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D E C I S I O N
of 28 November 2001

Case Number: J 0005/01 - 3.1.1

Application Number: 96922477.3

Publication Number: 0836536

IPC: B08B 7/04

Language of the proceedings: EN

Title of invention:

On-site generation of ultra-high-purity buffered-HF for
semiconductor processing

Applicant:

Air Liquide America Corporation

Opponent:

-

Headword:

Correction of errors/AIR LIQUIDE OF AMERICA

Relevant legal provisions:

EPC Art. 16, 18, 96

EPC R. 67, 88

Keyword:

-

Decisions cited:

J 0008/82, J 0004/85, J 0042/92

Headnote:

The wording of Articles 16 and 18 EPC as they stand leaves no room for an interpretation according to which the responsibility for a European patent application could be split between Receiving Section and Examining Division. The clear and mutually exclusive allocation of this responsibility in the Convention prevails over considerations of procedural or cost economy (contrary to decision J 0008/82). Thus, relying on the point in time at which a request for correction was made rather than on the two acts mentioned in Article 16 EPC (request for examination or indication under Article 96(1) EPC) would be *contra legem*.



Case Number: J 0005/01 - 3.1.1

D E C I S I O N
of the Technical Board of Appeal 3.1.1
of 28 November 2001

Appellant: Air Liquide America Corporation
2700 Post Oak Boulevard
Suite 1800
Houston
Texas 77056 (US)

Representative: Vesin, Jacques
L'AIR LIQUIDE, S.A.
Service Propriété Industrielle
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 5 October 2001
refusing a correction under Rule 88 EPC
concerning European patent application
No. 96 922 477.3

Composition of the Board:

Chairman: J.-C. Saisset
Members: R. T. Menapace
G. E. Weiss

Relevant facts and submissions

- I. For the European patent application No. 96 922 477.3 which originated from the international application published under WO 96/39266 the written request for examination was filed and the examination fee was paid on 31 December 1997.
- II. The supplementary search report having been transmitted to the applicant, he declared by letter received on 28 January 2000 that he wished to proceed further with the European patent application (Article 96(1) EPC).
- III. On 5 October 2000 the Office issued a decision by which the applicant's request of 7 April 1998 to correct the number of the second priority application [from 08/499,427] to 08/499,562 was rejected.
- IV. The cover page of the decision shows the letterhead of Directorate General 2 of the EPO and is signed "RECEIVING SECTION M. de Roo". In point 5 of the Reasons for the Decision it is stated: "Since at the time of filing the Rule 88 request the present application was still under the responsibility of the Receiving Section, the present decision has been made by and under the responsibility of the Receiving Section".
- V. Notice of appeal against this decision of the Receiving section was filed on 1 December 2000; the appeal fee was paid on the same day. The statement setting out the grounds of appeal was received on 5 February 2001. The Appellant requested cancellation of the decision under appeal and the correction of the number of the second priority application from 08/499,427 to 08/499,562; further he requested oral proceedings "prior to any

rejection".

VI. On 2 March 2001 the Head of the Central Unit Formalities (Receiving Section) decided that the decision under appeal was "sustained", i.e. it would not be rectified pursuant to Article 109(1) EPC. Consequently the case was forwarded to the Legal Board of Appeal.

Reasons for the Decision

1. The appeal is admissible.
2. It is clear from the facts set out above under points III and V, that notwithstanding the use of the letterhead of Directorate General 2 the decision under appeal was taken by the Receiving Section which also decided not to rectify it.
3. Said decision was taken after the applicant had indicated under Article 96(1) EPC that he wished to proceed further with the application, at which point in time the Examining Division became responsible for the examination of the application and the Receiving Section ceased to be responsible (Article 16 in conjunction with Article 18(1) EPC).
4. The Board is aware of decision J 8/82 of 8 November 1983 (OJ 1984, 155) in which it was held under point 3 of the Reasons, that in respect of a request to amend the designation of inventors the Receiving Section remains competent to issue its decision even after responsibility for the examination of the application has passed to the Examining Division. However, the Board in its present composition does not see a reason

for extrapolating this finding beyond the case then decided: The reasoning in that decision, namely that a *de novo* consideration by the Examining Division would be "pointlessly wasteful of time and money", is not convincing. The wording "The Receiving Section shall be responsible .. up to the time when a request for examination has been made or the applicant has indicated under Article 96, paragraph 1, that he desires to proceed further with his application" (Article 16 EPC) and "An Examination Division shall be responsible for the examination of each European patent application from the time when the Receiving Section ceases to be responsible" (Article 18(1) EPC) leaves no room for an interpretation according to which responsibility for a European patent application could be split between Receiving Section and Examining Division. The clear and mutually exclusive allocation of this responsibility in the Convention prevails over considerations of procedural or cost economy. Thus, relying on the point in time at which a request for correction was made rather than on the two acts mentioned in Article 16 EPC would be *contra legem*. It is also pointed out in this context, that corrections under Rule 88 EPC are not a matter which forms part of the examination on filing or of the examination as to formal requirements (Articles 90 and 91 EPC). Rather, the wish or the need for a correction may arise during the whole grant procedure and even afterwards, eg. during opposition proceedings (cf. decision J 42/92); so, the nature of the issue or the specific tasks of the two bodies in question do not suggest it either, to retain the responsibility for deciding on corrections under Rule 88 EPC (first sentence - for corrections necessitating a technical examination see decision J 4/85, OJ 1986,205) with the Receiving Section.

5. It follows from the foregoing that the decision under appeal was taken by the Receiving Section when it was no longer empowered to take it. As this is a serious deficiency of the decision under appeal the Board raises it on its own motion, even if it was not objected to by the Appellant. This deficiency qualifies as a substantial procedural violation, so that the impugned decision cannot stand and the appeal must be allowed without consideration of the merits of the case.

6. As this substantial procedural violation was not in any way caused by the applicant reimbursement of the appeal fee is equitable (Rule 67 EPC)

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the Examining Division for further prosecution.

3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

S. Fabiani

J.-C. Saisset