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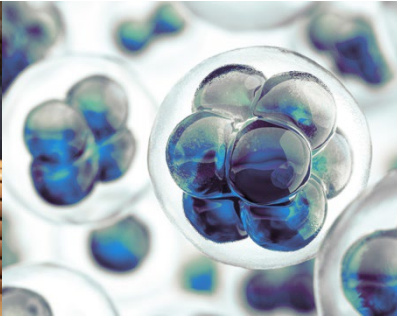
Office européen
des brevets

Examination Matters 2021

Correction of errors in proceedings before the EPO



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6-10 December 2021

Presenter



Katarzyna Walert

- Lawyer
- Directorate Patent Law (D521)
- Joined the EPO in 2013
- Previous experience: qualified Polish lawyer in private practice
- Dr. iur. (Universität Augsburg), LL.M IP (Munich Intellectual Property Law Center)



Presenter



Jaime Jiménez

- Lawyer
- Directorate Patent Law (D521)
- Joined the EPO in 2011
- Previous experience: Legal and policy advisor in the Spanish Patent and Trademark Office (2005-2011), national delegate in the EPO Committee on Patent Law (2010-2011)



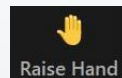
Question



Have you ever requested the correction of any errors in proceedings before the EPO?

yes

no



= yes

Today's topics

- Correction of **errors in documents** filed with the EPO
 - ✓ General requirements
 - ✓ Additional requirements (application documents, declaration of priority)
- Correction of **errors in decisions**
- Correction of **errors in publication**
- Correction of **formatting or editing errors**

Rule 139 EPC

Rule 140 EPC

Correction of errors in documents filed with the EPO (1/6)

- Linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request
- A **mistake** in a document filed with the European Patent Office exists if the document does not express the **true intention** of the person on whose behalf it was filed

Rule 139, 1st sentence, EPC

J 8/80

Correction of errors in documents filed with the EPO (2/6)

Substantive requirements:

- The Office must be satisfied that a mistake **was made**, **what** the mistake was and **what** the correction should be
- The burden of proof is on the requester
 - ✓ If the mistake **is not immediately evident**, there should be **no reasonable doubt** as to the party's true original intention

J 8/80

Correction of errors in documents filed with the EPO (3/6)

Formal requirements:

- Only mistakes in documents filed can be corrected, **not in procedural actions or facts**
- **In any proceedings before the EPO**, including appeals...
 - ...as long as they are **pending**
 - In particular, until the **decision** (grant / refusal) is **handed over to the EPO postal service** for notification

G 1/12

J 42/92

G 12/91

Correction of errors in documents filed with the EPO (4/6)

Formal requirements

Handover to the internal EPO postal service:



Remark: the EPO intends to revise the 10-day Rule along 2022 to support the digital transformation of the procedures.

Correction of errors in documents filed with the EPO (5/6)

Decision to grant a European patent pursuant to Article 97(1) EPC

Following examination of European patent application No. 08717804.2 a European patent with the title and the supporting documents indicated in the communication pursuant to Rule 71(3) EPC dated 22.01.15 is hereby granted in respect of the designated Contracting States.

Patent No. : 2137142
Date of filing : 14.03.08
Priority claimed : 15.03.07/EPA 07104275

Designated Contracting States and Proprietor(s) : AT BE BG CH CY CZ DE DK EE ES FI FR GB GR HR HU IE IS IT LI LT LU LV MC MT NL NO PL PT RO SE SI SK TR
BASF SE
67056 Ludwigshafen/DE

This decision will take effect on the date on which the European Patent Bulletin mentions the grant (Art. 97(3) EPC).

The mention of the grant will be published in European Patent Bulletin 15/31 of 29.07.15.

Examining Division

English R De Nooy A Fritz M



Registered letter
EPC Form 2006A 12.07 (26/06/15)

to EPO postal service: 26.06.15



Correction of errors in documents filed with the EPO (6/6)

Effect

- The corrected version of the document is treated as if it were the one received on the filing date
- **However**, the correction does **not affect**:
 - "the **application as filed**"
 - any **decisions** taken on the basis of the document prior to correction
 - **time limits** that have expired



G 1/12

J 3/01

Correction of errors in the description, claims or drawings

- (...) if the request for such correction concerns the **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
- The **complete documents forming an application** (i.e. description, claims and drawings) **cannot be replaced** by other documents

Rule 139, 2nd sentence, EPC
GL H-VI, 2.2.1

G 2/95

Correction of the priority claim (1/2)

Lex specialis: Rule 52(2), (3) EPC

- A declaration of priority may be **added within 16 months** from the earliest priority date claimed or **corrected within 16 months** from the earliest priority date claimed, or **within 4 months** from filing date, whichever is later

BUT

- after that 16-month period a correction under **Rule 139 EPC** is **also possible**

GL A-V, 3

Correction of the priority claim (2/2)

The request for correction must be made promptly, in any case **early enough** to be mentioned in the **published application**

Rule 139 EPC
GL A-V, 3; A-VI, 1.3

(19)	 <p>Europäisches Patentamt European Patent Office Office européen des brevets</p>	
	(11)	EP 2 407 210 A1
(12)	EUROPEAN PATENT APPLICATION	
(43) Date of publication:	18.01.2012 Bulletin 2012/03	(51) Int Cl.: A62B 35/04 (2006.01)
(21) Application number:	10166139.5	
(22) Date of filing:	16.06.2010	
(84) Designated Contracting States:	AL AT BE BG CH CY CZ DE DK EE ES FI FR GB GR HR HU IE IS IT LI LT LU LV MC MK MT NL NO PL PT RO SE SI SK SM TR	
Designated Extension States:	BA ME RS	
(71)	[Redacted]	
(72)	[Redacted]	
(74)	[Redacted]	
Remarks:	• A request pursuant to Rule 139 EPC for addition of a declaration of priority (R. 52(1) EPC) is pending. • A request pursuant to Rule 139 EPC for addition of a declaration of priority (R. 52(1) EPC) is pending.	

Correction of errors in the declaration of priority

- If **no mention of the request** is published, **third parties** may be **adversely affected** by the correction
- The **inconsistency** to be corrected must be **immediately evident** from the published application or on inspecting the file



GL A-V, 3

Study case 1 (1/4)

Facts:

- On 4 January 2011, a EP was filed claiming priority of 30 December 2010 (from a Japanese application)
- On 24 May 2012 the **priority document** was filed
 - ✓ The **file number** and the **date of filing** (19 April 2010) of the priority application were different than those stated in the priority declaration
 - ✓ The **subject matter of the priority application** corresponded to that of the EP application

Study case 1 (2/4)

Facts:

- On 11 September 2012 the **application** was **published**, indicating the date of the **priority as claimed** in the application
- On 1 October 2015, **request for correction** of the priority claim, along with:
 - ✓ Explanation on the circumstances of the mistake
 - ✓ Copy of an email dated 28 September 2015 where an assistant draws the professional representative's attention to the mistake

Study case 1 (3/4)

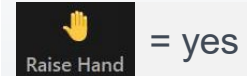


Questions:

- Did the applicant act with due diligence?
- Can the interest of third parties be adversely affected by the correction?
- Is the error obvious in the face of the application as published?
- Is it clear how the error should be corrected?
- Can the correction be allowed?

yes

no



Study case 1 (4/4)



Answers:

- Did the applicant act with due diligence? **yes**
- Can the interest of third parties be adversely affected by the correction? **yes**
- Is the error obvious in the face of the application as published? **yes**
- Is it clear how the error should be corrected? **yes**
- Can the correction be allowed? **yes**

Correction of errors in decisions (1/5)

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

- An "obvious mistake" exists if the text of the decision is **manifestly other than intended** by the department concerned
- The errors to be corrected ...
 - ✓ cannot concern the intention of the deciding instance, which can only be challenged in appeal,
 - ✓ but rather the form in which that intention was expressed

Rule 140

T 850/95

GL E-VI, 3

G 8/95

Correction of errors in decisions (2/5)

- Rule 140 EPC cannot be used to correct errors in the text of the granted patent (description, claims and drawings)
 - Requests for such corrections are **inadmissible**



G 1/10

Correction of errors in decisions (3/5)

- Rule 140 EPC cannot be used to correct errors in the text of the granted patent (description, claims and drawings)
 - Requests for such corrections are **inadmissible**
- So, what can be corrected under Rule 140 EPC?



G 1/10

Correction of errors in decisions (4/5)

- Rule 140 EPC cannot be used to correct errors in the text of the granted patent (description, claims and drawings)
 - Requests for such corrections are **inadmissible**
- So, what can be corrected under Rule 140 EPC?

For instance:

- **Bibliographic data**
- Errors in **other decisions**
(e.g. re-establishment of rights, refusal)



G 1/10

Correction of errors in decisions (5/5)

- The correction can be made ...
 - at the request of a party or by the EPO of its own motion
 - and at any time (even if no proceedings are pending)
- The correction takes effect retrospectively
 - It is treated as if it had been originally issued in the corrected form
 - However, expired time limits (e.g. opposition period) are not triggered anew

T 212/88

Study case 2 (1/3)

Facts:

- An EP application was filed in the name of "ACCURACY SYSTEMS", a company based in UK
- The patent is eventually granted (to "ACCURACY SYSTEMS")
- 2 years after publication of the grant, the proprietor requests the correction of its name to "ACCURACY Ltd." on the following grounds and evidence:
 - Its real name at the time of filing was and still is "ACCURACY Ltd." (submitted proof: extracts from commercial register).
 - "ACCURACY SYSTEMS" is the name the proprietor uses in trade, but not its real company name. No company with such a name exists in UK.
 - The address of the company remains the same, as confirmed by the extract from the Register.

Study case 2 (2/3)




Questions:

- Does the requested correction concern the intention of the examining division?
- Does the requested correction concern the way in which the division's intention was expressed?
- Does the decision to grant contain an "obvious error"?
- Does the fact that the request was filed 2 years after grant have any influence?
- Can the correction be allowed?

yes

no

 = yes

Study case 2 (3/3)



Answers:

- Does the requested correction concern the intention of the examining division? **no**
- Does the requested correction concern the way in which the division's intention was expressed? **yes**
- Does the decision to grant contain an "obvious error"? **rather yes**
- Does the fact that the request was filed 2 years after grant have any influence? **no**
- Can the correction be allowed? **yes**

Correction of errors in publication

- Errors in publication occur where
 - the content of the **published application** (description, claims and drawings as in the A publication) **differs** from the text of the **application as filed**, or
 - the **printed specification** (B publication) **differs** from the text of the **granted patent**
- Errors in publication can be corrected **at any time**

GL, H-VI, 4; Annex to C-V

Correction of formatting or editing errors

- **Recap:** Rule 140 EPC is not available to correct the text of the patent (G 1/10)
- **Exceptionally**, the EPO may correct **formatting/editing errors**
 - these errors are **alterations in the patent documents** occurring during the **technical preparation of the text intended for grant**, and which are indicated neither by standard marks nor in the text of the communication under Rule 71(3) EPC,
 - e.g. some lines disappear
 - **Difference with non-marked substantive amendments**

GL, H-VI, 4; Annex to C-V

Study case 3 (1/4)

Facts:

- A **communication under Rule 71(3) EPC** is sent to the applicant, whereby:
 - **Claim 9** as submitted by the applicant **is incomplete** (the text of the final part of the claim is missing)
 - In the communication (EPO Form 2004) no change in claim 9 is mentioned
 - In the attached text of the application ("Druckexemplar"), the absence of part of claim 9 is not indicated by a "standard mark"

Study case 3 (2/4)

Facts:

- The applicant **approved** the text intended for grant by paying the fee for grant and filing the translations of the claims in time (Rule 71(5) EPC)
- The **application** was **granted** with the **incomplete claim 9** and the grant was mentioned in the European Patent Bulletin
- 15 months later, the proprietor requested the correction of the error as an **error in publication**

Study case 3 (3/4)




Questions:

- Does the incomplete claim 9 constitute an error in publication?
- Does it qualify as a formatting or editing error?
- Is the fact that proceedings are no longer pending relevant to decide on the request?
- Can the error be corrected?

yes

no

 = yes

Study case 3 (4/4)



Answers:

- Does the incomplete claim 9 constitute an error in publication? **no**
- Does it qualify as a formatting or editing error? **yes**
- Is the fact that proceedings are no longer pending relevant to decide on the request? **no**
- Can the error be corrected? **yes**

Summary

Rule 139, 1st sent., EPC

- Errors, mistakes
- by the **applicant / party**
- in **documents** filed with EPO
- Original **intention of the party**
- On written request
- As long as the **proceedings** are **pending**

Rule 140 EPC

- Errors, **obvious** mistakes
- by the **EPO**
- in **decisions**
- Original **intention of the EPO department**
- By the EPO of its own motion **or** on written request
- No time bar