



Case Number : J 3/91 - 3.1.1

D E C I S I O N
of 16 June 1993
correcting errors in the decision
of the Legal Board of Appeal
of 1 December 1992

Appellant : UNI-CHARM CORPORATION
182, Shimobun
Kinsei-cho
Kawanoe-shi
Ehime-ken (JP)

Representative : Jones, Colin
W.P. Thompson & Co.
Coopers Building
Church Street
Liverpool L1 3AB (GB)

Decision under appeal : Interlocutory decision of the Examining Division
of the European Patent Office dated
17 September 1990 refusing the correction of the
claimed priority date.

Composition of the Board :

Chairman : O. Bossung
Members : M. Aúz Castro
G. Davies

In application of Rule 89 EPC the decision given on 1 December 1992 is hereby corrected as follows:

On page 2, lines 3 and 4 the phrase "which had been published earlier than application GB-A-2 114 173" is replaced by "which had a filing date earlier than the date of publication of application GB-A-2 114 173".

On page 9, line 9 the term "Examining Division" is replaced by "Receiving Section" and on page 10, last line, the term "file number" is replaced by "priority date".

The Registrar:

J. Rückerl

On behalf of
the Chairman:

M. Aúz Castro

A	X	B		C	
---	---	---	--	---	--

File Number: J 3/91 - 3.1.1
Application No.: 84 300 001.9
Publication No.: 0 147 904
Title of invention: Method for production of non-woven fabric

Classification: D04H 1/44

DECISION
of 1 December 1992

Applicant: UNI-CHARM CORPORATION

Headword: Priority declaration (correction)/UNI-CHARM

EPC Article 88(1)
Rules 38(1), 88

Keyword: "Correction of particulars after publication" - "Error of transcription - interest of third parties - apparent discrepancy" - "Reimbursement of appeal fee - substantial procedural violation"

Headnote

Particulars of a priority declaration (date and file number pursuant to Rule 38(1) EPC) may be corrected even after publication of the European patent application without a warning provided that the interests of third parties are not adversely affected (see decision J 04/82, OJ EPO 1982, 385 and J 03/82, OJ EPO 1983, 171).

The interests of third parties are not adversely affected by a correction, if the mistake in the particulars of the priority declaration is apparent on the face of the published patent application ("apparent discrepancy").



Case Number : J 3/91 - 3.1.1

DECISION
of the Legal Board of Appeal 3.1.1
of 1 December 1992

Appellant : UNI-CHARM CORPORATION
182, Shimobun
Kinsei-cho
Kawanoe-shi
Ehime-ken (JP)

Representative : Jones, Colin
W.P. Thompson & Co.
Coopers Building
Church Street
Liverpool L1 3AB (GB)

Decision under appeal : Interlocutory decision of the Examining Division of the EPO dated 17 September 1990 refusing the correction of the claimed priority date.

Composition of the Board :

Chairman : O. Bossung
Members : M. Aúz Castro
G. Davies

Summary of Facts and Submissions

- I. The applicant and Appellant filed European patent application no. 84 300 001.9 at the United Kingdom Patent Office on 3 January 1984 claiming the priority of Japanese patent application no. 57-233998. State and filing date of the priority application were indicated as "Japan 31st December, 1983".
- II. On 24 April 1984, the applicant filed a certified copy of the Japanese priority document together with a verified translation into English, the certified copy showing on the front page, among indications in the Japanese language and in Japanese characters, the following data in English:

"Date of Application: 1982....12....31"
"Application Number: 57....233998..."
- III. The application was published on 10 July 1985 indicating on the front page the coded priority data as follows:

"Priority: 31.12.83 JP 233998/83"
- IV. In the European Search Report, document "GB-A-2 114 173 (UNI-CHARM)" published on 17 August 1983 was considered relevant. The report was transmitted to the applicant on 6 February 1987 and published on 1 April 1987.
- V. By communication dated 17 August 1988, the Primary Examiner of the Examining Division raised objections against the patentability of the claimed invention (lack of novelty, lack of inventive step) in view of patent application no. GB-A-2 114 173.

The applicant responded by letter dated 19 December 1988 claiming priority from Japanese application no. 57-233998, which had been published earlier than application GB-A-2 114 173. The priority date was once again wrongly stated (31 October 1982 instead of 31 December 1982).

- VI. By a second communication dated 14 March 1989, the applicant was informed that the date of 31 December 1983 had been wrongly indicated as the filing date of the priority application, the correct date being 31 December 1982. However, the conditions for a correction under Rule 88 EPC, as laid down by the jurisprudence of the Legal Board of Appeal, were not met in the present case, because the European application had already been published and a correction would lead to a much earlier priority date.
- VII. In his response to this communication dated 28 June 1989, the Appellant's representative expressed astonishment at learning that the priority date had been shown incorrectly and requested correction of both the priority date and the priority application number, the former to be corrected both on the request form and on the printed application and the latter to be corrected on the printed application. He explained the circumstances in which the mistake concerning the priority date in the request form had been made and argued in detail that the jurisprudence of the Boards of Appeal as to the admissibility of corrections would permit a correction of the priority date in the present circumstances. He also submitted that the Receiving Section had wrongly transcribed the priority date of the Japanese priority document and for that reason the mistake had remained undiscovered for such a long time.

VIII. By interlocutory decision dated 17 September 1990, the Examining Division refused the applicant's request for correction of the claimed priority date but allowed separate appeal pursuant to Article 106(3) EPC. The decision stated, with reference to the jurisprudence of the Legal Board of Appeal, that, once an application had been published, a correction of dates in the application relevant for the technical and legal assessment of the application was only possible under exceptional circumstances. The general rule was that the public should be entitled to rely on the published information as being both accurate and complete. Only in cases where failure to include a warning in the publication was due to an omission by the Office could a correction be allowed after publication. It was held that this requirement was not met in the present case as the Receiving Section had not noticed that the priority dates indicated in the request form and in the later submitted priority document were different. The Examining Division emphasised, with reference to the Examining Guidelines and decision J 11/89 of the Legal Board of Appeal, that the Receiving Section was not obliged to make a comprehensive check as to the correctness of the priority date. With regard to the Legal Board's decision J 10/87 referred to by the applicant, the Examining Division argued that, in the present case, the public interest in being able to rely on information officially published by the EPO must rank higher than the interest of the applicant in having his incorrect, already published statement ignored. The addressees of the publication, in order to assess the possible coming into existence of a potential exclusive right, could assume, for instance in effecting a search, that every document found published before that date could constitute state of the art for the European patent application and be prejudicial to the patentability of the invention concerned.

IX. The applicant filed an appeal against the interlocutory decision of the Examining Division on 12 November 1990. A Statement of Grounds of Appeal and Deposit Account Debit Order in respect of payment of the appeal fee were enclosed therewith. The Appellant requested

- the correction of the claimed priority date,
- the correction of the priority application number,
- the refund of the appeal fee on the grounds of several procedural violations.

In its Statement of Grounds the Appellant presented the following arguments:

- No practice has been established so far as regards the correction of the particulars of priority data. The jurisprudence of the Legal Board, referred to in the decision under appeal, dealt only with cases of omission of a designation of State or of a claim to priority but not with the question of correction of the priority particulars. The question arose, therefore, whether the public needed to rely on the publication of the priority particulars.
- The error in the priority date was partially due to a mistake by the Receiving Section while the incorrect transcription of the Japanese priority application number was a mistake for which the Receiving Section was fully responsible. Having wrongly replaced the Japanese Showa year 57 by 1983 (instead of 1982) the mistake of the priority date was no longer immediately apparent on the face of the published application.
- Third parties would be adequately protected if correction were to be allowed. Pursuant to Article 88(3) EPC, a competitor may be expected to study the

priority document before assessing its relevance to his own intentions. Thus, third parties could not be adversely affected by the requested correction of the priority date since a file inspection would immediately reveal the error. Furthermore, a prudent person would wait for the grant of a European patent or at least examine the situation much more thoroughly.

- Insofar as refund of the appeal fee was requested, the Appellant claimed that substantial procedural violations had been made both by the Receiving Section and the Examining Division: incorrect transcription of the Japanese priority application number, lack of notification of this modification to the applicant, considerable delay in issuing the interlocutory decision on the part of the Examining Division.

X. The Legal Board of Appeal invited the President of the EPO upon his request to comment on the questions of general interest arising in this case as well as in three other closely related cases. After having analysed the relevant preparatory documents leading to the adoption of the European Patent Convention and the case law of the Legal Board of Appeal relating to correction of mistakes under Rule 88 EPC, the Statement of the President, dated 15 April 1992, came to the following conclusion with regard to the present case: "a further development in the case law of the Legal Board of Appeal, which would in future allow correction of mistakes made in the particulars of an otherwise valid claim to priority requested after publication of the European patent application without any warning of a request for correction could sufficiently take into account the above mentioned interests of third parties in relying on the published information of the EPO as being both accurate and complete if third parties could see without any great

effort that there must be a mistake in the published declaration of priority" (no. 43 and 65.2 of the statement). The President of the EPO expressed his view that in the present case the requested correction of errors under Rule 88 EPC should be allowed (no. 66.1 of his statement).

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC, and, therefore, is admissible.
2. The Appellant filed a European patent application claiming priority from an earlier Japanese patent application and asked for correction of both the priority date and the file number of the priority application indicated in the application form and in the already published application.

Pursuant to Rule 88 EPC, first sentence, certain errors, in particular "errors of transcription and mistakes in any document" filed with the European Patent Office, may be corrected on request. The relevant case law of the Legal Board of Appeal dealing with the conditions for correction of a declaration of priority under Rule 88 EPC is summarised in the reasons for the decision in case J 06/91 of 1 December 1992. The teaching of this jurisprudence has to be applied to the present case as well.

However, the present case and case J 02/92 (decided the same day) are the first cases which do not concern correction of an omitted priority declaration but correction of particulars in the priority declaration, i.e. date and file number as required by Article 88(1) and Rule 38(1) EPC.

The following particulars of the present case give the Legal Board cause to develop further its previous case law:

- The request for correction was filed several years after the publication of the patent application and the search report;
- the error for which correction is requested does not concern an omission in the priority declaration but an error and mistake concerning particulars of the priority declaration (date, file number).

3. As a necessary safeguard against abuse of the provisions of Rule 88 EPC, the Legal Board of Appeal has stated that "before the European Patent 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" (J 08/80, OJ EPO 1980, 293, 296 par. 5; J 04/80, not published, par. 3; J 04/82, OJ EPO 1982, 385, 389 par. 6).

In the present case, these conditions are fulfilled. By mistake, the applicant indicated the wrong priority date in the request form. A certified copy of the Japanese priority document showing on the front page the correct date of application and the correct Japanese application number (including the "Showa" year 57 = 1982) was filed in due time (within 16 months from the correct priority date). The applicant's professional representatives, who were responsible for checking the application form, explained the mistake in their Statutory Declarations dated 27 June 1989 as an "oversight" due to time pressure in filing the application.

The Board is satisfied that this clerical error, typing 1983 instead of 1982 when filling in the Request for Grant form, is a typical error of transcription within the meaning of Rule 88 EPC, first sentence. The incorrect transcription of the Japanese application number by the Receiving Section is to be classified too as such an error of transcription, in principle open for correction under Rule 88 EPC. Neither the priority date nor the priority document number as filed and published conform to what was apparently intended.

4. In principle, Rule 88 EPC, first sentence, in cases of an incorrect priority declaration of this nature allows a correction without any time bar, even after publication of the patent application. However, such a correction is at the discretion of the competent authorities (J 07/90, to be published, par. 2.2.; G. Paterson, The European Patent System, London 1992, no. 5-52, 6-05, 6-08). In case J 07/90, the Board stated that the EPO is "by no way compelled to permit the correction of errors of any kind at any time". According to the legal text of the provision in the three official languages ("können" - "may" - "peuvent"), the European Patent Office has the authority to permit certain types of corrections at its discretion. The overriding principle in exercising the discretionary power is to balance the interests of the applicant in gaining optimal protection and the interests of the public in respect of legal security (cf. R. Singer, Europäisches Patentübereinkommen, 1989, Article 123 par. 21).
- 4.1 In weighing up the interests of third parties and those of the applicant, the Board is satisfied in the particular circumstances of this case, involving as it does a mere typing error, that the interests of third parties will not be adversely affected by a correction of the priority declaration as requested.

4.2 It may be left open whether and to what extent the Receiving Section is obliged to check a filed declaration of priority in order to eliminate misleading mistakes. However, the Board hesitates to share the view of the Examining Division that the Receiving Section acted correctly, because it failed to notice the irregularity in the application form. In this respect, the situation differs from that in case J 11/89 quoted by the Examining Division, as the ~~Examining Division~~ ^{RECEIVING SECTION} wrongly transcribed the priority year and failed to notice the discrepancy in the application form.

4.3 The Board finds that a correction of particulars in a priority declaration is admissible at least in a case, such as the present one, where the discrepancy is apparent on the face of the published patent application itself, even if this results in backdating the priority by one year.

Looking at the particulars of the publication of patent application no. 84 300 001.9, the mistake to be corrected is apparent already from the front page of the A2-publication:

The date of the claimed priority shown on the front page of the publication is very close to the filing date of the European patent application itself (31 December 1983 respectively 3 January 1984). Such a short period of time should have attracted the careful reader's attention. It is obvious from the publication of the given data that something must be wrong.

In addition, it has to be taken into account that, as a matter of practice, for a priority application filed on 31 December 1983, it is impossible to obtain a file number

of the same year indicated in a declaration of priority filed three days later.

Finally, one has to consider in this context that the practitioner experienced in filing European and international patent applications knows that, if priority is claimed from a Japanese patent application, the original document shows the "Showa" year. He knows that the transcription of the original document number, as occurred in the present case, creates an additional source of error.

With regard to the apparent discrepancy concerning the filing date, priority date and file number of the priority document, the public may not rely in the present case on the correctness of the publication of the European patent application. Thus, a retrospective correction of the priority date may be permitted in spite of the fact that the European patent application was published without any warning, that the request for correction was filed only years later and that the correction leads to a one-year-earlier priority date.

5. As far as the request for correction of the file number of the priority document is concerned, the above considerations lead to the same result. Obviously, no substantial interest exists in maintaining a wrong file number in the published application. Third parties should inspect the file if they wish to draw substantive conclusions from the priority document. In this respect, the file number as such is of no relevance to a competitor who has to make up his mind whether he may use the invention or not. A correction does not affect his interests, if the relevant priority document is available. In the present case, the correct document was filed in due time regardless of the applicant having indicated the wrong ~~file number~~ ^{priority date}.

6. Pursuant to Rule 67 EPC, reimbursement of the appeal fee shall be ordered if it is equitable by reason of a substantial procedural violation. The wrong transcription of the Japanese priority date cannot be considered a procedural violation of this kind. The Receiving Section is not obliged by procedural law to inform the applicant that the "Showa" year has been transcribed to terms of the Christian era. The transcription is a routine matter familiar to the practitioners dealing with industrial property rights (see Rule 79 PCT).

The Examining Division apparently initially hesitated to issue an interlocutory decision dealing only with the request for correction of the declaration of priority. The original intention to avoid a time-consuming interlocutory procedure in favour of a comprehensive decision in substance does not amount to a procedural violation, even if in the end the Examining Division complied with the request of the applicant for an interlocutory decision.

The Legal Board of Appeal accordingly finds that the circumstances of the case do not justify an order for reimbursement of the appeal fee pursuant to Rule 67 EPC.

Order

For these reasons it is decided that:

1. The interlocutory decision of the Examining Division dated 17 September 1990 is set aside.

2. It is ordered that the request for grant filed on European patent application No. 84 300 001.9 be corrected as follows:
 - the filing date of the priority application as indicated in the declaration of priority shall be replaced by the date of "31st December, 1982";
 - the application number of the priority document shall be replaced by "JP 233998/82".

3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

M. Beer

O. Bossung