

Abstract

Applicant filed an international application designating the EPO and claiming no priority. Realizing the error a few months later, applicant requested correction of the application to include a priority claim. After entering the regional phase the Receiving Section refused the correction and the applicant appealed. The Board found that a request to correct a mistake under Rule 88 EPC should be made early enough to include a warning of a pending correction request with the international publication. An appropriate warning was published and the correction was permitted.

EPO boards of appeal decisions

Date of decision 01 December 1991

Summary of Facts and Submissions

- I. The Applicant and Appellant filed international application no. PCT/US xxx on 22 August 1988 with the USPTO in its capacity as receiving Office, naming the EPO as a designated Office (EURO/PCT application no. xxx). In the request form, Box VI, which provides for priority claims, was marked "not applicable".
- II. On 12 October 1988, the Applicant filed a replacement sheet with the USPTO in which priority was claimed from US patent application no. xxx filed on 24 August 1987 and requested correction of the error in Box VI of the original request form under Rule 91 PCT on the ground that the failure to claim priority at the time of first filing the application had been an obvious error in the international application. On 1 February 1989, having had no reply to that request, the applicant filed a further petition with the USPTO requesting that the international application be given the priority date of 24 August 1987 based on the prior US application.
- III. On 22 March 1989, the USPTO denied the Applicant's request on the ground that the claim of priority had to be evident from the application papers as originally filed in order to be correctable as an obvious error and no information had been included in the request form that would identify the priority application. The PCT Rules did not permit adding priority information which had been totally omitted at the time of filing.
- IV. On 10 April 1989, the Applicant filed a request for reconsideration of the USPTO's decision of 22 March 1989. That request was denied by a decision of 14 April 1989.

V. On 18 April 1989, the Applicant transmitted a certified copy of the priority document to the International Bureau PCT requesting that the delay in submitting it be excused due to the delay in the US receiving Office in acting on the Applicant's request for correction of the obvious error in failing to claim the priority in the original request form and for preparation of a certified copy. On 10 May 1989, the Applicant filed with the International Bureau a request for early publication of the application together with a warning concerning the request for rectification filed at the US receiving Office.

VI. The application entered the European phase on 24 April 1989 and the completed Form 1200 was accompanied by a request that the EPO should review the decision of the receiving Office and any decision of the International Bureau in accordance with Article 25 PCT and recognise the priority claim.

VII. On 29 June 1989, the international application was published under no. WO 89xxx together with a warning concerning the request for rectification under Rule 91.1 (f) PCT.

VIII. By letter of 28 December 1989, the receiving Office of the EPO requested the Applicant to file further evidence in support of the request to recognise the priority claim and, in particular, copies of the various documents which had accompanied the original international application. The documents in question were supplied together with a letter dated 12 February 1990 and the intention of the Applicant and inventor always to claim the priority in question was attested to by way of affidavit dated 9 February 1990.

IX. By decision of the EPO Receiving Section dated 24 January 1991, the request to amend the application to add the priority claim was refused. The request was treated as a request for correction of an error under Rule 88 EPC pursuant to Article 27(4) PCT, Article 25 PCT being considered inapplicable. The Receiving Section held that the evidence produced was insufficient to conclusively establish that a mistake had actually been made and how it had been made and that therefore no correction was possible under Rule 88, first sentence.

X. On 22 February 1991, the Appellant filed a notice of appeal against this decision, paying the appeal fee on the same day. A written statement of grounds of appeal was filed on 24 May 1991.

XI. The grounds of appeal may be summarised as follows: the Applicant and Appellant and his US attorney had been aware of the need to claim priority from the US application no. xxx in the international application no. PCT/US xxx. The

attorney had informed the Appellant by letter that any foreign patent application should be made within 12 months of the priority date, namely by 24 August 1988. In early August 1988, at the appellant's request, the international application had been prepared based on the priority application. The papers were forwarded to the Appellant for signature under cover of a letter dated 9 August 1988 in which it was specifically stated that the international application had to be filed by 24 August 1988. A letter dated 23 August addressed to the Appellant by a senior partner of the US attorneys confirming that the international application had been filed on 22 August provided clear evidence of the fact that both the attorneys and the Appellant were aware of the importance of filing the international application within the priority year. The letter stated inter alia: "the only reason we advanced the \$1,485.00 on the PCT application is that the time for filing the application would have expired on 24 August 1988 and you stated that you had part of the filing fee in the mail to us, which we have now received". The attorneys at that time believed that the application had properly claimed the priority.

These facts were supported by an affidavit from the Appellant.

The preparation of the international application had been done by a paralegal assistant acting on the instructions of the Appellant's US attorney. The assistant had taken a previously prepared and filed application as a model because she knew how important correct completion of the request papers was and, in particular, correct claiming of the priority. She had unfortunately used the wrong prior application, which had led to the mistake being made. Affidavits from the attorney and the paralegal assistant were submitted in support of the above.

The error came to light during review of notifications from the US receiving Office and the International Bureau, which stated that no priority had been claimed in respect of the application. It was then that the attorney became aware that Box VI in the request had been marked "not applicable". It was thought that the mistake was not too severe as the prior US application no. xxx and its filing date were mentioned several times in the PCT application documents, so that it was obvious that priority should have been claimed. A request to correct that obvious error under Rule 91.1 PCT had been filed shortly thereafter on 12 October 1988. The European phase had been entered on 24 April 1989, the 20-month time limit having been calculated as if the priority claim had been valid. All procedural steps had been duly executed.

XII. In accordance with Article 12(a) of the Rules of Procedure of the Boards of Appeal (OJ EPO 1989, 361), the President of the EPO was invited to comment on the present case as well as on three other pending cases concerning mistakes in priority declarations. Two of these cases, namely, J 3/91 (Unicharm) and J

2/92 (United States), concerned typing mistakes as regards the priority date and priority file number. Hitherto, all priority cases have concerned omission of the date and State of the earlier application as in the present case. In the fourth case, J 6/91 (Du Pont), the Appellant sought to introduce an erroneously omitted priority declaration after publication of the application pursuant to Article 21 of the Patent Cooperation Treaty. Oral proceedings took place on 28 February 1992 concerning J 6/91 to which the President and the representatives of the Appellants in all four cases were invited.

XIII. The President of the EPO submitted comments on these cases in writing and was represented at the oral hearing. He defended the view that, with regard to mistakes in claiming priority, a distinction should be made between (a) mistakes made in a priority declaration concerning details of the date, State and file number of the previous application, and

(b) omission of a statement of date and state at the time of filing the European application. As regards mistakes of the first kind, (a) above, in principle, correction under Rule 88, first sentence EPC would be possible.

As regards omissions, (b) above, correction pursuant to Rule 88, first sentence, was possible. However, in the interests of third parties, a time limit should be observed. It should be laid down in such a way that the 18-month publication period - calculated from the earliest priority - can be observed.

In respect of the present case, where the application for correction had been filed in time, the President took the view that the result should depend on whether in the opinion of the Legal Board of Appeal a failure to claim the (only) priority had been credibly shown to be a mistake. The mere fact that on the date of application the Applicant was entitled to claim the priority should not be sufficient.

XIV. At the same time as the Legal Board of Appeal is deciding this case, it is also deciding the following cases: J 3/91 (Uni-Charm) and J 6/91 (Du Pont). Each case is decided on its own merits. However, to the extent that general considerations and principles of law apply to all these cases, these are contained in the decision in J 6/91 (Du Pont) (to be published). The findings of the Board regarding the extent to which the rules applying to the correction of mistakes in the form of typographical errors may differ from the requirements with respect to omissions are set out in its decision in J 3/91 (Uni-Charm), (to be published).

Reasons for the Decision

1. The appeal is admissible.

2. The case law of the Legal Board of Appeal relating to correction of errors with respect to designation of States and priority claims under Rule 88 EPC, first sentence, as developed since 1980, is reviewed and further interpreted in J 6/91 (Du Pont) (to be published). The case law relevant to the present case may be summarised as follows:

(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) in the case of international applications filed under the PCT, pursuant to Article 158(1) EPC, publication by the International Bureau of WIPO under Article 21 PCT takes the place of publication in the European patent bulletin.

3. In the present case, applying the relevant conditions for correction of an omitted priority established by the case law of the Board, as set out in paragraph 2, above, the Board is satisfied that the document filed with the EPO, i.e. the application, did not express the true intention of the Applicant in that a priority was omitted. The request for correction was made promptly and sufficiently early for a warning to be included in the publication of the international application (see VII, above).

4. The only question remaining to be decided in this case is whether the failure to claim the omitted priority has been credibly shown to be a mistake. In this regard, the Board has had available to it evidence that was not before the Receiving Section. It is satisfied on the basis of the evidence that the omission of the priority was a genuine mistake and that the application to correct the omission does not represent a change of mind or subsequent development of plans on the part of the Applicant. In particular, the evidence of the Appellant and his US attorneys to the effect that they were aware of the importance of filing the international application within the priority year and concerning the efforts made by them to do so in time shows clearly that their true intention was

to claim the priority. Indeed, for some time they held the mistaken belief that the priority had been claimed. The mistake was made by a paralegal assistant acting on the instructions of the Appellant's US attorney. The Appellant has satisfied the Board, therefore, that a mistake was made, what it was and what the correction should be.

5. It may be noted that the omission of a priority declaration within the meaning of Article 88(1) and Rule 38(1) EPC will, in nearly all cases, be an error and will not express the true intention of the person on whose behalf the so-called second filing is made. In principle, there is every reason to believe that the omission of a declaration of priority to which an Applicant is entitled in a particular case would be an error capable of correction under Rule 88, first sentence EPC. It follows, that, as a general rule, there is no need in cases of this kind to require special evidence (affidavits and the like) to discharge the burden on the Applicant of proving that a mistake has been made.

ORDER

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. It is ordered that the request form filed on 22 August 1988 according to Article 4 PCT with respect to international application PCT/US 88xxx (later European patent application No. xxx) be corrected, insofar as the European Patent Office is concerned as designated office, by adding the priority data concerning US patent application No. xxx filed on 24 August 1987, in Box No. VI on page 4 thereof.

Case law reports: CLBA 1996