

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen
(D) [] No distribution

**Datasheet for the decision
of 29 September 2009**

Case Number: T 0493/08 - 3.4.02

Application Number: 01980926.8

Publication Number: 1385040

IPC: G02F 1/13

Language of the proceedings: EN

Title of invention:

Photoinduced switching liquid crystal device

Patentee:

Japan Science and Technology Agency

Headword:

Re-establishment of rights in respect of the appeal term (no)

Relevant legal provisions:

EPC Art. 21, 106, 108, 121, 122

EPC R. 111(2), 136, 139, 140

Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the EPC Revision Act, Article 1

Relevant legal provisions (EPC 1973):

EPC Art. 21, 97(4), 106, 107, 108, 122, 158(2)

EPC R. 51(4), 68(2), 69, 78, 83, 85, 88, 89, 107(1)(d), 108(3)

Keyword:

"EPC Article 122: rectification of a decision to grant further to requests under Rules 89 or 88 or Article 122 EPC 1973 instead of an appeal (no), excuse of error of law (no), all due care (no)"

Decisions cited:

G 0003/91, G 0012/91, G 0008/95, G 0001/97, J 0005/80,
J 0006/91, J 0028/92, J 0042/92, J 0003/01, J 0002/02,

J 0023/03, J 0019/04, J 0001/07, J 0006/07, T 0042/84,
T 0315/90, T 0413/91, T 0714/92, T 0881/98, T 1093/05,
T 0971/06, T 1026/06, T 1465/07

Catchword:

-



Case Number: T 0493/08 - 3.4.02

D E C I S I O N
of the Technical Board of Appeal 3.4.02
of 29 September 2009

Appellant: Japan Science and Technology Agency
4-1-8, Honcho
Kawaguchi-shi
Saitama (JP)

Representative: Hoarton, Lloyd Douglas Charles
Forrester & Boehmert
Pettenkoferstrasse 20-22
D-80336 München (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 21 June 2007
to grant European patent No. 1385040 pursuant
to Article 97(2) EPC 1973.

Composition of the Board:

Chairman: A. G. Klein
Members: B. Müller
M. Rayner

Summary of Facts and Submissions

Case history up to the summons to oral proceedings

- I. The appeal filed on 22 October 2007 is directed against the decision of the examining division of 21 June 2007 to grant European patent No. 1385040 indicating France (FR), the United Kingdom (GB) and the Netherlands (NL) as the designated Contracting States. The mention of the grant was published in European Patent Bulletin 07/29 of 18 July 2007.

The corresponding international application had been filed on 29 October 2001 with a priority date of 10 April 2001; the international application number is PCT/JP01/09465. The application published on 24 October 2002 under No. WO 02/084387 A 1 contains a designation for a European patent of the European Contracting States AT, BE, CH, CY, DE, DK, ES, FI, FR, GB, GR, IE, IT, LU, MC, NL, PT, SE, TR. The steps for entry into the regional phase before the EPO were taken on 24 October 2003. On EPO Form 1200 for entry into the European phase the box next to Section 10.1 was ticked. According to the text under that Section "[i]t is currently intended to pay seven times the amount of the designation fee. The designation fees for all the EPC contracting states designated in the international application are thereby deemed to have been paid ..." (footnote and emphases omitted). Under Section 10.2 the box adjacent to which was *not* marked, the three contracting states GB, FR and NL were expressly indicated. According to the text under that Section "it is currently intended to pay fewer than seven designation fees" for these three states. Following the

pre-printed text under Section 10.2 no communication under Rule 108(3) EPC (1973) should be issued for contracting states not thus indicated. Three designation fees were paid on 24 October 2003, which the Office allotted to the three Contracting States indicated under Section 10.2, i.e. FR, GB, NL.

The appellant requests that the decision to grant be rectified to indicate the designated contracting states of France, United Kingdom, the Netherlands and Germany (DE). The appellant puts forward that the facts and arguments surrounding the rectification of the decision are contained in the request for *restitutio* accompanying the notice of appeal and the papers filed on 18 and 19 September 2007 in connection with this matter. The appellant also requests reimbursement of the appeal fee as the appeal was necessitated because of a procedural violation on the part of the European Patent Office (EPO). Oral proceedings are requested as a precautionary measure. Together with the appeal the appellant further requests "restitutio for appealing against the decision to grant dispatched 21 June 2007". The *restitutio* fee had already been paid on 18 September 2007 but another such fee is paid in case this request for *restitutio* is deemed to be a separate request from the earlier matter. The appeal fee is also paid.

II. The grounds pertaining to the appeal and the associated request for re-establishment of rights submitted on 22 October 2007 are summarized as follows.

There was a time limit of 21 August 2007 for appealing against the decision to grant but this time limit was

not observed. The removal of the cause of non-compliance is the date when the EPO informed the representatives that, despite there having been a procedural violation, no legal remedy was available any longer to the EPO to restore or correct the application to remedy the loss of rights, i.e. the loss of the DE designation. The formalities officer of the examining division advised verbally "- telecon 15-16/10/07 -" that while it was accepted that there had been a procedural violation, the only mechanism to remedy the situation would have been to appeal the decision to grant. According to the appellant's representative, the application for *restitutio* filed on 22 October 2007 was therefore made in good time. The representative maintains that the EPO advised that *restitutio* was not available but that is incorrect. *Restitutio* is available for the time period for appealing the decision to grant. This is not one of the time limits excluded by Article 122(5) EPC 1973.

The representative further states that the facts communicated in his earlier communications of 18 and 19 September 2007 remain unchanged and show that the applicant at all material times had taken due care to observe the time limit but despite all care having been taken, there was a resultant loss of rights. A large contributing factor to this loss of rights was the procedural violation by the EPO in not sending a communication of loss of rights. The circumstances leading to the loss of rights are as follows.

The original error was the attorney not indicating the German designation in Form 1200 (entry into the European phase) and paying the associated designation

fee. The applicant's instructions were very clear identifying Germany as a designated state. The secretary who completed the Form 1200 did not spot that the DE designation was missing and that this was inconsistent with the client's instruction. The supervising attorney when signing the Form 1200 did not spot the inconsistency with the client's instruction. Even though the firm applies a double check when papers are filed through their Munich office, as the papers in question were, and the secretaries in that office also check the filing papers, that further check failed to identify the inconsistency with the client's instruction. The file is then consistent with proceedings before the EPO so when the designations were checked against the content of the file, it appeared that everything was in order. For example, the representatives reported to the client that there were three designations, not four as in accordance with the client's instructions. The A1 publication of the specification lists *all* available designations so the error was not highlighted at that stage. The communication under Rule 51(4) EPC 1973 and the decision to grant were consistent with the earlier content of the file and the Form 1200 designations. It was only when the designation of Germany was attempted to be validated that the inconsistency with the client's instructions was identified and the error spotted. A respective letter dated 18 July 2007 and showing a "RECEIVED" stamp of the same date was attached to the representative's communication of 18 September 2007. In that letter the representative's German colleague referred to the representative's letter of 10 July 2007 instructing the colleague's German law firm to validate the patent in Germany. The

German representative wrote that according to the Register of the German Patent and Trade Mark Office the application was no longer available for validation in Germany as Germany was no longer among the designated countries since 2004.

The representative maintains that a communication pursuant to Rule 108(3) EPC 1973 noting loss of rights should have been sent to the applicant, as designations of contracting states were deemed to be withdrawn. The representatives' normal process involves very carefully reviewing any notice of loss of rights and it would have been immediately apparent to the prosecuting attorney that there had been an error and this would have been corrected by way of the routine standard procedure under Rule 69 and Rule 108(3) EPC 1973 by payment of the designation fee and its surcharge. However, the EPO did not, as it should have done, send the notice of loss of rights so the error went undetected until this late stage. The representatives' system relies upon the EPO correctly issuing notices of loss of rights and in this instance, the EPO's failure to issue the loss of rights communication resulted directly in the error not being identified and the German designation being lost.

Failure to dispatch the notice of loss of rights constitutes a procedural violation. Therefore, reimbursement of the appeal fee is requested.

