

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

File No.: J 0011/92 - 3.1.1
Application No.: 90 309 493.6
Publication No.: 0 416 814
Classification: C07D 501/36
Title of invention: Cephalosporin compounds, process for their
preparation, pharmaceutical compositions and
intermediates

D E C I S I O N
of 12 January 1994

Applicant: Beecham Group p.l.c.
Proprietor of the patent: -
Opponent: -

Headword: Priority declaration (correction)/BEECHAM

EPC: Art. 88(1)
R. 38(1), 38(3), 88, first sentence

Keyword: "Correction of errors/omissions" - "Priority declaration" -
"Correction after publication" - "Public interest"

Headnote

An incomplete priority declaration may be corrected, by the addition of an omitted priority in special circumstances, even after publication of the European patent application without a warning to the public that a request for correction has been made, provided that the public has been informed about the full scope of European patent protection sought, by way of a second European or Euro-PCT patent application, filed as a precautionary measure by the applicant in due time (continuation of the case law of the Legal Board of Appeal as summarised in case J 6/91, to be published).



**Europäisches
Patentamt**

**European
Patent Office**

**Office européen
des brevets**

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number: J 0011/92 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 12 January 1994

Appellant: Beecham Group p.l.c.
SB House
Great West Road
Brentford
Middlesex TW8 9BD (GB)

Representative: Connell, Anthony Christopher
SmithKline Beecham
Corporate Patents
Great Burgh
Yew Tree Bottom Road
Epsom, Surrey KT18 5XQ (GB)

Decision under appeal: **Decision of the Receiving Section of the European
Patent Office dated 22 January 1992 refusing the
addition of a priority.**

Composition of the Board:

Chairman: R. Schulte
Members: G. Davies
M.K.S. Aúz Castro

Summary of Facts and Submissions

- I. The applicant and appellant filed European patent application No. 90 309 493.6 on 30 August 1990, claiming priority from the following UK patent applications (i) GB-A-8 919 945.9 and (ii) GB-A-8 919 946.7, both of 4 September 1989, and (iii) GB-A-9 010 265.8 and (iv) GB-A-9 010 299.7, both of 8 May 1990.
- II. On 25 January 1991, the applicant requested correction under Rule 88 EPC of the Request for Grant Form 1001 by the addition of a fifth priority from UK application GB-A-9 006 728.1 dated 26 March 1990, which had been inadvertently overlooked on filing. It was explained that the first priority claimed ((i) above) disclosed a generic scope and seven examples, while the third ((iii) above) disclosed a further twenty-four examples. Between those two applications, the applicant had also filed UK application No. 9 006 728.1, which disclosed twenty-one of the twenty-four examples of (iii). Accordingly, UK application GB-A-9 006 728.1 was the first application to disclose the subject-matter of the twenty-one examples, while (iii) was the second to do so; thus (iii) provided no basis for priority in respect of that common subject-matter.

The applicant also requested that a warning be published concerning the request for correction at the time of publication of the application in the European Patent Bulletin. The applicant recognised that this particular request was being made after the technical preparations for publication of the application under Article 93 had been completed, pursuant to Rule 48(1) EPC, but submitted that, according to the case law of the Legal Board of Appeal, discretion could be exercised in this respect provided preparations were not too far advanced

for publication, which the applicant assumed to be the case since the intended date of publication had not yet been notified to it. Moreover, the applicant drew attention to decision J 14/82, in which the Board had considered the circumstances in which a request for correction could be granted, even if a warning had not been published. In that case, it was said that the interests of third parties could also be sufficiently protected if a second application were to be published claiming the priorities sought to be claimed in the first application by means of the request for correction. For this reason, as a precautionary measure, the applicant had also filed a second application on 4 March 1991, viz. international application No. PCT/GB91/00331, claiming priority from UK application No. 9 006 728.1 dated 26 March 1990 (the subject of the request for correction), and naming the EPO as a designated office. That application was due to be published under Article 21(2)(a) PCT in late September 1991. Should the request for correction be granted, it was the intention of the applicant not to proceed with the international application.

