

J 03/81

Articles 122, 150(3) Rule 88 EPC
Articles 4(1)(ii), 26 Rule 4.1(ii)(iv)PCT

"international application" "correction of mistake" ✓
"public interest" ✓ "re-establishment of rights" ✓ "payment of fee" ✓

HEADNOTE

- I. If a mistake is made in designating States in a European patent application, then, in general, a request for correction of the mistake by adding the designation of another State must be refused, in the public interest, if it is not made until it is too late to add to the application as published a warning to third parties that the request has been made.
- II. Where an international application filed under the PCT is deemed to be a European patent application, the same general rule must apply mutatis mutandis, even though publication of the international application by the International Bureau necessarily precedes the time at which the applicant can request the EPO to correct any mistake in the application.
- III. Where the EPO has funds standing to the credit of any person, a fee for re-establishment of rights which that person has to pay can only be considered to have been paid when the EPO has been instructed to allocate the appropriate amount to the payment of that fee.



Case N°. J 03/81

DECISION

of 7 December 1981

Appellant: BODENRADER, Bonnie J.
11 Castle Heights Road
Andover
Massachusetts 01910
United States of America

Representative: Woodcraft, David Charles
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Decision under Appeal: Decision of the Receiving Section of the European Patent Office dated 12 November 1980 rejecting requests for correction of a mistake in designating States or alternatively for re-establishment of rights in respect of European Patent Application N°. 80 900 028.4

Composition of the Board:

R.Singer, Chairman
P.Ford, Member
L.Gotti Porcinari, Member

SUMMARY OF FACTS AND SUBMISSIONS

- I. By letter dated 18 October 1979 the appellant instructed a United States Patent Attorney to file an international application under the PCT, designating the Soviet Union, Japan, Denmark and "all countries available thru and for the European Patent Convention".
- II. On 26 October 1979, the Patent Attorney, who had no previous experience of filing international applications under the PCT, consulted the United States Patent and Trademark Office by telephone about the designation of States and recorded in a memorandum, which has been produced in evidence, that he had been advised that "for regional protection for all member countries a single state with the notation "regional patent" would be sufficient". It does not appear that he read Article 4(1)(ii) PCT or Rule 4.1(b)(iv)PCT at the time. Accordingly, acting on his understanding of the advice he had been given, the Patent Attorney included in the appellant's international application, filed in the U.S.A. on 16 November 1979, the designation "United Kingdom - regional patent", believing that he had thereby designated all available EPC Contracting States. Priority was claimed from a United States patent application filed on 27 November 1978.
- III. On 3 January 1980, the International Bureau of WIPO sent a notification to the EPO that the record copy of the international application had been received (Form PCT/IB/302). This form notified the EPO that a regional patent was sought for the United Kingdom only and that the EPO would act as designated Office for that application. Simultaneously, the International Bureau sent a notification to the Patent Attorney (Form PCT/IB/301), which, according to the International Bureau (letter of 28 July 1980), clearly indicated that only the United Kingdom had been designated for a regional (European) patent.

- IV. On 29 May 1980, the international application was published by the International Bureau with the designation "United Kingdom - regional patent" amended to "GB (European patent)".
- V. On 25 June 1980, the Patent Attorney read PCT Gazette No.12/1980 (dated 29 May 1980), which contained details of the appellant's international application. He noticed that other international applications which designated States for which a European patent was desired, identified each such State. He then realised, for the first time, that he had made a mistake and he immediately instructed the appellant's European professional representative in England to act for the appellant in the processing of the international application in its regional phase and in particular to seek to correct the mistake in only designating one Contracting State for the European patent.
- VI. On 26 June 1980, the European professional representative in England notified the EPO by telephone that the mistake had been made and on 7 July 1980 he gave instructions to the EPO by telex (duly confirmed by letter dated 10 July 1980) for the payment of ten designation fees (subsequently reduced to eight).
- VII. On 22 July 1980, the appellant's European professional representative wrote to the EPO requesting correction of the designation "GB (European patent)" under Rule 88 EPC by the addition of seven other EPC Contracting States or alternatively re-establishment of rights under Article 122 EPC.
- VIII. With a letter dated 10 October 1980 the appellant's European professional representative filed affidavits stating the facts of the case and sworn respectively by the appellant, a United States Attorney who manages the business and legal affairs of the appellant and the appellant's United States Patent Attorney. A further affidavit by the United States Patent Attorney was filed on 3 June 1981.