III. With the letter of 18 September 2007 mentioned above and preceding the alleged verbal advice on the proper procedure given by the formalities officer of the examining division "- telecon 15-16/10/07 -", the

appellant's representative had made the following requests:

- to "now afford the applicant the opportunity to respond to the Rule 69 communication which should have flowed from Rule 108(3)" and to re-publish the mention of grant indicating DE, FR, GB and NL as designated Contracting States (first and primary request); the designation fee and surcharge for the state of Germany were paid at the same time;
- to correct an error under Rule 88 EPC 1973 in the Form 1200 submitted when entering the European regional phase of this application to designate also the state of Germany and to re-publish the mention of grant to show also the correct designation of Germany (second and subsidiary request);
- in parallel with or if necessary after refusal of the second request, restitution of the designation of the German state under Article 122 EPC 1973; the re-establishment fee was also paid;
- to conduct oral proceedings if refusal of the above requests was contemplated.

IV. With a letter dated 20 February 2008 the formalities officer of the examining division communicated the division's "observations" that were made "further to ... [the] notice of appeal". She stated essentially the following:

- A correction under Rule 139 EPC allowing the correction of errors in documents filed with the EPO is not possible, because the applicability of this rule is limited to the time before the decision to grant a patent was issued.

- The argument that the error was due to a procedural violation of the EPO need not be examined at this stage. Procedural errors, omissions or other deficiencies are remedied with the grant of the patent.

- The conditions of Rule 140 EPC are not met. The mistake is not to be considered as obvious since the representative approved the text intended for grant. At any rate the absence of Germany among the designations does not correspond to an error of the examining division.

- The request for re-establishment of rights is not allowable according to Article 122(4) and Rule 136(3) EPC (2000). The provisions of Article 122 EPC (2000) are not applicable to any period for which further processing under Article 121 EPC (2000) is available. Therefore, re-establishment of rights is excluded in this case.

- The appeal and the request for re-establishment were remitted to the Boards of Appeal.

The summons

V. The appellant was summoned to the oral proceedings, which were held on 1 July 2009. In an annex accompanying the summons the Board set out the appellant's requests, summarised the facts of the case and provided a preliminary and non-binding opinion on their legal assessment. The above facts and submissions have been reproduced largely identically from that annex.

The reply to the annex to the summons

VI. In reply to the annex to the summons, the representatives acknowledge and agree with the annex insofar as the request for re-establishment of the time limit for the appeal is seen to be admissible; however, they contest the suggestion that there was a failure to take all due care required by the circumstances. In summary they argue that the representative is an experienced professional representative with many years of successful and reliable service as a European Patent Attorney. The representative is a partner of a well respected firm of patent attorneys, other partners of which were consulted in relation to this matter. The representative not unreasonably believed that at least one of the requests submitted prior to the request of 22 October 2007 would be granted and that an appeal would not be necessary. The representative made a reasonable interpretation of the EPC and case law of the Boards of Appeal. All due care was, therefore, taken and the request for re-establishment should succeed; the appeal should proceed accordingly.

VII. More specifically, as far as the representative is concerned, "[t]he failure to file an appeal before the deadline was an error but this error was not made in ignorance of the provisions of the EPC but was made despite a careful and considered review of the EPC and the associated case law". If the Board remained unconvinced that all due care was taken in deciding on the course of action in the present case, then it was submitted that the interpretation of the EPC which resulted in the requests of 18 September 2007 was not unreasonable. Reference was made to J 28/92: the

representative should not be penalized for a reasonable interpretation of the EPO even if that interpretation turned out to be wrong. The question of whether or not the representative's interpretation of the EPC was *correct* is notably different from the question of whether or not the interpretation was *reasonable*. If it can be shown, as it can, that the representative's interpretation of the EPC was *reasonable*, then the taking of all due care follows irrespective of whether or not that interpretation is deemed to be correct.

The three substantive requests of 18 September 2007, which are referred to as First, Second and Third Request, were submitted instead of the filing of a Notice of Appeal. They were the result of a not unreasonable interpretation of the EPC 1973, which was the law relevant on that date.

VIII. The First Request could be considered to be, in effect and substance, a request for a correction of the decision to grant under Rule 89 EPC 1973. It was noted that the annex to the summons indicates that the Board is of the view that no such request was ever made. However, the provisions of Rule 89 EPC 1973 appear to be the appropriate mechanism by which, in accordance with the First Request, the examining division could have rectified the substantial procedural violation which had occurred at the time the request was made. There is no requirement in the EPC (1973 or 2000) for every request to be explicitly supported by Article and Rule numbers in the request itself. Instead, the Articles and Rules of the EPC provide the legal *mechanisms* by which requests can be performed. The First Request could, therefore, have been handled by

the EPO using Rule 89 EPC 1973 as the relevant legal mechanism.

Applying this legal mechanism to the First Request the representative says that he has identified no decision of the Boards of Appeal which was published prior to the deadline for filing the notice of appeal of 3 September 2007, which is based on circumstances which are substantially identical to the chain of events on which the representative based the requests of 18 September 2007. The chain of events which lead to the present situation are substantially unique and relatively rare. G 12/91 (OJ 1994, 285) states that "once proceedings have been completed the decision-making department can no longer *amend* its decision" (emphasis added). Under the EPC there is a clear distinction between the use of the term "amend" and the use of the term "correct". A correction is a procedure requiring the rectification of an error; an amendment, on the other hand, does not require, as a prerequisite, an error but may be requested even if an error as such has not occurred. This is apparent by close inspection of the Article 123, Rule 51(5), Rule 86, Rule 88 and Rule 89 EPC 1973. It is not unreasonable to interpret the decisions of the Enlarged Board of Appeal with reference to the language of the EPC. This interpretation is mirrored by G 8/95 (OJ 1996, 481) which states: "[T]he difference between an appeal and a request for correction of a decision may be seen in the fact that in the first case the remedy is directed against the substance of the decision and in the latter case against the form in which the decision was expressed." The EPO cannot have intended to issue a decision without having, themselves, complied with the

EPC. Without issuing a communication under Rule 108(3) EPC 1973, the opportunity was still available for the applicant to pay the designation fee for the other states not listed on the decision to grant. This is a matter of fact and not an arguable issue requiring a decision as such. The error was, therefore, considered to be an error in the "form" of the decision.

Further, in G 8/95 the Enlarged Board of Appeal decided that a request for a correction under Rule 89 EPC 1973 was to be made to the department which issued the decision. The representative cannot be expected to be aware of every such request made by other representatives in relation to other cases. Although decisions of the Boards of Appeal are published and searchable, the day-to-day decisions made by, for example, the examining division cannot be searched to identify instances in which requests for a correction under Rule 89 EPC 1973 have been allowed after the completion of proceedings before a decision-making department. It was, therefore, not unreasonable to conclude that requests for a *correction* of the decision to grant, even after the completion of proceedings, may well have been granted in the past. It was (and is) not possible to confirm this one way or the other.

Consequently, it was reasonable to conclude that G 12/91 was not relevant to the present set of circumstances because it related to an *amendment* and not a correction. Moreover, it was not unreasonable to conclude that requests for a correction in circumstances not dissimilar to those in the present instance had been accepted in the past.

The present situation is importantly different from most requests for a correction (be they under Rule 88 or 89 EPC 1973) because the EPO had committed a substantial procedural violation and impinged significantly on the legitimate expectations of the parties involved. It was considered that, in the event of a substantial procedural violation, the EPO owes a duty of care to the party or parties wronged by that violation, in the present case, the proprietor of the patent. The decision containing the error should, so it was thought, have been considered void, *ab initio*, and a corrected decision issued so as to absolve the wronged party of all effects of the violation and the loss of legitimate expectations. This can be seen by examining cases in which decisions which have been issued by departments of the EPO have been corrected. For example, in the case of T 714/92 a substantial procedural violation was noted by the patent proprietor and, on appeal, the decision was set aside and the case was remitted to the Examining Division by way of correction of that violation. It is, therefore, accepted that a substantial procedural violation by the EPO should be corrected by the EPO to liberate the wronged party from the effects of the violation.

It was not, consequently, unreasonable for the representative to conclude that, in the face of the precedent from the Boards of Appeal, the examining division should rectify the procedural "perversion" without the examining division causing further damage on the proprietor by requiring an (unnecessary) appeal, which, despite the possibility of a refund of the appeal fee, necessarily entails a substantial cost in

professional fees and the like (which the EPO do not take it upon themselves to reimburse).

T 1093/05, OJ 2008, 430 (referenced in the annex to the summons by the Board), was published in Official Journal issue 8-9 of 2008 long after the deadline for filing the Notice of Appeal and only made publicly available less than three months prior to expiry of the deadline for filing a Notice of Appeal in the present case. It was not unreasonable for the representative not to have considered the content of this decision before the deadline for filing an appeal.

