

Abstract

The applicant filed an international application with two errors in the priority claims. The application had been published with erroneous information, and so the Receiving Section refused to allow the errors to be corrected, which would have moved the priority date back one day. On appeal, the Board allowed the corrections since they were both clerical and such that they could have been discovered by any third party inspecting the publication documents. The Board held that the application would be granted the earlier priority date, and that the correct priority document could be provided to the International Bureau even though the deadline for doing so had passed.

EPO boards of appeal decisions

Date of decision 01 December 1992

Summary of Facts and Submissions

I. On Monday, 24 July 1989 the applicant and appellant filed international application PCT/US 89/03267 at the US Patent and Trademark Office as receiving Office. In the International Application Form (PCT/RO/101), Box No. VI relating to the priority claim was completed claiming the priorities of three national (US) applications. As entered in the form, these were:

Country: (1) United States of America Filing date: 23 July 1988, Application number: 223,270 Country: (1) United States of America

Filing date: 13 December 1989, Application number: 283,739

Country: (1) United States of America

Filing date: 27 April 1989, Application number: 334,304

The receiving Office was requested to prepare and transmit to the International Bureau certified copies of the above-mentioned earlier applications repeating the above-stated document numbers (final part of Box No. VI of the International Application Form).

II. Also filed at the US receiving Office was a PCT International Application Transmittal Letter dated 24 July 1989 asking inter alia for the preparation and transmittal of certified copies of the priority documents as identified in Box VI of the request form, and for a foreign transmittal licence. As part of the Disclosure Information for obtaining such licence it was stated:

"There are three prior applications:

(A) Serial Number 223,270 filed on July 23, 1988;

(B) a continuation-in-part of A -- Serial Number 283,739 filed on December 13, 1988; and

(C) a continuation-in-part of (B) -- Serial Number 334,304 filed on April 27, 1989"

It was added that "the combined subject-matter of these three prior applications is substantially identical to the subject- matter of the accompanying international application".

However, the correct information regarding the priorities would have been:

Filing date Application number

(1) 22 July 1988 (a Friday) 223,270

(2)

(3) 27 April 1989 344,304

Document 334,304 concerns in fact an application in the name of different inventors concerning a different subject-matter, the application being dated 6 April 1989.

III. The US receiving Office forwarded the application to the International Bureau, which received it on 4 September 1989. The International Bureau notified the European Patent Office, in its capacity as a designated Office, by letter dated 6 September 1989 of the receipt of the record copy confirming the three priority dates as claimed by the applicant.

IV. Both the PCT application and the international search report (ISA/US) were published by the International Bureau on 8 February 1990, stating the claimed priority data as (partially wrongly) submitted by the applicant.

V. The International Bureau forwarded the application to the European Patent Office in its capacity as elected Office; the notification of 9 February 1990 issued pursuant to Rule 61.2 PCT stated once more the wrong filing date of 23 July 1988. The EPO informed the applicant's professional representative, by

letter dated 9 March 1990, that European patent application No. 89 909 503.8 had been allocated to the application.

VI. By letter dated 2 April 1990, the US receiving Office notified the appellant's professional representative of the transmittal of the priority documents to the International Bureau, as requested in the international application and the transmittal letter. Accordingly, the International Bureau received copies of the correct priority documents Nos. 223,270 and 283,739 and, as erroneously requested by the applicant, of the wrong document No. 334,304. The international Bureau confirmed by notifications to the applicant and with copies to the EPO dated 9 and 17 August 1990 that it received the priority documents 223,270 and 334,304 on 15 May 1990 and document No. 283,739 on 24 July 1990.

VII. By two letters dated 25 May 1990, the International Bureau invited the applicant's professional representative to request rectification with regard to "an inconsistency" between the priority date of 23 July 1988 (and 27 April 1989 respectively) claimed in Box VI of the Request of the above international application and the filing date of 22 July 1988 (and 6 April 1989 respectively) appearing on the certified copy of the priority application received by the International Bureau on 15 May 1990.

VIII. By letter dated 6 July 1990, the applicant's professional representatives requested rectification of errors indicating that

- the correct priority date of the first priority application would have been 22 July 1988 (instead of 23 July 1988) and

- the claimed third priority date of 27 April 1989 should be replaced by 6 April 1989.

IX. The International Bureau transmitted copies of the priority documents Nos. 223,270 and 283,739 and the wrong document No. 334,304 to the EPO and notified the applicant's professional representative (copies to the EPO) by four letters dated 9 and 17 August 1990 that - the copy of the priority document No. 283,739 had not been received within the time limit referred to in Rule 17.1(a) PCT, - the letter dated 25 May 1990 inviting the applicant to request correction had been sent in error, as the time limit under Rule 91.1(g) PCT had expired and - a request for rectification could still be submitted directly to each designated Office. The applicant was finally informed that a copy of these letters, together with the above-mentioned priority documents, had been forwarded to the designated Offices for their consideration.

X. Attached to its letter dated 3 December 1990, the International Bureau transmitted to the EPO a copy of the international preliminary examination report (completed on 4 September 1990 by IPEA/US). The applicant's European professional representative, authorised for the proceedings at the EPO, initiated the European regional phase of the application by transmittal letter dated 28 December 1990 and the attached form 1200, both received by the EPO the following day.

XI. By letter dated 2 April 1991, the Receiving Section of the EPO informed the applicant's European professional representative that the priority dates as published by the International Bureau and the dates appearing in the copy of the priority documents differed as follows:

US serial No. 223,270: 23.07.1988 and 22.07.1988;

US serial No. 334,304: 27.04.1989 and 06.04.1989.

After having reported on these discrepancies to the US professional representative and having received instructions, the European professional representative requested the following corrections by letter dated 16 May 1991:

- priority date of application 223,270: 22.07.1988;

- serial No. of priority document dated 27.04.1989: 344,304.

In addition, it was requested that the publication of the bibliographic data of the international application should be accompanied by a notice informing the public of the present request for correction under Rule 88 EPC and that oral proceedings under Article 116 EPC be appointed.

XII. The bibliographic data of the Euro-PCT patent application were published on 29 May 1991 in section I.1 of the European Bulletin under No. 0 428 603 according to notification of the publication to the applicant by letter dated 17 April 1991.

XIII. On 9 July 1991 the EPO received a certified copy of the correct priority document No. 344,304, accompanied by a transmittal letter dated 4 July 1991.

XIV. By decision dated 19 July 1991, the Receiving Section refused the request for correction on the following grounds:

Rule 88 EPC providing for correction of errors was in principle applicable to Euro-PCT applications pursuant to Article 150(3) EPC. The request for

correction had arrived at the EPO so late, however, that the EPO was not able to come to a decision on the request before publication of the application or even to include a warning of the correction in the publication. As no warning had been published, a correction was no longer possible because of the overriding factor of the public interest (see decision J 3/81, OJ EPO 1982, 100). The public would have been misled had the wrong priority date been corrected after publication.

Concerning the wrong document number, the Receiving Section pointed out that the public could not rely on the published information as being both accurate and complete because a wrong document number was published and the corresponding wrong document was on file.

XV. On 13 September 1991, the applicant filed a notice of appeal against this decision having paid the appeal fee on 12 September 1991. A written statement of grounds of appeal dated 25 November 1991 was received by the EPO two days later.

The appellant requested that:

- the claimed first priority date (A) be corrected;
- the document number concerning the third priority claim (C) be corrected;
- the replacement of the (US) priority document No. 334,304 by (US) priority document No. 344,304 (see letter of the applicant dated 16 May 1991, page 3, last paragraph) be allowed;
- the appeal fee be refunded.

The appellant argued essentially as follows:

The errors in the priority declaration had resulted from a typing error and from a misunderstanding during a telephone conversation and thus were simple clerical errors that could be corrected pursuant to Rule 88 EPC. The appellant explained in detail the particular circumstances that had led to the mistakes in the priority declaration and submitted written declarations from both the US and the European professional representatives dated 14 and 26 November 1991 respectively.

The appellant considered that, according to the relevant jurisprudence of the Legal Board of Appeal, correction of clerical errors was possible even after publication of the application provided that the interests of third parties were not adversely affected. On checking the priorities by file inspection third parties

would immediately realise that there were errors in the published priority declarations, these being apparent on the face of the international application and from the correspondence between the International Bureau and the applicant's US professional representative. An individual to whom the exact priority date was critical would have realised immediately that the priority date of 23 July 1988 could not be correct because this day was a Saturday. US patent applications were never accorded weekend filing dates. Furthermore, by allowing the priority period to be backdated by only one day, the public interest would not be significantly prejudiced.

Concerning the error in the serial number of application No. 344,304, the appellant submitted that a third party would not be misled because on inspection of the file the error would be revealed. As the published international application showed the correct date and State, even members of the public who did not consult the official file could not be significantly misled.

The late filing of the certified copy of the correct priority application No. 344,304 after expiry of the 16-month period was considered a deficiency which had been remedied by subsequent filing of the correct document.

XVI. The applicant requested that the appeal fee be refunded on the following grounds:

The Receiving Section had ignored the request for oral proceedings asked for in the correction request dated 16 May 1991.

The decision of 19 July 1991 had been issued before a reasonable opportunity had been given to submit the information and evidence promised in the correction request in order to demonstrate precisely how the errors took place.

The Receiving Section had not given any guidance as to the nature of any evidence which it might require in spite of the fact that guidance had been asked for in the correction request.

XVII. The Legal Board of Appeal invited the President of the EPO to comment on the questions of general interest arising in this case as well as in three other closely-related cases. The statement of the President came to the conclusion that the requested corrections should not be allowed in this case, because a request for correction had not been made until more than four and a half months after entry into the regional phase.

Reasons for the Decision

1. The appeal complies with Article 106 and Rules 64 and 78(3) EPC, and, therefore, is admissible.
2. The appellant filed an international application claiming priority from three previous patent applications filed at the US Patent and Trademark Office according to Article 8 PCT and Article 4 of the Stockholm Act of the Paris Convention for the Protection of Industrial Property. Correction of the priority date of the first priority application and of the file number of the third priority application, both data being wrongly indicated in the application form and later in the published international application, is requested.
3. According to Article 150(3) and Rule 88, first sentence, EPC, applicable pursuant to Article 26 PCT, certain errors, in particular "errors of transcription and mistakes in any document", may be corrected on request also in the case of an international application.

The Receiving Section of the EPO has correctly applied Rule 88 EPC to the present case notwithstanding the fact that the time limit for correction under the PCT had expired according to Rule 91.1(g) PCT (see J 3/81, OJ EPO 1982, 100). According to the basic provisions of Articles 150(3), 158(1) EPC and Article 11(4) PCT, the applicant for an international application has the same legal possibilities as an applicant for a European patent application with regard to correction of mistakes in the priority declaration. Even if the international application has been published by the International Bureau without publication of a request for rectification pursuant to Rule 91.1(f) PCT, in principle, a correction of the priority declaration still remains possible during the regional phase according to Rule 88 EPC, as interpreted by the relevant case law of the Legal Board of Appeal.

4. The relevant case law of the Legal Board of Appeal dealing with the conditions for correction of a declaration of priority under Rule 88 EPC is summarised in the reasons for the decision in case J 6/91 of 1 December 1992. The teaching of this jurisprudence has to be applied to the present case as well. However, the present case and case J 3/91 (decided the same day) are the first cases which do not concern correction of an omitted priority declaration but rather correction of particulars in the priority declaration, i.e. date and file number as required by Article 8 and Rule 4.10(a) PCT and Article 88(1) and Rule 38(1) EPC respectively. The following particulars of the present case give the Legal Board cause to develop further its previous jurisprudence:

- the error for which correction is requested does not concern an omission in the priority declaration but an error and mistake concerning particulars of the priority declaration (date and file number);

- the request for correction was filed after the publication of both the international application and the bibliographic data of the application pursuant to Article 158(1) EPC;

- the priority documents did not arrive at the International Bureau within the time limits referred to in Rule 17.1(a) PCT;

- a correction after expiry of the time limit referred to in Rule 91.1(g) PCT was refused by the International Bureau.

5. The requested correction of the filing date concerning the first priority application (A) and of the file number of the third priority application (C) is to be permitted for the following reasons:

5.1 As a necessary safeguard against abuse of the provisions of Rule 88 EPC, the Legal Board of Appeal has stated that "before the European Patent Office can accede to a request for correction of a mistake it must be satisfied that a mistake was made, what the mistake was and what the correction should be" (J 8/80, OJ EPO 1980, 293, point 5; J 4/80, OJ EPO 1980, 351, point 3; J 4/82, OJ EPO 1982, 385, point 6).

In the present case, these conditions are fulfilled. By mistake, the applicant indicated in the request form the wrong priority date concerning the first priority application (A) and the wrong document number concerning the third priority application (C).

The applicant's professional representatives explained the mistakes as "simple clerical errors", the source of the incorrect priority declaration being misleading information contained in a reporting letter to the applicant (US/NIH) and the incorrect document number resulting from a misunderstanding during a telephone conversation (US/NTIS).

The Board is satisfied that these clerical errors, that is, typing 23 July instead of 22 July and indicating a wrong document number 334,304 instead of 344,304 when filling in the international patent application form, are typical errors of transcription in the meaning of Rule 88, first sentence, EPC. The way in which the mistakes resulted from mistyping and misunderstanding is clearly explained. Neither the priority date nor the priority number as filed and published represent what was apparently intended.

5.2 In principle, Rule 88, first sentence, EPC in cases of an incorrect priority declaration of this nature allows a correction without any time bar, even after publication of the patent application. However, such a correction is at the

discretion of the competent authorities (J 7/90, OJ EPO 1993, 133, point 2.2.; G. Paterson, *The European Patent System*, London 1992, Nos. 5-52, 6-05, 6-08). In case J 7/90, the Board stated that the EPO is "in no way compelled to permit the correction of errors of any kind at any time". According to the legal text of the provision in the three official languages ("können" - "may" - "peuvent"), the European Patent Office has the authority to permit certain types of corrections at its discretion. The overriding principle in exercising the discretionary power is to balance the interests of the applicant in gaining optimal protection and the interests of the public in respect of legal security (cf. R. Singer, *Europäisches Patentübereinkommen*, 1989, Article 123, point 21).

5.2.1 In weighing up the interests of third parties and those of the applicant, the Board is satisfied in the particular circumstances of this case, involving as it does purely clerical errors, that the interests of third parties will not be adversely affected by a correction of the priority declaration as requested.

5.2.2 The Board finds that a correction of particulars in a priority declaration is admissible at least in a case such as the present one where the discrepancy is apparent on the face of the published patent application itself even if this results in backdating the priority.

Looking at the particulars of the international publication of patent application No. PCT/US 89/03267, the mistake concerning the first priority date is apparent already on the front page of the publication to practitioners dealing regularly with patent applications of this kind. The priority date of 23 July 1988 is obviously incorrect because that day was a Saturday and US patent applications are not accorded weekend filing dates.

With regard to the apparent discrepancy concerning the priority date of the priority document, the public could not rely in the present case on the correctness of the publication of the international patent application. It may be expected that third parties interested in the accurate priority date will investigate the discrepancy and thus ascertain the correct priority date by file inspection. Thus, a retrospective correction of the priority date may be permitted in spite of the fact that the international patent application was published without any warning and that the correction has the effect of making the date for publication of the application prescribed by Article 93(1), Article 158(1) and Rule 104b(1) EPC one day earlier.

5.2.3 As far as the request for correction of the file number of the third priority document (C) is concerned, the above considerations on the balance of interests lead to the same result. Obviously no substantial interest exists in maintaining a wrong file number in the published application. Third parties should inspect the

file if they wish to draw substantive conclusions from the priority document. In this respect, the file number as such is of no relevance to a competitor who has to make up his mind whether he may use the invention or not. A correction does not affect his interests.

However, a correction of the file number only makes sense if the replacement of the wrong document concerned was still admissible more than three months after publication of the international application in the European Patent Bulletin. The question arises whether a wrong priority document may still be replaced after expiry of the time limits referred to in Rule 17.1(a) PCT and Rules 38(3) and 104b(3) EPC respectively.

6. The Board finds that, in cases where the applicant requested transmittal of the priority documents according to Rule 17.1(b) PCT in due time, a wrong priority document may be replaced, even after publication of the international application, if the appellant erroneously indicated a wrong document number.

6.1 The appellant asked for transmittal of the documents pursuant to Rule 17.1(b) PCT within the time limit as provided for in the second sentence of the provision. The question of re-establishment of rights (Article 48(2)(a) PCT and Article 122 EPC respectively) does not arise if the request for transmittal is filed in due time but executed late.

The situation according to Rule 17.1(b) PCT is similar to that under Rule 38(3), third sentence, EPC, with regard to the role the receiving Office has to play after receiving the request for transmittal of the relevant priority documents. The receiving Office is responsible for filing a copy of the indicated previous applications in due time. Thus, even if the documents are forwarded late by the receiving Office, the right of priority is not lost pursuant to Article 91(3) EPC and Rule 17.1(c) PCT.

6.2 A loss of the right of priority would be equally unjust in the circumstances of the present case. The wrong file number was erroneously indicated by mistake of the applicant. The mistakes in the request for transmittal emerged from clerical errors (see point 5.1 above). From the start there was no doubt which priority document the appellant intended to submit.

Third parties cannot be misled by a replacement of the wrong document after publication of the international application. They could easily find out from a file inspection that document No. 334,304 was completely irrelevant and that there was a discrepancy with regard to the priority dates. Thus, it was clear from the file that the relevant document concerning the claimed priority of 27 April 1989 was not yet on file.

6.3 However, the Board leaves open the question whether the replacement of a wrong priority document is always possible in cases where a correction of the document number is allowed under Rule 88 EPC. A problem may arise if the time limits referred to in Rule 17.1(a) PCT, Rule 38(3) and Rule 104b(3) EPC have expired and the conditions for a re-establishment of rights under Article 48(2)(a) PCT and Article 122 EPC are not fulfilled.

7. The Board orders the reimbursement of the appeal fee pursuant to Rule 67 EPC. It finds that the Receiving Section committed a substantial procedural violation when it issued a decision without having given the appellant an opportunity to submit detailed information and evidence as offered in the correction request of 16 May 1991 in order to demonstrate precisely how the errors had occurred. The Receiving Section took its decision on 19 July 1991 without having fixed a time limit for the submission of such evidence or having awaited it for a reasonable time. The appellant was entitled to expect the Receiving Section to await the further evidence, as it had announced by letter dated 4 July 1991 that further information would be provided to the Receiving Section in the near future. As the Board has already stated in case J 4/82 (OJ EPO 1982, 385, point 11), a premature decision of this kind represents a substantial procedural violation with regard to Article 114(2) EPC.

ORDER

For these reasons it is decided that:

1. The decision of the Receiving Section dated 19 July 1991 is set aside.
2. It is ordered that the request filed according to Article 4 PCT on international application PCT/US 89/03267 (later European patent application no. 89 909 503.8) be corrected, insofar as the European Patent Office is concerned as designated Office, as follows:
 - the filing date of the priority application No. 223,270 shall be replaced by the date "22 July 1988";
 - the application number of the national (US) priority application filed on 27 April 1989 shall be replaced by No. "344,304".
3. The replacement of (US) priority document No. 334,304 by (US) priority document No. 344,304 is allowed.
4. It is ordered that the appeal fee be reimbursed to the appellant.

O.J. EPO issue: 1994,375

Case law reports: CLBA 1996