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**Datasheet for the decision
of 7 February 2023**

Case Number: J 0003/21 - 3.1.01

Application Number: XXXXXXXX.X

Publication Number:

IPC:

Language of the proceedings: EN

Title of invention:

...

Applicants:

N.N.

Headword:

Relevant legal provisions:

EPC Art. 107, 112(1)(a), 123(2)
EPC R. 40(1)(c), 103(1)(a), 139

Keyword:

Correction of originally filed application documents (no)
Referral to the Enlarged Board of Appeal (no)
Reimbursement of the appeal fee (no)

Decisions cited:

G 0002/95, J 0005/06, J 0016/13, T 0723/02, T 0581/19

Catchword:

1. Mere inconsistencies among the indications in the request for grant of a European patent (EPO Form 1001), and between some of them and the originally filed application documents, are not sufficient to prove an alleged obvious error or the obviousness of a correction offered under Rule 139 EPC.

2. The ban on corrections under Rule 139 EPC by replacement of at least the complete description is categorical.



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Case Number: J 0003/21 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 7 February 2023

Appellant 1: N.N.
(Applicant)

Appellant 2: N.N.
(Applicant)

Appellant 3: N.N.
(Applicant)

Representative: N.N.

Decision under appeal: Decision of the Receiving Section of
17 March 2021 to reject the appellants' requests
for correction of the originally filed
application documents

Composition of the Board:

Chair W. Sekretaruk
Members: C. Almberg
A. Bacchin

Summary of Facts and Submissions

I. The appeal is against the Receiving Section's decision of 17 March 2021 to reject the appellants' ("the applicants") requests for correction of the originally filed application documents.

II. On 29 September 2020, the applicants filed, in the Chinese language, European patent application EP XX XXX XXX.X including an abstract, a description and 25 claims, the latter numbered with Arabic numerals.

III. In the request for grant of a European patent (EPO Form 1001), the applicants were identified, as was the Chinese filing language (box 5.1: "zh"). The number of claims was stated to be "15" (box 29), "as attached" (box 29.1). In the box designated for "Specification in admissible non-EPO language" (box B-1), "Chinese Original.pdf", "15 claims" and "drawing(s)" were indicated. In the two boxes designated for "Translation of specification", respectively "Specification EN.pdf" (box B-3) and "Drawings.PDF" (box B-4) were indicated, in both cases together with "figures(s) to be published: ; abstract".

IV. Alongside the Chinese application documents and the filled-out EPO Form 1001, i.e. still on 29 September 2020, the applicants filed, as a translation of the former, an abstract, a description and 15 claims in the English language, together with seven sheets of drawings with reference signs using Arabic numerals

(e.g. "404") and, for each sheet, lettering using the Latin alphabet (e.g. "FIG.1").

- V. In a telephone conversation with the Receiving Section on 9 October 2020, the applicants were informed of the discrepancy between, on the one hand, the number of claims indicated in EPO Form 1001 and as translated (15) and, on the other, the number of claims in the Chinese original application (25). They were also informed of the missing drawings in this application.
- VI. On 14 October 2020, the applicants filed an abstract, a description and 15 claims in Chinese, along with drawings seemingly identical to those filed on 29 September 2020. This filing was presented as a resubmission of the Chinese original application, "reduced to 15 claims and together with the missing drawings, which were included in the English translation". Furthermore, the applicants assumed that the filing date would not be postponed.
- VII. In a communication of 26 October 2020, the Receiving Section recalled that the originally filed Chinese application remained the basis of the application for the purposes of Articles 123(2) and 54(3) EPC, and therefore could not be replaced, with the effect that the replacement of documents sought by the applicants was unacceptable. Furthermore, the Receiving Section pointed at the deviating number of claims and raised doubts about the accuracy of the translation while reminding that under Article 14(2) EPC the translation may be brought into conformity with the original application at any time during proceedings before the EPO. The Receiving Section however stressed that, in view of the requirements of Article 123(2) EPC, only the Examining Division could decide on such a request.

VIII. By letter of 26 October 2020, the applicants filed an abstract, a description and 25 claims in English. They requested that the originally filed Chinese application documents be corrected by replacement with those filed on 14 October 2020 (main request) or with the originally filed English translation (auxiliary request), or that said translation be brought into conformity with the originally filed Chinese application by replacement of the originally filed 15 English claims with the 25 English claims thus filed on 26 October 2020 (further auxiliary request).

