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D E C I S I O N
of 3 December 1996

Case Number: J 0017/96 - 3.1.1

Application Number: 95309289.7

Publication Number: 0718444

IPC: E02F 3/47

Language of the proceedings: EN

Title of invention:

Oil supply mechanism in a deep excavator

Applicant:

NIKKEN CORPORATION

Opponent:

-

Headword:

Correction of mistake/NIKKEN

Relevant legal provisions:

EPC Art. 60(3), 61

EPC R. 88

Keyword:

"Correction substituting the name of the real applicant"

"Sufficient evidence of proof"

Decisions cited:

J 0007/80; J 0008/80; T 0219/86; J 0018/93

Catchword:

A correction substituting the name of the applicant is admissible under Rule 88 EPC.



Case Number: J 0017/96 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 3 December 1996

Appellant: NIKKEN CORPORATION
14-2 Nagatacho 2-chome
Chiyoda-ku
JP - Tokyo 100 (JP)

Representative: Shindler, Nigel
BATCHELLOR, KIRK & CO.
2 Pear Tree Court
Farringdon Road
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Decision under appeal: Decision of the Receiving Section of the European Patent Office dated 3 June 1996 refusing a request for correction under Rule 88 EPC with respect to European patent application No. 95 309 289.7.

Composition of the Board:

Chairman: J. C. Saisset
Members: J.-C. de Preter
M. Aúz Castro

Summary of Facts and Submissions

- I. European patent application No. 95 309 289.7 claiming two Japanese priorities No. 335640/94 of 21 December 1994 and No. 180771/95 of 23 June 1995 was filed with the UK Patent office on 20 December 1995 by a professional representative in the name of Nikken Corporation.
- II. By a letter dated 28 February 1996 the representative requested correction of the applicant's name pursuant to Rule 88 EPC to Japanic Corporation with the corresponding correction to the request for grant and the designation of inventor.

It was argued that the application was mistakenly filed in the name of Nikken Corporation as it was believed that Japanic Corporation, applicant in the priority applications, had already merged with Nikken Corporation on the date of filing of the European patent application. It was only discovered at a later date that the merger had not yet taken place. Copies of the relevant correspondence were filed as evidence.

In a communication dated 2 April 1996 the Receiving Section informed the representative that Rule 88 EPC was not intended to allow the substitution of the applicant and that this could only be done under Rule 20 EPC.

In his reply of 9 April 1996 the representative argued that Rule 88 EPC was very explicitly drafted for the purpose of allowing a correction of a mistake of "any document filed with the EPO" and that this Rule had been previously used to allow the correction of an applicant as shown by Decision J 0007/80. He argued that this case was similar to the case set out in that

decision, as the request for correction was made in order to ensure that the applicant's claim to priority under Article 87(1) EPC was supported. It was further stated that as Rule 20 EPC provides for the recording of transactions, an applicant could never be "corrected" under that Rule.

In a communication of 2 May 1996 under Article 113 EPC the Receiving Section informed the representative of its intention to refuse the requested correction. In his letter of 10 May 1996 the representative contested the Receiving Section's view.

III. By a decision of 3 June 1996 the Receiving Section refused the request on the ground that Rule 88 EPC was not intended to allow the substitution of one applicant for another. According to Article 60(3) EPC a person named as an applicant is deemed to be entitled to exercise the right to the European patent. Thus, the applicant's entitlement is not verified but is accepted by the EPO solely on the basis of his identification as applicant in the request so that he may not be replaced or substituted by way of correction, even if his entitlement is disputed. In the latter case the Convention provides for a special procedure, which cannot be circumvented by applying Rule 88 EPC, especially in view of the fact that Articles 60(3) and 61 EPC have precedence over Rule 88 EPC (Article 164(2) EPC).

Furthermore, no indication of exceptional circumstances could be derived from the documents on file as was the case in decision J 0007/80 in which the correction of the name of the applicant had been allowed. In that case the use of the Swedish language by a Dutch company (subsidiary of a Swedish company) had raised doubts

even at the time of filing as to whether the right person (firm) had been named as applicant in the application so that it therefore did not come as a surprise that the Swedish company was in fact the applicant.

