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File Number: J 6/91 - 3.1.1
Application No.: 89 902 578.7
Publication No.: 0 418 244
Title of invention: Superconducting Bi-Sr-Ca-Cu oxide compositions and process
for manufacture
Classification: C04B 35/00

D E C I S I O N
of 1 December 1992

Applicant: E.I. Du Pont De Nemours and Company

Headword: Correction/Priority declaration/DU PONT

EPC Rule 88, first sentence

Keyword: "Correction of errors/omissions - priority declaration"
"Correction of errors/omissions - after publication - public
interest"

Headnote

In principle, in the absence of any special circumstances, a request for correction of a priority claim by the addition of a first priority should be made sufficiently early for a warning to be included in the publication of the application. An exception to this rule may be allowed if it is apparent on the face of the published application that a first or only priority may be missing or wrong or that the date of a first or only priority is wrong. In such a case, the public interest is safeguarded by the fact that it was apparent from the published application that a mistake may have been or has been made with respect to the priority date claimed.



**Europäisches
Patentamt**

**European
Patent Office**

**Office européen
des brevets**

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number : J 6/91 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 1 December 1992

Appellant : E.I. Du Pont De Nemours and Company
1007 Market Street
Wilmington
Delaware 19898 (US)

Representative : Jones, Alan John
Carpmaels & Ransford
43 Bloomsbury Square
London WC1A 2RA (GB)

Decision under appeal : Decision of the Receiving Section of the European
Patent Office dated 29 January 1991 refusing
the addition of a priority.

Composition of the Board :

Chairman : O.P. Bossung
Members : G. Davies
M.K.S. Aúz Castro

Summary of Facts and Submissions

- I. The applicant and appellant filed patent application No. 152 186 at the USPTO on 4 February 1988 and a further continuation-in-part application No. 153 107 on 8 February 1988. On 3 February 1989, international application No. PCT/US 89/00355 naming the EPO as a designated office was filed (EURO/PCT application No. 89 902 578.7). In that application, the applicant only claimed the priority of the continuation-in-part application No. US 153 107.
- II. On 10 August 1989, the international application was published under No. WO 89/07087.
- III. On 9 March 1990, the applicant filed at the USPTO a request to authorize rectification of the international application by the addition of the earlier priority date. That request was refused by the USPTO by decision dated 1 May 1990 on the ground that the authorization for rectification could not be effected within the time limit prescribed by Rule 91.1(g) and (i) PCT, that is, within 17 months of the priority date.
- IV. On 27 March 1990, prior to entry into the regional (European) phase, the applicant applied under Rule 88 EPC for correction of the Euro-PCT application to add the priority of the earlier application and requested that a warning be published concerning the request for amendment at the time of publication of the details of the application in the European Patent Bulletin on entry into the regional phase. Entry into the regional phase took place on 29 June 1990 and, on that occasion, the applicant repeated its request for amendment of the application and for a warning relating thereto to be published in the European Patent Bulletin. Notice of the entry into the regional phase of the application was published in the

European Patent Bulletin on 27 March 1991 without, however, any such warning being given.

- V. By decision of the Receiving Section dated 29 January 1991, the request to amend the application was refused on the ground that, according to the case law of the Legal Board of Appeal, the request for correction was too late because it had not been filed sufficiently early for a warning to be included in the publication of the application. The application being a Euro-PCT application, pursuant to Article 158(1) EPC, the relevant publication was publication under Article 21 PCT. The interest of the public demanded that thereafter a correction of the priority date should not be allowed because the public was entitled to rely on the information published.
- VI. On 6 March 1991, the appellant filed a notice of appeal against this decision, paying the appeal fee on the same day. A written statement of grounds of appeal dated 7 June 1991 was received by the EPO by facsimile the same day (confirmed by letter of the same date received on 10 June 1991).
- VII. In oral proceedings held on 14 May 1992, the appellant requested that the contested decision be set aside and that European patent application No. 89 902 578.7 be corrected by the addition of a claim to priority from US application No. 152 186 dated 4 February 1988.
- VIII. The grounds of appeal put forward by the applicant in writing and at the oral proceedings may be summarised as follows: Rule 88, first sentence EPC, does not make corrections dependent on a time limit being observed. Rather it makes the allowability of corrections a matter of discretion on a case by case basis. The exercise of this discretion should not be cut down by introducing a

time limit into the Rule. To substitute a rigid time limit for the exercise of discretion would be contrary to Article 150(3) EPC, which, like Rule 88 EPC, contains no time limit. In a particular instance - depending on the circumstances - it should be possible to make a correction even in a situation where it was too late for a warning to be published in the European Patent Bulletin. In several previous decisions, the Legal Board of Appeal had permitted exceptions to the principle that the public must be warned (reference was made to the following cases: J 12/80, OJ 1981, 143; J 04/82, OJ 1982, 385; J 14/82, OJ 1983, 121; J 03/82, OJ 1983, 107 and unpublished decision J 11/89 dated 26 October 1989). In these cases, consideration of the need to warn the public had yielded to the justified interest of the applicant. In the present case, the applicant submitted that an exception was also justified. The priority date the applicant sought to add was only 4 days earlier than that claimed and neither publication of the international application nor entry into the regional phase had been delayed. Moreover, the informed public would have been capable of suspecting a mistake in the claim to priority because the claimed priority was a continuation-in-part application. Finally, the public could have been provided with sufficient warning if the notice concerning the entry into the regional phase in the European Patent Bulletin had carried a warning, as had been requested one year before publication. The public relied on the publication of details of a Euro-PCT application following entry into the regional phase and not on the published international application. At the time an international application is published it is not at all sure whether the PCT application will enter the European phase, and, if it does so, which individual European States will be designated. It is by reference to the EPO Bulletin or the EPO Register

that the public determine the existence of a European patent application.

IX. In accordance with Article 12(a) of the Rules of Procedure of the Boards of Appeal (OJ 1989, 361) the President of the EPO at his own request was invited to comment on the present case as well as on three other pending cases concerning mistakes in priority declarations. Two of these cases, namely, J 03/91 (Uni-Charm) and J 02/92 (United States), concerned typing mistakes as regards the priority date and priority file number. Cases of this kind have not previously come before the Legal Board of Appeal. Hitherto, all priority cases have concerned omission of the date and State of the earlier application. This is the case also of a fourth case to be decided by the Board (J 09/91 (Lochridge)).

X. The President of the EPO submitted comments on these cases in writing and was represented also at the oral hearing. He defended the view that, with regard to mistakes in claiming priority, a distinction should be made between (a) mistakes made in a priority declaration concerning details of the date, State and file number of the previous application and (b) omission of a statement of date and State at the time of filing the European application. As regards mistakes of the first kind, such as those in cases J 03/91 (Uni-Charm) and J 02/92 (United States), in principle correction under Rule 88, first sentence, EPC, would be possible.

As regards mistakes of the second kind ((b), above), such as that in the present case J 06/91, correction by way of re-establishment of rights under Article 122 was not possible because Rule 38(2) set no time limit. However, correction pursuant to Rule 88, first sentence, EPC was possible. Here, however, in the interests of third

parties, a time limitation should be observed. The time limitation should be laid down in such a way that the 18-month publication period - calculated from the earliest priority - can be observed. For this reason, in his opinion, correction in the present case, J 06/91, was not possible.

- XI. The Legal Board of Appeal hereby decides case No. J 06/91 (du Pont). On the same day, it is also deciding the following cases: J 03/91 (Uni-Charm) and J 09/91 (Lochridge). Each case is decided on its own merits. However, in view of the number of requests for correction concerning priority declarations currently pending before it, the Board takes this opportunity to review the development of its case law to date on this subject and to further interpret the law and procedure to be followed in cases of requests for correction of errors under Rule 88. To the extent that general considerations and principles of law apply to all the above-mentioned cases, these are contained in this decision.

