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Datasheet for the decision of 22 May 2014

Case Number: J 0016/13 - 3.1.01

Application Number: 08167183.6

Publication Number: 2061024

IPC: G09G3/34

Language of the proceedings: EN

Title of invention:
Display apparatus and control method thereof

Applicant:
Samsung Electronics Co., Ltd.

Headword:
Correction of application documents

Relevant legal provisions:
EPC Art. 21(3), 21(3)(a), 21(3)(c), 90(1), 90(3), 97(2), 122, 123(2)
EPC 1973 Art. 21(3)
RPBA Art. 11, 12(2), 12(4)
EPC R. 40(1)(c), 40(2) sentence 2, 40(3), 55, 56, 56(1), 56(1) sentence 2, 56(2), 56(3), 57(d), 58, 62, 66, 139, 140
EPC 1973 R. 46(2), 88
Guidelines for examination Part H, Chapter IV.2.3.1

Keyword:
Competence of the boards of appeal - Legal board competent to hear the case (yes)
Correction of error - (no)
Exchange of complete description and claims (no)
Incorporation by reference (not applicable)
Grant of time limit under Rule 56 (no)
Filing of missing parts under Rule 56 (not applicable)
Violation of legitimate expectations (no)

Decisions cited:
G 0003/89, G 0011/91, G 0002/95, G 0001/11, J 0004/85, J 0021/85, J 0005/06, J 0027/10, T 0689/90, T 0726/93, T 1382/08

Catchword:
Where the formal order of an appealed decision is obviously erroneous to such an extent that it is essentially incomprehensible when compared with the reasons in the body of the decision, in particular when it plainly does not correspond to any of the foreseen possible legal effects flowing from the substantive issue underlying the appealed decision, and if the competence pursuant to Article 21(3) EPC is supposed to change from one Board to another only because of such an "impossible" order, the formal order can be disregarded for the purposes of Article 21(3)(a) and (c) EPC, and rather the substantive request underlying the decision must be guiding in determining the Board competent to decide the case, see point 6 of the Reasons. (T 1382/08 not followed)

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Case Number: J 0016/13 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 22 May 2014

Appellant: (Applicant)	Samsung Electronics Co., Ltd. 129, Samsung-ro Yeongtong-gu Suwon-si, Gyeonggi-do, 443-742 (KR)
Representative:	Waddington, Richard Appleyard Lees 15 Clare Road Halifax HX1 2HY (GB)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 5 October 2012.**

Composition of the Board:

Chairman	T. Bokor
Members:	T. Karamanli
	C. Schmidt

Summary of Facts and Submissions

I. This is an appeal against the decision of the Examining Division, posted on 5 October 2012, not allowing the request of the applicant, now appellant, that the wrongly filed description and claims be exchanged under Rule 139 EPC.

II. The prosecution history, as far as relevant to the present decision, can be summarised as follows:

III. The application was filed electronically on 21 October 2008, claiming the priority of a patent application filed in the Republic of Korea and having a filing date of 14 November 2007. In the request for grant (EPO Form 1001E) the check-box at point 25.2, intended for indicating that the application is a complete translation of the previous application, was left empty. The application was filed with an English-language description of 14 pages and claims (claims 1-10), an abstract and four sheets of drawings with Figures 1-4. Fig. 1 was indicated for publication with the abstract.

IV. The priority document, in Korean, was added to the file of the application by the EPO on 23 December 2008, pursuant to the decision of the President of the EPO dated 12 July 2007 on the filing of priority documents (Special edition No. 3 OJ EPO 2007, 22). The appellant was informed of this in a communication dated 14 January 2009 (EPO Form 1195).

V. On 6 February 2009 the EPO sent the appellant a communication (EPO Form 1507N) accompanying the extended European search report. This communication informed the applicant, by way of check-boxes, that the abstract and the title of the application were approved. The European search opinion under Rule 62 EPC was attached to the

search report. It contained objections under Article 83 EPC, and a part II titled "Further remarks". Here it was firstly noted that the figures did not seem to correspond to the disclosure of the description and claims, and the applicant was advised that it could choose to delete the figures. Secondly it was noted that the disclosed and claimed subject-matter appeared to be the same as that of a co-pending application. Given that the present application had the earlier priority date, following publication its contents would be relevant for assessing the novelty of the co-pending application pursuant to Article 54(3) EPC.