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- IX. By a decision dated 12 November 1980, the Receiving Section of the EPO rejected both requests. The request for correction was rejected on the grounds that (a) the error was only with respect to the legal consequences of the procedural step taken and (b) the request was submitted at a very late stage of the procedure, after publication of the international application, so that acceding to such a request would cause uncertainty and leave third parties unprotected by rights of continued use provided for in the EPC. The request for re-establishment of rights was rejected on the ground that the appellant had not failed to observe a time limit.
- X. Notice of appeal was filed by telex dated 31 December 1980 (duly confirmed by letter dated 7 January 1981) and the appeal fee was duly paid. A Statement of Grounds of Appeal was filed on 11 March 1981. It was contended therein that the mistake could be corrected under Rule 88 EPC in conformity with the decisions of the Legal Board of Appeal in Cases J08/80 (Official Journal EPO, 1980, 293) and J04/80 (Official Journal EPO, 1980, 351). So far as the question of public interest was concerned, the appellant argued that the request for correction had not been made, as the Receiving Section considered, at a very advanced stage of the procedure. Rule 88 EPC contains no time limits and a file inspection would have alerted a third party to the possibility of amendment of the designations. So far as re-establishment of rights was concerned, the Receiving Section had been inconsistent: they had said that no time limit was involved and yet that the appellant was trying to extend the time limit for designation of States. Third party rights of intervening users could be protected by application of Article 122(6) EPC. The appellant requested a hearing.
- XI. On 13 May 1981, the Legal Board of Appeal confirmed by telex the appellant's suggested hearing date of 11 June 1981 and drew attention to two matters which seemed to be of special

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importance, namely: (a) that this was the first case in which correction of a mistake of law-interpretation of a treaty - was sought and that it might be right to apply the principle that everyone is presumed to know the law, (b) that it was not clear that re-establishment of rights lost in the international phase was authorised under the PCT and that it was difficult to say that there was a "time limit" when States had to be designated at the moment of application.

XII. At a hearing held on 11 June 1981, the appellant's European professional representative contended that the appellant's written submissions on the subject of re-establishment of rights were correct. So far as the request for correction was concerned, the unchallenged evidence indicated that the appellant had given clear instructions to designate all Contracting States of the EPC and that her United States Patent Attorney had understood and attempted to carry out those instructions. The procedure was unfamiliar and complicated. The Patent Attorney had either misunderstood, or been given wrong advice by, the United States Patent and Trademark Office. Immediate steps had been taken to correct the mistake as soon as it was noticed. The mistake was an omission and the application did not express the applicant's true intention. Thus it could be corrected in accordance with the decision in Case J08/80. The original designation "United Kingdom - regional patent" was clearly ambiguous and no one would have expected a PCT application to designate the EPO in respect of a single Contracting State. The appellant's conduct in promptly seeking correction and disclosing all material facts had been exemplary. The principle that everyone is presumed to know the law should not be applied in a case of procedural error: it was not applied in cases of procedural error before the English civil courts. In Case J06/79 (Official Journal EPO 1980, 225) the Legal Board of Appeal had granted re-establishment of rights where inaccurate information given by the EPO had caused an applicant for an international application to fail to observe a time limit. The present case was comparable.

XIII. Shortly before the hearing, it came to the attention of the Legal Board of Appeal that there was no record that the fee of DM100 for re-establishment of rights had been paid. The Board allowed the question of re-establishment of rights to be argued at the hearing on the provisional assumption that the fee had been paid. However, on 3 July 1981 the appellant's European professional representative wrote to the EPO, in effect acknowledging that he had not previously given instructions for the fee to be taken from funds standing to the credit of the appellant and asking for this to be done retrospectively by adjustment of the records.

REASONS FOR THE DECISION

1. The appeal complies with Articles 106-108 and Rule 64 EPC and is, therefore, admissible.
2. Article 122(3) EPC provides that an application for re-establishment of rights shall not be deemed to be filed until after the fee for re-establishment of rights has been paid. Furthermore, Article 122(2) provides that the application must be filed within two months from the removal of the cause of non-compliance with the time limit and is only admissible within the year immediately following the expiry of the unobserved time limit.

In the opinion of the Board, if the EPO has funds standing to the credit of the applicant, then instructions may be given to allocate the appropriate amount to the payment of the fee for re-establishment of rights, but it would be clearly inconsistent with the provisions of Articles 122(2) and (3) EPC to allow such instructions to have retrospective effect.

