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D E C I S I O N
of 14 February 2002

Case Number: J 0017/97 - 3.1.1
Application Number: 94112056.0
Publication Number: 0798015
IPC: A61N 1/365

Language of the proceedings: EN

Title of invention:
Rate responsive cardiac pacemaker

Applicant:
SULZERmedica

Opponent:
-

Headword:
Identity of the applicant of a divisional
application/correction

Relevant legal provisions:
EPC Art. 76
EPC R. 88, first sentence

Keyword:
"Divisional application - correction substituting the name of
the applicant by the name of the applicant of the parent
application"
"Proof of true intention - inconsistent and contradictory"

Decisions cited:
J 0008/80, J 0006/91

Catchword:
-



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Boards of Appeal

Chambres de recours

Case Number: J 0017/97 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 14 February 2002

Appellant:

SULZERmedica
4000 Technology Drive
Angleton
Texas 77515 (US)

Representative:

Haft, von Puttkamer, Berngruber, Czybulka
Patentanwälte
Franziskanerstraße 38
D-81669 München (DE)

Decision under appeal:

Decision of the Receiving Section of
27 September 1996 refusing to treat European
patent application No. 94 112 056.0 as a
divisional application.

Composition of the Board:

Chairman: J. Saisset
Members: G. E. Weiss
J. C. M. De Preter

Summary of Facts and Submissions

- I. The European patent application No 87 111 912.9 was filed on 17 August 1987 by a professional representative in the name of "Intermedics Inc., Freeport, Texas, USA". On 3 August 1994, the representative of Intermedics Inc. approved the text of the application according to Rule 51(4) EPC.

- II. On 2 August 1994 - one day before the approval of the text of the application - the European patent application 94 112 056.0 was filed by the same professional representative in the name of "SULZERmedica, Angleton, Texas, USA" as a divisional application on the earlier application No 87 111 912.9.

- III. On 5 October 1994 the representative of Intermedics, Inc. and SULZERmedica requested that the European Patent Office register the assignment of the divisional application to Intermedics Inc. The administrative fee was duly paid. A declaration of assignment has been produced.

In the communication pursuant to Rule 69(1) EPC dated 21 October 1994, the Receiving Section informed the representative that, due to the different identities of the applicants in the divisional application and the parent application, the European patent application could not be treated as divisional application.

In his reply received on 23 December 1994, the representative requested revocation of the communication dated 21 October 1994 and submitted an agreement dated 7 July 1994 by which Intermedics Inc. had assigned the prospective subject-matter of the divisional application to SULZERmedica.

In the communication dated 10 November 1995, the Receiving Section informed the representative that it intended to refuse the request to revoke the communication dated 21 October 1994. The following grounds were given:

- (a) as Article 76 EPC derives from Article 4G Paris Convention, it follows that, although the word applicant is not expressly mentioned in Article 76 EPC, only the applicant himself is entitled to divide a European patent application.
- (b) the right to divide can only be exercised by the same person as the right to the patent as a whole, namely the applicant of the parent application (Article 60(3) EPC).
- (c) the assignment to SULZERmedica must be taken to have effect from the date on which the conditions according to Rule 20 EPC were fulfilled (28 December 1994), and not from 7 July 1994, the purported date of the assignment.

IV. On 20 June 1996 the representative of SULZERmedica explained again the special circumstances of this case and filed after telephone discussions with formalities examiners of the Receiving Section a request for correction of the name of the applicant of the divisional application pursuant to Rule 88 EPC.

V. By decision posted on 27 September 1996 the Receiving Section refused the request for registering a transfer of rights pursuant to Article 72 EPC, the request to correct the name of the applicant pursuant to Rule 88 EPC and the request to revoke the communication pursuant to Rule 69(1) EPC; insofar as the filed

European application could not be treated as divisional application pursuant to Rule 25(1) EPC. The main reasons for the decision are the same as those given to the representative in the communication dated 10 November 1995.

VI. Appeal against the decision was lodged on 27 November 1996 and the appeal fee was paid on the same day. The statement of grounds was filed on 6 February 1997 and completed with a letter received 27 April 2001. The principal grounds relied on in the request to correct the name of the applicant of the divisional application pursuant to Rule 88 EPC are the following:

- in 1990 Intermedics Inc. was incorporated into the company SULZERmedica and since then was designated "Intermedics Inc. a company of SULZERmedica";
- since early 1993 the services of Intermedics with respect to patents and other legal matters were transferred to SULZERmedica USA Inc. at the same place in Angleton, Texas, USA;
- in September 1993 discussions for filing the divisional application started; end of January 1994 the notification pursuant to Rule 51(4) EPC for the parent application was dispatched. Unfortunately the discussions with respect to the divisional application lasted longer than expected so that a request for a two months extension of term for filing the statement of approval for the parent application was filed by letter of 31 May 1994. After this extension had been allowed the approval to file the divisional application was given end of July 1994. The divisional application

was then filed on 2 August 1994. Since all patents and legal matters had been handled by SULZERmedica for more than one year and since appellant's representative was informed by the patent attorney of Intermedics in autumn 1993 that this company had been taken over by SULZERmedica in the form of a merger, the divisional application had been filed in the name of SULZERmedica.

