

Aktenzeichen: J 04/82
Case Number:
N° du recours :

82,385

ENTSCHEIDUNG / DECISION
vom / of / du 21 July 1982

Anmelder: YOSHIDA KOGYO K.K.
Applicant:
Demandeur :

Stichwort: priority declaration / Yoshida
Headword:
Référence :

EPÜ/EPC/CBE Article 88(1); Rules 38(1), 41(2), (3), 67, 88
Paris Convention Article 4 D(1), (2)

"correction of mistakes" - "declaration of priority" - "public interest" - "substantial procedural violation" - "reimbursement of appeal fee"

Leitsatz / Headnote / Sommaire

- I. If a mistake is made in a declaration of priority it may be corrected in accordance with Rule 88 EPC, provided that a request has been made for correction sufficiently early for a warning to be included in the publication of the application.

- II. Where a department of the EPO is informed by an applicant's representative that information and evidence will be submitted in support of an application for correction under Rule 88 EPC as soon as it is available, the department may commit a substantial procedural violation if it issues a decision without having fixed a time limit for the submission or having waited for a reasonable time.

Europäisches
Patentamt

Juristische
Beschwerdekammer

European Patent
Office

Legal Board
of Appeal

Office européen
des brevets

Chambre de
recours juridique



Case No. J 04/82

DECISION

of 21 July 1982

Appellants:

YOSHIDA KOGYO K.K.
No. 1 Kanda Izumi-cho Chiyoda-ku
Tokyo
Japan

Professional representative:

Devons, David Jon
Marks & Clerk
57-60 Lincoln's Inn Fields
LONDON WC2A 3LS
England

Decision under appeal:

Decision of the Receiving Section
of the European Patent Office dated
30 March 1982 rejecting a request
to correct a mistake in the request
for grant filed on European patent
application No. 81305962.3 by adding
a further convention date to the one
claimed in part VII thereof on the
date of filing.

Composition of the Board:

Chairman : R. Singer

Member : P. Ford

Member : L. Gotti Porcinari

SUMMARY OF FACTS AND SUBMISSIONS

- I. On 18 December 1981, a firm of professional representatives, practising in England, filed European patent application No. 81305962.3 on behalf of the appellants, acting on the written instructions of the appellants' Japanese patent attorneys. Priority was claimed, in accordance with these instructions, from a single national patent application filed in Japan on 25 December 1980.

- II. By oversight, the Japanese patent attorneys' instructions to the professional representatives omitted to state that the appellants had ordered that priority should be claimed also from a second national patent application filed in Japan on 5 January 1981.

- III. On 28 January 1982, the Japanese patent attorneys, having discovered the omission, immediately notified the professional representatives by telex. On 1 February 1982, the professional representatives wrote to the Receiving Section of the EPO asking whether it would be possible to claim a second priority date, but not alleging that any mistake had been made. According to a note in the file, on 5 February 1982, the professional representatives were informed by the Receiving Section, by telephone, that it was not possible to add a second priority.

- IV. On 10 March 1982, the professional representatives sent to the Receiving Section certified copies of both sets of priority documents, alleging, in their accompanying letter, that they had not received a reply to their letter of 1 February 1982 and stating that they were informed by the Japanese patent attorneys that the second priority had been omitted purely as a result of a mistake and that evidence was being assembled to prove this. The professional representatives stated that they would supply further information and evidence as soon as it was available, so that the mistake could be corrected in accordance with Rule 88 EPC.

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- V. On 30 March 1982, the Receiving Section issued the decision under appeal, rejecting the request for correction on the ground that there was no reference to more than one claim of priority at the time of filing the application.
- VI. Under cover of a letter dated 11 May 1982, the professional representatives filed a notice of appeal and a statement of grounds of appeal and evidence in the form of affidavits. The appeal fee was duly paid.
- VII. In their notice of appeal, the appellants requested cancellation of the decision under appeal, allowance of the request for correction and refund of the appeal fee.
- VIII. In their statement of grounds, the appellants alleged that, as was stated in the accompanying affidavits, the omission to instruct the professional representatives to claim the second priority was due to mistakes in the office of the Japanese patent attorneys. The relevant file record had not been amended to conform with written instructions to claim the second priority received from the appellants in November 1981; these instructions had not been given to the secretary who had to prepare the relevant letter of instructions to the professional representatives, which she had written according to the file record; and the attorney who had signed that letter had failed to spot the omission. The appellants contended that they had applied to correct the error promptly and before publication of the application. They also drew attention to the fact that they would be allowed to add the second priority for corresponding national applications in Australia, Canada and the USA.
- IX. The affidavit evidence of the Japanese patent attorney concerned, which is accompanied by relevant documents and sworn translations thereof, establishes the facts as to the instructions given to him by the appellants and the making of the mistake in his

office and that he only became aware of the failure to claim the second priority on 28 January 1982, when he found the appellants' written instructions of November 1981 amongst papers on his desk and not in the relevant file. The evidence also includes exchanges of telex messages with the professional representatives and with patent attorneys handling the corresponding national applications in Australia, Canada and the USA.

REASONS FOR THE DECISION

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC, and is, therefore, admissible.
2. This is the first case in which the Legal Board of Appeal has had to consider a request for correction of a declaration of priority. Rule 88 EPC, first sentence, provides in very general terms for correction on request of mistakes in any document filed with the European Patent Office. A declaration claiming the priority of an earlier application has to be included in the request for grant of a European patent (cf. Rule 26(2)(g) EPC). Correcting a mistake in the request for grant does not have to be obvious within the meaning of Rule 88 EPC, second sentence, since it does not concern a description, claims or drawings. It follows that a mistake concerning a declaration of priority may be corrected under Rule 88 EPC, first sentence, unless there are any other provisions of the EPC or any overriding principles which exclude such correction.
3. Nothing in the EPC expressly prohibits correction of mistakes made when claiming priority.