IV. An appeal against the decision was lodged on 11 July 1996 and the statement of grounds was filed on the same day. The appeal fee was paid on 15 July 1996. The principal grounds relied on are the following:

- Rule 88 EPC does not exclude the substitution of a mistakenly named applicant in order to correct the mistake and is useful for the correction of any mistake appearing in a document filed with the EPO. If the document is not a description, claims or drawings, the correction does not need to be obvious nor is some special circumstance beyond mere abnormal circumstance required for correction of a mistakenly named applicant.
- As there is no dispute and no doubt as to the proprietorship the provisions of Articles 60 and 61 EPC do not appear to be relevant.

The appellant also explained that the patent application had been assigned to Nikken Corporation by virtue of the assignment of 29 January 1996, a copy of which was enclosed, and that the assignor, Japanic Corporation, had been dissolved after that assignment.

V. The appellant requested:

- that the decision under appeal be set aside and that the named applicant be changed to Japanic Corporation under Rule 88 EPC;

- that the appeal fee be reimbursed in the event of the appeal being allowed;
- that, if the Board of Appeal was not persuaded by the grounds of appeal, a date be set for oral proceedings.

Reasons for the Decision

1. The Board states that the reasons for refusing the appellant's request are exactly the same as in the Receiving Section's decision of 18 August 1993 with respect to European patent application No. 92 303 280.9 filed in the name of Cardiac Pacemakers. This decision was set aside by Decision J 0018/93 of 2 September 1994 allowing the requested correction substituting the name of the applicant. The Legal Board in its actual composition does not see any reason to deviate from Decision J 0018/93 and can only repeat what has already been explained clearly in that decision i.e:

"In Article 60(3) EPC the principle is established that the EPO assumes the applicant to be entitled to the European patent. This fiction only relieves the EPO from any need to investigate the existence of the entitlement. However, when a person referred to in Article 60(1) EPC, other than the applicant, disputes the entitlement to the grant of a European patent, the entitlement may be modified under the conditions provided for in Article 61 EPC.

A modification as to the identity of an applicant is also allowable under Rule 88 EPC concerning the correction of errors in documents filed with the European Patent Office. Indeed this Rule, which is not in conflict with the provisions of Article 61 EPC,

which concerns ownership disputes, provides that mistakes in any such document may be corrected on request, the only additional condition according to the second sentence of that Rule being that, if the request concerns a description, claims or drawings, the correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as a correction. This condition does not apply in the present case. Here it is only necessary to verify whether there is sufficient evidence to support the request under Rule 88 EPC, as was decided in decision J 0007/80, OJ EPO, 1981, 137 (see reason 3) which allowed the correction substituting the name of the applicant in the absence of any "exceptional" circumstances (cf. also T 0219/86 OJ EPO, 1988, 254 concerning the correction of the name of the opponent).

Where the correction of a mistake is requested and the second sentence of Rule 88 is not applicable, the Board must be satisfied that a mistake was made, what the mistake was and what the correction should be. In order to avoid any abuse of the provisions of Rule 88 EPC, the burden of proving the facts must be a heavy one (J 0080/80, OJ EPO, 1980, 293)".

2. In the present case the mistake already appears plausible when the priority documents filed in the name of Japanic Corporation are considered. Moreover, in the letter of 27 November 1995 containing the instructions from the Japanese patent attorney to the European representative it was explained that the Japanese applications were filed in the name of Japanic Corporation but that the applicant had changed its name from Japanic Corporation to Nikken Corporation because of a merger so that the European application had to be filed in the name of Nikken Corporation. However, the European representative was informed by letter of

7 January 1996 from the said Japanese patent attorney that the merger had not yet been effected. A copy of these letters was attached to the appellant's request of 28 February 1996 together with a letter of Japanic Corporation and of Nikken Corporation consenting to the correction of the application. Under these circumstances the Board is satisfied that all the evidence needed has been provided to allow the appellant's request for correction.

3. The request for reimbursement of the appeal fee has to be rejected. Although the Receiving Section, which is regularly faced with correction problems, should have been aware of Decision J 0018/93 and should therefore have considered it in its decision, it's error remains an error of judgment and was not a substantial procedural violation (Rule 67 EPC).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. It is ordered that the name of the applicant in European patent application No. 95 309 289.7 (request for grant and designation of inventor) be corrected to that of Japanic Corporation (930-1, Hakari-Cho, Ashikaga-Shi, Tochigi-Ken, JP)
3. The request for reimbursement of the appeal fee is rejected.

The Registrar:

The Chairman:

M. Beer

J.-C. Saisset