

Europäisches  
Patentamt

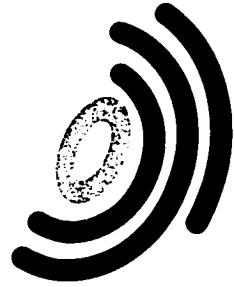
Beschwerdekammern

European Patent  
Office

Boards of Appeal

Office européen  
des brevets

Chambres de recours



Case Number : J 11/89

**D E C I S I O N**  
of the Legal Board of Appeal  
of 26 October 1989

**Appellant :** Kyodo Printing Co., Ltd.  
14-12, 4-Chome Koishikawa  
Bunkyo-Ku  
Tokyo 112  
Japan

**Representative :** Charlton, Peter John  
Elkington & Fife  
High Holborn House  
52/54 High Holborn  
London WC1V 6SH  
Great Britain

**Decision under appeal :** Decision of the Receiving Section  
of the European Patent Office  
dated 2 December 1988.

**Composition of the Board :**

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

Veröffentlichung im Amtsblatt	<del>Nein</del>
Publication in the Official Journal	Yes/No
Publication au Journal Officiel	<del>Non</del>

Aktenzeichen / Case Number / N<sup>o</sup> du recours : J 11/89

Anmeldenummer / Filing No / N<sup>o</sup> de la demande : 87 307 018.9

Veröffentlichungs-Nr. / Publication No / N<sup>o</sup> de la publication :

Bezeichnung der Erfindung: Optical recording card and method of reading  
Title of invention: the same  
Titre de l'invention :

Klassifikation / Classification / Classement : G 06 K 7/14

**ENTSCHEIDUNG / DECISION**

vom / of / du 26 October 1989

Anmelder / Applicant / Demandeur : Kyodo Printing Co., Ltd.

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Priority declaration/KYODO

EPÜ / EPC / CBE Rule 88 EPC

Schlagwort / Keyword / Mot clé : Correction of priority declaration after  
publication (yes) - special circumstances

**Leitsatz / Headnote / Sommaire**

## Summary of Facts and Submissions

- I. European patent application No. 87 307 018.9 was filed on 7 August 1987. In the request for grant form, a declaration of priority was made in respect of Japanese patent application No. 187 475/86 of 9 August 1986 (cf. Rule 26(2)(g) EPC).
- II. On 6 November 1987, i.e. within the period of 16 months prescribed by Rule 38(3) EPC, the Applicant's representative filed not only a copy of the Japanese application referred to in the request for grant form but also a copy of a later Japanese patent application, namely No. 250 460/86 of 21 October 1986. In the covering letter, nothing was explicitly said about the filing of the copy of this latter Japanese application. Both documents were put on the file, and it was noted by the Receiving Section that the request for grant form did not cover the later Japanese application. However, no action was taken to clarify with the Applicant's representative whether it was intended to claim priority from the second Japanese application.
- III. The technical preparations for publication were completed in January 1988 and the European patent application was published on 24 February 1988, claiming only one priority.
- IV. The representative supplied the translations of both Japanese applications filed on 6 November 1987 under cover of a letter dated 3 May 1988.
- V. By letter dated 12 May 1988, the Applicant's representative requested correction under Rule 88 EPC of the request for grant by adding a claim to priority based on the second Japanese application. In support, it was submitted that it

had always been the intention of the Appellant to claim two priorities as could be clearly seen from a letter from the Applicant of 3 August 1987, and the omission of a reference to the later Japanese application in the request for grant was due to an oversight on the part of the representative. The filing of copies of the two Japanese applications and subsequent furnishing of translations of both of them within the time limits prescribed by the EPC with regard to priority documents clearly confirmed that intention. While the EPO had in no way been responsible for the error, if the Receiving Section had asked the representative why two priority documents had been filed, then the error would have been immediately apparent to the representative and could have been corrected in good time before the publication of the European application. Although the representative was aware of the reluctance of the Legal Board of Appeal to allow corrections at such a late stage, that not even a warning could be included in the publication of the application, as explained in the decisions J 04/82 (OJ EPO 1982, 385) and J 14/82 (OJ EPO 1983, 121), it was nevertheless argued that in view of the special circumstances of the present case, the interest of the public would not be prejudicial by allowing the requested correction.

- VI. The Receiving Section, in refusing the request for correction, referred in its decision to the case law established by the Legal Board of Appeal by the decisions referred to above, drawing particular attention to the fact that in the present case the request for correction was not made until after the patent application had been published.
- VII. The Applicant filed a notice of appeal on 2 February 1989 requesting that the decision of the Receiving Section be set aside and the request for correction be granted. The

appeal fee was duly paid. In the statement of grounds of appeal, filed on 20 March 1989, the Appellant maintained the submissions and arguments presented in the course of the proceedings before the first instance.

#### Reasons for the Decision

1. The appeal is admissible.
2. On the evidence before it, the Board is satisfied that it was the true intention of the Applicant at all times to claim priority from both Japanese patent applications, and that the omission of a reference to the second application in the request for grant was due to a mistake within the meaning of Rule 88 EPC.
3. As rightly pointed out by the Appellant, it follows from the case law established by this Board, that only in very special circumstances may a correction of a mistake of this kind be allowed under Rule 88 EPC, when the application for correction cannot even be the subject of a warning in the European patent application as published. The question is, whether there are any such circumstances in the present case.
4. In considering this question, the reason for the delay in making the request for correction is of importance. It appears from the facts of the present case, that the representative, when filing copies of the Japanese applications and translations of them within the time limits prescribed by the EPC in respect of priority documents, was not aware of the mistake. There is every reason to believe that, if he had been made aware of it in early November 1987 he would immediately have made a request for correction and an appropriate warning to the

public of the request for correction could have been inserted in the application on publication.

5. However, the Receiving Section, although it had noted in the file that there was no formal claim to priority in the request for grant in respect of the second Japanese application, did not inform the Applicant's representative of this deficiency; nor did the Receiving Section take any other action in order to clarify the matter. The delay of the request for correction under Rule 88 can, therefore, not be considered as indicating any lack of diligence on the part of the representative.
6. Irrespective of the fact that there were no specific provisions obliging the Receiving Section to take any particular action upon the receipt of the copies of the two Japanese applications in question on 6 November 1987, the Board takes the view that it would have been proper and acting in good faith for the Receiving Section to have contacted the representative - e.g. by telex or telephone - and that if it refrained from so doing it could not refuse a subsequently made request for correction, except on the most compelling grounds of public interest.
7. As to the public interest of being able to rely on the publication of a European patent application, it is to be noted that in the present case, as in Case J 14/82 referred to in paragraph V above, the unpublished priority claim refers to a later application than that which was actually referred to in the publication of the European patent application. This is obviously less harmful to the interest of the public, since it provides the correct starting point in time for the state of the art to be considered.
8. In these circumstances, the Board takes the view that, on balance, the interest of the Applicant in not being

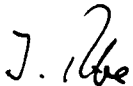
deprived of claiming the priority of the second Japanese application ought to be held as of greater importance than the interest of the public in being informed about the second priority claim of later date than the one already mentioned in the publication of the European patent application. It follows, that the request for correction must be allowed.

### Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. It is ordered that the request for grant is to be corrected by adding a priority reference to Japanese patent application No. 250 460/86 of 21 October 1986.

The Registrar:



The Chairman:

