12/819,944 of 21 June 2010 (P1).

4. Under Rule 139 EPC, first sentence, linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request. A mistake is said to exist in a document filed with the EPO if the document does not express the true intention of the person on whose behalf it was filed. The mistake may take the form of an incorrect statement or it may result from an omission. Correction can take the form of amending the incorrect statement or adding omitted matter (J 8/80, J 6/91).

Presence of a mistake

5. The board concurs with the finding of the Receiving Section that the true intention of the applicant was indeed to claim the priority of P1, in addition to P2.
   - P2 is a divisional application of P1, which means that the subject matter contained in P2 should be disclosed in P1.
   - The relevant deadlines following PCT filing were monitored based on the filing date of P1 on 21 June 2010: the PCT application was filed within the 12-

month period on 19 May 2011, and the request to enter the European regional phase was filed on 21 January 2013, precisely 31 months from the filing of P1.

Conditions for correction of priority data

6. However, with regard to the correction of priority data, the interest of third parties in maintaining legal certainty must be taken into account. Published data must be reliable as such. The established case law requires that the request for correction should be made early enough for a warning to be included in the publication of the application. When no warning is published, only special circumstances may justify the correction at a later stage if the interest of the public is not seriously affected. In case law, this has been accepted in the following circumstances:
   - the discrepancy is apparent on the face of the application as published (J 6/91);
   - the public was otherwise informed about the full scope of the protection (J 11/92: the applicant filed a second application claiming priority of the omitted priority document in due time);
   - other circumstances which guarantee that the interest of the public is not seriously affected: for example if only a subsequent priority was added or if the correction concerned merely typographical errors in the details of the priority declaration (date or file number : J 2/03; J 3/91; J 2/92).

7. In the present case, the request for correction was filed on 6 July 2017, i.e. more than five years after the publication of the international application No PCT/US2011/037235 on 29 March 2012, which then contained no warning that a request for the correction

of the priority data had been made, and more than four and a half years after filing the request for entry into the European regional phase (21 January 2013).

8. The correction concerns the addition of a second earlier priority claim and not merely the correction of typographical errors in the details of the priority declaration.

Detection of the mistake in the PCT application

9. The appellant disagrees with the finding of the Receiving Section that the mistake could not be detected from the publication of the application itself. Rather it considers that third parties would notice from the publication that the parent application was filed only eight months after the filing date of P2, i.e. before the expiry of the 12-month period, which would prompt them to consult the priority document and find out the divisional status of P2.

10. The board cannot follow this reasoning: Article 87 (1) EPC does not require the parties to make full use of the twelve-month period from the date of filing of the first application. The fact that the priority year was not exploited in full can therefore not be seen as a discrepancy regarding the details in the priority declaration or even as an incentive for the public to consult the priority document. The board therefore agrees with the Receiving Section's analysis that, on the basis of the published PCT application, third parties could not detect any error concerning the priority claim: there are no apparent discrepancies regarding the priority data. The PCT application is of US origin, in line with the claimed priority US

12/888,107 (P2), and its filing date (22 September 2010) lies within the priority period.

Consultation of the priority document and definition of relevant third parties

11. The appellant is however of the opinion that any third party interested in the patentability or scope of the application would consult the priority document, which was readily available for consultation at the time the relevant PCT application was published.

12. At this point, it is necessary to consider the definition of the relevant "public" or "third party" who would consult the published PCT application. According to the appellant, the relevant "public" is defined as a qualified person, typically a patent attorney, who would assess the validity of the priority claim and therefore consult the priority document. Taking into account the primary purpose of the publication of the application, which is mainly to disclose technical information in order to foster innovation, the board considers that the published application would first be consulted by a person skilled in the art. That person would look for technical information in the field of the invention. They would closely review the technical content of the published application, as well as the details of the priority declaration, to determine the full scope of protection. But unless an obvious discrepancy regarding the details of the priority declaration prompts this, the person skilled in the art would rely on the published data without consulting the priority document.

13. The board also does not agree with the appellant's statement that the interest of the public would not be adversely affected by the addition of the priority claim to P1. The request for correction relates to the addition of a previous priority claim, which would then modify the relevant period of protection and may therefore affect the interest of any person interested in the invention, whether or not they have consulted the priority document and even if no intervening prior art has been cited during search and examination proceedings.

14. The question of whether a patent attorney would detect the error by inspecting the priority document is therefore irrelevant. It can be accepted that such a qualified person seeking to assess the validity of the priority claim would consult P2 and realise that it is a divisional application from P1 and therefore that P2 is not the "first application" for the relevant subject-matter. But it is not sufficient that the mistake may be detected after consulting the priority document : the published data as such must be reliable on the publication date.

Conclusion

15. The board comes to the conclusion that there are no special circumstances which would justify making an exception to the general rule that a request for correction should be made sufficiently early for a warning to be included in the publication of the application. The finding of the Receiving Section in the decision under appeal is therefore justified.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

C. Eickhoff W. Sekretaruk

Decision electronically authenticated