Aktenzeichen / File Number / Numéro du dossier

J 7 194 · 3/1

In der Anlage erhalten Sie

- ☐ eine Kopie des Berichtigungsbeschlusses
- ☐ ein korrigiertes Vorblatt (Form 3030)
- ☐ einen Leitsatz / Orientierungsatz (Form 3030)
- ☐ _____

Please find enclosed

- ☐ a copy of the decision correcting errors
- ☐ a corrected covering page (Form 3030)
- ☐ a headnote / catchword (Form 3030)
- ☐ Decision correcting errors in the decision.

Veuillez trouver en annexe

- ☐ une copie de la décision rectifiant des erreurs
- ☐ une page de garde (Form 3030) corrigée
- ☐ un sommaire / une phrase vedette (Form 3030)
- ☐ _____

Anmeldung Nr. / Patent Nr.: _____ (soweit nicht aus der Anlage ersichtlich)

Application No. / Patent No.: 91111531.9 (if not apparent from enclosure)

Demande n° / Brevet n°: _____ (si le n° n'apparaît pas sur l'annexe)

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: J 0007/94 - 3.1.1

D E C I S I O N
of 20 February 1995 correcting an error in the decision of the Legal Board of Appeal 3.1.1 of 18 January 1995

Appellant: FONTECH Ltd
131 Hapalmach Street
Beer-Sheva
ISRAEL

Representative: Gervasi, Gemma, Dr
NOTARBARTOLO & GERVASI Srl
Viale Bianca Maria 33
I-20122 Milano (IT)

Decision under appeal: Decision of the Receiving Section of the European Patent Office dated 14 December 1993 refusing the request for correction of the priority in European patent application No. 91 111 531.9 pursuant to Rule 88 EPC.

Composition of the Board:

Chairman: R. Schulte
Members: R. E. Teschemacher
G. Davies

Pursuant to Rule 89 EPC, the abbreviation "EPC" is deleted in the decision of the Legal Board of Appeal of 18 January 1995, case No. J 7/94, on page 5, lines 10 and 14.

The Registrar: The Chairman:

M. Beer R. Schulte

BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS

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D E C I S I O N
of 18 January 1995

Case Number: J 0007/94 - 3.1.1

Application Number: 91111531.9

Publication Number: 0466146

IPC: G09C 5/00

Language of the proceedings: EN

Title of invention:
Graphic matter and process and apparatus for producing, transmitting and reading the same

Applicant:
FONTECH Ltd

Opponent:
-

Headword:
Priority declaration (correction)/FONTECH

Relevant legal provisions:
EPC Art. 88, 91
EPC R. 38, 88

Keyword:
"Correction of errors (priority)"
"Correction after publication"
"Public interest"

Decisions cited:
G 0001/88, G 0003/89, G 0011/91; J 0003/82, J 0004/82, J 0014/82, J 0003/91, J 0006/91, J 0002/92, J 0011/92

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

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G. Davies

Headnote:
I. The correction of priority data, not requested sufficiently early for a warning to be included in the publication of the application, is only allowable if it is justified by special circumstances (confirmation of J 6/91, OJ EPO 1994, 349). This applies also to the addition of a priority of a later date than the priority claimed erroneously.
II. The mere fact that an existing priority was not claimed does not justify the correction.

Summary of Facts and Submissions

I. European patent application No. 91 111 531.9 was filed on 11 July 1991 claiming priority from 3 earlier applications in Israel. The declaration of priority in box 25 of the request form contained the following details:

Filing Date	Application No.
July 11 '90	95037
Jan. 16 '91	96969
Jan. 16 '91	96973

II. The priority documents for the three priorities were filed on 5 September 1991 in due form and the application was published with the priority data as indicated in the request form. The European search report was dispatched on 15 December 1992.

III. On 11 February 1993 the Applicant requested correction under Rule 88, first sentence, EPC of the declaration for the first priority whose data should read "filing date: 25 October 1990, application No. IL 96118". It was explained that, when drafting the specification of application No. 96969, reference had been made by mistake to application No. 95037, and that this mistake had been carried over to application No. 96973 and to the present application. It was submitted that it was immediately evident that this was a clerical error, that no rights of third parties were jeopardised by the correction, and that nothing else could have been intended than that what was offered as a correction. At the same time the priority document for application No. 96118 was filed.

IV. By decision of the Receiving Section, dated 14 December 1993, the request for correction was refused. The decision pointed out that according to decision J 4/82 (OJ EPO 1982, 385) a request for correction of a priority declaration was allowable if it was filed early enough for a warning to be published with the publication of the application in order to make the published information on priorities reliable for third parties. Extraordinary circumstances justifying an exception to this rule, as had been present in cases J 14/82 (OJ EPO 1983, 121), J 3/91 (OJ EPO 1994, 365) or in J 2/92 (OJ EPO 1994, 375) could not be accepted in this case. Neither did the publication contain any indication of an obvious incorrectness of the declaration of priority nor had the correction been requested within a very short term after filing the application.

V. On 10 February 1994, the Applicant filed a Notice of Appeal and on 16 February 1994, the appeal fee was paid. A written Statement of Grounds was filed on 8 April 1994. Subsequently, in response to a communication of the Board, the Appellant supplemented its submissions.

VI. The arguments in support of the appeal may be summarized as follows:

The relevant case law, in particular decisions J 3/91 and J 2/92, did not provide for a time limit for a request for correction nor did it require that a warning must be published with the application. The requested correction fully respected the balance of the interests of the Applicant in gaining optimal protection with those of the public in respect of legal security as defined in J 3/91 and J 2/92.

The Receiving Section was wrong in refusing the request for the reason that the mistake was not apparent on the face of the published application. It was sufficient that the mistake made was fully and frankly explained. A comparison of the published application with application IL 95037 would have revealed this mistake which became evident when the correction was requested, in particular since the figures of the present application were lacking in the earlier application. This satisfied also the standard for a correction under Rule 88, second sentence, EPC as laid down by the Enlarged Board of Appeal in G 3/89 and G 11/91 (OJ EPO 1993, 117 and 125), according to which an error is obvious if the skilled person is in no doubt that the information given is not correct.

The declaration of priority did not reflect the true intention of the Applicant, since he wanted to cite all priority documents the content of which corresponded to the specification of the present application. The only possible reason for indicating the wrong priority was a clerical error, which was at the same time the reason for the successive actions of the Applicant. Such error did justify the addition of the omitted priority as this was stated in particular in decision J 11/92 (to be published in OJ EPO, headnote in OJ EPO 6/1994), which case was very similar to the present one.

It was submitted that the Applicant acted with due diligence in requesting the correction as soon as possible. It was not possible for the Applicant to detect the omission until the application and the priority were checked in the light of the search report. Therefore the lapse of time between the dates of priority and filing of the application on the one hand and the submission of the request for correction on the

other hand was less relevant than the fact that the correction was requested within a short time after receipt of the search report.

Finally the technical content of application IL 96118 was known to the public since the present application was published because it was contained in the present application as published. Any change of the priority application was impossible, since it was in existence from its filing date at the Patent Office of Israel.

Reasons for the Decision

1. The admissible appeal cannot be allowed.

2. The Board has summarised its jurisprudence with regard to the correction of errors under Rule 88, first sentence, EPC concerning priority data in decision J 6/91, (OJ EPO 1994, 349). In the present case the request for correction was refused for the reason that it had not been requested sufficiently early for a warning to be included in the publication of the application, and special circumstances justifying the correction at a later stage were absent. This general standard applied by the Receiving Section is in accordance with decision J 6/91 (pt 3(4) of the reasons).

3. The Appellant has not been able to establish any circumstances justifying that the interests of the public should come second to the interest of the Appellant in having the correction made (cf J 6/91, pt 3(6) of the reasons).

