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D E C I S I O N
of 3 September 2001

Case Number: J 0016/99 - 3.1.1

Application Number: 94300156.0

Publication Number: 0608979

IPC: H02P 7/63

Language of the proceedings: EN

Title of invention:
Switching circuit

Applicant:
Switched Reluctance Drives Limited

Opponent:
-

Headword:
Correction of error/SWITCHED RELUCTANCE

Relevant legal provisions:
EPC R. 88, 89

Keyword:
"Correction of error under Rule 88 EPC - after grant - no
proceedings pending - correction under Rule 89 EPC"
"Formalities officer not competent to decide"
"Reimbursement of appeal fee (yes)"

Decisions cited:
J 0042/92, T 0850/95 (of 12 July 1996), G 0008/95

Catchword:
-



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Boards of Appeal

Chambres de recours

Case Number: J 0016/99 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 3 September 2001

Appellant: Switched Reluctance Drives Limited
East Park House
Otley Road
Harrogate
North Yorkshire HG3 1PR (GB)

Representative: Hale, Peter
Kilburn & Strode
20 Red Lion Street
London WC1R 4PJ (GB)

Decision under appeal: Decision of Examining Division of the European
Patent Office dated 24 February 1999 refusing a
correction to European patent No. 608 979.

Composition of the Board:

Chairman: J.-C. Saisset
Members: C. Rennie-Smith
M. B. Günzel

Summary of Facts and Submissions

- I. European Patent No. 608979 was granted on 10 June 1998 on the basis of application No. 94 300 156.0 which was filed on 10 January 1994 by Switched Reluctance Drives Limited, an English company ("the appellant"), and claimed a priority date of 14 January 1993 from GB application No. 9 300 734.2. The certified copy of that GB application filed at the EPO on 11 February 1994 showed on its face that the application date of the GB application was 13, not 14, January 1993.

- II. As to the reason for the one day difference between the actual filing date of the GB application and the priority date claimed therefrom in the European patent application, the error arose when the appellant's patent attorney noted the wrong date when taking instructions by telephone to file the European application, the appellant itself having filed the earlier GB application. It is not known whether the appellant gave its attorney the wrong date or the attorney made a mistake in his note.

- III. The European application proceeded through all its stages to grant without the discrepancy being noticed either by the appellant or the EPO. The search report revealed no "P document" so the priority date was not scrutinised by the Examining Division. The file shows no mention was made of the priority date after receipt by the EPO of the copy priority document until the request for correction referred to below. Only when the appellant received a letter of 9 June 1998 from its attorney enclosing a copy of the Decision to Grant a European Patent (EPO Form 2006) was it noticed that the priority date was shown as 14 January 1993. In a letter dated 22 July 1998 the appellant requested a correction under Rule 88 EPC.

- IV. By a communication of 25 November 1998, the Formalities Officer of the Examining Division indicated the request was not allowable. In response the appellant asked for an appealable decision which was issued by the Formalities Officer on 24 February 1999. The present appeal was commenced by a Notice of Appeal received on 29 March 1999. The appeal fee was paid on 26 March 1999. The Grounds of Appeal and supporting evidence were filed by both fax and letter dated 23 June 1999.
- V. The reasons given by the Examining Division for refusing to allow the requested correction were that, while a declaration of priority may, upon request and in certain circumstances, be corrected pursuant to Rule 88 EPC, in the present case the request could not be allowed for two reasons:
1. First, correction of errors in documents filed with the EPO are only possible under Rule 88 until, at the latest, the decision to grant has been handed to the EPO postal service - see decision G 12/91 and Part C, chapter VI, para. 5.9 of the Guidelines for Examination (referred to hereafter as "the Guidelines"). Once a patent is granted, the Examining Division has no power to alter or amend its text under Rule 88 or any other EPC provision (apart from Rule 89 EPC which was said not to be relevant here) because, unless an opposition or appeal is pending, there are no longer any proceedings in being.
 2. Second, the request in this case could not be allowed in view of various decided cases of the Legal Board of Appeal which have held that requests for corrections must, for reasons of public interest in the reliability of officially published information, be made at the latest in time to enable a warning to be published together

with the patent application. In this case the error was due to an oversight by the applicant or its representative and the reason no warning was given to the public was that the request for correction was filed late, namely after the patent was granted.

VI. The appellant's arguments can be summarised as follows:

1. While it may be correct that after the decision to grant has been issued the Examining Division has no power to alter or amend the substantive content of a patent, this is not the case as regards purely bibliographic data. This distinction is implicit in the two sentences forming Rule 88 and supported by the passage in the Guidelines relied on by the Examining Division which says *inter alia*

"Linguistic errors, errors of transcription and mistakes in any document filed with the Office may be corrected at any time." [*Emphasis added by the appellant.*]
2. The case law of the Boards of Appeal and the Guidelines expressly state that correction of an error under Rule 88 is a matter of discretion which can be exercised at any time. The case law, although stressing the desirability of timely requests for correction of priority date mistakes, admits the possibility of exceptions when the balance of interest between the patentee and third parties should be exercised in favour of the patentee, as in the present case.
3. The request for correction in this case was made promptly after the error was discovered.

4. As regards the public interest, the alteration is only of one day and will show the correct priority date which is in any event ascertainable from the publicly available GB priority document. Thus, the public interest will be served by ensuring legal certainty.

5. If the correction is not allowed, the appellant will suffer because some national patent offices will not amend their records without a decision from the EPO allowing the correction. As this would not be the case with patents obtained through national procedures, the appellant is discriminated against by comparison with proprietors of patents obtained nationally. In support of this argument the appellant filed copies of letters from three of its representative's correspondents in other contracting states than GB confirming, in at least one and possibly two cases, that their national offices will not allow amendment without an EPO decision to correct the date, and a copy of a letter from the GB Patent Office confirming that in GB the public record has been corrected. The EPO is thus under a duty to allow an amendment in a matter on which national offices look to it for authority.