VI. With a communication dated 22 April 2009 (EPO Form 1133) the applicant was notified that the application and the search report were to be published on 20 May 2009. Another communication dated 26 May 2009 (EPO Form 1081) reminded the applicant that designation fees had to be paid and a request for examination had to be made by paying the examination fee within six months after the publication of the search report (Rules 39(1) and 70(1) EPC). The representative of the applicant authorised the EPO to debit the designation and examination fees from its deposit account by instructions sent electronically on 12 November 2009

VII. With a communication dated 7 December 2009 (EPO Form 2001A) the Examining Division invited the applicant to file within four months observations and/or corrected application documents in view of the deficiencies stated in the search opinion.

VIII. With letter dated 19 January 2010 the applicant filed "corrected specification and claims" and requested the correction of an error under Rule 139 EPC. It was submitted that the application had been filed with

incorrect description and claims, while the drawings were correct. The error was clear, and anyone noting an inconsistency between the claims and drawings would consider looking at the priority document already on file, or at equivalent applications claiming the same priority. In that case they would have seen the English-language US application. The latter was already available by the time the European application was published. In this manner the request for correction was obvious in the sense that it was immediately evident that nothing else would have been intended than what was enclosed with the request, i.e. the description and claims offered as correction. The scope of the claims did not go beyond what the person skilled in art would have considered to be the scope of the claims of the original filing, this being consistent with the scope of the Korean priority document. In view of the pending request for correction, an extension for responding to the communication of 7 December 2009 (see point VII) was also requested. In further support of the request for correction, a translation of the priority document was filed with letter dated 4 February 2010.

IX. With letter dated 16 July 2010 the applicant provided details as to how the erroneous exchange of the application documents occurred and stated that the request for correction had been filed immediately when the inadvertent error was discovered. With letter dated 11 August 2010 the applicant referred to the requested correction and stated that the offered correction should be considered as an amendment to address the objections raised in the examination report, i.e. the EPO communication of 7 December 2009.

X. With communication dated 25 February 2011 the Examining Division informed the applicant that the request for correction under Rule 139 EPC did not appear allowable.

This followed from decisions G 3/89 and G 11/91 of the Enlarged Board of Appeal, which restricted corrections to errors which were indubitably obvious errors to the skilled person. The discrepancy between the drawings and the other parts of the application as filed would not have revealed which one had been wrong and which one had been correct. Furthermore, the offered correction did not comply with Article 123(2) EPC. The priority document and parallel applications could not be relied on for the missing disclosure, as these documents did not form part of the application as filed.

XI. The applicant submitted with letter dated 4 May 2011 that the requested correction was in line with the findings of decision G 3/89, as the skilled person would have seen the error, i.e. the mismatch between the drawings and the description/claims. The description itself referred to the related applications and stated that the contents of these were incorporated by reference. Hence the skilled person would have looked at the Korean priority document and the parallel US application and would have considered these as forming part of the disclosure.

XII. The Examining Division refused the request for correction in a decision posted 5 October 2012. According to the order of the decision found on page 1 of EPO Form 2916, entitled "Decision", the following was decided: "In the matter of European patent application No. 08167183.6 it is decided as follows: The request under Rule 139 EPC to exchange the wrongly filed description and claims cannot be allowed". The "Decision" was followed by Facts and Submissions essentially listing the events described in points III to XI above. In the Reasons for the decision, the Examining Division essentially repeated the arguments of its previous communication (see point X above) and stated that a correction under Rule 139 EPC was not

available, because the correction offered was not evidently the only possible correction, and furthermore such an exchange of the documents would have brought in new subject-matter, contrary to Article 123(2) EPC. The general statement on page 13 of the description referring to the priority document and other documents of the applicant did not help, as these were not available to the public or the EPO on the date of filing of the present application. The request for grant did not indicate that the application was meant to be a complete translation of the previous application.

XIII. The decision was issued with a cover page, EPO Form 2007, with a different order, namely a refusal of the application. The decision also contained the signature page with the signatures of the members of the Examining Division, EPO Form 2048.2, which contained the order that the application was refused on the basis of Article 97(2) EPC. The refusal was also registered in the electronic file system of the EPO.

XIV. Notice of appeal was filed on 5 December 2012, and appeal fee was paid the same day. The statement setting out the grounds of appeal was filed on 21 January 2013.

