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Aktenzeichen / Case Number / N<sup>o</sup> du recours : J 8/89

Anmeldenummer / Filing No / N<sup>o</sup> de la demande : 82 303 423.6

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Bezeichnung der Erfindung: Glow plug quick heating control device

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : F02P 19/02

### ENTSCHEIDUNG / DECISION

vom / of / du 4 July 1989

Anmelder / Applicant / Demandeur : Isuzu Motors Limited

Patentinhaber / Proprietor of the patent /

Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Mistake in designation of Contracting States

EPÜ / EPC / CBE Article 79(1) and Rule 88

Schlagwort / Keyword / Mot clé : Correction of mistake in designation of Contracting State refused - delay in applying for correction excessive

Leitsatz / Headnote / Sommaire

Europäisches  
Patentamt

Beschwerdekammern

European Patent  
Office

Boards of Appeal

Office européen  
des brevets

Chambres de recours



Case Number : J 8/89

**D E C I S I O N**  
of the Legal Board of Appeal  
of 4 July 1989

**Appellant :** Isuzu Motors Limited  
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6 Chome, Shinajawa-ku  
Tokyo  
Japan

**Representative :** Evershed, Michael et al.  
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**Decision under appeal :** Decision of the Examining Division of  
the European Patent Office  
dated 29 December 1989.

**Composition of the Board :**

**Chairman :** P. Ford  
**Members :** L.C. Mancini  
E. Persson

## Summary of Facts and Submissions

- I. The appeal is against the decision of the Examining Division dated 29 December 1987 in respect of application No. 82 303 423.6, refusing a request under Rule 88 EPC to substitute Sweden for Switzerland and Liechtenstein as a designated State.
- II. The subject application was filed on 29 June 1982. On page 2 of the request form (part VIII) the United Kingdom, France, the Federal Republic of Germany, the Netherlands, Italy and Switzerland (plus Liechtenstein) were indicated as designated States. The application was published on 12 January 1983 indicating those States only.
- III. After substantive examination the applicant was informed of the text in which the Examining Division intended to grant the patent by advance notice (EPO Form 2004) dated 9 April 1986.
- IV. By telex of 5 June 1986, duly confirmed by letter, the Appellant then requested the correction. It was explained that in the letter instructing the representative to file the application there had been a typographical or clerical error: the letter indicates on the first page Switzerland as a State to be designated, whereas on the second page among the representatives for the designated States a representative is indicated for Sweden but not for Switzerland. This discrepancy resulted in the designation of Switzerland in the request form by the representative who confirmed to his client, however, in accordance with page 2 of the letter the Appellant's instruction to file an application with the designation of Sweden. It had always been the intention to designate Sweden but not Switzerland.

Statutory declarations and comprehensive exhibits were filed to establish those facts.

- V. The decision by the Examining Division refusing the request was issued on December 29, 1987.

Two grounds were given for the decision, namely:

1. Risk of damage to third parties who would have noted from the published application that Sweden was not a designated State and would therefore have been entitled to assume that no European patent would be granted for any State not so designated, this risk outweighing any disadvantage to the Appellant.
2. Undue delay in requesting the correction:

In the present case there is no doubt that a mistake had been made, what the mistake was and what the correction should be. The submission of the applicant showed that the indication of Switzerland as a designated State in the request form did not conform to the true intention of the applicant, who wanted Sweden to be designated instead.

But the Appellant did not, however, ask for correction of this mistake in due time, thus going against the principle developed in case law that the interest of an applicant in introducing a designated State by way of correction has to be balanced against the public interest in obtaining correct information from the EPO.

- VI. The Appellant filed an appeal against this decision and supported the Statement of Grounds of Appeal by argument in the Oral Proceedings.

The Appellant also relied upon a written opinion by a professor in intellectual property law at the Stockholm School of Economics. This opinion was introduced and accepted as the purely hypothetical view of a learned author based on general principles of Swedish law, on the possible interpretation that Swedish courts might give to the position of a third party who had commenced using the invention in Sweden before being notified of the Appellant's request for correction. It was not suggested that there was any specific provision in Swedish legislation or any case law directly relevant to the question in issue.

#### Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. Under Article 79(1) EPC, the Contracting States for which protection is sought have to be designated in the request for grant, on the filing date. In an early decision the Legal Board of Appeal stated that this principle does not exclude the application of Rule 88, first sentence, EPC, and has allowed corrections in the designation of States (J 8/80, OJ EPO 1980, 293). In later decisions the Board defined the conditions under which correction is possible, stating that correction after publication of incomplete designations is most undesirable and the public should be able to rely on the publication itself and that the request for correction 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 (J 3/81, OJ EPO 1982, 100 and J 21/84, OJ EPO 1986, 75).

3. The public interest in legal certainty is the reason of paramount importance why a request for correction of designations can be allowed only if it is made sufficiently early for a warning to be included in the publication of the application; this is a general principle which has constantly been applied except when publication took place prematurely or was erroneous, in either case due to no fault of the applicant or his representative. Neither of these exceptional conditions allowing a late request for correction applies to the present appeal.

The Board does not consider that there is any reason to depart from established principles in the present case. In particular, the Appellant's case that there could be no detriment to the public interest in allowing the correction sought, based on the evidence of the Swedish professor, is not convincing. Third parties ought not to be faced with the expense and uncertainty of litigation in order to find out whether they are free from liability for infringement in circumstances such as those of the present case.

4. The Board considers that the error was such that it could have been detected and corrective action taken before publication of the application.

There was such an obvious inconsistency in the instructions sent to the representative that it should have been noticed both by the sender and by the recipient. The delay in requesting correction was regrettably far too long for it now to be allowed.

**Order**

**For these reasons, it is decided that:**

**The appeal is dismissed.**

**The Registrar:**

**J. Ruckerl**

**The Chairman:**

**P. Ford**