It was submitted also that to allow the correction would be to the advantage of third parties as it would clarify the issue of what subject-matter was entitled to which priority date.

III. On 13 March 1991, the application was published in the European Patent Bulletin without any warning having been given. The international application was published as WO 9114692 on 3 October 1991.

IV. By decision of the Receiving Section dated 22 January 1992, the request for correction was refused on the ground that, according to the case law of the Legal Board of Appeal, a correction could only be allowed if

the correction was requested sufficiently early for a warning to be included in the published application. Otherwise, for reasons of general legal certainty, it was not in the public interest to allow amendments to priority declarations. Although a mistake could be corrected after completion of the technical preparations for publication in some circumstances, this was only possible in cases where it was still technically feasible to add a warning. In the present case, the request had been filed six and a half weeks before publication. At that stage, it had no longer been possible to intervene in the publication process. The decision in J 14/82 did not help the applicant because the facts of the case were different. There the applicant had filed a request for a warning to be published in time (six months prior to publication), but the Office had failed to publish the warning and, therefore, had been at fault.

V. On 18 March 1992, the applicant filed a notice of appeal against this decision, paying the appeal fee on the same day. A written Statement of Grounds of Appeal was filed on 24 March 1992. Oral proceedings were requested, were the Board minded to maintain the decision under appeal.

VI. The grounds of appeal put forward by the applicant may be summarised as follows: in decision J 14/82, the Legal Board of Appeal had allowed a request for correction under Rule 88 EPC by the addition of three intermediate priority dates omitted from the original request for grant, even though the application as published contained no warning that such a request for correction had been made. Earlier decisions, for example, J 4/82, had established that, if such a warning was included, the request could be allowed. In J 14/82, the Board had considered whether or not the public interest would be adversely affected by allowing the correction and had

come to the conclusion that it would not because the appellants had taken the precaution of filing a further European patent application, in which the three omitted priority dates had been claimed. Thus, third parties would have been warned about the full scope of European protection sought by way of the publication of the further European patent application. It was submitted that a similar situation prevailed in the present case. The appellant had filed a further patent application, viz. the PCT application, designating, *inter alia*, the EPO, in which the omitted priority date had been claimed.

The appellant submitted that the Receiving Section had misinterpreted decision J 14/82, when it had suggested that the decision was strongly influenced by the failure of the EPO to publish the warning in spite of the fact that it had been requested in time. In the appellant's view, the key factor in the decision had been whether or not the public interest would be adversely affected if previous case law were to be modified and the correction to be allowed even though no warning had been published. The Board in that case had concluded that it would not because the public would have been sufficiently warned by the publication of the further European patent application. It was submitted that the same applied in the present case.

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 multiple priorities from four UK patent

applications, filed on 4 September 1989 and 8 May 1990, but failed to claim priority from a fifth UK patent application, dated 26 March 1990. Correction of the priority declaration by the addition of the omitted priority date is requested although the European patent application was published without a warning concerning the request for correction.

- 2.1 Pursuant to Rule 88 EPC, first sentence, "mistakes in any document filed with the European Patent Office may be corrected on request". According to the case law of the Legal Board of Appeal with regard to correction of errors under Rule 88 EPC in cases of correction of a priority declaration, as developed since 1980 and summarised in case J 6/91 (decision of 1 December 1992, to be published, see headnote in OJ EPO 1993/08), a mistake may be an incorrect statement or, as in the present case, result from an **omission** (cf. J 8/80, OJ EPO 1980,293; J 3/82 OJ EPO, 1983,171; J 4/82, OJ EPO 1982,385; J 14/82, OJ EPO 1983,121; J 6/91, EPOR 1993, 318 and headnote in OJ EPO 1993 number 8, page XIV, point 3(2) of the grounds for the decision, and the unpublished decisions J 11/89, dated 26 October 1989, and J 9/91, dated 1 December 1992).
- 2.2 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 (cf. J 8/80, OJ EPO 1980, 293, 296, point 5 of the grounds for the decision; J 4/80, OJ EPO 1980, 351, 353, point 3 of the grounds for the decision; J 4/82, OJ EPO 1982, 385, 389, point 6 of the grounds for the decision).