XV. In the grounds of appeal the appellant requested, as its main request, that the decision of the Examining Division be set aside, and that the application be corrected to contain the intended documents and remain pending for examination. As an auxiliary request it was requested that the time limit for filing missing parts pursuant to Rule 56 EPC be extended so as to allow the applicant to remedy the deficiencies in the documents on file. Oral proceedings were also requested.

XVI. Concerning the main request, the appellant took issue with the reasoning of the appealed decision. It submitted that the skilled person would have noted the discrepancies and could and would have consulted the earlier and the parallel applications, given the pointer in the description at page 13. These applications were also available to the skilled person or to the EPO, e.g. the latter obviously had access to the Korean priority document. Case law, specifically decisions J 4/85 and T 726/93 based on similar facts, was applicable to and supported the appellant's case.

XVII. Concerning the auxiliary request, the appellant argued that the EPO ought to have discovered the discrepancy in the application documents, and the appellant should have been given the possibility to correct the error under Rule 56(3) EPC by being allowed to file the correct specification, this being a missing part wholly contained within the priority document. The reference signs of the abstract did not correspond to the figures and thus showed that the abstract did not belong to the application, so that the presence of an error was obvious. The EPO did not discover the error, though it was a duty of the Receiving Section to fully review the application documents. Rather, the EPO misled the applicant by approving the abstract. In this manner the EPO prevented the applicant from taking action in good time. Overall, the EPO had violated the legitimate expectations of the applicant, and had not shown good faith. This could also be regarded as a procedural violation by the EPO. This violation of the rights of the applicant should be made good by allowing the applicant to file the missing parts under Rule 56(3) EPC.

XVIII. On 14 February 2014 the Board issued a summons to oral proceedings and in the communication of 26 February 2014

the Board indicated its preliminary opinion that the request for correction was not allowable, essentially for the reasons set out in points 14 to 20 below. As to the auxiliary request, the requested setting of a time limit pursuant to Rule 56 could also not be allowed, essentially for the reasons set out in points 22 to 28 of below. The Board also indicated why it considered itself to be the competent Board for deciding the appeal.

XIX. Oral proceedings were held on 22 May 2014. The appellant's main request was that the decision under appeal be set aside and that the correction of the specification under Rule 139 EPC and the filing of the correct one be allowed. The auxiliary request was that the Board allows the filing of missing parts by granting a time limit under Rule 56(3) EPC. Concerning the main request, it was submitted that decisions G 2/95 and J 5/06 were not transferable to the present case. These decisions concerned situations where the applicant wanted a complete specification to be exchanged, but did not apply where only certain elements needed to be corrected. Therefore the reasoning of decisions T 726/93 and J 4/85 still applied. The skilled person would not only have seen that there was an error, but would also have immediately seen the obvious correction, this being the offered replacement. Concerning the auxiliary request, the appellant referred to its written submissions. As to the competence of the Board, it agreed with the Board that refusal of the application was not the issue and needed no discussion.

XX. The decision of the Board was announced at the end of the oral proceedings.

Reasons for the Decision

1. The appeal is admissible.

Competence of the Legal Board of Appeal

2. On the face of the decision under appeal, the Examining Division decided that the application is refused on the basis of Article 97(2) EPC. This wording is found on the cover page (EPO Form 2048.2) containing the signatures of the members of the Examining Division. The attached EPO Form 2007 also contains the refusal as the formal order. However, in the body of the decision the order is worded differently: "The request under Rule 139 EPC to exchange the wrongly filed description and claims cannot be allowed." The reasoning of the decision is also consistent with this order, while apparently none of the reasons supports a refusal of the application under Article 97(2) EPC. The Board takes it that the order in the body of the decision is the correct one which reflects the genuine intention of the Examining Division. Thus the Board considers that the cover page with the refusal is merely a formal error, and that the decision only concerned refusal of the request for correction under Rule 139 EPC. In this situation the question arises whether the Board competent for deciding on the appeal under Article 21(3) EPC should be chosen according to the (erroneous) formal legal effect as derivable from the cover page or the Register, or rather according to the intended (factual) legal effect as derivable from the body of the decision, in particular its reasons and other statements it contains.

