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Aktenzeichen / Case Number / N° du recours : J 19/87

Anmeldenummer / Filing No / N° de la demande : 84 305 049.3

Veröffentlichungs-Nr. / Publication No / N° de la publication :

Bezeichnung der Erfindung: Apparatus and methods for analogue-to-digital and  
Title of invention: digital-to-analogue conversion  
Titre de l'invention :

Klassifikation / Classification / Classement : H03M 1/20

**ENTSCHEIDUNG / DECISION**  
vom / of / du 21 March 1988

Anmelder / Applicant / Demandeur : Burr-Brown-Corporation

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Assignee/Burr-Brown

EPU / EPC / CBE Articles 87(1), 88(1)

Kennwort / Keyword / Mot clé : "Claim for priority - successor in title"

Leitsatz / Headnote / Sommaire

Europäisches  
Patentamt  
Beschwerdekammern

European Patent  
Office  
Boards of Appeal

Office européen  
des brevets  
Chambres de recours



Case Number : J 19/87

**D E C I S I O N**  
of the Legal Board of Appeal  
of 21 March 1988

**Appellant :** Burr-Brown Corporation  
67 30 S. Tucson Blvd.  
Tucson, Arizona 85706  
USA

**Representative :** Boon, Graham Antony  
Elkington and Fife  
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**Decision under appeal :** Decision of the Receiving Section of  
the European Patent Office dated  
8 January 1987 refusing a request for  
correction under Rule 88 EPC

**Composition of the Board :**

**Chairman :** P. Ford  
**Members :** G.D. Paterson  
E. Persson

## Summary of Facts and Submissions

- I. On 29 July 1983 Mr Belcher filed United Kingdom patent application No. 8 320 534. By an assignment dated 8 November 1983, Mr Belcher assigned to National Research and Development Corporation (NRDC) his rights in the invention and in the UK patent application, together with the right to file further patent applications in respect of the invention and the right to claim priority from the UK application.
- II. By an assignment under seal dated 25 June 1984, which was signed by NRDC but not by Mr Belcher, NRDC assigned back to Mr Belcher the rights in the invention and the UK application, and agreed that the assignment dated 8 November 1983 was void and of no further effect.
- III. On 25 July 1984 Mr Belcher filed European patent application No. 84 305 049.3, claiming priority of 29 July 1983 from the UK application.
- IV. By an assignment dated 5 October 1984, Mr Belcher assigned the UK application and the European application to the Appellant. This assignment was recorded.
- V. By a letter dated 6 February 1986, the Appellant requested that the applicant for the European application be corrected so as to be in the joint names of NRDC and Mr Belcher, under Rule 88 EPC. The reason for this request was stated to be:
  - (a) that Mr Belcher had been informed that the assignment dated 25 June 1984 was void having regard to the requirement in Section 30(6) of the UK Patents Act 1977 that "any assignment ... of a patent or ...

application ... shall be void unless it is in writing and is signed by or on behalf of the parties to the transaction ...". As stated in II above, such assignment had not been signed by Mr Belcher;

- (b) that the European application contained inventive matter extending beyond the disclosure of the UK application, which had originated with Mr Belcher. Having regard to Article 87(1) EPC and because the assignment dated 25 June 1984 was void, the European application should have been filed in the joint names of NRDC and Mr Belcher.

- VI. Evidence from Mr Belcher was filed in support of the request under Rule 88 EPC.

During detailed correspondence between the Receiving Section and the Appellant, in a Communication dated 1 August 1986, the Receiving Section set out grounds on which it was likely that the request under Rule 88 EPC would be refused. It was also pointed out that having regard to Mr Belcher's evidence to the effect that the assignment dated 25 June 1984 was void, the EPO "must assume that he had no rights whatsoever to the UK application" at the date of filing of the European application, 25 July 1984; but that "the only way of ensuring acknowledgement of the priority right would be by producing facts, evidence and arguments or a decision of the competent national authority (the Comptroller) in support of a conclusion to the contrary, i.e. that Mr Belcher, at the point in time when filing the European application, had a right to the UK application, or at least to the respective priority. This is entirely left to the initiative of the applicant".

No such facts, evidence or argument in support of such a conclusion were filed by the Appellant in response to this Communication.

- VII. A Decision of the Receiving Section was issued on 8 January 1987, in which the request for correction of the application under Rule 88 EPC was rejected.

A Notice of Appeal was filed on 7 March 1987, and a statement of grounds of appeal was filed on 12 May 1987, together with further evidence in the form of three Statutory Declarations in support of the application under Rule 88 EPC.

- VIII. In a communication from the rapporteur dated 5 November 1987, it was suggested that the application under Rule 88 EPC was not necessarily the appropriate means to the end which the Appellant desired, namely, that a valid claim to priority from the UK application could be made. The Appellant was invited, pursuant to Article 114(1) EPC, to file a legal opinion, preferably from an independent legal expert, setting out the true effect in English law of the contract under seal dated 25 July 1984. It was pointed out that it is essential that in proceedings before the EPO any relevant national law should be properly established and proved by a party to such proceedings.

In response, the Appellant filed an "Opinion" from an English patent barrister. This stated that, as a matter of English law, the effect of the assignment dated 25 June 1984 was that from that date, Mr Belcher was a "successor in title" to the inventor (also Mr Belcher) in relation to the right to apply for a European patent, and in relation to the right to claim priority from the UK application.

The Appellant also stated in response to a question from the rapporteur, that if it was held that the European application could validly claim priority from the UK application, the Appellant did not wish to pursue the request for correction under Rule 88 EPC.

#### Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC, and is admissible.
2. The application under Rule 88 EPC to correct the information identifying the applicant as set out on the application form was based upon the Appellant's belief, derived from some advice that he had received, that as a matter of English law, the assignment dated 25 June 1984 was void and had no legal effect because it had not been signed by Mr Belcher. However, according to the fully reasoned expert opinion referred to in paragraph VIII above, which the Board accepts as correctly representing the relevant English law, this assignment did have certain legal effects in spite of the fact that it had not been signed by Mr Belcher. In particular, after this assignment was executed on behalf of NRDC on 25 June 1984, Mr Belcher became the owner of the invention, and became entitled in equity to the UK application. As such, he was entered on the Register of Patents in the UK.

Accordingly, in the Board's view, on 25 July 1984 Mr Belcher was a successor in title of NRDC to the invention, NRDC having been in turn a successor in title of the inventor (Mr Belcher) by reason of the assignment dated 8 November 1983. Thus, on that date Mr Belcher was entitled to the right to apply for and be granted a European patent in respect of the invention the subject of

the UK application, having regard to Article 60 EPC, first sentence. Furthermore, in the Board's judgement, under Article 87(1) EPC on 25 July 1984 Mr Belcher enjoyed, for the purpose of filing the European patent application in respect of the invention the subject of the UK application, a right of priority. A declaration of priority was therefore properly made on the Request for grant form, in accordance with Article 88(1) EPC.

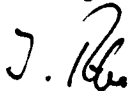
3. Having regard to this finding, it is unnecessary for the Board to consider and decide upon the request which the Appellant made under Rule 88 EPC.

#### Order

For these reasons, it is decided that:

The applicant for European patent application No. 84 305 049.3 enjoys a right of priority as set out in the declaration of priority.

The Registrar:



The Chairman:

