

Enlarged Board of Appeal EPO, 16 April 1996, Correction of decision to grant – US Gypsum

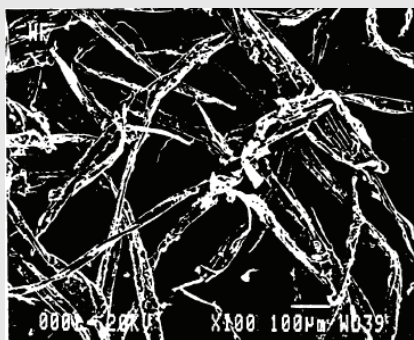


Fig. 3

PATENT LAW

Appeal from decision refusing a request for correction of the decision to grant

- [An appeal from a decision of an Examining Division refusing a request under Rule 89 EPC for correction of the decision to grant is to be decided by a Technical Board of Appeal.](#)

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Enlarged Board of Appeal EPO, 16 April 1996

(P. Gori, R. Teschemacher, C. Andries, G. Gall, G.D. Paterson, J.-C. Saisset, P. van den Berg)
Decision of the Enlarged Board of Appeal dated 16 April 1996
G 8/95

[...]

Applicant: United States Gypsum Company
Headword: Correction of decision to grant / US GYPSUM II

Summary of Facts and Submissions

I. [European patent application No. 89 311 913.1](#) designating Spain and Greece was filed on 16 November 1989. The Examining Division informed the Applicant in a communication of 30 May 1994 of the version in which it intended to grant the patent. In a letter dated 7 September 1994 the Applicant approved the text intended for grant. Once the formal requirements under Rule 51(6) EPC had been fulfilled, the decision to grant was dispatched on 23 February 1995.

II. In a fax dated 10 March 1995, the Applicant filed two additional pages 4a and 4b of the description and requested that they be included in the patent specification prior to publication. In a communication dated 17 March 1995, the Applicant was informed that the technical preparations for the publication of the patent specification had been completed before the fax dated 10 March 1995 had been received and that a request to amend the decision to grant could be filed upon receipt of the printed specification. In a fax dated 18 April

1995, the Applicant requested that the patent be re-published incorporating the missing pages.

III. The Examining Division issued a decision dated 8 May 1995, pre-printed on Form 2053, "refusing a request for correction of errors in decision (Rule 89 EPC)" on the ground that "the corrections specified did not relate to passages in the patent specification where the Division wished to base its decision on a different text (Guidelines, Part E-X, 10)".

IV. The patentee appealed against this decision. Pursuing the request for correction, the Appellant submitted that pages 4a and 4b had been omitted due to a clerical error when a full replacement specification was filed on 25 March 1994. The text was intended to be identical to the text previously submitted in the corresponding Euro-PCT application 90 901 172.8 in which, at the time, it was not possible to designate Spain and Greece. This intention had been expressly declared when the amended specification was filed. The additional pages contained text providing support for, and corresponding to, claims 6, 9, 10, 12 and 17 as agreed and accepted by the examiner.

V. The Examining Division remitted the file to the Board of Appeal, addressing it to Technical Board of Appeal 3.3.2 on the basis of the business distribution scheme for the Technical Boards of Appeal.

VI. Board of Appeal 3.3.2 referred the following questions of law to the Enlarged Board of Appeal in accordance with Article 112(1)(a) EPC:

"Are appeals from a decision of an Examining Division refusing a request under Rule 89 EPC for correction of the decision to grant to be decided upon by a Technical Board of Appeal (Article 21(3)(a)(b) EPC) or by the Legal Board of Appeal (Article 21(3)(c) EPC)?

If the answer is depending on the circumstances of the case, who shall decide on the competence?"

VII. In its decision of referral (T 850/95, OJ EPO 1996, 455), Technical Board of Appeal 3.3.2 drew attention to the following previous case law:

(i) In decision J 30/94 dated 9 October 1995, the Legal Board of Appeal held that a decision refusing a request for correction under Rule 89 EPC did not concern the grant of the patent and that the Legal Board was responsible for examining the appeal under Article 21(3)(c) EPC. The fact that a request for correction related to a decision to grant a patent did not, according to that decision, alter the competence to consider it because what was under appeal was the decision to refuse the request for correction, not the decision to grant a patent.

In two earlier decisions, J 12/85, OJ EPO 1986, 155, and J 27/86 dated 3 October 1987 (not published in OJ EPO), the Legal Board decided on appeals from decisions refusing requests under Rule 89 EPC for correction of the decision to grant. These decisions did not specifically address the question of competence.

(ii) In contrast thereto, two Technical Boards accepted their competence under Article 21(3)(a) EPC to decide on appeals against decisions refusing a request for correction under Rule 89 EPC in decisions T 546/90, dated 12 September 1991, and T 946/91, dated 17 August

1993, neither of which were published in OJ EPO. In T 546/90 it was requested that drawings be replaced and in T 946/91 that mistakes in the definition of certain compounds be corrected.

VIII. In view of this divergency in the case law, Board of Appeal 3.3.2 considered whether a solution to the question of competence could be found in the EPC which would indicate which of the above decisions should be followed. The Board examined the object and purpose of Article 21(3) EPC and its legal history. It did not, however, come to an unequivocal conclusion. For reasons of legal certainty the Board decided to refer the matter to the Enlarged Board of Appeal.

IX. In response to a communication dated 10 January 1996 from the Enlarged Board of Appeal, the Appellant in case T 850/95 submitted that appeals from decisions under Rule 89 EPC were appropriately covered by the second clause of Article 21(3)(b) EPC, which provides for a composition of three technically qualified and two legally qualified members when the Board considers that the nature of the appeal so requires.

Reasons for the Decision

1. The competence of the Technical Boards of Appeal and the Legal Board of Appeal in grant proceedings is laid down in Article 21(3) EPC as follows:

"For appeals from a decision of an Examining Division, a Board of Appeal shall consist of:

(a) two technically qualified members and one legally qualified member, when the decision concerns the refusal of a European patent application or the grant of a European patent and was taken by an Examining Division consisting of less than four members,

(b) three technically qualified members and two legally qualified members, when the decision was taken by an Examining Division consisting of four members or when the Board of Appeal considers that the nature of the appeal so requires,

(c) three legally qualified members in all other cases."

2. Whereas in the business distribution scheme pursuant to Rule 10(1) EPC the Boards in the composition under Article 21(3), sub-paragraphs (a) and (b), are called Technical Boards of Appeal, the Board in the composition under sub-paragraph (c) is called the Legal Board of Appeal. The Legal Board of Appeal is competent in all cases except those specified in sub-paragraphs (a) or (b). The situation stipulated in sub-paragraph (b) in ex parte proceedings is clear because the Technical Boards of Appeal in this composition are competent in all cases in which the decision under appeal was from an Examining Division enlarged by a legal member, irrespective of the content of the decision.

In contrast, sub-paragraph (a) relates to cases decided by an Examining Division consisting of less than four members: where the decision concerns the refusal of the application or the grant of the patent, the Technical Boards of Appeal are competent to decide the appeal, otherwise the Legal Board of Appeal has to decide. Therefore, as correctly stated in J 30/94 (above) and in the decision of referral, the decisive question is whether the decision on a request for correction of the decision

to grant "concerns" the decision to grant. The rationale in J 30/94 (above) is that only an appeal against the decision to grant concerns the decision to grant, whereas the decision of referral concludes that the wording of Article 21(3)(a) EPC allows the interpretation that any decision related to the decision to grant is within the scope of the provision.

3. In order to come to a proper interpretation of Article 21(3)(a) EPC it seems appropriate to consider at the outset the aim of an appeal against a decision to grant the patent on the one hand and of a request for its correction on the other hand.

3.1 A party who appeals against the decision to grant is aiming to change the decision under appeal by alleging that the decision does not correspond to its requests in contravention of the law (see. Article 113(2) EPC). Otherwise the party would not be adversely affected by the decision under appeal pursuant to Article 107, first sentence, EPC (J 12/85, OJ EPO 1986, 155, Reasons, 4-6). The aim of the appeal is to eliminate this adverse effect (G 9/92, OJ EPO 1994, 875, Reasons, 9).

3.2 A party who requests a correction under Rule 89 EPC is also aiming to "change" the decision. The basis of such a request is, however, not that the party was not granted what it had requested. Rather, such a request is based on the allegation that there is a linguistic error, error of transcription or similar obvious mistake. This opportunity for corrections is a principle known in many legal systems (see eg Article 66 of the Rules of Procedure of the European Court of Justice); where a decision does not express the manifest intention of the deciding body, an obvious clerical mistake in the decision can be corrected.

3.3 Thus the difference between an appeal and a request for correction of a decision may be seen in the fact that in the first case the remedy is directed against the substance of the decision and in the latter case against the form in which the decision was expressed. Regardless of this difference, in both cases the object of the remedy is the decision itself. Therefore, a request for correction of the decision to grant concerns the grant of the patent.

3.4 The competence to correct errors in a decision under Rule 89 EPC lies with the body which has given the decision. Hence, in the examination procedure the Examining Division has to decide on a request to correct errors in the decision to grant. If, as stated above, the request for correction of the decision to grant concerns the grant of the patent, then the decision on the correction must also concern the grant of the patent, since it is the request of the party which defines the subject of the dispute.

4. The Enlarged Board agrees with the statement made in J 30/94 (above) that it is the decision to refuse the request for correction which is under appeal. This does not, however, alter the subject of the dispute in the second instance. The decisive criterion in Article 21(3)(a) EPC is not that the decision under appeal is the decision to grant itself. It is sufficient for the decision to "concern" the grant and this must necessarily be the case if the subject of the decision is the text in which

the patent is to be or has been granted, since this is the result of the substantive examination and defines the rights conferred by the patent.

5. In this respect the decision to refuse a request for correction under Rule 89 EPC is different from other decisions which the Examining Division may take in the course of the examination procedure and which do not affect directly the decision to grant. Such decisions, preceding the decision to grant, may influence the outcome of the grant procedure. For example, a decision of an Examining Division refusing a request for correction in respect of a designation under Rule 88, first sentence, EPC and allowing a separate appeal pursuant to Article 106(3) EPC is prejudicial to the territorial scope for which the patent may be granted later on. In contrast to a final decision on refusal or grant pursuant to Article 97(1) EPC, such an interlocutory decision by definition does not terminate the proceedings. It therefore does not concern the grant of the patent within the meaning of Article 21(3)(a) EPC and the Legal Board of Appeal would be responsible for an appeal pursuant to Article 21(3)(c) EPC (see. J 8/89, dated 4 July 1989, not published in OJ EPO), unless the decision has been taken by an Examining Division consisting of four members.

6. For the reasons set out above, the Enlarged Board has come to the conclusion that the decision refusing a request for correction of the decision to grant concerns the grant of the patent within the meaning of Article 21(3)(a) EPC.

Therefore, it is the Technical Boards as defined in Article 21(3)(a) and (b) EPC which have to decide on the appeals which are the subject of the decision of referral. This applies irrespective of the circumstances of the individual case. Hence, the second question in the referral is inapplicable.

ORDER

For these reasons it is decided that:

An appeal from a decision of an Examining Division refusing a request under Rule 89 EPC for correction of the decision to grant is to be decided by a Technical Board of Appeal.