3. The Board is aware of decision T 1382/08 of 30 March 2009, in which under comparable circumstances a Technical Board

of Appeal found that it was competent to decide an appeal filed against a decision on a request under Rule 46(2) EPC 1973 (refund of further search fees). (It is noted that this decision preceded decision G 1/11 of 19 March 2014 of the Enlarged Board of Appeal, deciding that for appeals concerning such requests, when not part of a grant/ refusal, a Technical Board of Appeal is competent). The deciding Board in case T 1382/08 derived the competence of a Technical Board under Article 21(3)(a) EPC 1973 from the formal legal effect of the decision (refusal), in spite of the fact that it was obviously erroneous, as in the present case. Furthermore, also as in the present case, the refusal was entered in the European Patent Register. The deciding Board held that the legal effect of the decision as apparent towards the public was decisive for determining the Board competent pursuant to Article 21(3) EPC 1973 (corresponding to Article 21(3) EPC), see point 1.3 of the Reasons.

4. The present Board does not follow this formal approach, which has certain disadvantages. First of all, such a situation would, in theory, in all likelihood lead to a remittal to the department of first instance on the basis of a substantial procedural violation, on the grounds of missing or contradictory reasons. Simply ignoring the wrong formal order of the appealed decision is not an option, because a possible dismissal of the appeal (on the underlying substantive issue) will make this wrong formal decision final (and as such essentially incurable). Remittal causes significant delay to the proceedings, without seeming to provide any satisfactory legal relief to the appellant. This route was also chosen by decision T 1382/08. Alternatively, a “formally competent” Board taking up the case may choose to decide the case on the merits, but this leads to the rather unsatisfactory situation that the case is decided on its merits by a

Board which in fact is not competent, given the legislative intent behind Article 21(3) EPC. This can be particularly problematic if in this manner the Legal Board rather than a Technical Board decides a case on technical issues (see also G 1/11, point 10 of the Reasons).

5. These disadvantages are also apparent here. A transfer of the case to a Technical Board for the sole purpose of setting the decision under appeal aside, e.g. on the basis of a substantial procedural violation, and remitting the case for correction of the decision does not seem equitable towards the appellant, to whom the error of the Examining Division cannot be imputed. However, this is not necessary. In its decision G 1/11, the Enlarged Board of Appeal found that where in the regulation of the competences between the Technical Boards and the Legal Board a lacuna in the law is discernible, the substantive matters to be decided on should be guiding when assigning the case to the appropriate Board (point 13 of the Reasons). The Enlarged Board of appeal concluded that a lacuna in Article 21(3) EPC existed, in the sense that it could not be established if the legislator had indeed considered the special and apparently contradictory constellation of the substantive issues (unity of the application, a technical question) and the competent Board (the Legal Board) which would have followed from a "blind" application of Article 21(3)(c) EPC. The Enlarged Board of Appeal held in decision G 1/11 that in this situation the substantive issues and procedural economy should be decisive, which clearly pointed to the competence of the Technical Board.

6. The Board holds that the same considerations are applicable here. It can be safely presumed that the legislator did not intend – it could not have seriously intended - to rely on the competence rules of

Article 21(3) EPC in those rare and practically unforeseeable procedural situations where a decision is issued with an obviously erroneous and on an objective view, "impossible" order. This is the case where the formal order of the appealed decision is essentially incomprehensible when compared with the reasons in the body of the decision, in particular when it plainly does not correspond to any of the foreseen possible legal effects flowing from the substantive issue underlying the appealed decision. The present Board holds that in such situations, if the competence is supposed to change from one Board to another only because of the "impossible" order, the order can be disregarded for the purposes of Article 21(3)(a) and (c) EPC, and rather the substantive request underlying the decision must be guiding. In the present case this request concerns the allowability of the correction under Rule 139 EPC in combination with the priority document, as explained in detail in points VIII and XVI-XVII above, an issue that quite obviously does not fall under Article 21(3)(a) EPC. Accordingly, the Board is satisfied that it is competent to decide on the case pursuant to Article 21(3)(c) EPC.

Exchange of application documents under Rule 139 EPC ("Main request")

7. The Examining Division based its decision firstly on the argument that the proposed replacement was not evident because it was not clear if the description or rather the drawings were erroneous. As a second independent argument, the Examining Division held that an exchange of the documents would bring in new subject-matter, contrary to Article 123(2) EPC. The general statement in the application pointing to the priority document and other documents of the applicant could not be relied on, as these were not available to the public or the EPO on the

date of filing the present application. The Board concurs with the substantive conclusions of the Examining Division, though partly with somewhat different reasoning concerning compliance with Article 123(2) EPC.

