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**D E C I S I O N**  
of 27 November 1995

**Case Number:** T 0796/94 - 3.5.2

**Application Number:** 84304576.6

**Publication Number:** 0130844

**IPC:** H01R 23/68

**Language of the proceedings:** EN

**Title of invention:**

Interconnection apparatus for wiring harnesses

**Patentee:**

Sumitomo Wiring Systems, Ltd., et al

**Opponent:**

STRIBEL GMBH  
Siemens AG

**Headword:**

Correction of priority/SUMITOMO

**Relevant legal provisions:**

EPC R. 88

**Keyword:**

"Correction requested only after grant - late"  
"No warning issued to the public"  
"Public seriously affected by correction - refused"

**Decisions cited:**

J 0004/82, J 0014/82, J 0003/91, J 0006/91, J 0002/92

**Catchword:**

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Case Number: T 0796/94 - 3.5.2

DECISION  
of the Technical Board of Appeal 3.5.2  
of 27 November 1995

**Appellant:**  
(Proprietor of the patent) Sumitomo Wiring Systems, Ltd.  
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**Respondent:**  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office dated 13 September 1993  
refusing correction of a priority declaration.

**Composition of the Board:**

**Chairman:** W. J. L. Wheeler  
**Members:** C. Holtz  
R. G. O'Connell

## Summary of Facts and Submissions

- I. The appeal contests the decision of the Opposition Division to refuse a request for correction of the declaration of two priority documents in European patent application No. 84 304 576.6 (hereinafter "application A").
- II. The appellant filed application A and a sister application (No. 84 304 577.4, hereinafter "application B") on 4 July 1984. Both were titled "Interconnection apparatus for wiring harnesses". Application A claimed priority from two previous applications in Japan: JP 122640/83 and JP 122641/83, both of 5 July 1983 (EPO form 1001, Section VII). Application B claimed priority from the same date, based on JP 122642/83. All three priority documents bear the same title as the applications. Certified copies and translations of the two priority documents for application A were filed on 2 October 1984.
- III. Application A was published on 9 January 1985, and the mention of the grant of European patent No. 0 130 844 on this application was published on 27 September 1989. Two oppositions were filed against this patent on 27 June 1990.
- IV. On the same day, 27 June 1990, which was the last day of the nine month period in which oppositions could validly be filed, the appellant filed two requests, one under Rule 19 EPC to have the name of the inventor corrected, and the other under Rule 88 EPC to have the priority declaration corrected to refer to JP 122642/83 of 5 July 1983 instead of the two Japanese applications entered in

Section VII on EPO form 1001 and to permit the appellant to replace the incorrect priority documents on file with the correct one.

- V. The request for rectification of the designation of the inventor was granted, but the request to correct the priority declaration was refused in the decision under appeal.
- VI. Oral proceedings were held before the Board on 7 June 1995. Only the appellant was present, the two opponents having informed the Board that they did not wish to attend.
- VII. The appellant requested that the decision under appeal be set aside and that the appellant be permitted to correct the priority claim in European Patent No. 130 844 by correction of the declared priority and be given the opportunity to file the correct document JP 122642/83 and a translation thereof.
- VIII. The appellant's arguments can be summarised as follows:
- (a) The erroneous priority declaration was made on the application form for the present European patent as a result of a mistake made in Japan, which caused the names of the inventors and the priority data of applications A and B to be interchanged on the filing instructions sent to the appellant's European representative, copies of which had been submitted. The European representative had filed the two European applications and the priority documents on the basis of the instructions received from Japan, but the initial error made in Japan meant that the wrong JP application numbers were

entered on the application forms for the two patents, which in turn led to the wrong priority documents being filed.

(b) There were no previous decisions of the EPO Boards of Appeal addressing the unique circumstances of the present case, in that the priority date claimed for the present case was correct. Applications A and B were identical in the following respects:

- They had the same application date (4 July 1984) and the same priority date (5 July 1983),
- They had the same publication date (9 January 1985),
- They had the same title of invention, and
- The applicants were the same.

(c) The case law of the EPO Boards of Appeal regarding the correction of errors with respect to the designation of states and priority claims under Rule 88 EPC was reviewed in decision J 6/91 (OJ EPO, 1994, 349). The present case met all the conditions set out in paragraph 3 (points 1-4 and 6) of the reasons of that decision, namely: (1), (2) and (3) - the appellant had provided proof that a genuine mistake had occurred in the form of an incorrect statement which did not express its true intention; (4) - the request for correction was made promptly in the sense that the appellant acted as soon as it became aware of the mistake; (6) - the public interest would not be adversely affected if the correction were allowed. Condition (5) was not applicable.

(d) Regarding promptness, the appellant only became aware of the erroneous (interchanged) priority declarations when the granted patents were sent to

their respective inventors, who raised the alarm in May 1990. In accordance with the usual practice, the appellant's representative had filed the certified copies of the priority documents with their original bindings intact and had not made copies of them for his own file. He had no reason to suspect they were incorrect and no objection regarding the priority documents had been raised by the EPO. The EPO should not expect applicants to keep to higher standards than it did itself.

- (e) The conclusion in the decision under appeal that the necessity to perform a technical analysis of the content of the priority documents would not meet the condition of Rule 88, second sentence, EPC, that the mistake must be obvious, was wrong. A correction of priority was not a purely legal issue. Any seriously interested third party **would have to** compare the priority documents with the **claims** of the application to be able to establish whether it had reason to oppose the patent or not.
  
- (f) The correct priority document was available because it was on file by way of application B. Decision J 14/82 (OJ EPO, 1983, 121), paragraph 8 of the reasons, applicable to the present case, made it clear that a warning to the public of the existence of a missing priority document could be derived from the publication of another European application. Although the correct priority document had not been available in application A, it had been filed in due time, albeit placed in the file of application B. A seriously interested third party, who wanted to know if it might be infringing the patent, or if it should oppose the patent, would study the file, including the priority documents. On making a file inspection of

Application A, this party would realise that not even Claim 1 would be entitled to the claimed priority date, because JP 122640/83 did not disclose the bus bar on the wiring board as claimed in application A. A further discrepancy would be apparent to the third party from the drawings, Figure 1, of application A as compared to Figure 1 of each of JP 122640/83 and JP 122641/83.

- (g) The seriously interested third party would however, irrespective of whether he could recognise these discrepancies, as a routine measure search neighbouring areas as well. A sample Derwent data base search result would have revealed the existence of the family: EP 130 844 (application A), US 4 685 753, etc. This US patent however did not correspond to application A in subject-matter, but to application B, and claimed priority from JP 122640/83. The Derwent search result would also have shown another family: EP 130 845 (application B), US 4 603 930, etc. This US patent conversely corresponded in subject-matter to application A and claimed priority from JP 122642/83. The third party would thus become aware of the error in the priority declarations of the two European applications/patents and would recognise that there was a potential for correction, which if allowed would not come as a complete surprise. This situation was comparable with that in J 2/92 (OJ EPO, 1994, 375).
- (h) The public at large would not be adversely affected either, since the published priority date was correct, and the public would be advised about the correction of the number of the JP priority document if the patent was republished after the opposition.

## Reasons for the Decision

### 1. *Formal issues*

- 1.1 Although the request for correction was made after grant of the patent, proceedings were still pending before the EPO. The decision under appeal was taken by the Formalities Officer for the Opposition Division after two oppositions had been filed. In accordance with Article 21(4) EPC, the appeal is therefore to be considered by a Technical Board of Appeal.

All conditions for admissibility under Articles 106-108 EPC having been met, the appeal is admissible.

### 2. *Rule 88 EPC and the relevant case law*

- 2.1 Linguistic errors, errors of transcription and mistakes in any document filed with the EPO may be corrected on request, Rule 88, first sentence, EPC. However, if the request for such correction concerns a description, claims or drawings, the correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction, Rule 88, second sentence, EPC.
- 2.2 According to decision J 4/82 (OJ EPO 1982, 385) and subsequent decisions by the Legal Board of Appeal, an error in a priority declaration may be corrected in accordance with Rule 88, first sentence, EPC.
- 2.3 Decision J 14/82 (OJ EPO 1983, 121), following decision J 4/82, allowed the correction of an omission to declare three priorities, dated between the first, correctly claimed, priority and the date of filing of the



application, on the condition that, if the correction was not requested in time for a warning to be issued in connection with the publication of the application ("late corrections"), the interest of the public must not be adversely affected, this interest being defined in point 6 of the reasons as the right of the public to be able to rely on the published information (including the priority date) as being both accurate and complete.

- 2.4 According to decisions J 3/91 (OJ EPO 1994, 365) and J 2/92 (OJ EPO 1994, 375), the interests of third parties are not adversely affected by a "late" correction of a priority declaration if the mistake in the particulars of the priority declaration is apparent on the face of the published patent application ("apparent discrepancy"). From this it may be concluded that whenever the "adversely affected" issue arises, as it does in the case of late corrections, conditions similar to those laid down by Rule 88, second sentence, EPC have to be fulfilled, at least in situations where the priority date would be backdated.
- 2.5 More than a dozen decisions of the Legal Board of Appeal relating to correction of errors with respect to priority claims under Rule 88 EPC were reviewed in the decision J 6/91, OJ EPO, 1994, 349, which contains the following summary thereof in paragraph 3 of its reasons:
- (1) A mistake exists where a document filed with the EPO does not express the true intention of the person on whose behalf it was filed;
  - (2) A mistake may be an incorrect statement or result from an omission;

(3) The burden on the applicant of proving that a mistake has been made, what the mistake was and what the correction should be is a heavy one; Rule 88 may not be used to enable a person to give effect to a change of mind or subsequent development of plans;

(4) The request for correction must be made promptly and, except in exceptional circumstances, sufficiently early for a warning to be included in the publication of the application;

(5) concerns international applications filed under the PCT and is not applicable to the present case;

(6) Where no warning is published, the question whether the public interest would be adversely affected by allowing the correction must be considered. Correction of a priority without warning to the public has only been allowed where the above conditions have been fulfilled and there have been the following special circumstances:

(i) the EPO was partly responsible for the fact that no warning was published; and/or

(ii) the interest of the public was not seriously affected; for example, the mistake was obvious on the face of the application as published; only a second or subsequent priority was added; or the public was otherwise informed about the full scope of protection sought by the applicant.

### 3. *The present case*

3.1 This is the first case of a request for correction of a priority to come before a Board of Appeal where both the date and the state of the earliest priority as claimed

under Article 88 and Rule 38 EPC were correctly given; only the number of the priority document was incorrect. It is also the first case to come before a Board of Appeal in which the request for correction was made during opposition proceedings after grant of the patent. The previous case law is therefore only applicable to the present case insofar as it would apply regardless of these circumstances.

It should be noted that the circumstances in the decision J 6/91 differed from those in the present case in that the correction concerned an omitted first priority and the request was made before entry into the regional (European) phase of a Euro-PCT application.

- 3.2 The Appellant has satisfied the Board that a genuine mistake occurred in the form of a clerical error (confusing the priority declarations for two parallel applications). Points (1), (2) and (3) recited in paragraph 2.5 are thus met in present case. In reaching this conclusion, the Board has read the word "applicant" in point (3) as not excluding a "proprietor", so as not to debar, from the outset, any possibility of correction of a priority after grant, irrespective of the circumstances of the case.
- 3.3 However, with regard to point (4) of the summary recited in paragraph 2.5 above, whereas the Board accepts the Appellant's assertion that the request was made promptly in the sense that it was made as soon as the mistake was discovered, it remains an indisputable fact that the request was not made sufficiently early for a warning to be included in the publication of the application. Indeed, it was even too late for a warning to be included in the publication of the patent. The request was made at an extremely late procedural stage, on the last day of the nine month period in which an opposition

may be validly filed. The fact that the wrong priority data and the corresponding wrong priority documents were on file would have misled anyone who had made a file inspection during this time. In view of the fact that a third party contemplating whether or not to oppose the patent would not have had an opportunity to assess the patent on the basis of the corrected priority, the Appellant's request could be granted only if there were very exceptional circumstances in the Appellant's favour.

3.4 As to the special circumstances mentioned under items (i) and (ii) of point (6) of the summary in paragraph 2.5 above, the following is to be noted:

3.4.1 (i) The responsibility of the EPO

(a) The Receiving Section is not obliged to examine the content of the priority document(s), although it does, in cases where it is obvious, as for example from the title of the priority document, that that document relates to subject-matter quite different from that of the application, inform the applicant of the discrepancy (cf. Guidelines for Examination in the EPO, Part A, Chapter III, Section 6). In the present case, the documents filed in support of the priority claim were consistent and satisfied the requirements of Article 88 EPC and Rule 38 EPC and there was no obvious discrepancy the Receiving Section could have pointed out.