Rule 41(2) EPC relieves the Receiving Section of the EPO of any obligation to inform the applicant, and to give him the opportunity to remedy the deficiencies, if the examination as to formal requirement reveals that the applicant, while

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claiming priority, has omitted to indicate the date or State of first filing. At the Munich Diplomatic Conference, the Chairman of Main Committee I, in answer to a question put by the FICPI delegation, said that an incorrect indication of the date or State of first filing could be corrected in accordance with Rule 88 EPC. He pointed out that the Main Committee shared this view: Minutes of the Munich Diplomatic Conference for the setting-up of a European system for the Grant of Patents, page 92, M/PR/I, paras 2242-3.

Rule 41(3) EPC obliges the Receiving Section of the EPO to inform an applicant, and give an opportunity for correction, if the examination reveals that the date of first filing given on filing the European patent application precedes the date of filing by more than one year.

It follows that the special provisions of Rule 41 EPC cannot be interpreted as excluding correction of mistakes made when claiming priority. No other provisions of the EPC appear to be relevant to the matter in any way.

4. The question arises whether, even though the Paris Convention may not be applied directly (cf. decision of the Legal Board of Appeal of 11 June 1981 in Case No. J 15/80; Official Journal EPO 1981, 230), it has the indirect effect of imposing relevant time limits on claiming priority. Article 4 D(1) of that Convention prescribes that each country shall determine the latest date on which the declaration of priority must be made and Article 4 D(2) provided that particulars of the declaration shall be published in the publications of the competent authority, in particular in the patent specification. Bodenhausen has pointed out that "lack of such publication will not, however, invalidate the right of priority (Actes de Washington, page 307)": Bodenhausen, Guide to the Application of the Paris Convention, BIRPI 1968, 49, para. (f).

Some countries do in fact permit a declaration of priority to be made after the date of filing of the application to which it relates. It is clear, therefore, that there is no overriding principle of a time limit in the Paris Convention which might conflict with retrospective correction under Rule 88 EPC of a mistake in a declaration of priority.

5. As the Legal Board of Appeal has previously held in Case No. J 08/80 (Official Journal EPO, 1980, 293), for the purposes of Rule 88 EPC, a mistake may be said to exist in a document filed with the European Patent Office if the document does not express the true intention of the person on whose behalf it was filed. Correction can take the form of adding omitted matter.
6. However, before the Office can accede to a request for correction of a mistake it must be satisfied that a mistake was made, what the mistake was and what the correction should be. In cases, such as the present, where the making of the alleged mistake is not self-evident, the burden of proving the facts is a heavy one. The evidence in this case is detailed and clear and well supported by documents. The Legal Board of Appeal finds it convincing.
7. In the present case, the applicants' intention to claim the second priority is clear from the written instructions to the Japanese patent attorneys dated 9 November 1981 and stamped as having been received by them on the following day. These instructions are included in the comprehensive documentation which accompanies the affidavit evidence filed.
8. The way in which the mistake was made in the Japanese patent attorneys' office is clearly explained. It is also evident that the appellants, the Japanese patent attorneys and the professional representatives all acted promptly to rectify the mistake.

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9. There can be no danger to the public interest if correction of the mistake is allowed. Although the application was published on 14 July 1982, the specification included on its front page a warning that a request had been made for correction under Rule 88 EPC for the purpose of adding the second priority claim. The same information was published as an annexe to the European Patent Bulletin No. 82-28 dated 14 July 1982. Furthermore, the search report cannot be regarded as misleading, because the second priority claim is of later date than the first.

10. The decision under appeal was made without any reference to the established case law of the Legal Board of Appeal relating to correction of mistakes under Rule 88 EPC in designation of contracting States (Cases Nos. J 08/80, Official Journal EPO 1980, 293; J 04/80, Official Journal EPO 1980, 351; J 12/80, Official Journal 1981, 143; J 03/81, Official Journal EPO 1982, 100). It did not take into consideration the requirements of Rule 88 EPC and, therefore, it must be set aside.

11. The professional representatives indicated in their letter of 10 March 1982 that they would be submitting information and evidence in support of their request for correction of a mistake under Rule 88 EPC. The decision under appeal was given on 30 March 1982 before the appellants had had a reasonable opportunity to submit the information and evidence, which, in the circumstances, had to be sent from Japan. Article 114(2) EPC gives the EPO a discretion to disregard facts or evidence which are not submitted in due time. However, facts or evidence which are submitted in due time must be considered. In the present case, the Receiving Section had been informed that information and evidence would be submitted as soon as it was available. The Receiving Section could either have fixed a time limit for the submission or waited for a reasonable time. It did neither and, therefore, the decision under appeal was issued prematurely. It follows that there was a substantial procedural violation, within the meaning of Rule 67 EPC, which makes it equitable to order reimbursement of the appeal fee.

For these reasons,

it is decided that:

- (1) The Decision of the Receiving Section of the European Patent Office dated 30 March 1982 is set aside.
- (2) It is ordered that the request for grant form filed on European Patent Application No. 81305962.3 is to be corrected by adding a reference to Japanese Patent Application No. 4 of 5 January 1981 in field VII of page 2 thereof.
- (3) It is ordered that the appeal fee be reimbursed to the appellants.