Reasons for the Decision

1. The appeal is admissible.
- 2.1 The case law of the Legal Board of Appeal relating to correction of errors and mistakes in documents filed with the EPO under Rule 88 EPC has developed on an ad hoc basis since 1980. The first cases to be decided concerned requests for correction of designations of States in European patent applications. The principles established were subsequently applied to cases concerned with correction of errors in priority declarations as to date and State of previous filing.

2.2 In Case J 08/80 (OJ EPO 1980, p. 293), the first appeal under Rule 88 EPC to come before the Board, the Board for that reason explained the law and the procedure to be followed in cases of requests under Rule 88 EPC. It established the following general principles to be applied in all such cases:

- (1) for the purposes of Rule 88 EPC a mistake may be said to exist in a document filed with the EPO if the document does not express the true intention of the person on whose behalf it was filed. The mistake may take the form of an incorrect statement or it may result from an omission. Correction, accordingly, can take the form of putting right an incorrect statement or adding omitted matter (point 4 of the grounds for the decision);
- (2) for correction to be allowed, the EPO must be satisfied that a mistake was made, what the mistake was and what the correction should be (point 5 of the grounds for the decision);
- (3) where the making of the alleged mistake is not self-evident and in cases where it is not immediately evident that nothing else would have been intended than what is offered as the correction, the burden of proving the facts must be a heavy one. Provisions designed to facilitate correction of mistakes cannot be allowed to be used to enable a person to give effect to a change of mind or subsequent development of plans (point 6 of the grounds for decision).

In that case, where the request for correction had been made less than a month after filing the application, it was observed that, because the request for correction had been made promptly, it was unnecessary to consider whether

the right to obtain correction was subject to certain inherent time limitations (point 10 of the grounds for the decision).

- 2.3 In the next case concerning Rule 88 EPC, J 12/80 (OJ EPO 1981, 143), the Legal Board of Appeal referred to the above mentioned observation and stated " In the present case, there is no doubt that the application for correction was made promptly" (point 7 of the grounds for the decision). The headnote to the case interpreted this statement as follows: "Correction of mistakes in the request for grant of a European patent is not excluded, provided the request for correction is made promptly...".

In this case, the application had been published without the designation of Switzerland, while the appeal was pending. Thus, the question arose of the public interest in knowing with certainty the legal position. However, the appellant had had no control over the publication and the Board held it would not be right to refuse correction of the mistake, if the appellant was otherwise entitled to it, because of the intervening publication.

The Board concluded: "Rule 88 EPC does not contain any express provision protecting third parties such as is found in Article 122(6) EPC, to deal with comparable situations arising where restitution of rights is granted. In the absence of specific provision in the EPC, the solution of any problem of third party rights must be left to the national Courts of competent jurisdiction" (point 9 of the grounds for the decision).

- 2.4 This case law was further clarified in Case J 03/81 (OJ EPO 1982, 100). This case established two principles, which subsequently have been consistently followed by the Legal Board of Appeal.

- (1) The general rule must be that a request for correction of a mistake in designating States in a European patent application by adding the designation of another State must be refused in the public interest, if it is made too late for a warning to third parties to be added to the published application (point 6 of the grounds for the decision).

- (2) Where an international application filed under the PCT is deemed to be a European patent application, the same general rule must apply, in the public interest, even though publication by the International Bureau of WIPO necessarily precedes the time at which the applicant can request the EPO to correct any mistake in the application. The applicant, however, may ask the International Bureau to publish a warning in which case a request for correction under Rule 88 could be allowed (point 9 of the grounds for the decision).

2.5 In two decisions dated respectively 21 July 1982 (J 04/82, OJ EPO, 1982, 385) and 19 January 1983 (J 14/82 (OJ EPO, 1983, 121), the Legal Board of Appeal held that the same conditions as those developed for the correction of designation of States should apply to requests for correction of declarations of priority. In those decisions, the Board allowed the requests, holding that a mistake in a declaration of priority may be corrected under Rule 88 EPC, first sentence, provided that correction has been requested sufficiently early for a warning to be included in the publication of the application. Both of these decisions concerned multiple priorities and in each case the earliest priority had actually been claimed in the uncorrected Request for

Grant, while subsequent priorities had been omitted. It followed that the time table for publication of the application in accordance with Article 93(1) EPC, as soon as possible after the expiry of a period of eighteen months from the date of priority, was unaffected by the acceptance or refusal of the request for correction.

In J 14/82, moreover, the Board found that in the event that a warning is not published, the question whether the public interest would be adversely affected by allowing the correction must be considered, taking into account any special circumstances of the case (point 5 of the grounds for the decision).

- 2.6 The first case to deal with the omission of a first (and only) priority, Case J 03/82, was dated 16 February 1983 (OJ EPO 1983, 171). Correction of the omission was allowed, although a warning had not been published because the EPO was responsible for the failure to publish. The Board allowed the correction as an exception to the general principle that "If, by mistake, a claim to priority is omitted from a request for grant form, and the effect of allowing correction of the mistake would be to make the date for publication of the application, prescribed by Article 93(1) EPC earlier, then the request for correction of the mistake must be received by the EPO in sufficient time for the application to be published on the appropriate date, including the necessary warning to the public that the request for correction has been made" (headnote of the decision).

The principle that a request for correction of a priority claim should be made early enough for a warning to third parties to be added to the application as published was followed in Case J 21/84 of 29 November 1985 (OJ EPO 1986, 75).

In J 08/89 of 4 July 1989 [1990] EPOR 55, in a case concerning the correction of a State designation, the Board held that "It is an established principle that save in exceptional circumstances the designation of States will not be corrected if the application for correction is made too late to be noted in the publication of the application". In that case, the Board described exceptional circumstances as including "when publication took place prematurely or was erroneous, in either case due to no fault of the applicant or his representative" (point 3 of the grounds for the decision).

- 2.7 The last case in which a correction of a priority declaration was considered was J 11/89 dated 26 October 1989 (unpublished). In that case, the applicant had omitted to claim a second and later Japanese priority and filed a request for correction only after publication of the application. However, he had supplied a copy of the later Japanese priority document to the EPO at the same time as he filed a copy of the duly claimed priority document within the 16-month period laid down by Rule 38(3) EPC. This discrepancy was noted by the Receiving Section but no action had been taken to inform the Applicant. The Board allowed the correction even though it had been requested after publication without any warning to the public because of the special circumstances of the case. These were: the circumstances did not indicate any lack of diligence on the part of the representative; it would have been proper and an action of good faith for the Receiving Section to draw the discrepancy to the attention of the applicant; the fact that the omitted priority claim referred to a later application than that actually referred to in the publication of the application.

2.8 In a recent case, J 07/90 of 8 August 1991 (to be published), a case concerning correction of a State designation, the Board upheld the requirement that a request for correction must be made early enough to enable a warning to be published together with the European patent application.

3. The present case law of the Legal Board of Appeal with regard to correction of errors with respect to designation of States and priority claims under Rule 88, as developed since 1980, may be summarised as follows:

- (1) a mistake exists where a document filed with the EPO does not express the true intention of the person on whose behalf it was filed;
- (2) a mistake may be an incorrect statement or result from an omission;
- (3) the burden on the applicant of proving that a mistake has been made, what the mistake was and what the correction should be is a heavy one; Rule 88 may not be used to enable a person to give effect to a change of mind or subsequent development of plans;
- (4) the request for correction must be made promptly and, except in exceptional circumstances, sufficiently early for a warning to be included in the publication of the application;
- (5) in the case of international applications filed under the PCT, pursuant to Article 158(1) EPC, publication by the International Bureau of WIPO under Article 21 PCT takes the place of publication in the European patent bulletin;

(6) where no warning is published, the question whether the public interest would be adversely affected by allowing the correction must be considered; to date, correction of a priority without warning to the public has only been allowed where the above conditions have been fulfilled and there have been the following special circumstances:

- (i) the EPO was partly responsible for the fact that no warning was published; and/or
- (ii) the interest of the public was not seriously affected; for example, the mistake was obvious on the face of the application as published; only a second or subsequent priority was added; or the public was otherwise informed about the full scope of protection sought by the applicant.

The Board points out, however, with regard to (i) above, that in these decisions the contributory responsibility of the EPO was due to the uncertainty of the office as to how to proceed at a time when the legal situation and the practice of the EPO were not clear with respect to correction of errors under Rule 88 (cf. J 21/84 (point 5 of the grounds for the decision)).

4. To date the majority of requests for corrections under Rule 88 which have been adjudicated upon by the Board have concerned designations of States and priority declarations. So far as errors in claiming priority are concerned, all requests for correction have concerned omissions of date and State of a previous application. As mentioned in paragraph IX above, there are at present pending before the Board, however, cases in which

correction of mistakes in the form of typographical errors made in declarations concerning the date and State of previous applications have been requested and it is necessary to consider if and to what extent the rules applying to the correction of such errors may differ from the requirements with respect to omissions. The findings of the Board on this issue are set out in its decision in J 03/91 (Uni-Charm).

5.1 In the present case, applying the conditions for correction of an omitted priority established by the case law of the Board, as set out in paragraph 3 above, the Board is satisfied that a mistake exists, what it is and what the correction should be. The applicant and appellant omitted to claim priority from a previous application which preceded by four days the date of the application from which priority had in fact been claimed in the international application. The request for correction, however, was not made sufficiently early for a warning to be included in the publication of the application by the International Bureau of WIPO (in this case the relevant publication pursuant to Article 158(1) EPC).

5.2 The questions arise therefore whether the public interest would be adversely affected by allowing the correction and whether there are any special circumstances in this case which would permit an exception to the rule that the request for correction must be made sufficiently early for a warning to be included in the publication of the application. In deciding this matter, the Board takes account of the fact that, as seen above (paragraph 2.3), in the absence of any express provision protecting third parties in Rule 88, the solution of any problem of third party rights must be left to the national Courts of competent jurisdiction (J 12/80). This Board has also found that such rights would be sufficiently protected by

a national court applying Article 122(6) EPC mutatis mutandis (J 10/87, OJ 1989 323).

5.3 The applicant has claimed that Rule 88, first sentence, EPC, does not make corrections dependent on a time limitation being observed but makes the allowability of corrections a matter of discretion on a case-by-case basis. The applicant relied also on Article 150(3) EPC which provides that an international application, for which the EPO acts as a designated Office or elected office, shall be deemed to be a European patent application. It followed that publication of a warning in the European Patent Bulletin would have been sufficient. In relation to these arguments, the Board upholds its case law. As the Board said in J 07/90 already referred to, "Rule 88, first sentence, EPC in no way compels the EPO to permit the correction of errors of any kind at any time. All three texts of this rule ("können" - "may be" - "peuvent") give the EPO the authority to permit certain types of correction at its discretion, which also means that corrections can be made dependent on conditions. A time limitation is a reasonable condition if... correction is to be permitted at all" (point 2.2 of the grounds for the decision). A time limitation imposed by the Legal Board of Appeal in the public interest is hardly arbitrary. Publication of a warning in the European Patent Bulletin at the time of the mention therein of the international application is not an alternative option; as seen above, according to Article 158 EPC, publication under Article 21 PCT of a Euro-PCT application takes the place of the publication of the European patent application.

5.4 The appellant requested that an exception be made to the principle that the public be warned in this case, relying on previous decisions where the need to warn the public

had yielded to the justified interest of the applicant. It was submitted that the omitted priority date was only four days earlier than that actually claimed and that the informed public would have been capable of suspecting a mistake in the priority claim because the international application was a continuation-in-part application of the omitted priority application details of which were given in the first paragraph of the description of the published international application. This, it was submitted, represented sufficient warning to the public. The fact that the omitted priority date was only four days earlier does not of itself help the appellant. As the Board found in J 14/82, "A European patent application is published early, in accordance with Article 93 EPC, in order to inform the public about the existence of a potential European patent. Not only the technical content and the designated States concerned are of importance for the information of third parties but also the filing date and any priority date. In principle, the public should be entitled to rely on the published information as being both accurate and complete" (point 6 of the grounds for the decision). The Board finds that, in the public interest, this principle is of overriding importance in the case of a first or only priority unless it is apparent on the face of the published application that a first or only priority may be missing or wrong or that the date of a first or only priority is wrong (as for example in the case of an inaccurate transcription of a Japanese date, cf. J 03/91 (Uni-Charm)).

- 5.5 The appellant argues that in this case it was apparent on the face of the published application that the earlier priority was missing. The international application, which actually claimed priority from a continuation-in-part application dated 8 February 1988, was itself presented as

a continuation-in-part application and the first paragraph of the published description was headed and read as follows:

"Background of the Invention
Cross-References to Related Application

This application is a continuation-in-part application of Serial No. (CR-8641) filed on February 4, 1988."

The Board finds that, taken alone, the fact that the international application was itself presented as a continuation-in-part application would not be sufficient to warn the informed public that a first priority might be missing. A continuation-in-part is a second application repeating some substantial portion or all of the earlier application and adding matter not disclosed in the earlier application. Claims that are dependent upon new matter added by a continuation-in-part application are entitled to the filing date of the continuation-in-part, not that of the parent application (see Chisum, Patents, Vol. 4, 1992, 13.03 [3]). The fact that the application from which priority was claimed was a continuation-in-part application would not necessarily imply therefore that there was an earlier priority which should have been claimed. However, in the particular circumstances of this case, the Board finds that the fact that the international application was presented as a continuation-in-part application, taken together with other factors in the case, which would have been apparent to the reader from the first two pages of the published international application, would have been sufficient to put the informed public on notice that a first priority might be missing or that a typographical error had been made. These factors are the following:

the date of the priority actually claimed and that of the earlier application of which the international application was presented as a continuation-in-part were only four days apart (8 and 4 February respectively), which is unusual; the filing date of the international application was 3 February 1989 and therefore it was within the priority year of the 4 February 1988 application and in time to claim priority therefrom.

The fact that the international application was filed on 3 February 1989 would suggest that the applicant intended to claim the priority of 4 February 1988 and that therefore a first priority was missing. Another explanation for the discrepancy which could occur to the informed public would be that the date of 8 February given for the date of the priority actually claimed was a typing mistake. This conclusion could be drawn because it is not clear from the published application whether the application from which priority was claimed and the original application of which the present application is presented as a continuation-in-part were one and the same (only the applicant's serial number for the latter application being given).

- 5.6 The Board finds, therefore, that in this case an exception to the general rule that a request for correction should be made sufficiently early for a warning to be included in the publication of the application is justified and that the requested correction by way of addition of the omitted priority date should be allowed. The Board is satisfied that the public interest is safeguarded by the fact that it was apparent from the face of the published application that a mistake may have been made with respect to the priority date claimed. The Board has also taken account of the fact that the applicant and appellant acted promptly

and that the patent grant procedure, and entry into the regional phase, including publication of the application after 18 months, has not been held up in any way.

Order

For these reasons, it is decided that:

1. The Decision under appeal is set aside.
2. It is ordered that the request form filed on 3 February 1989 according to Article 4 PCT with respect to international application PCT/US 89/00355 (later European patent application No. 89 902 578.7) be corrected, insofar as the European Patent Office is concerned as designated office, by adding the priority data concerning US patent application No. 0 152 186 filed on 4 February 1988, in Box No. VI on page 4 thereof.

The Registrar:



M. Beer

The Chairman:



O.P. Bossung