In the present case, these conditions are fulfilled. The applicant in preparing the European application inadvertently overlooked the existence of UK application No. 9 006 728.1 dated 26 March 1990 and thus failed to complete the priority declaration with respect thereto. The Board is satisfied that the applicant intended to claim priority from the fifth UK patent application as well and that the document filed with the EPO, i.e. the application, did not express the true intention of the applicant (c.f. case J 6/91, point 3 (1) of the grounds for the decision). As the Board has noted in case J 9/91 (point 5 of the grounds for the decision), in principle, there is every reason to believe that the omission of a declaration of priority to which an applicant is entitled in a particular case would be an error capable of correction under Rule 88, first sentence, EPC. As a general rule, there is no need in cases of this kind to require special evidence (affidavits and the like) to discharge the burden on the applicant of proving that a mistake has been made.

- 2.3 According to the case law of the Legal Board of Appeal (J 7/90, OJ EPO 1993, 133, 138, point 2.2 of the grounds for the decision; J 6/91, point 5.3 of the grounds for the decision) Rule 88, first sentence, EPC in no way compels the EPO to permit the correction of errors of any kind at any time but gives the EPO the authority to permit certain types of correction at its **discretion** ("können" - "may" - "peuvent"). The overriding principle in exercising this 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 Patent-übereinkommen, 1989, Article 123 para. 21).

In weighing up the interests of third parties and those of the applicant, the Board is satisfied in the

particular circumstances of this case that the interests of third parties will not be adversely affected by a correction of the priority declaration as requested.

2.3.1 The Legal Board of Appeal has allowed the completion of a priority declaration by an omitted priority even after the publication of the European patent application in cases where the correction was requested sufficiently early for a warning to be included in the published application (cf. J 4/82, OJ EPO 1982, 385; J 14/82, OJ EPO 1983, 121). The decision of the Receiving Section under appeal has stated correctly that these conditions are not met in the present case. The request for correction was made after the technical preparations for publication of the application under Article 93 EPC had been completed pursuant to Rule 48(1) EPC (about six and a half weeks before publication).

2.3.2 However, the question arises, whether there are any **special circumstances** in the present 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.

In case J 14/82 (OJ EPO 1983, 121) the Board considered as special circumstances being relevant for a correction of an omitted (later) priority after publication of the European application without including a warning to the public the following two aspects:

- (a) The applicants did all they could do, by asking for correction of the mistake within a relatively short period of time after filing the application; the EPO therefore should not have published the application without including a warning to the public (point 7 of the grounds for the decision).

- (b) Third parties had been informed about the full scope of European protection sought, by way of a second European patent application, published about 15 weeks after the publication of the first European application, claiming the omitted priorities in relation to the same subject-matter (point 8 of the grounds for the decision).

In case J 3/82 (OJ EPO 1983, 171) the decision of the first instance was overturned because the Receiving Section had wrongly considered the request for correction of the priority declaration as not allowable and, therefore, had refused to publish the necessary warning to the public that a request for correction had been made.

In case J 11/89 (dated 26 October 1989, unpublished) the Board allowed a correction because the Receiving Section, although having noted in the file that there was no formal claim to priority in the request for grant in respect of a second application, had not informed the Applicant's representative of this deficiency (cf. points 5 and 6 of the grounds for the decision).

- 2.3.3 There is no dispute in the present case with regard to the actions and responsibilities of the EPO. Since the relevant priority document was not attached to the application form, the Receiving Section was not in a position to know that the priority declaration was incomplete. The request for correction was made when the technical preparation for publication of the application had reached a stage when "no remarks could be added" (internal note of 13 February 1991).

However, the Receiving Section has misinterpreted the relevant case law, summarised above, in particular decision J 14/82. It expressed the opinion that the

Board allowed the correction "only because the request was filed sufficiently early and the Office was at fault as it had not published a warning" (point 3 of the grounds for the decision under appeal). One has, however, to bear in mind that a correction under Rule 88 EPC, first sentence, is at the **discretion** of the competent authorities and that the interest of the Applicant in gaining optimal protection and the interest of the public in legal security are to be balanced (see above point 2.3). Following this basic principle, in case J 14/82 the Board concluded that "in these special circumstances it is possible for the Board to decide that the public interest would not be adversely affected by allowing the present appeal" (point 8 of the grounds for the decision). The essential element of that reasoning was clearly that third parties had been informed about the full scope of European protection sought, by way of the second European patent application, filed as a precautionary measure by the applicant. The question whether the Office has acted properly or not is of no relevance with regard to the protection of the public interest.

- 2.3.4 In the present case, just as in case J 14/82, the appellant filed in due time, as a precautionary measure, a second application claiming priority from the omitted UK application. By this "auxiliary" application third parties were informed about the full scope of European protection sought. The fact that the appellant chose the PCT route for an international application makes no difference. The EPO was named as designated Office. Thus the international application is deemed to be a European patent application (Article 150(3) EPC) and the publication of the international application takes the place of the publication of a European patent application under Article 93 EPC (Article 158(1) EPC).

The PCT application was published a considerable period after the publication of the European application (about 29 weeks). During this period, the public remained incompletely informed of the full scope of protection (in case J 14/82 only about 15 weeks). However, this uncertainty is acceptable since it represents the normal situation within the priority year under Article 87(1) EPC.

In addition, it should be noted that, in the present case, the public was fully informed about the scope of European patent protection sought as far as the subject-matter is concerned, since the 28 examples disclosed in the omitted priority application are covered by the first priority application No. GB-A-8 919 945.9 (7 examples) and the third priority application No. GB-A-9 010 265.8 (21 examples).

Finally, the Board has taken into account the fact that the applicant acted promptly after detection of the mistake and that the patent grant procedure, including publication of the application after 18 months, has not been held up in any way.

In these circumstances, on balance, the interest of the applicant in not being deprived of claiming the priority of the application No. GB-A-9 006 728.1, dated 26 March 1990, should prevail over the public interest in being informed about the additional priority claim.

- 2.4 For these reasons the requested correction of the priority declaration is allowed. The Board observes, however, that the certified copy of the missing priority document had not been filed before the end of the sixteenth month after the priority date (cf. Rule 38(3) EPC). According to Rule 41(1) EPC, first sentence, the Receiving Section shall inform the applicant about the

deficiency of a missing priority document and invite him to remedy the deficiency within such period as it shall specify. The sanction under Article 91(3) EPC, i.e. the loss of the right of priority, takes effect only if the applicant fails to take advantage of that opportunity (cf. J 1/80, OJ EPO 1980, 289, point 3 of the grounds for the decision).

In the present case, the applicant was not in a position to file the priority document in due time and the Receiving Section was unable to issue a communication under Rule 41(1) EPC, because the deficiency of the priority declaration was revealed only after the expiry of the 16-month period for filing the priority document. The Receiving Section did not subsequently invite the applicant to file the missing priority document, apparently because it took the view that a correction of the priority declaration was not possible for other reasons. Thus the right of priority with respect to the fifth application has not been lost as the result of the fact that no communication under Rule 41(1) EPC was issued by the Receiving Section.

The Board exercised the power within the competence of the Receiving Section (cf. Article 111(1) EPC, second sentence) and issued the communication foreseen in Rule 41(1) EPC. The appellant filed the missing priority document within the time limit specified by the Board, thus preserving its right of priority.

It follows that the request for correction must be allowed.

Order

For these reasons, it is decided that:

1. The decision of the Receiving Section dated 22 January 1992 is set aside.
2. It is ordered that the Request for Grant form filed with respect to European patent application No. 90 309 493.6 on 30 August 1990 be corrected by adding the priority data concerning UK patent application No. GB-A-9 006 728.1 filed on 26 March 1990, on page 2 thereof.

The Registrar:

The Chairman:

M. Beer

R. Schulte