

Aktenzeichen:  
Case Number: J 13/82  
N° du recours :

83, 12

ENTSCHEIDUNG / DECISION  
vom / of / du 18 October 1982

Anmelder:  
Applicant: General Datacomm Industries, Inc.  
Demandeur :

Stichwort:  
Headword: Correction of description / General Datacomm  
Référence :

EPÜ / EPC / CBE

Article 78(1) (b), Rule 88  
"Correction of mistakes" - "Appendix to description"

Leitsatz / Headnote / Sommaire

- I. Rule 88, second sentence, EPC, requires that a correction to the description filed on a European patent application must be obvious, in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction. This requirement is not satisfied in a case in which the mistake to be corrected consists of an omission and the omitted matter is also missing from priority documents filed with the EPO, at the time when the request for correction is received.
- II. The facts that the omitted matter is on file at the national industrial property office concerned and that a copy of it was in the possession of the applicant's representative, are, in this respect, without significance.



Case Number: J 13 / 82

**DECISION**  
of the Legal Board of Appeal

of 18 October 1982

**Appellant:**

General Datacomm Industries, Inc.  
One Kennedy Avenue,  
Danbury, Connecticut  
U.S.A.

**Representative:**

William Potter McCallum  
Messrs. Cruikshank & Fairweather  
19, Royal Exchange Square  
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G1 3AE  
Scotland  
Grande Bretagne

**Decision under appeal:**

Decision of the Receiving Section  
of the European Patent Office dated  
6 April 1982 rejecting a request to  
correct a mistake in the description  
filed on European patent application  
N°.82300154.0, by adding an "Appendix".

**Composition of the Board:**

**Chairman:**

R. Singer

**Member:**

P. Ford

**Member:**

L. Gotti Porcinari

SUMMARY OF FACTS AND SUBMISSIONS

- I. On 12 January 1982, European patent application N°.82300154.0 was filed by the appellant's representative, claiming priority from an application for a US national patent filed on 12 January 1981.
- II. On 29 January 1982, the applicant's representative sent to the Receiving Section three copies of an "Appendix" consisting of 14 sheets of computer print-out which had been omitted from the description as filed.
- III. On 5 February 1982, a certified copy of US Patent application N°.224339 of 1 December 1981, was filed. The certified copy did not include any "Appendix".
- IV. By letter dated 17 February 1982, the Receiving Section informed the appellant that the "Appendix" could not be accepted as an amendment since it was filed prior to the receipt of the search report (Rule 86(1) EPC).
- V. On 24 March 1982 the appellant replied submitting that the "Appendix" had been inadvertently omitted from the description and that its late filing did not constitute an amendment in the sense of Article 123(2) and Rule 86(1)EPC. The attention of the Office was also drawn to the fact that the "Appendix" sent on 29 January 1982 was identical to that included in the priority documents. Correction in accordance with Rule 88 EPC was requested.
- VI. On 6 April 1982 the Receiving Section issued the decision under appeal, rejecting the request for correction on the grounds that on the date of filing of the application it was evident that the "Appendix" mentioned on page 27 of the description was missing but that it was not obvious what the correction should have been. Furthermore, contrary to the appellant's assertion, this Appendix was not included in the certified copy of the US priority documents, received on 5 February 1982.

.../...

VII. On 2 June 1982, the appellant's representative filed a notice of appeal against the decision of the Receiving Section. The appeal fee was duly paid. In the statement of grounds, filed on 29 July 1982, it was submitted that Rule 88 EPC is applicable because it appears obvious from the documents that the "Appendix" had been omitted. The fact that the "Appendix" was in the representative's office at the time of filing the European patent application, was verified by a sworn declaration from the clerk responsible for the filing of the application. The appellant contends that as the "Appendix" was actually on file at the U.S. Patent Office, even though it was not filed with the EPO at the date of filing the European patent application, this was sufficient for the purposes of Rule 88 EPC. The appellant requested that the decision of the Receiving Section should be cancelled and that the appeal fee should be reimbursed.

Reasons for the decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. The Legal Board of Appeal has previously decided, in Case N° J 08/80, on 18 July 1980 (Official Journal EPO, 1980, page 293), that mistakes within the meaning of Rule 88 EPC can consist of omissions.
3. An "Appendix" of the kind with which this appeal is concerned must be regarded as part of the description, according to Article 78(1)(b) EPC.
4. Correction of the description is dealt with in Rule 88, second sentence, EPC, which expressly refers to such a possibility and prescribes conditions under which correction may be permitted. In particular, the correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction.

5. This condition is not satisfied in the present case. Although at page 27, lines 16-23, of the description reference is made to a "program..... furnished as an appendix to this application", it is not immediately evident that the missing document was incontrovertibly the "Appendix" submitted on 29 January 1982. The "Appendix" forming part of the priority documents was not available to the EPO. The facts that the "Appendix" was on file at the U.S. Patent Office and that a copy of it was in the possession of the appellant's representative are in this respect without significance.
6. As the conditions for application of Rule 88 EPC are not satisfied the Decision of the Receiving Section must be affirmed.
7. As the appeal is rejected, no reimbursement of the appeal fee can be ordered.

For these reasons,

it is decided that:

The Appeal against the Decision of the Receiving Section of the European Patent Office dated 6 April 1982 and the application for reimbursement of the appeal fee are dismissed.

The Registrar:

The Chairman: