

Enlarged Board of Appeal EPO, 19 November 1992, Glu-Gln - CELTRIX



PATENT LAW

Correction or amendment

- [Correction of error in or amendment of description, a claim or a drawing comprised in a European patent application is subject to the prohibition of extension laid down in Article 123\(2\) EPC](#)

If the description, a claim or a drawing comprised in a European patent application contains an error on the date of filing, correction of the error under Rule 88, second sentence, EPC has the effect of amending the European patent application as filed. If a European patent application or a European patent which has been amended compared with the version as filed is corrected under Rule 88, second sentence, EPC, the same applies to the amended version. Both are special cases involving an amendment within the meaning of Article 123 EPC and are likewise subject to the prohibition of extension laid down in Article 123(2) EPC.

Obvious correction: objectively and unambiguously recognizable incorrect information

- [The requirement laid down in Rule 88, second sentence, EPC that a correction must be obvious further implies that the incorrect information is objectively recognisable, too. The skilled person must thus be in a position objectively and unambiguously to recognise the incorrect information using common general knowledge.](#)

3. The parts of a European patent application or of a European patent relating to the disclosure (the description, claims and drawings) may therefore be corrected under Rule 88, second sentence, EPC only within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge and seen objectively and relative to the date of filing, from the whole of these documents as filed

Evidence

- [Evidence of what was common general knowledge on the date of filing may be furnished in connection with an admissible request for correction in any suitable form allowed by the Convention, in Article 117\(1\) EPC in particular, as means of giving or obtaining evidence. It may thus be based upon means of evidence in other than document form.](#)

Before a correction can be made under Rule 88, second sentence, EPC it has to be established in point of fact what actually a skilled person would derive, on the date of filing, from the parts of the European patent application relating to the disclosure. As a result of the prohibition of extension under Article 123(2) EPC, documents other than the description, claims and draw-

ings may only be used insofar as they are sufficient for proving the common general knowledge on the date of filing. On the other hand, documents not meeting this condition may not be used for a correction under Rule 88, second sentence, EPC even if they were filed together with the European patent application. These include, inter alia, priority documents, the abstract and the like. Under certain circumstances the content of a document not belonging to the parts of a European patent application relating to the disclosure may be included, by means of reference, partially or wholly in the disclosure. The Enlarged Board, however, sees no reason to specify these circumstances in the present procedure.

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Enlarged Board of Appeal EPO, 19 November 1992
(P. Gori, W. Moser, H. Brinkhof, K. Bruchhausen, G. Gall, G. Szabo, P. van den Berg)

Decision of the Enlarged Board of Appeal dated 19 November 1992

G 11/91

[...]

Applicant: CELTRIX LABORATORIES, INC.

Headword: Glu-Gln/CELTRIX

Summary of Facts and Submissions

I. In case T 184/91 it has to be decided whether or not to allow the appellants' request under Rule 88, second sentence, EPC to correct in their European patent application the amino acid residue in position 12 of the N-terminal sequence of CIF-B, originally given as Glu, to read Gln. The Examining Division refused this request on the grounds that this corrected information could be derived neither from the European patent application as filed, nor from the priority documents, but only from a laboratory report provided by a third party, and that it was contradictory to Article 123(2) EPC.

II. The competent Technical Board of Appeal 3.3.2 also attached decisive importance to the points of law referred to the Enlarged Board of Appeal in case G 3/89 (pending) when considering case T 184/91. It decided in its interlocutory decision T 184/91 of 25 October 1991 to submit the points formulated in case G 3/89 to the Enlarged Board of Appeal again. They read as follows:

"1. Where a correction is requested in accordance with Rule 88, second sentence, EPC, are documents submitted after the date of filing admissible as evidence that nothing else would have been intended than what is offered as the correction?

2. Is such a correction admissible even where the amendment requested would represent an (inadmissible) extension within the meaning of Article 123(2) EPC of the subject-matter disclosed in the documents actually submitted on the date of filing?"

III. Technical Board of Appeal 3.3.2 made in that decision the following comments:

- Decision T 401/88 (OJ EPO 1990, 297) investigated

the relationship between corrections under Rule 88, second sentence, EPC and amendments under Article 123(2) EPC. It thus implicitly appeared to be based on the opinion that a correction under Rule 88, second sentence, EPC was to be considered an amendment in the sense of Article 123(2) EPC. The decision did not however give a definite answer to the question of whether there might exist any circumstances under which corrections pursuant to Rule 88 EPC would not have to meet the requirements of Article 123(2) EPC.

- Decision J 4/85 (OJ EPO 1986, 205), on the other hand, held that the application of Rule 88, second sentence, EPC did not contradict Article 123(2) EPC. This seemed to deviate from decision T 401/88 (above) because it states that Article 123(2) EPC could not be applied to corrections under Rule 88, second sentence, EPC.

- As further relevant decisions it mentioned cases T 417/87 of 17 August 1989, T 3/88 of 6 May 1988 (both unpublished) and T 200/89 (OJ EPO 1992, 46). Decisions T 417/87 and T 3/88 related to the correction of transcription errors (in decision T 417/87 changing the Figure 8 into 3 in a patent number, and in Decision T 3/88 changing the Figure 163 in a temperature range to read 136, the correction being allowed in both cases). IV. The appellants' submissions in the statement of grounds of appeal and in letters dated 25 November 1991 and 10 June 1992 could be summarised as follows:

- There was a fundamental difference between corrections under Rule 88, second sentence, EPC and amendments under Article 123(2) EPC. A correction admissible under Rule 88, second sentence, EPC might also involve changes which would give rise to an addition to the content of a European patent application as filed, contravening the prohibition of extension under Article 123(2) EPC. This had to do with the fact that Article 123(2) and Rule 88, second sentence, EPC were legal provisions which were independent of one another. Furthermore, Rule 88, second sentence, EPC would be practically meaningless if corrections were only permitted within the framework of Article 123(2) EPC.

- A correction under Rule 88, second sentence, EPC presupposed that it was immediately evident that nothing else would have been intended than what was offered as the correction. However, it did not require the error to be corrected to be immediately evident as well. It did not necessarily have to be a question of an obviously absurd statement; rather, it was sufficient for the error to become evident once the correction had been offered.

- When assessing whether the proposed correction is obvious, the important factor was what had been made available to the public on the date of filing within the meaning of Article 54 EPC. Evidence might be furnished using any suitable means.

Reasons for the Decision

1. If the description, a claim or a drawing comprised in a European patent application contains an error on the date of filing, correction of the error under Rule 88, second sentence, EPC has the effect of amending the

European patent application as filed. If a European patent application or a European patent which has been amended compared with the version as filed is corrected under Rule 88, second sentence, EPC, the same applies to the amended version. Both are special cases involving an amendment within the meaning of Article 123 EPC and are likewise subject to the prohibition of extension laid down in Article 123(2) EPC.

This assertion is substantiated as follows:

1.1 Rule 88 EPC appears in Chapter V of Part VII of the Implementing Regulations to the Convention, which covers Rules 86 to 89 EPC. This part relates to Part VII of the Convention (Articles 113 to 134 EPC).

1.2 The rules in the Implementing Regulations largely follow the sequence of articles in the Convention. Chapter V in Part VII of the Implementing Regulations contains implementing provisions relating to Article 123 EPC (Amendments), insofar as the content of a European patent application as filed is concerned. Rules 86 and 88, second sentence, EPC constitute such implementing provisions.

1.3 Article 123(1) EPC enables the conditions under which a European patent application or a European patent may be amended to be laid down in the Implementing Regulations to the Convention. On the other hand, it is a mandatory provision of Article 123(2) EPC that amendments of this kind are only admissible insofar as the subject-matter of the amended European patent application or of the amended European patent does not extend beyond the content of the European patent application as filed. The provisions in the Implementing Regulations to the Convention governing the conditions mentioned in Article 123(1) EPC are thus invariably bound by Article 123(2) EPC, insofar as they relate to the content of the European patent application as filed. As Article 123 EPC furthermore does not distinguish between amendments due to correction and other amendments, it likewise covers the former.

1.4 The term "content of the application" used in Article 123(2) EPC relates to the parts of a European patent application which determine the disclosure of the invention, namely the description, claims and drawings also mentioned in Rule 88, second sentence, EPC. Consequently, the prohibition of extension under Article 123(2) EPC also applies to a correction under Rule 88, second sentence, EPC.

1.5 This interpretation is also in keeping with the importance accorded by the Convention to the content of a European patent application as filed - i.e. on the filing date - in respect of its legal effects.

1.6 Infringement of the prohibition of extension under Article 123(2) EPC is a ground for both opposition (Article 100(c) EPC) and revocation (Article 138(1)(c) EPC), regardless of whether it results from a correction (Rule 88, second sentence, EPC) or some other amendment (Rule 86 EPC). The legal validity of a granted European patent should not be jeopardised because a correction under Rule 88, second sentence, EPC contains an inadmissible extension within the meaning of Article 123(2) EPC.

2. According to Rule 88, second sentence, EPC, "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". Interpretation of this requirement for a correction under Rule 88, second sentence, EPC should take into account that the prohibition of extension enshrined in Article 123(2) EPC also applies to such a correction (see point 1.4 above). This means that, when ascertaining the information the person making the request (the applicant or patent proprietor) actually meant to give, instead of the incorrect particulars, on the date of filing or when making an amendment under Article 123 EPC, what matters is what a skilled person would objectively have derived from the description, claims and drawings of a European patent application on the date of filing. The object here is to rule out evidence being used to extend the disclosure beyond what is objectively recognisable on the date of filing as the intention of the person making the request. The requirement laid down in Rule 88, second sentence, EPC that a correction must be obvious further implies that the incorrect information is objectively recognisable, too. The skilled person must thus be in a position objectively and unambiguously to recognise the incorrect information using common general knowledge.

3. The parts of a European patent application or of a European patent relating to the disclosure (the description, claims and drawings) may therefore be corrected under Rule 88, second sentence, EPC only within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge and seen objectively and relative to the date of filing, from the whole of these documents as filed.

4. A correction under Rule 88, second sentence, EPC is of a strictly declaratory nature. The corrected information merely expresses what a skilled person, using common general knowledge, would already derive on the date of filing from the parts of a European patent application, seen as a whole, relating to the disclosure. This does not therefore affect the content of the European patent application as filed. Under these circumstances, there cannot be said to be any retroactive effect. Since a correction admissible under Rule 88, second sentence, EPC is thus of a declaratory nature only, it does not infringe the prohibition of extension under Article 123(2) EPC either.

5. With regard to a correction under Rule 88, second sentence, EPC it follows that the parts of a European patent application or of a European patent relating to the disclosure must, either on the date of filing or following an amendment under Article 123 EPC, contain such an obvious error that a skilled person is in no doubt that this information is not correct and - considered objectively - cannot be meant to read as such. If, on the other hand, it is doubtful whether any information at all is incorrect, then a correction is ruled out. The same applies if incorrect information only becomes apparent in the light of the proposed correction.

6. The parts of a European patent application as filed which relate to the disclosure must further allow a

skilled person - using the common general knowledge on the date of filing - directly and unequivocally to ascertain the precise content of the information the person making the request actually meant to give, instead of the incorrect particulars, on the date of filing or when making an amendment under Article 123 EPC, so that, for said skilled person, "it is immediately evident that nothing else would have been intended than what is offered as the correction" (Rule 88, second sentence, EPC). However, if there is any doubt that nothing else would have been intended than what is offered as the correction, a correction cannot be made.

7. Before a correction can be made under Rule 88, second sentence, EPC it has to be established in point of fact what actually a skilled person would derive, on the date of filing, from the parts of the European patent application relating to the disclosure. As a result of the prohibition of extension under Article 123(2) EPC, documents other than the description, claims and drawings may only be used insofar as they are sufficient for proving the common general knowledge on the date of filing. On the other hand, documents not meeting this condition may not be used for a correction under Rule 88, second sentence, EPC even if they were filed together with the European patent application. These include, inter alia, priority documents, the abstract and the like. Under certain circumstances the content of a document not belonging to the parts of a European patent application relating to the disclosure may be included, by means of reference, partially or wholly in the disclosure. The Enlarged Board, however, sees no reason to specify these circumstances in the present procedure.

8. Evidence of what was common general knowledge on the date of filing may be furnished in connection with an admissible request for correction in any suitable form allowed by the Convention, in Article 117(1) EPC in particular, as means of giving or obtaining evidence. It may thus be based upon means of evidence in other than document form.

9. Since the requirements for furnishing evidence that nothing else would have been intended than what is offered as the correction depend essentially on whether or not the prohibition of extension under Article 123(2) EPC is to be taken into account in the case of a correction under Rule 88, second sentence, EPC, the second point of law will be answered before the first.

ORDER

For these reasons it is decided that:

The points of law referred to the Enlarged Board of Appeal by Technical Board of Appeal 3.3.2 in its interlocutory decision are answered as follows:

1. The parts of a European patent application or of a European patent relating to the disclosure (the description, claims and drawings) may be corrected under Rule 88, second sentence, EPC only within the limits of what a skilled person would derive directly and unambiguously, using common knowledge, and seen objectively and relative to the date of filing, from the whole of these documents as filed. Such a correction is of a strictly declaratory nature and thus does not in-

fringe the prohibition of extension under Article 123(2) EPC.

2. Evidence of what was common general knowledge on the date of filing may be furnished in connection with an admissible request for correction in any suitable form.