The appellant also requested that oral proceedings be arranged if there were any objections to allowing the request. He produced some evidence, in particular a letter of 17 August 1994 of SULZERmedica which mentioned that the filing of a divisional application in the name of SULZERmedica was incorrect and that Intermedics, Inc. was still a viable entity.

VII. In an annex to the summons to oral proceedings pursuant to Article 11(2) EPC of the Rules of Procedure of the Boards of Appeal sent to the representative on 5 October 2001, the Board drew the attention of the appellant to inconsistencies between appellant's explanations and some documents on file and on the established case law of the Boards of Appeal concerning Rule 88 EPC.

VIII. Oral proceedings were held on 14 February 2002.

IX. The appellant requested that the decision under appeal be set aside and that the request to correct the name of the applicant pursuant to Rule 88 EPC to Intermedics Inc. and to revoke the communication of 21 October 1994 pursuant to Rule 69(1) EPC be allowed.

Reasons for the decision

1. The appeal is admissible.
2. The appeal is limited to the request for correction of the identity of the applicant of a divisional application. Rule 88 EPC governs the correction of errors in documents filed with the European Patent Office. In the present case the request does not concern the description, claims or drawings, so that it is only necessary to verify whether or not, there is sufficient evidence to support it. In such circumstances the case law of the Boards of Appeal has ruled that 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 (emphasis added). In order to avoid any abuse of the provisions of Rule 88 EPC, the burden of proving the facts, ie the burden on the applicant of proving that a mistake has been made, what the mistake was and what the correction should thus must be a heavy one (J 8/80, OJ EPO 1980, 293). Rule 88 EPC may not be used to enable a person to give effect to a change of mind or subsequent development of plans. These principles have been reaffirmed in all subsequent decisions (see for example J 6/91, OJ EPO 1994, 349).
3. In the present case it is alleged that the present application was filed in error by SULZERmedica and should have been filed by Intermedics, Inc.

According to the appellant the error arose from the fact that for more than one year before the filing of the present application all patents and legal matters were handled by SULZERmedica and in particular from the

fact that appellant's representative was informed by the patent attorney of Intermedics, Inc. in autumn 1993 that this company had been taken over by SULZERmedica in the form of a merger.

However, these explanations are clearly inconsistent with the fact that the parent application continued to be prosecuted by Intermedics, Inc. and also by the fact that by agreement of 7 July 1994 the right to file the divisional application was assigned from Intermedics, Inc. to SULZERmedica.

This agreement was concluded during the two months extension of term, which was requested by letter of 31 May 1994 for filing the statement of approval because of the ongoing discussions about the filing of the divisional application and made clear that it was SULZERmedica's intention to file the divisional application.

Whatever the doubts expressed for the first time at the oral proceedings by appellant's representative concerning the real date of that agreement, the Board can only take account of the date mentioned in this agreement of which a photocopy was sent by said representative by letter of 18 December 1994 with the clear purpose to prove that the right to file the divisional application had been assigned by Intermedics, Inc. to SULZERmedica before the filing of the present application.

As to the letter of 17 August 1994 of the appellant to its representative, in which it was indicated that the filing of the divisional application in the name of SULZERmedica was incorrect, the Board notes that this letter was written approximately three weeks after the filing of the present application and contradicts the above-mentioned agreement and thus the true intention

of the appellant at the time of the filing of said application. Moreover, this letter is self-contradictory where it is stated that Intermedics, being still a viable entity, would be the "assignee", and owner of this application.

Thus, the request under Rule 88 EPC cannot be allowed.

Order

For these reasons it is decided that:

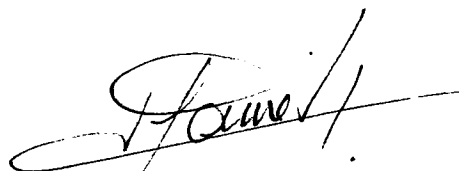
The appeal is dismissed.

The Registrar:



S. Fabiani

The Chairman:


J.-C. Saisset