6. The Receiving Section of the EPO should have noticed the error between the filing of the priority document on 11 February 1994 and publication of the application on 3 August 1994 and brought it to the appellant's attention in time for it to be corrected prior to publication.

- VII. The appellant requests that the decision under appeal be reversed and the correction to the priority date from 14 January 1993 to 13 January 1993 be made. Oral proceedings are not requested.
- VIII. In a communication of the rapporteur posted on 28 May 2001 the Board indicated on a provisional basis its view that the case should be remitted to the Examining Division for consideration under Rule 89 EPC and invited the appellant's observations. In a letter dated 4 July 2001, the appellant intimated its agreement to that course of action.

Reasons for the Decision

1. The appeal is admissible.
2. Both the appeal and the request for correction giving rise to the decision under appeal were couched in terms of Rule 88 EPC. It is at least doubtful whether the EPO is competent to allow a correction under Rule 88 EPC when no proceedings are pending before it (see J 42/92, unpublished, reasons, paragraph 4). In this respect the decision under appeal may have been correct but, since the decision must be set aside and the case remitted to the Examining Division for the reasons set out below, the Board makes no decision on that.
3. Rule 89 EPC, which is headed "Correction of errors in decisions" reads:

"In decisions of the European Patent Office, only linguistic errors, errors of transcription and obvious mistakes may be corrected."

The decision under appeal said (reasons, paragraph 2, second sentence):

"Once a patent is granted, the Examining Division is no longer empowered to alter or extend the text of the patent, neither under Rule 88 EPC nor under any other provision of the EPC (**except Rule 89 EPC which, however, is not relevant under the given circumstances**), because proceedings are no longer pending unless an opposition or appeal is validly filed." (*Emphasis added*)

4. Although the request giving rise to the first instance decision made no reference to Rule 89 EPC, it appears to the Board that Rule 89 is if anything more applicable to the present case than Rule 88 EPC since, being applicable to "errors of transcription and obvious mistakes" in "decisions of the European Patent Office", it allows correction of such errors in inter alia decisions to grant patents (as happened for example in decision T 850/95 of 12 July 1996, OJ 1997, 152) without the limiting requirement of pending proceedings. Even though Rule 89 EPC was not cited by the appellant, not only was the first instance not restricted to a consideration merely of the appellant's submissions but was obliged to consider all relevant legal provisions which could lead to the result that the requested correction of the priority date would have to be allowed (see Article 114(1) EPC).

5. It is clear in the present case that what the appellant wanted to achieve was amendment of the incorrect priority date to the correct one as shown on the front page of the GB priority document from which the priority of the European application had been claimed. The date, country and file number of claimed priorities are unambiguously part of the decision to grant (see in

the present case page 53 of the examination file). Therefore, when correction of the priority date of a granted patent is requested, there may be a case for correction under Rule 89 EPC of the EPO's decision to grant. As for example decision T 850/95 (cited above, reasons, paragraphs 2 and 6) shows, even when the error originated with or was contributed to by the applicant, incorporation of the error into the decision to grant may give rise to an error in that decision by the EPO which can be corrected under Rule 89 EPC if it can be said that the EPO could not have wanted to grant the patent with the incorrect content of which correction is requested. In T 850/95 the error was in the text of the description in the body of the patent itself and the existence of the error was apparent from a comparison of the text of the patent as granted with that of a parallel application in a separate file. In the present case, not only is the error simpler in nature, being merely a date (albeit possibly an important one) shown in the bibliographic data, but it is clearly apparent from reference to the priority document on the same file. Accordingly in the Board's judgment, Rule 89 EPC should have been considered more closely and could not simply be dismissed as "not relevant".

6. Further, and more importantly for the disposition of the present appeal, the Formalities Officer who made the decision under appeal had no authority to make a decision under Rule 89 EPC. Such decisions must be made by the Examining Division (see G 8/95, OJ 1996, 481, reasons, paragraph 3.4), and are not one of the category of decisions which can be delegated to Formalities Officers (see the Notice at OJ 1984, 317 as revised by the further Notice at OJ 1989, 178 - the version applicable at the time of the decision under appeal - and now again revised, with no effect on the point at issue here, by the Notice at OJ 1999, 504).

7. It therefore appears to the Board that not only was a relevant provision of law affecting the appellant's request wrongly dismissed as irrelevant but that provision was not even considered by the appropriate first instance department. In the circumstances not only must the decision under appeal be set aside but the case should be remitted to the Examining Division for it to consider the appellant's original request taking full account inter alia of Rule 89 EPC.

8. The Board also considers that, since Rule 89 EPC should have been considered and the Formalities Officer should therefore have passed the request to the Examining Division but failed to do so, there has been a substantial procedural violation and in the circumstances it is equitable to order reimbursement of the fee paid for the present appeal pursuant to Rule 67 EPC.

Order

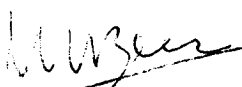
For these reasons it is decided that:

1. The decision under appeal is set aside.

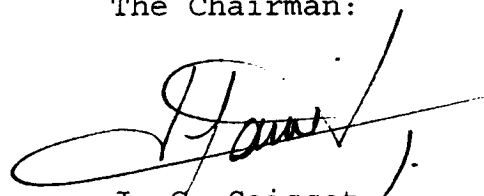
2. The case is remitted to the Examining Division for further prosecution.

3. The reimbursement of the appeal fee is ordered.

The Registrar:


M. Beer

The Chairman:


J.-C. Saisset