4. In exercising its discretion when deciding on a request for correction of a priority, the Board has to bear in mind the purpose of the formalities for claiming priority. The EPC provides for such formalities in Article 88 and Rule 38 EPC. They have to be fulfilled at the filing date or within strict time limits (Rule 38(2) to (4) EPC), irrespective of the question whether there is relevant state of the art in the priority interval. These provisions are in accordance with Article 4D(1) EPC, second sentence, of the Paris Convention, according to which each country shall determine the latest date on which the declaration of priority must be made. The date or the period must be so fixed that the obligation, under Article 4D(2) EPC of the Paris Convention, to publish the particulars contained in the declaration can be complied with. This system aims at avoiding the unsatisfactory situation that the claim of priority comes as a surprise to those affected by the patent (Bodenhausen, Paris Convention for the Protection of Industrial Property, Geneva 1968, Art. 4D, note (a); Ladas, Patents, Trademarks and Related Rights, National and International Protection, Vol. 1, Cambridge, Mass. 1975, §§ 271 et seq.). In the European patent system, the publication of the application is foreseen i.a. in order to shorten the period of uncertainty for competitors in respect of emerging patents (van Empel, The Granting of European Patents, Leyden 1975, pt 371). The publication can only fulfil its purpose if it contains the elements which are essential for the patentability of the invention in respect of which a patent application is made. The patentability of an invention cannot be evaluated without the relevant state of the art which can only be determined if it is known whether a priority is claimed and the extent to which it is valid (Article 54 in connection with Article 89 EPC). This is why Rule 38(5) EPC provides expressly for the

particulars of the priority declaration to appear in the published application.

5. This information is not only necessary for third parties in order to foresee which patents have to be respected in future. Article 67 EPC gives the Applicant provisional protection from the date of publication of the application. This means that competitors are forced to take into account the effects of patent protection already at this date (Paterson, The European Patent System, London 1992, paragraph 6-18). They can, however, be expected to respect these effects only if they have at the same time a reliable legal basis for the economic decisions they have to take. This includes in particular the priority data, as already stated above.

6. This is the reason why the case law has put particular emphasis on the aspect of legal security in cases where a correction of a priority declaration was not requested sufficiently early for a warning to be included in the publication and why the Board cannot agree with the opinion of the Appellant that deleting a wrong priority and adding a new one would not damage the interest of the public but simply inform the reader of the real priority. On the contrary, the free possibility to amend or to add priority declarations after the publication stage would restrict the reliability of the publication in respect of one of its most essential elements.

7. It also has to be remembered that under Article 164(2) EPC the Implementing Regulations must be interpreted in the light of the Convention (G 1/88, OJ EPO 1989, 189, pt 4 of the reasons). In the present case Articles 88(1), 91(1)(d) and (3) EPC are relevant. These stipulate that the right of priority shall be lost if the requirements concerning the claim to priority have not been satisfied. This means that a practice allowing

the unlimited addition of priority declarations under Rule 88 EPC outside the framework of Article 88 in connection with Rule 38 EPC would be contrary to the Convention. Consequently the mere fact that an existing priority was not claimed cannot justify to add this priority by correction. For these reasons the Board maintains its practice that a correction at this stage may only be allowable under special circumstances, in particular if it is apparent on the face of the published application that a priority is wrong or missing.

8. This cannot be accepted in the present case. It is not sufficient, as suggested by the Appellant, that a mistake may be detected after consulting the priority document, since the published data as such should be reliable at the publication date. In any case it was not apparent even from the priority document as filed relating to the priority indicated in the request form that the priority data were not correct. The Appellant's argument that the mistake was already apparent from the fact that the present application contained several sheets of drawings quite different from the drawings of the priority document, is not convincing since there is no rule that the earlier application is more or less identical to the application for which priority is claimed. It may make sense for an Applicant to claim priority only for a certain embodiment of an invention which does not need to be shown in a drawing. Otherwise Articles 88(2) and (3) EPC dealing with multiple and partial priorities would be meaningless. A discrepancy between the technical fields of the applications concerned was not apparent.

9. The Appellant is of the opinion that the interest of the public is not affected anyway by the addition of a second or subsequent priority. It is true that in such a case the publication of the application is not delayed which is an important aspect for the system of early publication as laid down in Article 93 EPC. Nevertheless also the addition of a priority of a later date than the priority claimed erroneously may affect the public because any additional priority is relevant for the evaluation of the validity of the patent.

10. Any other special circumstances justifying the requested correction, comparable to those accepted in the previous case law are not evident. Neither was the EPO responsible for not giving a warning to the public at the publication stage (cf J 3/82, OJ EPO 1983, 171) nor has the public been informed about the full scope of protection sought by way of a parallel application (cf J 11/92 op. cit.).

11. Since the request cannot be allowed for the preceding reasons, the question may be left unanswered whether the mistake made was the consequence of a clerical error as alleged by the Appellant.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

M. Beer R. Schulte