

**Enlarged Board of Appeal EPO, 19 November 1992, Correction**

**PATENT LAW**

**Correction of application; prohibition on extension**

- 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 general 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 infringe the prohibition of extension under Article 123(2) EPC.

**Evidence of common general knowledge**

- 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.

Source: [epo.org](http://epo.org); OJ 1993, p. 117

**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 3/89**

[...]

**Headword: Correction under Rule 88, second sentence, EPC**

**Summary of Facts and Submissions**

I. In case T 401/88 (OJ EPO 1990, 297) it was held that a requested amendment which represents an inadmissible extension within the meaning of Article 123(2) EPC, and which cannot be allowed, may not be allowed as a correction under Rule 88, second sentence, EPC either. An error may be corrected only if a skilled person would regard the correction as necessarily implied by the contents of the documents as originally filed - in the same way as when the admissibility of an amendment under Article 123(2) EPC is assessed. This follows both from Article 138(1)(c) EPC, under which a European patent is revoked if its subject-matter extends beyond the content of the application as filed, and from Article 164(2) EPC, which stipulates that the provisions of the Convention take precedence over those of the Implementing Regulations.

II. Decision J 4/85 (OJ EPO 1986, 205) ruled that in applying Rule 88 EPC it is necessary to take account of all the facts and evidence enabling the applicant's intention to be established immediately when the request for correction is examined, and not to limit the examina-

tion to the patent application proper and to the documents filed with it. The priority document is an important element in establishing the applicant's intention and must be taken into consideration even if it was not filed with the European patent application. The correction of an error restores the application to the form in which it has been established that the applicant intended to file it, the correction thus taking effect retroactively on the date on which the application was filed.

III. On 7 December 1989, in accordance with Article 112(1)(b) EPC, the President of the European Patent Office referred the following points of law to the Enlarged Board of Appeal because of their importance and in order to ensure uniform application of the law:

"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?"

IV. In the President's view decisions T 401/88 and J 4/85 (see points I and II above) contradict each other. In his referral and in a further opinion submitted on 23 July 1991 the President essentially states the following:

- Under the EPC the possibilities and limits of patent protection are essentially bound up with the disclosure made before the European Patent Office on a particular qualifying date, the date of filing. The right to patent protection is based solely on the disclosure of the invention before the European Patent Office on the date of filing. The limit of possible protection laid down by Article 123(2) EPC in the interests of third parties is linked solely to the subject-matter as disclosed on the date of filing.

- The Legal Board of Appeal's ruling in case J 4/85 (see point II above) might lead to cases in which the versions of granted patents corrected in this way run considerable risk of being revoked under Article 138(1)(c) EPC, which states that there is a ground for revocation if the subject-matter of the European patent extends beyond the content of the application as filed.

- National revocation authorities are not bound by any decision of the European Patent Office during the grant procedure to accord a document not actually submitted until after the filing date the status of a disclosure as filed. They may interpret Article 138 EPC as they see fit if instead they take the view that the admissibility of an extension is dependent solely on the content of the documents actually submitted to the Office on the date of filing.

- In the context of patent law harmonisation the Enlarged Board of Appeal's ruling on the points of law referred to it will be crucial to how the purpose and limits of the prohibition of extension are interpreted within the European patent system as a whole. The line taken will also need to find acceptance with the compe-

tent authorities in the Contracting States.

- For a correction to be admissible it must meet two conditions: first, the requested correction may not depart from what the applicant intended to disclose on the date of filing; secondly, a correction of the description, claims or drawings which is based on documents submitted after the date of filing may only be allowed if the requested amendment does not represent an inadmissible extension within the meaning of Article 123(2) EPC of the subjectmatter disclosed in the documents actually submitted or available to the European Patent Office on the date of filing.

- Applicants may cite documents already submitted on the date of filing in substantiation of their request for a correction in accordance with Rule 88, second sentence, EPC, but they may also cite evidence not submitted until later - documents filed together with the request for correction, for example - provided this evidence is sufficient for proving that this is what was originally intended.

- Allowing a correction to a patent application and the resulting patent as granted which produced a version whose content could not be derived by a skilled person on the basis of the documents actually submitted on the date of filing would not only run counter to the importance Article 123(2) EPC accords the original disclosure before the European Patent Office for the patentability and the legal validity of European patents, it would also be at odds with the requirement that Article 123(2) EPC (i.e the Convention) take precedence over Rule 88 EPC (the Implementing Regulations).

#### **Reasons for the Opinion**

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 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.

**Conclusion**

For these reasons the points of law referred to the Enlarged Board of Appeal by the President of the European Patent Office 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 general 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 infringe 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.