Moreover, even if considered, it is not unreasonable for the representative to have discounted the decision. The Boards of Appeal of the EPO make a large number of decisions, many of which sway on the individual facts of the case in question. A single decision which is still too new to have been followed or supported by additional cases cannot be sufficient to be taken as a definitive precedent. The Boards of Appeal appear to share this view by stating that a legitimate expectation (in the case of deviation from a legitimate expectation) cannot be based on a precedent set in a single decision of the Boards of Appeal, see J 27/94. Indeed, even publication in the Official Journal and in the "Case Law of the Boards of Appeal of the EPO" is not sufficient to permit reliance on the reasoning of a decision in the context of legitimate expectations, see J 25/95. This reasoning applies equally to the present circumstances.

The existence of the decision in Case T 1093/05, decided on its own facts, in no way deprives the above

interpretation of the EPC in the present case of its reason. Indeed, from a different perspective, when faced with a substantial procedural violation by the EPO the representative in T 1093/05 also chose not to appeal the decision to grant. This course of action, therefore, appears to be a common course of action which a professional representative may choose to take after careful consideration of the relevant options. Although not a direct indication of the application of all due care, the more professional representatives who make the same interpretation of the EPC when faced with (some) comparable circumstances, the more this is an indication that such an interpretation is not unreasonable.

The error in the decision to grant was an obvious error suitable for correction under Rule 89 EPC 1973. In particular, the EPO requires that the users of the European patent system are familiar with the patent application process and the procedures before the EPO, see, for example, the case law of the Boards of Appeal relating to the requirements for requesting re-establishment. The substantial procedural violation made by the EPO would have been obvious to anyone considering the content of the case history for this application (which is publicly available information). This was the case in T 1093/05 and is also the case in the present circumstances. The fact that an obvious error has not been noticed does not detract from the obvious nature of that error; every obvious error must have gone unnoticed at some point not to have been corrected instantly.

In short, not only was it reasonable for the representative to conclude that no appeal would be necessary but it was also not unreasonable for the representative to conclude that a correction under Rule 89 EPC 1973 would be successful.

IX. As for the Second Request the representative submits that, in the exceptional event of a substantial procedural violation by the EPO, the application of Rule 88 EPC 1973 after the grant of a patent had not been considered by the Boards of Appeal at the time of the deadline for filing the appeal in the present case. It was not unreasonable for the representative to be of the view that the duty of care owed by the EPO to the proprietor of the patent would permit Rule 88 EPC 1973 to be applied even after the grant of a patent (and outside of opposition proceedings). There is no explicit provision of the EPC which would exclude this possibility. The reasoning in J 42/92 does not apply to the present set of circumstances which are notably different from the facts of J 42/92. In any event the reasoning in J 42/92 is not equitable and is flawed.

X. In relation to the Third Request the representative argues that similar considerations have to be applied as were applied in relation to the Second Request. There is no bar to the date on which a communication under Rule 108(3) EPC 1973 could have been issued. From a strict reading of the EPC 1973 there seems to be no explicit restriction on the issuance of such a communication after the grant of a patent in situations in which the EPO has committed a substantial procedural violation, thus permitting payment of the designation fee within two months of the issuance of the

communication. According to a strict reading of the EPC 1973 the EPO is, indeed, *obligated* to issue the communication.

XI. Although the interpretation of the EPC 1973 is what is relevant when considering whether or not all due care was taken, the imminent implementation of the EPC 2000 contributed to the decisions which were made. At the time of an unprecedented change in European patent law and practice, the representative submits that it may be prudent to "cover one's bases".

XII. As for the appeal, the representative, in summary, argues that the original error by the representative responsible for the case at the time was compounded by a substantial procedural violation by the EPO. The appellant had a right to rely on legitimate expectations that the European Patent Office would comply with the requirements of the European Patent Convention (namely, Rule 108(3) EPC 1973). The loss of rights was a direct result of the failure of the EPO to comply with the provisions of the EPC.

The oral proceedings

XIII. The oral proceedings dealt with the request for re-establishment of rights in respect of the term for filing an appeal only. The representative submitted that all due care was taken.

The failure of the EPO to issue the Rule 108(3) communication (loss of rights) was a mistake which overshadowed the case and set its context. It was a one in a million procedural error admitted by the EPO and

it was reasonable to expect the EPO to correct the mistake. The decision to grant was not a correct reflection of the applicant's rights at the time. Had the loss of rights communication been sent, then the designation fee for Germany would have been paid, that it was not, was a direct result of the error and there should have been a route to correct this error.

In the law firm where the representative works this mistake originally went unnoticed. Validation is not normally handled by an attorney and the mistake was not spotted even upon receipt of the letter of the German colleague received on 18 July 2007, according to which the application was no longer available for validation in Germany, as since 2004 Germany was no longer among the designated countries. The information conveyed by that letter, in line with his law firm's standing practice, was checked by clerical staff against computerised records only. Those records did not show Germany as a country for which designation was sought. This was due to an error made in the representative's law firm in omitting Germany in entering data of the letter of the client's domestic (Japanese) law firm of 2 October 2003 asking the representative's law firm to file the patent application from which the patent in suit originated. It is not uncommon for clients to try to validate in the wrong country and postal exchanges for clarification of such matters take time and are not considered urgent.

In reply to a question from the chairman as to why a loss of rights communication would have been noticed if the validation error letter had not been, the representative explained that in the case of a loss of

rights communication a check with the original instructions is made. In validating no check is made, but six weeks thereafter (i.e. from 18 July 2007) until expiry of the appeal period on 3 September 2007 should have been long enough to spot the error.

The EPO had sent no communication pursuant to Rule 108(3) EPC 1973. The Rule 51(4) communication does not also constitute a Rule 108(3) communication as it is not a loss-of-rights communication. The rapporteur remarked that agreement had been given to the Rule 51(4) communication, to which the appellant responded that the error had been committed earlier. Had the EPO sent a Rule 108(3) communication, as it should have done, under the practice of his law firm, that communication would have caused the secretaries in the Munich office of the representative's law firm to make a check against the original file in which the letter of 2 October 2003 was included. Thus they would have identified the error. The letter would have been forwarded to his firm's London office and compared with the records there. Then the file would have gone to him being the fee earner. He would have checked it against his personal paper file, which also included the letter of 2 October 2003. Thus he would also have spotted the error. In the present case the comparison with the original file was carried out later, subsequent to contacts with the client's Japanese law firm, and the error was detected. The representative, departing from his initial statement in this regard, was not sure, without checking the file, whether that happened within the appeal period that ended on 3 September 2007 or thereafter. If necessary, this information could be supplied after the hearing.

Originally no appeal against the decision to grant was filed. In a normal case, the representative acknowledged that an appeal had to be filed (in order to have a decision rectified). In the present exceptional case and unique context, the EPO error distracted from the law. He was under pressure of time. Asking other, including senior attorneys, inside and outside the law firm, did not lead to anyone suggesting an appeal should be filed in the present circumstances. The representative was therefore comfortable with his interpretation of the law and tried his absolute best to rectify the EPO error, which had distracted, even blinded, him from filing an appeal. This seemed the best way of handling the situation. An appeal did not seem the best route, but in retrospect the best approach would have been to run both the request (for correction under Rule 89) and an appeal.

More specifically, the interpretation of the EPC at which the representative arrived was as follows: he deemed a request under Rule 89 for correction to be appropriate. The first request in his letter of 18 September 2007 was to be interpreted as constituting such a request. Should the EPO have found the request to be in any way vague, then it should have asked for clarification (see J 15/92). The mistake in the decision to grant was obvious. A Rule 108(3) communication was not a courtesy service. He had an absolute expectation that the EPO should grant, a legitimate expectation that the EPO would correct and that a Rule 89 request was a route available. The EPO admitted that a loss-of-rights communication should have been sent. It was reasonable to expect the EPO to

make a correction since it had been their error. The principles of good faith, equity and fairness had to be applied. He did not come to the extreme conclusion that it was unnecessary to file an appeal. He reasonably misinterpreted Rule 89.

Case T 1093/05 where it was held that a decision on an application could be set aside only following an admissible, allowable appeal and not on the basis of a request under Rule 89, save for obvious errors, was wrongly decided. That case showed that other attorneys had adopted the same approach as the representative, which is why that approach was not an unreasonable one.

In J 23/03 it was said that the examining division, upon adoption of the decision to grant, wanted to adopt the text of the Rule 51(4) communication with the designation of Greece (GR) instead of United Kingdom (GB) and was not in error in this respect. According to the representative, J 23/03 has to be distinguished from the present case because of the express indication of GR instead of GB as one of the designated states in Form 1200, which was made erroneously.

The representative made no submissions relating to the Second and Third Request submitted with his letter of 18 September 2007 and also briefly addressed in his reply to the annex to the summons.

The representative requested re-establishment of rights in respect of the term for filing an appeal against the decision to grant of 21 June 2007.

At the end of the oral proceedings the chairman announced that a decision would be given in writing.

Reasons for the Decision

1. Background

The appeal filed on 22 October 2007 is directed against the decision of the examining division of 21 June 2007 to grant European patent No. 1385040. Under Article 108, first and second sentences, of the EPC 1973, notice of appeal must be filed in writing at the Office within two months after the date of notification of the decision appealed from. The notice shall not be deemed to have been filed until after the fee for appeal has been paid. In the present case this time limit elapsed on 1 September 2007. This follows from Rule 78(2) and Rule 83(1), (2) and (4) EPC 1973 (*cf.* T 1026/06, point 1). 1 September 2007 having been a Saturday, the time limit extended to 3 September 2007 pursuant to Rule 85(1) EPC 1973. As no notice of appeal was given nor was the appeal fee paid by that latter date, the appeal of 22 October 2007 should be deemed not to have been filed resulting in the loss of the right of appeal (Article 106(1) and 107 EPC 1973), unless the application for re-establishment of rights that the appellant also submitted on 22 October 2007 is granted. The aforementioned provisions of the EPC 1973 are referred to because the appeal time limit expired before the entry into force of the EPC 2000 on 13 December 2007 (*cf.* J 10/07). There would be no difference in outcome if pertinent provisions of the EPC 2000 were applied pursuant to Article 1, No. 1, of

the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the EPC Revision Act (see special edition No. 1/2007 OJ EPO, at pp. 197 *et seq.*).

2. Inability to observe a time limit vis-à-vis the EPO

2.1 Pursuant to paragraph 1 of Article 122(1) EPC 1973 and EPC 2000, for re-establishment of rights to be possible, the applicant must have been unable to observe a time limit vis-à-vis the EPO. According to T 413/91 (at point 4) the word "unable" implies an objective fact or obstacle preventing the required action. Such an obstacle could e.g. consist of a wrong date inadvertently being entered in a monitoring system. Re-establishment of rights does not imply any right to have the fatal effect of an intentional step cancelled, even if this step later on proved to have been a mistake. A party thus cannot deliberately abstain from fulfilling the conditions for a valid appeal, and then achieve an appellate review through the back door of a *restitutio* request. Similarly, it was stated in J 2/02 (at point 7) that Article 122 EPC 1973 does not imply for an applicant any right to have the final effect of an intentional action cancelled. Case T 1026/06 (see point 3) was distinguished from T 413/91 and J 2/02 where the parties had deliberately refrained from taking the required action within the appropriate time limits due to reasons outside of the proceedings (expectation of an agreement with the other party, financial considerations). In T 1026/06 it was noted that the appellant was aware that a time limit was running. It did not let this time limit elapse in full consciousness of the ensuing legal consequences. Rather

it believed that it did not have to avail itself of the remedy because the mistake could be corrected in a different manner. Hence, the board held that the appellant was indeed unable to file an appeal as a consequence of an error of law.

- 2.2 In the present case the representative initially was unaware that Germany ceased to be among the designated countries. As follows from his submissions in the hearing, despite the information thereof by the communication of the German attorney of 18 July 2007, he still did not become conscious that Germany should have been among the Contracting States designated in the decision to grant. He had thus succumbed to an error of fact.

Once having become knowledgeable of the fact that the omission of DE was an error, he did not consider that an appeal was appropriate to have Germany added to the designated countries but relied on other avenues of relief to this end. It was only a communication by the EPO, i.e. the telephone conversation with the formalities officer of the examining division in mid-October 2007, that, according to his credible submissions, informed him of the need to file an appeal. Whether or not an appeal was indeed necessary, need not be decided at this stage because he was entitled to rely on this information (see Case Law of the Boards of Appeal of the EPO, 5th edition 2006, VI.A.). Thus, applying the rationale of the decisions referenced in the previous section, the representative was unable to file an appeal due to an error of law.

3. Admissibility of the application for re-establishment

3.1 Respect of the two-month time limit

3.1.1 Principles

Pursuant to Article 122(2), first and third sentences, EPC 1973 and Rule 136(1), first sentence, EPC 2000 the application must be filed within two months of the removal of the cause of non-compliance with the period, but at the latest within one year of expiry of the unobserved time limit.

According to the established case law, where a time limit was not observed due to an error of *fact*, the removal of the cause of non-compliance with that time limit within the meaning of Article 122(2) EPC 1973 occurs on the date on which the patent applicant *should* have become aware of the error of fact (see J 19/04, point 3), i.e. not necessarily when it *actually* became aware. In T 315/90 (at point 6) the board held that the date of the removal is the date at which the appellants should have discovered the committed error if they had taken all due care, due care being a permanent obligation.

Where a time limit was not observed due to an error of *law*, it seems that generally the due-care requirement is only assessed in the context of the merits of an application for restoration (see Case Law of the Boards of Appeal, *ibid.*, VI.E.6.3.2(b), and recently J 6/07, at point 2.4, and the additional cases cited there).

Against this backdrop the Board considers that, where a time limit was not observed due to an error of law, the removal of the cause of non-compliance with that time limit occurs on the date on which the applicant *actually* became aware of the error of law. (In an apparent contrast to this view, in T 1026/06 the date when the applicant *should* have made investigations was considered to be critical, even though the applicant apparently failed to undertake such investigations as a consequence of what was considered to be an error of law; see points 3 to 5. Given that the application for re-establishment was filed more than two months after the error *should* have been discovered, the application was found to be inadmissible.)

Considerations analogous to the above made for a patent applicant apply to a patent proprietor.

3.1.2 The case at hand

(a) The question

In the present case the appellant's representative was unable to observe the appeal time limit, which extended to 3 September 2007. As set out above, in the present case non-compliance with the appeal period was the consequence, initially, of an error of fact and, subsequently, an error of law. It must now be determined at which date, in the light of these errors, the cause for non-compliance with the appeal time limit was removed.

(b) The error of fact

Regarding the representative's error of fact of being unaware that DE should have been among the designated Contracting States in the decision to grant, he himself submitted that the omission was spotted on 18 July 2007 on receipt of the above-mentioned letter of his German colleague. However, from his submissions in the hearing it follows that the omission was not recognised as an error at the same time but only later, in the course of contacts with the client's Japanese law firm (see above, point XIII). He was not sure whether that happened within the appeal period or thereafter.

The Board holds that, on having become aware of the omission, the representative should also have become cognizant that the omission amounted to a mistake. It does not constitute due care on his part to rely on computerised records only and not on the original documents, in this case the letter of the client's Japanese law firm of 2 October 2003, given the importance of the correct designation of Contracting States. The representative himself, in the application for restoration of the designation of the German state filed as Third Request with the letter of 18 September 2007, submitted that the "removal of the cause of non-compliance was the receipt by the attorney of the original information that Germany was not designated. ... This occurred on 18 July 2007 ... (see page 3, 7th paragraph).

In the Board's opinion it could well be argued that the representative should have become aware of the omission (and the fact that it constituted an error) at an

earlier stage, e.g. on receipt of the decision to grant of 21 June 2007, or at least on 10 July 2007 when his German colleague's law firm was instructed to validate the patent in Germany.

In the context of inability of observance of the time limit, however, this question shall remain an open one: the time limit extended to 3 September 2007, and the period from 18 July 2007 must be considered as largely sufficient to enable the appellant to lodge an appeal. It follows that the representative was *not* unable to meet the appeal deadline due to the above error of fact.

In the context of determining the date of removal of the cause of non-compliance with the appeal time limit, in any case, even once the error of fact had been removed, the representative still believed that no appeal needed to be filed. This means that once the above error of fact had been removed, another cause of non-compliance, namely an error of law, came into being, as will be shown in the following section.

(c) The error of law

The fact that the representative initially believed that no appeal needed to be filed (and consequently no appeal fee needed to be paid) to "rectify" the decision to grant amounted to an error of law because of the information of the EPO of the need to file an appeal given in mid-October 2007. Even considering, as the representative did, that the remedies he had chosen to rely on with his letter of 18 September 2007 (i.e. the requests under Rules 89 and 88 and Article 122 EPC 1973) constituted possible ways to have the decision to

grant overturned, the representative has not denied that an appeal equally was a way to reach that result. Whether or not the remedies he had availed himself of were suitable or whether an appeal was indeed the only appropriate remedy need therefore not be decided in this context.

According to the representative the information of the need to file an appeal to remedy the situation was given verbally "- telecon 15-16/10/07 -" by the formalities officer. In the request for restoration it is expressly stated that the "removal of non-compliance is the date when the EPO informed us ... [that] no legal remedy was ... now available to the EPO ... [and that] the only mechanism to remedy the situation would have been to appeal the decision to grant" (see the paragraph bridging pages 1 and 2). In the hearing the representative explained that, by using the term "telecon 15-16/10/07", he wanted to say that it was either on 15 or on 16 October 2007 that a teleconference with the formalities officer over the telephone was held, but he did not remember the exact date. The rapporteur mentioned that the file included a copy of the minutes of a telephone conversation ("Result of consultation") between the representative and the formalities officer that took place on 15 October 2007. In those minutes it is stated, *inter alia*, that the "EPO explained to ... [the representative] that his request dated 18.09.2007 could not be allowed, because the time limit for filing an appeal against the decision to grant dated 21.06.2007 had expired, and re-establishment of rights is excluded. A request under Rule 88 EPC is no longer possible because the EPO is bound by the decision to grant".

As in the case of an error of law it is decisive when the patent applicant or proprietor *actually* became aware of the error, the Board arrives at the conclusion, based on the credible submissions of the representative, as corroborated by the above minutes, that he obtained such knowledge only in the course of the telephone conversation on 15 October 2007.

(d) Conclusion

The cause of non-compliance with the time limit was thus removed on 15 October 2007. Consequently, the period of two months from the removal of that cause was complied with by the letter received on 22 October 2007, which contained the application for re-establishment of rights. The application was also filed within one year of expiry of the unobserved appeal time limit of 3 September 2007.

3.2 The applicable version of the EPC re-establishment provisions

The date of the removal of the cause of non-compliance with the appeal time limit having been determined, it can now be decided which version of the EPC re-establishment provisions (i.e. either those of the EPC 1973 or the EPC 2000) applies.

Pursuant to Article 1, No. 5, of the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the EPC Revision Act, Article 122 EPC 2000 shall apply to European patent applications pending at the time of its

entry into force, in so far as the time limits for requesting re-establishment of rights have not yet expired at that time. In the present case it was on 15 October 2007 when the cause of non-compliance with the time limit was removed. According to both Article 122(2) EPC 1973 and Rule 136(1) EPC 2000 the time limit for requesting re-establishment of rights expired two months later, i.e. on 15 December 2007, and extended to 17 December 2007. As the EPC 2000 entered into force on 13 December 2007, the time limit for requesting restoration was still pending on that date. Therefore, the condition of Article 1, No. 5, of the above Decision having been met, it is Article 122 EPC 2000, together with Rule 136 EPC 2000, which apply in the present case. Below these provisions will generally be referred to without the addition "2000".

3.3 Further admissibility requirements and conclusion

The request for re-establishment complies with the further formal requirements of Rule 136(1,2) EPC. It states the grounds and facts on which it is based. The omitted act, i.e. the filing of the notice of appeal, was completed on the day the request was filed.

This request, therefore, is admissible.

4. Payment of the fee

According to Rule 136(1), third sentence, EPC the request shall not be deemed to have been filed until the prescribed fee has been paid. The appellant paid a fee for an application for re-establishment filed on 18 September 2007, which was answered by the

formalities officer of the examining division with the above letter of 20 February 2008. This application aimed at the re-establishment of the designation of the German state and was thus different from the present request to reinstate the appeal term. Therefore, a separate fee for the present request is due. That fee has been paid.

5. No excluded time limit

The appellant is correct in saying that the time limit for filing an appeal against a decision to grant is not excluded from re-establishment of rights (Article 122(4) and Rule 136(3) in conjunction with Article 121(4) referring to Article 108 EPC).

6. Merits

6.1 Due care: the legal framework

Whether or not the request for re-establishment of rights can be acceded to depends on whether the substantive requirements of Article 122 EPC are also met. Under paragraph 1 of that provision the applicant for or proprietor of a European patent making the request must show that it has taken "all due care required by the circumstances". The request for re-establishment of rights of an applicant with a professional representative acting on its behalf is only allowable if both the applicant itself and its representative have met the necessary standard of care (see J 1/07, point 4.1). When an applicant is represented by a professional representative, a request for re-establishment of rights cannot be acceded to

unless the representative himself or herself can show that he or she has taken the due care required of an applicant by Article 122(1) EPC (*cf.* J 5/80, OJ EPO 1981, 343, headnote I). Analogous considerations apply where a patent proprietor is concerned.

As for the due care to be exercised on the part of the professional representative, there is a body of case law according to which ignorance or misinterpretation of EPC provisions cannot be excused; see Case Law of the Boards of Appeal, *ibid.*, section VI.E.6.3.2(b), and the cases referred to there, in particular T 881/98, point 4, citing T 516/91 and T 853/90. In a more recent decision in Case J 6/07 (at point 2.4) the Legal Board of Appeal affirmed case law to the same effect even where an applicant had not appointed a representative:

"In general, even in the case of an applicant who acts without the benefit of a suitably qualified representative, a mistake or ignorance as to the law is an insufficient ground for re-establishment. See e.g., J 5/94, point 3.1 of the Reasons; J 27/01, point 3.3.1 of the Reasons; and J 2/02, point 8 of the Reasons, first paragraph. The reason for this is simply that a person who makes such a mistake generally cannot be said to have taken all due care required by the circumstances; such a mistake is normally inconsistent with and indeed the antithesis of taking of all due care. This is particularly so where, as here, the law is clear. Taking of due care requires that a person engaged in proceedings before the Office, even when a layman, should acquaint himself with the relevant rules. See e.g., D 6/82 OJ EPO 1983, 337, point 8 of the Reasons; T 516/91, point 5 of the Reasons."

Misinterpretation of the law, however, was excused in J 28/92. The board held that the misinterpretation of a provision of the EPC by a representative was not without basis or unreasonable and considered that there was no basis for penalising the representative for having arrived at a not unreasonable interpretation of a rule of the EPC, which subsequently turned out to be wrong. The board accepted also that a letter of the receiving section was phrased in such a way as to encourage such an interpretation of the rule. In the board's view it would be unreasonable to apply the principle that everyone is presumed to know the law even to circumstances where there may be genuine doubt and differences of opinion about the meaning of a legal provision.

The present Board shares the view expressed in J 28/92 even though, as the rapporteur said in the hearing, it could not find in the database of the decisions of the EPO boards of appeal any decision in which J 28/92 had been cited. Rather, the decisions that it had retrieved were all based on the assumption that an error of law could not be excused. One might deduce from the appellant's reading of the case law according to which legitimate expectation cannot be based on a precedent set in a single decision of the boards that J 28/92 is not good law. Thus, once an error of law had been detected, due care would have to be denied. The representative's submissions seeking to establish that the avenues of relief that he chose were, if not correct, at least reasonable, would then be in vain, and the present Board would be prevented from giving them any consideration. The Board, however, believes

that J 28/92 can be reconciled with the opinion expressed in the established case law that a legal error cannot be excused. The Board interprets J 28/92 as meaning that there may be exceptions to that rule, which, however, can be acknowledged only under rigorous criteria, such as those established in that decision.

6.2 Due care on the part of the representative

Below it will be established first that, from a *correct* interpretation of the law, an appeal was the remedy to have DE added to the Contracting States designated in the decision to grant (see 6.2.1) and that, conversely, the three substantive requests filed with the letter of 18 September 2007 were not suitable to bring about that result (see 6.2.2 to 6.2.4). In conclusion, the representative committed an error of law (see 6.2.5). Second, it will be shown that it was *not reasonable* for the representative, either, to file any of those other requests instead of an appeal (see 6.2.6). It follows that the representative's error not to file an appeal cannot be excused and that, therefore, he has not taken all due care required by the circumstances of the present case (see 6.2.7).

6.2.1 The need to file an appeal

The question as to which was the appellant's proper legal remedy to have the decision to grant "rectified" would not arise if the decision were legally non-existent. In such a case, no remedy would have been needed as the EPO would yet have to adopt a valid decision to grant. In this context the Board notes that, in his submissions, the representative has

constantly stressed the EPO's failure to dispatch a Rule 108(3) communication, this alleged failure being the root of the omitted DE designation in the decision to grant. The Board assumes *arguendo* that the Office should indeed have issued such a communication. According to Rule 108(3) EPC 1973, if the EPO notes that the designation of a Contracting State is deemed to be withdrawn because the designation fee has not been paid in due time, it shall communicate this to the applicant. The loss of rights shall be deemed not to have occurred if, within two months, the omitted act is completed and a surcharge is paid. In the present case, under Rule 108(2) EPC 1973, the designations of all the Contracting States indicated in the international application, with the exception of FR, GB and NL, which were mentioned in section 10.2 of Form 1200 and for which the designation fees were paid on 24 October 2003, were deemed to be withdrawn on expiry of the 31-month period for entry into the regional phase before the EPO (Rule 107(1)(d) EPC 1973), which ended on 10 November 2003. The Board further considers that the communication sent pursuant to Rule 51(4) EPC 1973 did not constitute a Rule 108(3) communication because it did not expressly draw the attention to a loss of rights in relation to those Contracting States whose designation was deemed to be withdrawn. The Board holds that the failure to dispatch the Rule 108(3) communication does not make the decision to grant to be legally non-existent. Rather, the decision to grant can only lose its legal force if so ordered by the Board in appeal proceedings. This will be explained in greater detail below.

According to Article 106(1) EPC 1973, "[a]n appeal shall lie from decisions of the ... Examining Divisions ...". There can be no doubt that a decision to grant is a decision within the meaning of this EPC provision. Article 21(3)(a) EPC 1973 expressly mentions a decision concerning the grant of a European patent. For appeals from such a decision taken by an examining division consisting of less than four members, under that provision, a board of appeal shall consist of two technically qualified members and one legally qualified member. The condition of Article 106(3) EPC 1973 is also met because the decision to grant of 21 June 2007 terminated the examination proceedings (also referred to as proceedings up to grant or application proceedings) when it took effect on the date on which the European Patent Bulletin mentioned the grant, i.e. on 18 July 2007 (see Article 97(4) EPC 1973).

It is established case law that an examining division is bound by its final decision on an application, which can be set aside only following an admissible, allowable appeal; see T 1093/05, point 6, and the cases cited there, in particular G 12/91, where the Enlarged Board held at point 2: "Once ... [the decision] has been pronounced and, in the case of written proceedings, notified, the decision enters into force and cannot be amended, even by the department that issued it. A decision may only be revoked by the department that issued it by way of an interlocutory revision under Article 109 EPC if one of the parties has filed an admissible and well-founded appeal." In the light of the established case law the board handing down the decision in case T 1093/05 declared itself unable to follow T 971/06 which considered a decision to grant in

the absence of an approved text to be a nullity (but still ordered that the decision under appeal be set aside). In any case, the factual basis of T 971/06 is different because in the case at hand the text of the patent was approved.

The present decision to grant of 21 June 2007 is final and became binding on the examining division that issued it on the date it was handed over to the EPO postal service by the division's formalities section (see G 12/91, headnote). From that date onwards it could be "rectified" by an appeal. "Rectified" by an appeal would mean that the board would set the impugned decision to grant aside and remit the case to the first instance with the order to grant a patent with the designated Contracting States including DE.

In the light of the representative's submissions the question must be answered whether an appeal was the only available remedy in the present case or whether any of the alternative means of redress that he relied on in the letter of 18 September 2007 would also have been appropriate for having DE added as designated Contracting State in the decision to grant without the need for that decision to be set aside before. If so, the fact that no appeal had been filed against the rejection of those means by the EPO with the "observations" of 20 February 2008 might not exclude due care, because the Office might be bound by its statement in the telephone conversation of 15 October 2007 suggesting that an appeal against the decision to grant would have been the only remedy.

6.2.2 The request for correction under Rule 89 EPC 1973

(a) Application of Rule 89 in general

Correction pursuant to Rule 89 EPC 1973 would be an alternative means to rectify the decision if a request had been filed meeting the conditions of that Rule. The Rule is entitled "Correction of errors in decisions" and reads: "In decisions of the European Patent Office, only linguistic errors, errors of transcription and obvious mistakes may be corrected." When the request for correction was filed on 18 September 2007, the legal basis was Rule 89 EPC 1973 and not Rule 140 EPC 2000, as the EPC 2000 entered into force on 13 December 2007 only. In any case, both rules have the same wording.

A decision to grant contains an obvious mistake if the text given for grant is not and obviously cannot be what the examining division actually intended, and the erroneously indicated text can be replaced by that on which the examining division actually wanted to base its decision. For reasons of legal certainty and to prevent adverse effects for third parties, only obvious errors can be corrected. That means it must be clear not only that the examining division did not intend to grant the patent in the form actually granted, but also in what form it did intend to grant it. (See T 1093/05, point 7, and the cases cited there.)

The representative argued in the hearing that the First Request filed with the letter of 18 September 2007 constituted a request for correction under Rule 89 EPC 1973. As set out under point III, the request was to

"now afford the applicant the opportunity to respond to the Rule 69 communication which should have flowed from Rule 108(3)" and to re-publish the mention of grant indicating DE, FR, GB and NL as designated Contracting States. The Board, in favour of the appellant, takes this request as a request under Rule 89 EPC 1973.

The formalities officer of the examining division, in her "observations", expressed the view that the decision could not be corrected under Rule 140 EPC. The Board shares the view that a correction of an error further to the request based on Rule 89 EPC 1973 is not possible because the conditions set out above are clearly not met. There is no indication of a divergence between the text given for grant and the actual intention of the examining division. The representative approved the communication under Rule 51(4) by paying the fees and filing the translation in compliance with that provision. As the communication indicated FR, GB and NL as designated Contracting States, it must be assumed that the examining division wanted to grant a patent for those three states.

(b) The meaning of the terms "amend", "change" and "correct"

The representative disagrees with this conclusion. Referring to the sentence "Once proceedings have been completed the decision-making department can no longer amend its decision" in G 12/91 (at point 9.3) he argues that there is a clear distinction between the use of the term "amend" and the use of the term "correct" relying on various provisions of the EPC. He submits that an amendment does not require, as a prerequisite,

an error but might be requested even if an error as such had not occurred. These submissions would suggest that the sentence quoted from G 12/91 is not pertinent to the present case.

The Board considers that, in order to determine the meaning of the term "amend", it is useful to have a look at G 8/95. In that decision the Enlarged Board of Appeal distinguished between two situations in which the decision to grant was not what the applicant had asked for, and explained which errors were correctable under Rule 89 EPC 1973 and which were appealable. "A party who appeals against the decision to grant is aiming to change the decision under appeal by alleging that the decision does not correspond to its requests in contravention of the law (see Article 113(2) EPC)" (point 3.1). "A party who requests a correction under Rule 89 EPC is also aiming to 'change' the decision. The basis of such a request is, however, not that the party was not granted what it had requested. Rather, such a request is based on the allegation that there is a linguistic error, error of transcription or similar obvious mistake. ... [W]here a decision does not express the manifest intention of the deciding body, an obvious clerical mistake in the decision can be corrected" (point 3.2). "Thus the difference between an appeal and a request for correction of a decision may be seen in the fact that in the first case the remedy is directed against the substance of the decision and in the latter case against the form in which the decision was expressed" (point 3.3).

From the above portions of G 12/91 and G 8/95 the Board draws the following conclusions, which are based on the

assumption that the terms "amend" and "change" in the present context have an identical meaning (this assumption is corroborated by the fact that the corresponding terms in the French and German version, i.e. "modifier" and "ändern/Änderung", are identical): Rule 89 relates to obvious errors whose correction does *not* amount to an amendment or change of a *substantive* nature but simply gives the decision its intended expression. This view is supported by the fact that the word "change" in the context of Rule 89 was put into quotation marks in G 8/95. Any modification of the text of a decision going beyond an "amendment" or "change" to remedy an obvious error within the meaning of Rule 89, amounts to a *substantive* amendment or change, no matter whether it is

- an amendment, which is not the consequence of an error, and thus does *not* constitute a *correction*, e.g. an amendment of the granted claims further to the filing of new claims after compliance with Article 123 EPC has been established, or
- an amendment which is indeed the consequence of an error, but not an obvious one within the meaning of Rule 89, e.g. where the examining division has failed to take account of a key point. This is a *substantive correction*.

Moreover, G 12/91 dealt with the date on which the decision-making process following written proceedings is completed. It was held that, once proceedings have been completed, the decision-making department can no longer amend its decision. It must disregard any fresh matter the parties may submit to the EPO thereafter. (See point 9.3.) There is nothing in this decision limiting the finding about the completion of the

decision-making process to any particular kind of fresh matter submitted after the critical date, i.e. it does not rule out that additional designations of Contracting States, as in the present case, are considered to be such inadmissible fresh matter. Thus the sentence "Once proceedings have been completed the decision-making department can no longer amend its decision" is pertinent to the present case. The addition of DE in the decision to grant would amount to an amendment in the sense of a substantive correction, which is not covered by Rule 89 and not possible under G 12/91.

The representative further argues that the error made in the decision to grant was one of form and not of substance, the reason being that the EPO could not have intended to issue a decision without having, themselves, complied with the EPC. While the Board shares the view that members of the EPO do not intend to adopt decisions that infringe the EPC, the Board cannot subscribe to the conclusion that errors that still occur are errors of form. This view, if taken at face value, would, according to the above quote from G 8/95, indeed enable a correction under Rule 89 EPC 1973, without any statutory limitation of time, because the decision would not express the manifest intention of the deciding body.

Such a position would be the antithesis of the EPC's system of legal remedies. The EPC provides for access to the boards of appeal being judicial authorities pursuant to Articles 106 and 21(1) EPC. This right of access is subject to certain limitations, such as rules on time limits, in particular the appeal time limit

embodied in Article 108 EPC; cf. T 1465/07 (points 9 *et seq.*) delivered by the Board in the same composition. That appeal time limit has a legitimate aim, which is legal certainty and the proper administration of justice by avoiding any discrimination or arbitrary treatment (see point 14). This aim would be frustrated if requests under Rule 89 EPC 1973 or Rule 140 EPC 2000 could validly be brought without any statutory limitation of time. As a consequence, the alleged error in issue cannot be considered as one of form but only as one of substance of the decision. As follows from G 8/95, Rule 89 does not apply in this regard.

(c) Duty of care

The representative also relies on the EPO's duty of care due to which it should have issued a corrected decision to absolve the appellant of all effects of the violation and the loss of legitimate expectations. In this regard, he also invoked the principles of good faith, equity and fairness. In the Board's opinion, acknowledging a duty of care in this sense would, however, also lead to a conflict with the appeal system of the EPC. The same applies to the principles indicated. Therefore, this argument must fail.

In the context of "duty of care" the representative cited case T 714/92 where the patent proprietor noted a substantial procedural violation. The representative set forth himself that the case was remitted to the examining division on appeal. The board had found the appeal to be admissible and allowed it. It is therefore not intelligible how this decision could impact on the question of whether or not the present request for

reinstatement of the appeal period can be allowed, which is a condition of the admissibility of the appeal.

(d) Procedural violation and Rule 89

Finally, any substantial procedural violation of not sending the Rule 108(3) communication does not amount to an obvious error within the meaning of Rule 89. The Enlarged Board of Appeal, in reaction to the allegation that a violation of fundamental procedural principles constitutes an obvious mistake under Rule 89, held in G 1/97 that "a legal error, no matter whether it concerns substantive or procedural aspects, cannot be corrected" under this Rule (see OJ EPO 2000, 322, point 2(c)).

(e) Conclusion

As in T 1093/05, the appellant is challenging the substance of the decision to grant. The right way to do that would have been to appeal against it. The correction request cannot succeed because it challenges the form of the decision to grant, and the examining division wanted to issue it in that form. (See point 11.) "If a grant decision is defective, the patent proprietor must consider carefully the nature of the defect and how it is best rectified. If it involves a substantial procedural violation, rectification is possible only on appeal. A request for correction under Rule 89 EPC can succeed only if it is clear that the examining division did not intend to grant the patent in that form - and also in what form it did intend to grant it." (See point 12)

It will be shown in the following two sections of the present decision that the representative's request under Rule 88 EPC 1973 to correct Form 1200 by adding DE as a designated Contracting State and his application for re-instatement of the period for paying the corresponding designation fee and surcharge pursuant to Article 122 EPC 1973 do not change this result. It should be noted in this context that the representative made no submissions in the course of the oral proceedings regarding this avenue of relief.

6.2.3 The request for correction under Rule 88 EPC 1973

The representatives' Second Request made in his letter of 18 September 2007 was to correct an error under Rule 88 EPC 1973 in the Form 1200 submitted when entering the European regional phase of the application to designate also the state of Germany and to re-publish the mention of grant to show also the correct designation of Germany.

Pursuant to Rule 88, first sentence, EPC 1973, which is applicable to Euro-PCT applicants in the regional phase (see J 3/01, point 4), and whose text is identical with that of the first sentence of Rule 139 EPC 2000, "[l]inguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request."

The boards of appeal have held that, for a correction under Rule 88 to be possible, proceedings must still be pending; see J 42/92 and J 23/03. In the present case proceedings up to grant were terminated, once the decision to grant had been mentioned in the European

Patent Bulletin on 18 July 2007. The question arises as to whether the proceedings continue to be pending or are even revived when the EPO in one of the few cases provided for in the EPC has to deliver a decision after the grant of the patent has taken effect, such as in opposition proceedings or further to a request for correction under Rule 89 EPC 1973 (see J 23/03, point 2.1.2), as filed in the case at hand.

This question can remain an open one: there is no legitimate interest for the present request under Rule 88, because the requested correction would have no legal effect. The desired correction would only lead to a correction of Form 1200, by adding DE to the designated Contracting States. It would not have the effect that the designation fee paid on 18 September 2007 would be deemed to have been made within the time limit of 10 November 2003 (see above, point 6.2.1). Independent thereof, the correction of Form 1200 would not also bring about a correction of the decision to grant, which is not a document filed with the EPO. This decision would then simply diverge from Form 1200 insofar as DE is not included. In this regard, reference is made to the extensive explanations given in J 23/03, under section 2.2, that apply *mutatis mutandis* to the present case.

The representative's view, according to which J 23/03 is not applicable because of the express designation of GR, which should have been made for GB instead, is not convincing. In the context of Rule 88 there is no reason to distinguish an incorrect designation, as in J 23/03, from a missing designation, as in the present case. An omission can also amount to a mistake (see e.g.

J 6/91, at point 3(2), and J 3/01). The representative's request, incidentally, is based on this assumption. Therefore, both an incorrect designation and an omission of a designation, in principle, are mistakes within the meaning of that Rule.

As for his objection to J 42/92, the representative has not explained why, in his opinion, the reasoning in that decision is not equitable and flawed.

Finally, the EPO cannot have the alleged duty of care to apply Rule 88 even after the patent has taken effect, because such a duty would be in conflict with the above case law.

It follows from the foregoing that the Office could not have acceded to the request under Rule 88 EPC 1973.

6.2.4 The application for re-establishment of rights under Article 122 EPC 1973

According to the Third Request made with the letter of 18 September 2007 the representatives requested, in parallel with or if necessary after refusal of the Second Request, restitution of the designation of the German state under Article 122 EPC 1973. The omitted act was the payment of the designation fee for Germany and the 50% surcharge. The request for restitution was made within two months of the removal of the cause of non-compliance. The removal of the cause of non-compliance was the receipt by the attorney of the original information that Germany was not designated. The incorrect designation only came to light on 18 July 2007 as evidenced by the communication of the German

attorney. The unobserved time limit was the payment of the designation fee in response to the Rule 69 communication flowing from Rule 108(3). That communication had never been sent so that the two-month Rule 108(3) time limit had not been established. The grounds for *restitutio* are common with the facts noting the procedural violation and the grounds for correction under Rule 88 EPC 1973. The re-establishment and designation fees were paid.

In relation to this request, the Board recalls that the appellant lost its right to a European patent for Germany through its failure to pay the designation fee in due time. Re-instatement of periods for payment of designation fees, however, is not allowable pursuant to Article 122(5) EPC 1973, which applies in Euro-PCT proceedings to the time limits under Rule 107(1)(d) in conjunction with Article 158(2) EPC 1973. This follows from the decision of the Enlarged Board of Appeal in Case G 3/91, OJ EPO 1993, 8 (dealing with the then valid corresponding provisions of Rule 104b(1)(b)).

The restoration provisions of the EPC 1973 are referred to because, accepting *arguendo* that the removal of the cause for non-compliance took place on 18 July 2007, the time limit for requesting re-establishment of rights would in any case have expired on 18 September 2007 and thus before entry into force of the EPC 2000 on 13 December 2007; cf. above, point 3.2).

The fact that no communication under Rule 108(3) EPC 1973 had been sent noting the loss of, *inter alia*, the German designation and setting a time limit for payment of the designation fee with a surcharge, has no impact

on the exclusion of periods for payment of designation fees from reinstatement. Instead, it could have been dealt with in the framework of an admissible appeal.

6.2.5 Conclusion: a legal error

It follows from the above sections 6.2.1 - 6.2.4 that the decision under appeal could have been rectified only in the framework of an admissible appeal but not on the basis of any of the three substantive requests filed with the letter of 18 September 2007. Thus, the representative, in filing those requests instead of an appeal, erred in law.

The representative claims that "[t]he failure to file an appeal before the deadline was an error but this error was not made in ignorance of the provisions of the EPC but was made despite a careful and considered review of the EPC and the associated case law" (see point VII above).

The Board has difficulty in accepting such a logic. Rather, it holds that where an error in EPC law was made despite a careful and considered review of the EPC and the associated case law, such error may not amount to ignorance of the EPC and the case law in general, but it does constitute a misinterpretation of a specific point of EPC law, which is tantamount to ignorance of that point of law.

6.2.6 No reasonable interpretation of the law

(a) Introduction

The representative submitted that, if the Board remained unconvinced that all due care was taken in deciding on the course of action in the present case, then the interpretation of the EPC which resulted in the requests of 18 September 2007 was not unreasonable (see point VII above).

As a mistake or ignorance as to the law is generally an insufficient ground for re-establishment, the representative cannot be considered to have exercised all due care unless his case can be rated an exceptional one, because his misinterpretation of the EPC as to the need to file an appeal was not without basis or unreasonable, possibly because a statement the EPO encouraged such an interpretation (*cf.* point 6.1 above referring to J 28/92). These conditions are however not met in the present case.

(b) No excuse of the lack of awareness of the appropriate legal remedy

The need to file an appeal follows from the plain wording of the EPC, especially Article 21(3)(a) EPC 1973, and the case law, in particular decisions G 12/91 and G 8/95 of the Enlarged Board of Appeal; see points 6.2.1 and 6.2.2 above. Professional representatives are supposed to know the EPC and the case law, in particular the decisions of the Enlarged Board. This is true even though remedies against decisions to grant may be sought infrequently.

It was not reasonable for the representative to believe that an appeal would not be necessary because at least one of the three substantive requests filed with the letter of 18 September 2007 would be granted. First, the representative should have known the law set out under the preceding sections of present point 6. Second, the various additional reasons that the representative relied on to establish that the route he chose was reasonable are not convincing. They are addressed below.

- First Request of 18 September 2007

Regarding the interpretation of the sentence "Once proceedings have been completed the decision-making department can no longer amend its decision" in G 12/91, it has already been laid down above that the term "amendment" encompasses a substantive "correction" and the Board considers this to be clear. Furthermore, the same conclusion as in that sentence must be drawn from subsequent decisions of the boards that were all mentioned in T 1093/05, at point 6. There it was held that: "It is established board of appeal and Enlarged Board of Appeal case law that an examining division is bound by its final decision on an application, which can be set aside only following an admissible, allowable appeal (see G 12/91, OJ EPO 1994, 285, Reasons 2; G 4/91, OJ EPO 1993, 707, Reasons 7; T 371/92, OJ EPO 1995, 324, Reasons 1.4 and 1.5; T 1081/02 of 13 January 2004, not published in OJ EPO, Reasons 1.1.3; T 830/03 of 21 September 2004, not published in OJ EPO, Reasons 1.1 and 1.2)."

Whether or not the representative was supposed to have considered the content of T 1093/05 is immaterial, as the decision simply affirmed the case law cited in the previous paragraph that was adopted years before the deadline to file an appeal against the decision to grant, and thus the representative could be expected to be knowledgeable of that case law. In addition, had he considered T 1093/05, it would not have been reasonable to have discounted the decision for the sole reason that it was a single decision, because at least in this respect it was not.

The fact that the representative in Case T 1093/95, who was faced with a substantial procedural violation, also chose not to file an appeal does not help the representative in the present case, either. It is not intelligible how the fact that that representative and he himself refrained from filing an appeal could amount to a "common course of action". Given the sizeable number of professional representatives before the EPO, more than two representatives making the same mistake would be needed to make this mistake become a "common" one.

Finally, the Board finds the representative's reasoning that decisions of the first instance on possible requests for a correction under Rule 89 EPC 1973 are not searchable to be beside the point. Should there be decisions allowing such requests after the completion of the proceedings, those decisions would not be in compliance with the law and therefore plainly irrelevant.

- Second and Third Request of 18 September 2007

From the case law discussed above under sections 6.2.3 and 6.2.4 it should have been clear to the representative that neither the request under Rule 88 EPC 1973 nor the request under Article 122 EPC 1973 could have been allowed. For the Third Request this follows in addition from the EPO's communication of 27 August 2007 dispatched in another case and submitted by the representative with a letter of 19 September 2007. That communication noted the loss of rights in relation to the designations of certain contracting states. Under the heading "Means of redress" it was indicated in bold type that "The applicant's rights cannot be re-established under Article 122 EPC [1973]".

- The imminent entry into force of the EPC 2000

There is no discernible impact of the EPC 2000 on the course of action chosen by the representative. If he had really wished to "cover his bases", it might have been prudent for him to file an appeal, as soon as he recognised that the omission in the decision to grant constituted an error. In the oral proceedings he conceded that in retrospect the best approach would have been to run both the request for correction under Rule 89 and an appeal.

(c) No indication of the possibility of appeal

It is true that the examining division, in the impugned decision to grant, did not include a written communication of the possibility of appeal nor draw the attention to Articles 106 to 108 EPC 1973 and attach the text of those articles. While it seems that it has

been common practice for examining divisions to proceed this way when issuing decisions to grant, such practice is not in compliance with the provisions of Rule 68(2) EPC 1973 (now Rule 111(2) EPC 2000). The violation of those provisions, however, has no legal impact because the last sentence of Rule 68(2) EPC 1973 reads: "The parties may not invoke the omission of the communication". Furthermore, according to T 42/84 (OJ 1988, 251), omission of enclosure of the text of the articles alone cannot be invoked either.

(d) No misleading information from the EPO

The representative did not receive incorrect or misleading information from the EPO as to the need to file an appeal. On the contrary, it was the verbal advice of the formalities officer provided on 15 October 2007, which indeed prompted the present appeal. The information from the EPO according to which a request for re-establishment of rights was not available apparently does not concern the appeal deadline, but may rather have been aimed at the first *restitutio* request of 18 September 2007, and in any case the appellant did not rely on that information.

(e) Failure to file appeal not consequence of procedural violation

Nor would the representative be in a position to safely claim that his omission to file an appeal within the two-month time limit was the consequence of the alleged procedural violation on the part of the EPO. Assuming in his favour that such a violation took place because of the EPO's failure to issue a communication under

Rule 108(3) EPC 1973, such violation cannot have had any impact on his duty to be knowledgeable about the appropriate legal remedy for contesting a possibly deficient decision to grant.

(f) Conclusion

Against this backdrop it is clear that this is not a case in which the law was doubtful and the procedure that the representative chose to follow cannot be considered to have been a "not unreasonable" one, such as in case J 28/92.

6.2.7 Overall conclusion on due care on the part of the representative

In the light of the foregoing, the representative could be expected to know that in the present case the appeal was the only appropriate means of redress against the decision to grant of 21 June 2007 and that he could not successfully challenge that decision by the three substantive requests filed on 18 September 2007. Thus the representative missed the time limit for filing an appeal against the decision to grant as a consequence of a misinterpretation of a specific point of EPC law that cannot be excused. As a consequence, he cannot be considered to have exercised all due care required by the circumstances within the meaning of Article 122(1) EPC.

6.3 Due care on the part of the patent proprietor

As stated, the request for re-establishment of rights of a patent proprietor with a professional

representative acting on its behalf is only allowable if both the proprietor itself and its representative have met the necessary standard of care. Since the representative has not exercised due care, the question whether the proprietor itself has taken due care can remain an open one.

7. Reimbursement of the appeal fee

The appeal has not been filed within the deadline and the appeal fee was also paid late. The application for reinstatement of the time limit for filing an appeal and paying the appeal fee is not well-founded. As a consequence, pursuant to Article 108, second sentence, EPC 1973 the notice of appeal shall not be deemed to have been filed. In such a case the appeal fee is to be reimbursed (see T 1026/06, point 6, and the case law cited there).

Order

For these reasons it is decided that:

1. The request for re-establishment of rights of 22 October 2007 is refused.
2. The appeal is deemed not to have been filed.
3. The appeal fee is reimbursed.

The Registrar:

The Chairman:

M. Kiehl

A. G. Klein