The applicants questioned the Receiving Section's competence to decide on the requests. They further argued, in favour of correction, that the originally filed Chinese application documents were obviously wrong, and that the Chinese claims filed on 14 October 2020 were not materially different from the originally filed Chinese claims, which dependent claims were merely combined to reduce the number of claims.

IX. In a preliminary opinion of 25 January 2021 ("Communication under Article 113 EPC"), the Receiving Section was positive about the request for bringing the translation into conformity, but negative about the other requests as correction by replacement of the originally filed application documents was not allowed under the case law of the Boards of Appeal.

X. In its reply later in the same day, the applicants reiterated that the content of the Chinese claims filed on 14 October 2020 was identical to that of the originally filed Chinese claims, and suggested that the combination of claims made to reduce their number were "amendments within the disclosure". The filings of 14

October 2020 were therefore not a replacement of the application documents but merely a correction of them. In addition, they argued that an obvious error had been made, and that the Receiving Section lacked competence to decide on these matters.

XI. The impugned decision was based on requests made in the letter of 26 October 2020 and the reply of 25 January 2021, as interpreted by Receiving Section, and read as follows:

1. The main request for a correction under Rule 139 EPC of the Chinese application documents as filed dated 26.10.2020 is rejected.

2. The auxiliary request for replacing the Chinese application documents as originally filed with the English text filed on the date of filing dated 26.10.2020 is rejected.

3. The request for bringing the English translation into conformity under Article 14(2) EPC with the originally filed Chinese text dated 26.10.2020 may be granted and the application be prosecuted on that basis once this decision has become final.

4. The request for a correction of the claims under Rule 139, second sentence, EPC must be decided by the Examining Division once it has become competent.

XII. In the decision, the Receiving Section thus viewed the main request as one for correction by exchange of the Chinese application documents as originally filed. With reference to the case law's clear disapproval of any

correction by such an exchange of documents, and to the absent need for a technical assessment, the Receiving Section found itself competent, and rejected the request (cf. decision, points 1 and 9 to 14).

The auxiliary request was, in essence, also viewed as a request for correction by replacement of the originally filed application documents, and rejected on the same basis (cf. decision, points 2, 15 and 16).

As regards the further auxiliary request, i.e. for bringing the English translation into conformity with the originally filed Chinese application documents, the Receiving Section affirmed such a possibility, and laid out the conditions for further prosecution based on the English translation as revised on 26 October 2020 (cf. decision, points 3 and 17 to 19).

Furthermore, the Receiving Section read into the filing of 25 January 2021 a still further auxiliary request, namely for correction by replacement of the Chinese claims filed on 29 September 2020 with those filed on 14 October 2020. The Receiving Section regarded this as a matter of amendment of the claims, not a replacement of application documents, and referred to the Examining Division once competent at the examination stage (cf. decision, points 4, 20 and 21).

XIII. In their combined notice and statement of grounds of appeal, the applicants requested that the impugned decision be set aside and that the appeal fee be reimbursed. They basically asserted that the Receiving Section lacked competence, and that the corrections sought were allowable on the merits. In particular they argued that the only difference between the originally, but mistakenly, filed 25 claims, and the intended 15

claims, was a bundling of dependent claims to reduce the number of claims, and thereby cost, that did not alter the claimed content.

XIV. In the preliminary opinion issued by the Board, the applicants' unspecified substantive requests were assumed to basically correspond to those decided on by the Receiving Section albeit in a slightly different order. The Board provisionally saw no reason to set aside the impugned decision: (i) the requests for replacement of the originally filed Chinese application with that filed on 14 October 2020 or with the originally filed translation (cf. decision, points 1 and 2) both categorically contravened Article 123(2) EPC; (ii) the affirmed allowability of the request for bringing the translation into conformity rendered this part of the decision not appealable (cf. decision, point 3); (iii) the request for replacement of the originally filed Chinese claims were rightly left in abeyance pending technical examination (cf. decision, point 4). In the Board's preliminary view, the Receiving Section also did not appear to have exceeded its competence or otherwise committed any substantive procedural violation.

XV. By letter dated 5 December 2022, the applicants made requests seemingly aiming at replacement of the originally filed Chinese claims with those filed on 14 October 2020, or replacement of the originally filed Chinese application with the originally filed English translation or the English translation filed on 26 October 2020. In addition, they requested referral of two questions to the Enlarged Board of Appeal.

In relevant parts, the applicants argued essentially as follows. The Receiving Section was not competent for

questions relating to Article 123(2) EPC and was thus not entitled to issue the decision. Any correction under Rule 139 EPC presupposes that a new submission of documents takes place. The applicants' resubmission of application documents did not constitute an exchange in the sense of G 2/95 as their content was unaltered. The EPC accepts patent applications to be filed in any language. Just because the Receiving Section was unable to check the conformity of the contents does not mean that a Chinese submission could not be corrected.