8. Rule 139 EPC is worded as follows: "Linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request. However, 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."

9. It is undisputed that the requested correction concerns the description and the claims; hence the second sentence of the rule is applicable. The Board does not dispute that the skilled person would have immediately recognised the mismatch between the drawings and the other parts of the description, and therefore would also have sought to find out what the correct (or intended) application documents were. Allowing the correction under Rule 139 EPC here turns on the question whether it would be "immediately evident [for the skilled reader of the application] that nothing else would have been intended than what is offered as the correction", i.e. whether the contents of the priority document were the one and only possible replacement.

10. The Board holds that this is not the case, and in this respect concurs with the conclusion of the Examining Division. If two parts do not match, that alone is not enough to determine which one is wrong. However, even if it were obvious in this case that the description/claims were the wrong ones, the provisions of Rule 139, second sentence, EPC were not met. The Board is of the opinion

that a practically infinite set of perfectly plausible replacements can be imagined when a complete description and corresponding claim set turn out to be erroneous. A description completely corresponding to that of the priority document is only one plausible alternative, admittedly one with a relatively high probability, but still not approaching absolute certainty. So even a replacement with the priority document cannot be regarded as "immediately evident" in the sense that "nothing else would have been intended".

11. This is also not changed by reference to "common sense" or to decision J 4/85 of 28 February 1986 (OJ EPO 1986, 205). Decision J 4/85 is not followed for the reasons explained below, see point 15. Common sense would perhaps lead the skilled person to consult the parallel applications, but it would not provide the firm belief – the immediate evidence - required for Rule 139 EPC. Essentially, this firm belief in the one and only possible correction was also clearly stated in decision G 3/89 of 19 November 1992 of the Enlarged Board (OJ EPO 1993, 117), also relied on by the Examining Division: "if there is any doubt that nothing else would have been intended than what is offered as the correction, a correction cannot be made", see point 6 of the Reasons.

12. The Board also agrees with the further conclusion of the Examining Division that the proposed replacement would bring in added subject-matter infringing Article 123(2) EPC. It is settled case law that Article 123(2) EPC is also applicable to a correction under Rule 139 EPC, see G 3/89 (supra), point 1.4 of the Reasons. The appellant argues that the following passage of the description would lead the skilled person to look at additional sources of disclosure when reading the (allegedly wrong) description of the application:

"Attention is directed to all papers and documents which are filed concurrently with or previous to this specification in connection with this application and which are open to public inspection with this specification, and the contents of all such papers and documents are incorporated herein by reference".

13. The Board is unable to follow this argument. Firstly, this argument is already problematic for the very reason that the reference to the external documents is made in the allegedly erroneous document itself. As a question of simple logic, if a skilled reader noted that a document was erroneous, i.e. contradictory to the extent that it could not be taken to reflect the intentions of its author, then he would be in doubt as to the teaching of the document. This should then also apply to the cited passage, i.e. the instructions themselves to "incorporate by reference" the contents of the external applications. From this it follows directly that any incorporated external content would be equally doubtful, and as such could not be considered to be "clearly and unambiguously" disclosed, as required by the well-established test for Article 123(2) EPC.

14. Secondly, irrespective of the observations above, the Board holds that the mere "availability" to the EPO of the documents in question is, in principle, not relevant. The fictional skilled person, when establishing the content of an application for the purposes of Article 123(2) EPC, can only rely on the application documents. Furthermore, the content of an application is only determined by the specification, i.e. description, claims and drawings. It is another matter that in order to understand any patent application the skilled person inevitably also has to possess certain technical knowledge (the common general knowledge), but such technical knowledge must **by**

definition be publicly available. Put differently, the skilled person will not consult any other documents than the specification, even if he may notice inconsistencies in the specification. In particular, as a rule the skilled person cannot consult parallel (foreign) applications or the priority document in order to determine, still less to define completely, the content of an application at its filing date. The priority document may be taken into consideration only exceptionally, under the quite specific and limited possibility provided by Rule 56 EPC. However, this rule is not applicable here, as explained below.