(b) The Search Division is not responsible for the verification of any claimed priority, the basic reference date for the search being the date of filing of the European application (cf. Guidelines for Examination in the EPO, Part B, Chapter V, Section 5).

(c) Furthermore, in cases where all the prior art was available to the public before the date of the earliest priority document, as in the present case, the Examining Division need not scrutinise the priority documents (cf. Guidelines for Examination in the EPO, Part C, Chapter I, Section 5.3).

The Board therefore concludes that the EPO was not responsible for the fact that no warning was issued.

3.4.2 (ii) The effect on the interest of the public

(a) The dates and country given in the priority declaration appear quite normal, thus there was no apparent discrepancy on the face of the application as published. Nor was any discrepancy apparent on the face of the patent as published. Although it is possible that a skilled person after file inspection might doubt the validity of the priority as claimed, this would not meet the requirement of the mistake being obvious on the face of the application as published.

(b) The public was not otherwise informed about the mistake. The possibility of obtaining information about patent families and so on by searching the Derwent data base and then deducing that there was a potential for correcting the priority declaration in the present case, as explained by the Appellant, is not a substitute for specifically informing the public about the mistake made.

The Appellant has however further argued that the public was informed through application B. Even if an interested third party were expected to look for such an application, which is doubtful because it would put an undue burden on third parties, and had found

application B, this would not have been sufficient, since that application did not warn the public that the priorities had been mixed up.

In the present case, the public was not informed until the last day of the nine month period in which an opposition may be validly filed, with the consequence that no third party had the correct information on which to base a decision to oppose the patent or not.

3.5 The Appellant has argued that the fact that in the present case, the correction, if allowed, would not lead to a different priority date, was a special circumstance in which the public interest would not be adversely affected. The Board does not find this argument convincing, for the following reasons:

3.5.1 A priority declaration is not merely of a formal nature. Even though the correction, if allowed, would not alter the priority date claimed, it could affect the right of priority, since, according to paragraph (3) of Article 88 EPC, "the right of priority shall cover only those elements of the European patent application which are included in the application or applications whose priority is claimed." Therefore the right of priority will have the effect that the date of priority is counted as the date of filing of the European application in accordance with Article 89 EPC, only for those claims whose elements are included in the priority document. Thus, the disclosure in two different priority documents of the same date could have different effects on the prior art citable under Article 54(2) and (3) EPC. While the outer limits of the scope of protection sought are given by the application itself regardless of whether any priority is claimed, this difference in effect could affect the scope of protection which may be validly obtained.

- 3.5.2 The requirements for declaring and filing the particulars of a priority within the time limits prescribed by Rule 38 EPC aim at giving the public a timely possibility to study the content of the claimed priority, as part of the information gathering process, before deciding whether or not to oppose the patent. The right to challenge the patent by way of an opposition under Articles 99 and 100(a) EPC would be seriously undermined, if the identity of the priority document were to be corrected after the start of the nine month period in which an opposition may be validly filed.
- 3.6 The contention of the Appellant that it could not be expected to have spotted the mistake and that it should not be expected to show more due care than the EPO itself is not relevant, since Rule 88 EPC does not require any evidence of due care. If anything, this argument would tend to support the view that there was no apparent discrepancy.
- 3.7 Finally, the Appellant also referred to decision J 2/92 in support of the request for correction. The Board may sympathise with the Appellant's arguments insofar as they relate to the necessity for a third party to read not only the published application, but also to consult the priority documents on file, but, given the similarity of subject-matter and identity of titles of the application and the priority documents in the present case, the discrepancy would not be easy to find. Furthermore, a third party who managed to detect the discrepancy would still not be in a position to discover with reasonable certainty and without undue burden what the correct priority document(s) should be.

4. In the judgement of the Board, on balance, given the lateness of the request, the interest of the public is of overriding importance. Although it may lead to a loss of rights for the Appellant if the priority is not corrected, the rights of the public would be seriously affected if the correction were allowed.

Order

For these reasons it is decided that:

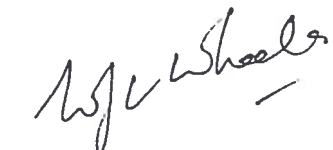
The appeal is dismissed.

The Registrar:



M. Kiehl

The Chairman:



W. J. L. Wheeler