In this case, no instructions were given until July 1981, although any unobserved time limit must have expired in or before June 1980. It follows that there was no valid application for re-establishment of rights before the Receiving Section or before the Legal Board of Appeal. Accordingly, that matter cannot be further considered.

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3. The question of correction of a mistake in designation of States under Rule 88 EPC has previously been considered by the Legal Board of Appeal in three Cases: J 08/80, J 04/80 and J 12/80.

In Case J 12/80 (Official Journal EPO, 1981, 143), the Board dealt with the point that the application for the European patent was published in its uncorrected form while the appeal was pending. The Board considered the question of public interest raised by this publication, as there was an unavoidable risk that a third party might have started to use the invention in the State which the appellant had failed to designate after publication but before the Board had decided the case. It was considered that it would not be right to refuse correction in the public interest, if the appellant was otherwise entitled to it, as the appellant had no control over the intervening publication.

4. The present case is, however, the first case in which no application for correction was made until after publication. The Receiving Section considered that this fact furnished one valid reason for refusing to allow correction of the mistake. The Legal Board of Appeal agrees with the view of the Receiving Section. The appellant has contended, correctly, that Rule 88 EPC contains no time limits, but Rule 88 EPC must be considered in the context of the European Patent System as a whole. Time limits are imposed by many provisions of the Convention and it is clear that they are imposed in the public interest. Indeed, non-observance of some of these time limits cannot be remedied.
5. The possibility that there may be inherent time limitations on a request for correction was referred to in Case J 08/80 and becomes critically important in the present case. Correction after publication of incomplete designations is most undesirable as the public should be able to rely on the publication itself. In the circumstances of Case J 12/80 the Board allowed correction of a designation which had been published because the appellant had applied for correction in good time before publication but the EPO itself had committed the error of publishing while the case was sub judice without even warning the public that a request for correction of a mistake in designating States had been made. In Cases J 08/80

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and J 04/80 publication also took place while the appeals were pending but this fact did not come to the attention of the Board in either case.

6. The Board is not impressed by the present appellant's argument that the existence of an application for correcting a mistake in designation can be ascertained by inspection of the file. Third parties the world over cannot be expected to undertake constant file searches in case designations have been omitted. The Board considers that the general rule must be that a request for correction of a mistake in designating States in a European patent application by adding the designation of another State must be refused, in the public interest, if it is not made until it is too late to add to the application as published a warning to third parties that the request has been made.
7. The present case concerns an international application which is treated as a European patent application by virtue of the provisions of Article 150 EPC. Such an application is conveniently, but not officially, termed a "Euro-PCT" application.
8. Article 26 PCT entitles an applicant for a Euro-PCT application to have an opportunity to correct his application to the extent and according to the procedure provided by the EPC for applicants for European patents. Article 26 PCT speaks of the rejection of an application. In the opinion of the Board, rejection of a designation of a State is within the scope of the Article.

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9. The question arises whether the general rule stated in paragraph 6 above must be applied to a Euro-PCT application? Every Euro-PCT application is published by the International Bureau before the time is reached at which the applicant can request the EPO to correct any mistake in the application under Rule 88 EPC. The Board considers that the general rule must apply, in the public interest, bearing in mind that an applicant for a Euro-PCT application is not entitled under Article 26 PCT to greater rights than an applicant for a European patent enjoys under the EPC.

The applicant can ask the International Bureau to ensure that public attention is drawn to the alleged mistake and the desired correction, when the application is published. There will then be no overriding factor of public interest against a request for correction under Rule 88 EPC.

10. In the present case, no request for correction was made until after publication and it was, therefore, too late. It is unfortunate for the present appellant that the mistake was not noticed in January 1980 when, in accordance with standard PCT procedure, the appellant's United States Patent Attorney was sent Form PCT/IB/301, which showed clearly that only the United Kingdom had been designated for a regional (European) patent. If some appropriate action had been taken at that time it might have been possible to consider further the appellant's request under Rule 88 EPC.
11. It follows that the question whether correction should be permitted when a mistake in designating States is due to an error of law does not have to be decided for the purposes of the present case.

For these reasons,

it is decided that:

The appeal against the Decision of the Receiving Section of the European Patent Office dated 12 November 1980 is dismissed.