15. The content of a patent application is **by definition** the specification as filed, as the very existence of a specification - at least a description, see Rule 40(1)(c) EPC - is the basis for according a filing date (see also G 2/95, OJ EPO 1996, 555, points 3 and 4 of the Reasons, further J 21/85, OJ EPO 1986, 117, point 3 of the Reasons). This means that at least the description as filed is inseparable from the accorded filing date (while e.g. drawings may be deleted completely without losing a filing date).

16. Though Rule 40(1)(c) EPC foresees the filing of patent applications by mere reference to a previous application (e. g. an application from which priority is claimed or a parent application), Rule 40(2), second sentence, EPC prescribes that this intention on the part of the applicant must be unmistakeably clear from the application documents, and in this case the contents of the previous application replace *in toto* the description (and drawings, if any), meaning in practice that these need not be filed at all in order for a filing date to be accorded (assuming that Rule 40(3) EPC is complied with). It is noted that the term "replaces" in Rule 40(2), second sentence, EPC means replacing the **requirement** for a physically filed

description in Rule 40(1)(c) EPC, and not the actual replacement of any previously filed description. The general statement in the present application cited by the appellant (see point 12 above) cannot be regarded as an explicit reference in the sense of Rule 40(2) EPC that is capable of defining any identifiable additional technical content for the application as filed that could be taken into account for the purposes of Article 123(2) EPC, even if this might have been the intention of the applicant. This situation is different from that foreseen by Rule 139 EPC, where an isolated error is noted and "automatically" corrected by the skilled person based on the total (technical) information content of the documents forming the application and common general knowledge.

17. The Board further notes that the present case is highly similar to case J 5/06 of 24 November 2006, and also cited in the Case Law of the Boards of Appeal (see Chapter IV.A. 5.5.2 in the 2013 edition). This decision explains that the approach of earlier decision T 726/93 of 1 July 1994 (OJ EPO 1995, 478) - which is also relied on by the present appellant - is not applicable following Enlarged Board decisions G 3/89 (*supra*) and G 2/95 (*supra*). Similar considerations as explained in J 05/06 apply to decision J 4/85 (*supra*), also relied on by the appellant. Thus the reasoning of J 4/85, namely that the intentions of the applicant must be given due consideration when applying Rule 88 EPC 1973 (corresponding to Rule 139 EPC), has been clearly overruled by later jurisprudence, see J 05/06, point 10 of the Reasons.

18. At the oral proceedings the appellant argued that the cited decisions of the Enlarged Board of Appeal were not applicable to the present case, given that G 2/95 and J 5/06 concerned cases where the whole application, and not only a part of it, had to be exchanged. However, the

Board holds that the *ratio decidendi* of these decisions is fully applicable to all cases where at least a complete description is sought to be exchanged. This follows from the principle outlined above that the filing date is inseparable from the description, since it is obvious that allowing an exchange of "only" the description by way of correction would directly result in the separation of the filing date from the description.

19. Thirdly, even if one were to accept that external (non-public) documents could in principle serve as a source of disclosure, in the present case this would not change the conclusion. The Board is aware that according to decision T 689/90 of 21 January 1992 (OJ EPO 1993, 616), under "particular conditions" it may be permissible for an applicant to rely on subject-matter which was intended to be included in the application by reference, see point 2.2 of the Reasons. However, the strict conditions for such an amendment are obviously not met in the present case. The Guidelines, while referring to the requirements as established by decision T 689/90, point out that as a general rule "*Features which are not disclosed in the description of the invention as originally filed but which are only described in a cross-referenced document which is identified in such description are prima facie not within 'the content of the application as filed' for the purpose of Art. 123(2) EPC*". See Part C, Chapter VI 5.3.8 titled "Reference document" of the version in force at the time of filing (version issued June 2005). The Board notes that this wording is also found in the Guidelines currently in force, see Part H, Chapter IV.2.3.1, essentially unchanged as compared with the earlier version. Concerning the "particular conditions" established by decision T 689/90, the Guidelines contain the following: "*Such an amendment would not contravene Art. 123(2) if the description of the*

invention as originally filed leaves no doubt to a skilled reader (see T 689/90, OJ 10/93 616) that:

I. protection is or may be sought for such features;

II. such features contribute to solving the technical problem underlying the invention;

III. such features at least implicitly clearly belong to the description of the invention contained in the application as filed (Art. 78(1)(b)) and thus to the content of the application as filed (Art. 123(2)); and

IV. *such features are precisely defined and identifiable within the disclosure of the reference document.*"

20. The Board holds that in the present case essentially none of the conditions I to IV listed above can be considered to be fulfilled. First of all, the general reference statement in the application (see point 12 above) does not make any specific reference to any identifiable application, let alone to any identifiable features. Secondly, the skilled reader inevitably has to recognise, as submitted by the appellant, that the description is not the correct one. As a result, the skilled reader is deprived of the original frame of reference into which the missing features allegedly found in the reference documents should be fitted, where he cannot even know exactly which reference documents are meant. For this reason, the skilled reader simply cannot proceed to examine the conditions I to IV, let alone ascertain beyond doubt that they are met. This makes it clear that the particular conditions for a possible "incorporation by reference" as established by decision T 689/90 obviously cannot be fulfilled in the present case. Thus the question whether the Examining Division's finding concerning the availability of the priority document and other documents on the date of filing of the present application was correct can be left open.

Extension of the time limit for filing missing parts under Rule 56(3) EPC ("first auxiliary request")

Admissibility of the request

21. This request was first submitted in the grounds of appeal, and no decision was made on it by the Examining Division. However, the Board considers that this request and the submitted grounds in support of the request are closely related to the substance of the appellant's original request, namely the request for correction under Rule 139 EPC. Concerning their substantive effects, both requests have the same purpose, namely the replacement of the "wrong" description/claims with the correct ones. Furthermore, the auxiliary request concerns a rather extraordinary, essentially unforeseen procedural possibility, based on the violation of legitimate expectations, another extraordinary circumstance. Thus it appears justified to consider this request not as a request directed at a separate and independent procedure within the grant proceedings, but rather as ancillary to the disputed issue of the correction under Rule 139 EPC. The relevant facts are all on file and require no further enquiries. Therefore, the Board considers it expedient to deal with the request and admits it under Articles 12(2) and 12(4) RPBA.

Allowability of the request

22. Rule 56(3) EPC permits the later filing of missing parts under certain conditions. One condition is that the missing parts must be filed within one of the two possible time limits under Rule 56(2) EPC. Only one of these time limits is applicable, the other one being a fixed time limit (within two months of the date of filing) set by Rule 56(2), first sentence, EPC and which has already

expired. Thus the setting of a time limit under Rule 56(3) EPC as requested by the appellant must implicitly rely on the other time limit of Rule 56(2) EPC, namely the time limit set by an invitation to file missing parts pursuant to Rule 56(1) EPC. Such an invitation was not issued by the EPO, but the appellant submits that it ought to have been issued as a question of good faith (or legitimate expectation). Quite apart from the fact that the omission of such a communication in the present case did not in any way violate the appellant's legitimate expectations (see below), Rule 56(1), second sentence, EPC is quite clear: "The applicant may not invoke the omission of such a communication". This means that the applicant alone is responsible for filing the correct documents and thus remains responsible for any loss of rights which may have been caused by the filing of wrong application documents. On this basis alone, the "good faith" argument of the appellant cannot succeed.

23. The Board does not examine in depth under which further conditions, e.g. until which stage of the grant procedure, is it possible for the EPO to issue an invitation to file missing parts under Rule 56(1) EPC. The Board notes that according to the Guidelines "it is not permissible [to rely on it] at later stages of the procedure", see Part H, Chapter IV.2.3.2, but otherwise it is not explained when the "later stages of the procedure" commence. The wording of the rule nevertheless implies that this possibility is limited to the examination of the European patent application under Article 90(1) EPC, i.e. the examination on filing under Rule 55 EPC, concerning the requirements for according a filing date. Arguably, the issuance of the invitation under Rule 56(1) EPC is no longer possible once the examination under Article 90(1) and Rule 55 EPC has been completed by the Receiving Section, and this is clearly the case here, implied by the fact that the case

has been transferred from the Receiving Section to the Search Division.

24. Furthermore, reference is made to decision J 27/10 of 9 December 2010, which held that "missing parts of the description" in Rule 56 EPC must mean a genuine part (fraction) of an originally filed description, so that this rule cannot serve as a basis for **substituting** a complete (or even partial) description, see points 11, 12 and 18 of the Reasons.

25. As to the substance of the "protection of legitimate expectations" argument, it is not apparent to the Board that the EPO made any error. As explained above, the examination of application documents for identifying any missing parts under Rule 56(1) EPC is part of the examination under Article 90(1) EPC, the purpose of which is to establish if a filing date can be accorded. Though it is implicit in this rule that the Receiving Section should check if any parts are missing, this can only be done by comparison with the request for grant, which specifically lists the items filed. However, at this stage the Receiving Section does not (and normally cannot) check the technical contents of the application. In particular, it is under no obligation to check whether the reference signs in the abstract correspond to those found in the drawings which are to be published together with the abstract. The Board can accept that it might have been obvious for a formalities officer in the Receiving Section to discover this fact, provided he was consciously looking for concordance between the abstract and the corresponding Fig. 1. This may even be possible without a formal technical qualification. However, the point is that the Formalities Officer simply did not have any obligation to make this check during the examination under Rules 55 and 56 EPC.

26. It is true that the Guidelines instruct formalities officers to notify the applicant under Rule 58 EPC that the abstract does not belong to the application, as part of the procedure under Article 90(3) and Rule 57(d) EPC (see Guidelines, A-III 10.2, also A-III 16.2). However, the primary instruction to formalities staff is that beyond checking the existence of the abstract, its content is normally checked by the Search Division. Only when it is obvious that the abstract does not belong to the application should this be brought to the attention of the applicant. There are no particular instructions in the Guidelines that the reference numerals must be checked. Otherwise there was no indicataion here that the abstract as filed was wrong in any way: it referred to an existing figure (Fig. 1), and had the same title as the description (Display apparatus and control method thereof). The drawings contained figures that were perfectly consistent with such types of inventions (block diagrams and flowcharts). In short, on an objective view, there was nothing in the file that could have established a reasonable, let alone a legitimate expectation that the abstract would be identified by the Formalities Officer as "obviously not belonging to the application".

27. Further arguments by the appellant that it had not been notified of the error in time and therefore could not take certain steps, such as withdrawing the application before publication or requesting re-establishment of rights in the time limit of Rule 56(3) EPC (see points 2.25-26 of the grounds of appeal), are apparently unfounded. According to the file, the extended European search report was issued on 6 February 2009, i.e. approximately four and a half months after the filing date, but still more than three months before publication. The report included the European search opinion (Rule 62 EPC). The search opinion

explicitly stated that "the figures presently on file do not seem to correspond to the disclosure and the claims", see page 2, point 2. Against this background, it remains unexplained why the appellant itself was unable to identify the error earlier than the stated date of 19 January 2010. Under such circumstances, any re-establishment in respect of the time limit of Rule 56 EPC under Article 122 EPC seems hardly possible, quite apart from the other procedural issues that such a request for re-establishment would inevitably raise.

28. The fact that the Search Division approved the abstract pursuant to Rule 66 EPC in the communication issued together with the search report and opinion (see point V above) cannot be objected to. The abstract apparently did correspond to the description. The fact that the figures did not correspond to the description was properly identified by the Search Examiner. It is not apparent what further duty to warn the applicant the EPO might have had at that stage of the proceedings. On this basis, the arguments of the appellant as listed in points 2.21 to 2.31 of the Grounds are apparently without merit. It has simply not been shown that the EPO did not fulfil its obligations in handling the present case.

Further procedure

29. The apparent formal decision to refuse the patent application is obviously wrong. The Board has explained above that remittal to the Examining Division on the basis of a substantial procedural violation would have caused significant delay. A similar delay would be likely if the Board remitted the case to the Examining Division simply with the order to examine if a correction under Rule 140 EPC would be appropriate. Thus the Board decides, also in view of Article 11 RPBA, last passage, to set

aside the decision under appeal with the order to continue the proceedings, but the Board refuses the request under Rule 139 EPC that the application documents be exchanged, as well as the request that a time limit under Rule 56(3) EPC be granted. This appears to the Board the most expedient way of preventing the formally wrong decision (refusal of the application under Article 97(2) EPC) from having any substantive legal effect, particularly in view of the fact that dismissing the appeal would immediately make this formally wrong decision final.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The request for correction of the specification under Rule 139 EPC with the description and claims filed on 19 January 2010 is refused.

3. The request for an extension of the time limit for filing missing parts under Rule 56(3) EPC is refused.

4. The case is remitted to the department of first instance for further prosecution.

The Registrar: The Chairman:

C. Eickhoff T. Bokor

Decision electronically authenticated