XVI. At oral proceedings held before the Board on 7 February 2023, the applicants made clear that points 3 and 4 of the impugned decision were not appealed.

Their final requests, as clarified, were as follows.

The applicants requested that the impugned decision be set aside and:

- that the Chinese description and drawings filed on 29 September 2020 and the corrected Chinese claims filed on 14 October 2020 be regarded as the application documents (main request);

- in the alternative, that the English application documents filed on 29 September 2020 be regarded as the application documents, upon abandonment of the Chinese version filed on the same day (first auxiliary request);

- further in the alternative, that the English application documents filed on 26 October 2020 comprising the English translation of 25 claims be regarded as the application documents (second auxiliary request).

At the same time, the applicants made clear that the second auxiliary request corresponded to the request addressed under point 3 of the impugned decision.

The applicants also requested that the following two questions, as reformulated at oral proceedings, be referred to the Enlarged Board of Appeal:

1. Handelt es sich bei dem rein formalen Akt der neuen Einreichung um einen Austausch der Unterlagen im Sinne der Entscheidung G 2/95? (Is the purely formal act of resubmission an exchange of documents within the meaning of the decision G 2/95?)

2. Wie ist die Beweislast im Falle eines Berichtigungsantrags? (What is the burden of proof in the case of a request for correction?)

Lastly, the applicants requested reimbursement of the appeal fee.

As regards the main request, the applicants argued that the originally filed greater number of Chinese claims was an obvious error and that such an error could be corrected. At the same time, they conceded that the difference in the number of claims meant a 50-50% probability that one or the other number was the right one.

In respect of the first auxiliary request, the applicants referred to the correction of an obvious error, and submitted that they had actually intended to file the application in English.

As to the second auxiliary request, the applicants stated that they maintained it, but, at the same time, confirmed that it corresponded to the request addressed under point 3 of the impugned decision.

Concerning the request for appeal fee reimbursement, the applicants asserted that the Receiving Section lacked competence to take the impugned decision.

Regarding the request for referral of questions to the Enlarged Board of Appeal, the applicants contested that the resubmission of a document constitutes an exchange if the content is unchanged, and that they should bear the burden of proving the unchanged content.

At the end of oral proceedings, the chair announced the Board's decision.

Reasons for the Decision

Main request, first auxiliary request

1. In respect of each of the main request and the first auxiliary request, the applicants seek correction of an "obvious error" allegedly made when they filed the Chinese application documents on 29 September 2020.
2. These factual allegations trigger the application of Rule 139 EPC which reads:

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.

3. According to established jurisprudence of the Boards of Appeal, the general principle is that each party bears the burden of proof for the facts it alleges. It applies no less in the specific case of a proposed correction under Rule 139 EPC where, in addition, the party has to establish such facts to the rigorous standard of "beyond reasonable doubt" (see Case Law of the Boards of Appeal, 10th ed., "CLBA", III.G.5.1.1 and II.E.5, and e.g. T 1248/08, reason 1.1.2, T 723/02, in particular reasons 2.4 to 2.6, and T 581/19, reason 3).
4. The applicants have not provided any evidence at all for the alleged obvious errors of originally filing 25 Chinese claims instead of 15 (main request), and of originally filing the application in Chinese instead of in English as intended (first auxiliary request).
5. Let alone have the applicants proven any of these alleged facts beyond a reasonable doubt.
6. The indications in EPO Form 1001 itself, of the number of claims; "15" (box 29.1) "as attached" (box 29.2), and of the specification in the admissible non-EPO language; "Chinese Original.pdf, 15 claims, drawing(s)" (box B-1), are, in the light of the indicated filing language "zh" (box 5.1), and of the *de facto* filing of 25 Chinese claims, not enough to dispel a reasonable doubt about the applicants' alleged facts.

This conclusion is actually quite in line with the 50-50% probability conceded by the applicants themselves. For these facts could be understood as equally supporting both alternatives: (i) the allegedly

intended filing of 15 claims in English and (ii) the *de facto* filing of 25 claims in Chinese.

7. Furthermore, since the corrections sought concern the claims (main request), respectively at least the description and the claims (first auxiliary request), also the stricter standard of the second sentence of Rule 139 EPC applies across these requests.
8. In addition to falling short of proving the alleged obvious errors regarding the number of claims and the filing language, the applicants have failed to prove the obviousness of the corrections sought, i.e. why it is immediately evident that nothing else would have been intended than what is offered as corrections by the main request and the first auxiliary request.
9. The applicants' alleged intent to keep the costs down is not evidence of the errors alleged or corrections sought and cannot affect the outcome of this review.
10. The applicants have thus failed to fulfill their burden of proof. For this reason alone, neither the main request nor the first auxiliary request is allowable.
11. Nevertheless, for the sake of argument, the Board makes a few more observations.
12. Since the main request is, in effect, merely aimed at correcting the originally filed claims, it appears to reflect the request addressed in point 4 of the impugned decision (cf. above, point XI) which is not appealed. Therefore, the main request would even look inadmissible.

13. The applicants have challenged the Receiving Section's competence to decide on questions relating to Article 123(2) EPC. This argument, however, is relevant only to point 2 of the impugned decision, since no request now on file reflects the one addressed in point 1 (which, in view of the filings of 14 October and 26 October 2020 and 25 January 2021, seems to concern an exchange of the complete application documents), and since points 3 and 4 are not appealed.

14. When deciding point 2, which addresses a request that reflects the present first auxiliary request, the Receiving Section did not exceed its competence (Article 16 in conjunction with Rule 10(1) EPC). That is because, effectively, the request addressed in point 2 aimed at correcting at least the description of the originally filed Chinese application by replacement with at least that of the English translation filed on the same day. The ban on such corrections, established in G 2/95 on the basis of Article 123(2) EPC and further developed in e.g. J 5/06 and J 16/13, is categorical and follows from the principle reflected in Rule 40(1)(c) EPC that the accorded filing date is inseparable from the description as originally filed. An exchange of the description by way of correction would directly result in the separation of the filing date from the description in contravention of Article 123(2) EPC. Refusing such a request for correction does not require any technical examination and technical qualifications, and this principle applies irrespective of any intention of the applicant (see e.g. G 2/95, reason 4, order and headnote, J 5/06, reasons 6 and 10, CLBA II.E.1.14.7 and IV.A.5.5.2, Rule 40(1)(c) EPC, and J 16/13, reasons 15 and 18).

15. The observations made above, in points 12 to 14, apply *mutatis mutandis* to the applicants' further allegations that the fewer claims offered as replacement were merely the result of a bundling of dependent claims, and that the content of the application was unchanged following the resubmission of documents. Also these allegations are unhelpful to the applicants' case.
16. The fact that the particular filing language is Chinese is immaterial to the above assessments.
17. In sum, none of the main request and the first auxiliary request is reason to set aside the appealed parts of the impugned decision.

Second auxiliary request

18. As confirmed by the applicants, the second auxiliary request corresponds to the request addressed under point 3 of the impugned decision which is not appealed.
19. Since the Receiving Section also appears to affirm the corresponding request's allowability, however only so after its decision has become final, i.e. when it is clarified which documents constitute the application and thus the basis for translation, it is questionable whether the applicants are adversely affected by this part of the impugned decision and, thus, whether it is appealable at all (cf. Article 107 EPC).
20. Therefore, the second auxiliary request is not admissible, and also no reason for the Board to set aside the impugned decision.

Referral to the Enlarged Board of Appeal

21. Under Article 112(1)(a) EPC, the Board shall refer any question to the Enlarged Board, if it considers that a decision is required to ensure uniform application of the law, or if a point of law of fundamental importance arises.
22. The questions offered by the applicants do not meet these criteria.
23. The first question is merely theoretical as none of the three requests on file relates to the mere resubmission of an application document that allegedly is already on file. To the contrary, each request involves a *de facto* exchange of application documents previously filed. Therefore, an answer to the first question is not relevant, let alone essential for deciding the present case (see CLBA, V.B.2.3.3).
24. The second question is already answered by the settled jurisprudence (see point 4 above).
25. Referral to the Enlarged Board of Appeal of the two questions is therefore not required (Article 112(1)(a) EPC), and the request is refused accordingly.

Reimbursement of the appeal fee

26. As apparent from the above, the Board deems the appeal not to be allowable. Already therefore, reimbursement of the appeal fee is ruled out (see Rule 103(1)(a) EPC). It is still opportune to recall that the Receiving Section acted within the boundaries of its competence when taking the impugned decision (see above, points 12 to 14), and to add that the Board

detected no procedural violation whatsoever in the first instance proceedings.

Order

For these reasons it is decided that:

1. The request for referral of questions to the Enlarged Board of Appeal is refused.
2. The appeal is dismissed.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chair:



C. Eickhoff

W. Sekretaruk

Decision electronically authenticated