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**Datasheet for the decision  
of 24 June 2008**

**Case Number:** T 0079/07 - 3.2.01

**Application Number:** 98203918.2

**Publication Number:** 0926366

**IPC:** F16C 32/06

**Language of the proceedings:** EN

**Title of invention:**

An hydrostatic bearing with a roughened annular area on the inside surface of the bearing

**Patentee:**

United Technologies Corporation

**Opponent:**

AIRBUS et al.

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 70(4)(b), 101(1)(2)(3), 122(5), 123(3)  
RPBA Art. 20, 21

**Relevant legal provisions (EPC 1973):**

EPC Art. 100, 111(1), 112(1)(a), 125, 138(1)  
EPC R. 89

**Keyword:**

"Competence for verifying conformity of examining division's correction decision with Rule 89 EPC 1973 (no)"  
"Referral to the Enlarged Board of Appeal (no)"  
"Remittal to the first instance (yes)"

**Decisions cited:**

G 0001/84, G 0001/86, G 0001/91, G 0004/91, G 0007/91,  
G 0008/91, G 0009/91, G 0010/91, G 0012/91, G 0009/92,

G 0004/93, G 0009/93, G 0001/95, G 0008/95, G 0001/97,  
J 0012/80, J 0005/81, J 0022/86, J 0010/87, J 0022/95,  
J 0016/99, J 0010/07, T 0099/85, T 0127/85, T 0271/85,  
T 0301/87, T 0198/88, T 0212/88, T 0550/88, T 0695/89,  
T 0371/92, T 0428/95, T 0263/00, T 0402/01, T 0226/02,  
T 0268/02, T 1063/02, T 1093/05

**Catchword:**

Neither the opposition division nor the board of appeal in opposition appeal proceedings has any competence to verify whether the examining division's decision to correct its grant decision complies with the requirements of Rule 89 EPC 1973 (see points 3 to 23 of the Reasons; deviating from T 268/02).



Case Number: T 0079/07 - 3.2.01

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.01  
of 24 June 2008

**Appellant:** United Technologies Corporation  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 6 November 2006  
revoking European patent No. 0926366 pursuant  
to Article 102(1) EPC 1973.

**Composition of the Board:**

**Chairman:** S. Crane  
**Members:** T. Karamanli  
J. Osborne

## Summary of Facts and Submissions

- I. European patent No. 0 926 366 was granted by a decision of 1 April 2004. The mention of the grant was published in the European Patent Bulletin on 12 May 2004.

Claim 1 as granted reads:

"A roughened orifice compensated hydrostatic bearing (10) comprising:

a hydrostatic bearing housing (12), the housing having a cylindrical inside surface with a center and an edge on either side of the center,

the hydrostatic bearing housing (12) having a plurality of orifices (14) for introducing a pressurized fluid into the housing at the center of the inside surface such that the fluid enters the hydrostatic bearing surface at the center and exits at the edges,

a roughened annular area (18) on the inside surface of the hydrostatic bearing characterised in that the roughened annular area (18) is located on the inside surface of the bearing (10) between a nonroughened annular center area (16) between the center and each edge to retard the fluid flow thereby reducing the whirl frequency and increasing the stiffness of the hydrostatic bearing."

- II. On 8 February 2005 a notice of opposition was filed in common by AIRBUS, AIRBUS France, AIRBUS UK Limited, AIRBUS Deutschland GmbH and AIRBUS España S.L. (hereafter: common opponents). The common opposition

was based on the grounds for opposition under Article 100(a) and (c) EPC 1973.

III. In its decision posted on 6 November 2006 the opposition division revoked the patent.

Concerning the ground for opposition under Article 100(c) EPC 1973, the opposition division found that the expression "the roughened annular area (18) is located on the inside surface of the bearing (10) between a nonroughened annular center area between the center and each edge" in claim 1 as granted included subject-matter which extended beyond the content of the application as originally filed and the application therefore had been amended in contravention of Article 123(2) EPC 1973.

With regard to amended claim 1 of the first auxiliary request it was held that the deletion of the term "between the center" did not contravene Article 123(2) EPC 1973, but was not allowable according to Article 123(3) EPC 1973.

IV. With a letter filed on 27 November 2006 UNITED TECHNOLOGIES CORPORATION (hereafter: patent proprietor) requested correction of the examining division's decision of 1 April 2004 to grant the European patent No. 0 926 366. He submitted that claim 1 of the granted patent should be corrected under Rule 89 EPC 1973 as the text of the decision to grant contained an obvious mistake and was manifestly other than intended by the examining division.

V. On 8 January 2007 the patent proprietor filed a notice of appeal against the above-mentioned decision of the opposition division and paid the appeal fee on the same day. The statement of the grounds of appeal was filed on 5 March 2007.

VI. With a decision of the examining division dated 16 May 2007 the decision of 1 April 2004 to grant a European patent was corrected under Rule 89 EPC 1973 so that claim 1 of the corrected European patent specification reads:

"A roughened orifice compensated hydrostatic bearing (10) comprising:

a hydrostatic bearing housing (12), the housing having a cylindrical inside surface with a center and an edge on either side of the center,

the hydrostatic bearing housing (12) having a plurality of orifices (14) for introducing a pressurized fluid into the housing at the center of the inside surface such that the fluid enters the hydrostatic bearing surface at the center and exits at the edges,

a roughened annular area (18) on the inside surface of the hydrostatic bearing, characterised in that the roughened annular area (18) is located on the inside surface of the bearing (18) between a nonroughened annular center area (16) and each edge to retard the fluid flow thereby reducing the whirl frequency and increasing the stiffness of the hydrostatic bearing."

The complete reprint of the European patent specification after correction of the claims was announced in the European Patent Bulletin 40/2007 on 3 October 2007.

- VII. In a letter filed on 13 July 2007 the patent proprietor (appellant) submitted that the grounds for revoking the patent were no longer valid since claim 1 as originally granted had been corrected by the EPO. It requested that the patent be reinstated and maintained on the basis of the corrected claim 1.
- VIII. With a communication dated 21 September 2007 the board drew the parties' attention to the fact that the competence to correct errors in a decision under Rule 89 EPC 1973 lay with the body which took the original decision and thus with the examining division as far as it concerned the correction of its own decision to grant. The board expressed its preliminary opinion that, as a result of the correction, the basis for the opposition division's finding of addition of subject-matter in claim 1 as granted no longer existed. In view of the fact that the opposition division's objection under Article 100(c) EPC 1973 had been removed and the ground for opposition under Article 100(a) EPC 1973 had not been examined by the opposition division, the board indicated that it considered it appropriate to exercise its discretion under Article 111(1), second sentence, EPC 1973 and to remit the case to the first instance for further prosecution.

- IX. In its reply of 8 January 2008 the appellant maintained its request filed on 13 July 2007.
- X. In a letter dated 18 January 2008 the respondents replied to the board's communication. They submitted that the board was competent to decide on the validity of the examining division's decision to correct its decision to grant and that the board had, therefore, to examine whether the requirements of Rule 89 EPC 1973 were fulfilled.
- XI. On 8 April 2008 the board issued a summons to attend oral proceedings to be held on 24 June 2008, together with a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA (OJ EPO 2007, 536)). The board expressed its preliminary opinion that neither the opposition division in opposition proceedings nor the board of appeal in opposition appeal proceedings was competent to review a decision correcting the decision for grant taken by the examining division under Rule 89 EPC 1973. The basis for the present opposition appeal proceedings was therefore the patent according to the corrected decision for grant.
- XII. In a letter received on 23 May 2008 the respondents submitted comments in response and requested that, if the board did not consider itself competent to review the examining division's decision under Rule 89 EPC 1973, the following questions should be referred to the Enlarged Board of Appeal:



1. Can a grant decision be corrected by an examining division under Rule 89 EPC 1973 or Rule 140 EPC 2000 during opposition or ensuing appeal proceedings?
  2. If the answer to question 1 is yes, does the opposition division or board of appeal conducting those proceedings have inherent competence to verify the validity of the examining division's correction decision?
  3. If the answer to question 2 is yes, can the opposition division or board of appeal conducting those proceedings entertain a request that the correction decision be set aside?
- XIII. At oral proceedings on 24 June 2008 the appellant requested that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution on the basis of the patent as granted in the corrected version according to the decision of the examining division dated 15 June 2007. The respondents requested that the appeal be dismissed, or that the questions submitted to the board with a letter of 23 May 2008 be referred to the Enlarged Board of Appeal.
- XIV. The respondents' arguments made orally and in writing, as far as they are relevant to this decision, can be summarised as follows:
- (a) In its decision G 8/95, Reasons, point 3.4, the Enlarged Board of Appeal held that the competence to correct errors in a decision under Rule 89 EPC 1973 lay with the body which had given the

decision. This could be explained by the fact that the instance which had taken the decision knew best whether indeed a mistake had taken place. Rule 89 EPC 1973 envisaged the correction of a clerical mistake, a linguistic error, an error of transcription or a similar obvious mistake. As stated in decision G 8/95, Reasons, point 3.2, a mistake could be corrected where a decision did not express the manifest intention of the deciding body. However, in its decision G 8/95 the Enlarged Board of Appeal had not directed itself specifically to the question of whether Rule 89 EPC 1973 was applicable to grant decisions. Since the EPO practice applied for many years had not been questioned in case G 8/95, the Enlarged Board of Appeal had not to decide on that issue. Moreover, the Enlarged Board of Appeal did not consider the case where a request for correction of the grant decision was filed during pending opposition or ensuing appeal proceedings.

- (b) It was true that correction of the grant decision concerned the *ex parte* grant proceedings which third parties were not party to. Therefore, there should be no general possibility for third parties to interfere in proceedings with regard to the correction of the grant decision. However, it was important to take into account the stage at which the request for correction was made by the patent proprietor and the correction took place. If a correction of the grant decision was made in violation of the provisions of Rule 89 EPC 1973 during opposition proceedings, it was contrary to the substantive provisions governing opposition

proceedings and in particular contrary to Article 123(3) EPC. The mere fact that a correction decision was taken under Rule 89 EPC 1973 did not necessarily mean that the requirements of that provision had been met and that the correction and its retrospective effect were justified. Not the form of the correction decision was decisive, but its content. If, as in the present case, the correction of the grant decision was not justified in view of the EPO jurisprudence with regard to Rule 89 EPC 1973, it contravened Article 123(3) EPC and concerned the substance of the grant decision. Neither the opposition division nor the board in opposition appeal proceedings should be bound by that correction decision.

- (c) According to decision G 1/86, in pending opposition proceedings the principle of equal treatment of all parties, as recognised by the Court of Justice of the European Communities, had to be applied. It was unfair that the patent proprietor could appeal against a decision refusing his request for a correction of the grant decision (T 770/95) whereas the opponent was forced to accept a correction decision which contravened its basic right not to be confronted with an extension of scope of protection conferred by a patent.
- (d) Where, as in the present case, an examining division modified a decision pursuant to Rule 89 EPC 1973 although the requirements for a correction within the meaning of said rule were

not fulfilled, such a modification was *ultra vires* and affected the *res judicata* effect of a final decision. The consequences were the more serious as the correction decision had an *ab initio* effect. Third parties who relied on the patent as originally granted for using an invention could become infringers with regard to altered claims after a correction of the grant decision. Where a correction under Rule 89 EPC 1973 took place, there was no protection of third parties' interests as was foreseen for example in Article 122(5) or Article 70(4)(b) EPC. Therefore, the requirements of Rule 89 EPC 1973 had to be interpreted strictly. Moreover, if an examining division took a correction decision in violation of said requirements, this should have no valid effect with respect to third parties and in particular opponents.

- (e) According to Article 138(1)(d) EPC 1973, a European patent could be revoked under national law if the protection conferred by the European patent had been extended. However, the extension of the scope of protection was determined with respect to the protection of the patent as granted or corrected. Thus, where an erroneous correction decision was taken which extended the scope of protection, third parties were deprived of their right to invoke revocation proceedings.
- (f) In view of these considerations, the opposition division and the board in ensuing appeal proceedings had to verify whether the correction complied with Rule 89 EPC 1973 before it

substituted the original grant decision by the grant decision as corrected. If this view were not followed, the decision of the examining division would encroach on the sphere of competence of the opposition division in opposition proceedings and/or the board of appeal in ensuing appeal proceedings and third parties would be confronted with that decision without having any possibility to defend themselves.

- (g) Since there were no clear EPC provisions or general lines of EPO jurisprudence for the competence of the board of appeal in opposition appeal proceedings to verify whether the correction of the grant decision complied with Rule 89 EPC 1973, it was expedient to look into procedural provisions of the national juridical systems which were applicable pursuant to Article 125 EPC 1973. In French law Article 4, first paragraph of the New Code of Civil Procedure (NCPC) provided that if the mistake concerned a decision contested by appeal, the competence for correcting the mistake lay with the jurisdiction to which the case was referred. In other words the competence was transferred to the appeal instance. This provision was justified in view of the suspensive effect of an appeal and of the endeavour to avoid opposing findings in the appeal decision and the correction decision. Also in § 319 (3) of the German Code of Civil Procedure (ZPO) it was stipulated that a decision allowing a request for correction could be contested by appeal. Thus the board was competent to review the correction decision of the examining division.

Even if explicit competence was denied the opposition division and the board of appeal in opposition appeal proceedings had at least the inherent competence, in view of a possible contravention of Article 123(3) EPC, to verify whether the examining division had correctly applied the provisions of Rule 89 EPC 1973, as was concluded in decision T 268/02. Even if the cited Article 4, first paragraph NCPC of French law did not apply directly in the present case, it should be taken into consideration with regard to an inherent competence of the board.

- (h) With regard to their request for referral to the Enlarged Board of Appeal, the respondents argued that if the present appeal board were to deny any competence for verifying the compliance of the examining division's correction decision with Rule 89 EPC 1973, it would deviate from decision T 268/02 where an inherent competence of the board had been accepted. Although in its decision T 268/02 the board did not specifically amplify its inherent competence, it was clear from the circumstances of the case that, with respect to Article 123(3) EPC, it was important to decide on whether the correction and its retrospective effect were justified or not. The question of the board's competence was also an important point of law within the meaning of Article 112(1)(a) EPC 1973 because this point of law concerned the rights of third parties who should only be confronted with the retrospective effect of a

correction under Rule 89 EPC 1973 if the requirements of that provision were fulfilled.

XV. The appellant's arguments made orally and in writing, as far as they are relevant to this decision, can be summarised as follows:

(a) In its decision G 8/95, the Enlarged Board of Appeal held that the competence for dealing with requests for correction of the decision to grant lay with the body which had taken that decision, i.e. the examining division, and that the form of the decision was corrected and not its substance. The correction decision taken in the present case had replaced the original, unintended, version of granted claim 1 with the proper intended version. This was not an "amendment" of the claim within the meaning of Article 123(2) or 123(3) EPC 1973. The decision to correct the decision to grant was a decision taken by the examining division and therefore a decision in *ex parte* proceedings. It was manifest that the respondents had no right of appeal against the examining division's decision which was effectively what they were seeking. Furthermore, as the respondents had conceded, the EPC did not give any explicit competence to the present board to review the examining division's decision. In support of an inherent competence of the present board the respondents were relying on an extrapolation of French law which was not applicable in present appeal proceedings. Therefore, the present board had no competence at all to verify whether the correction complied with Rule 89 EPC 1973.

(b) The respondents also questioned the applicability of Rule 89 EPC 1973 in general when the correction was made while opposition proceedings were pending. Rule 89 EPC 1973, however, placed no restriction on when a request for correction could be made. Hence there was no need for a referral to the Enlarged Board of Appeal.

(c) Since the basis for the objections under Article 123 EPC which had led to the revocation of the patent had been taken away by the correction of the grant decision, the decision of the first instance was to be set aside and the case remitted to the first instance so that it could prosecute the case on the basis of the patent as granted in the corrected version.

Consequently, the respondents' requests should be denied.

## **Reasons for the decision**

### *Introduction note*

1. The present decision is being taken after the entry into force of the revised European Patent Convention (EPC) on 13 December 2007. At that time, the contested European patent had already been granted. The board has therefore applied the transitional provisions in accordance with Article 7(1), second sentence, of the Revision Act of 29 November 2000 and the decisions of the Administrative Council of 28 June 2001 (Special



edition No. 1, OJ EPO 2007, 197) and 7 December 2006 (Special edition No. 1, OJ EPO 2007, 89). Articles and rules of the revised and former texts of the EPC are cited in accordance with the practice described on page 4 of the 13th edition of the Convention.

*Admissibility*

2. The appeal meets the requirements of Articles 106 to 108 and Rule 64 EPC 1973. Those provisions are to be applied in the present case with regard to the admissibility of the appeal since all the time limits for complying with the conditions for filing an appeal had expired before the revised EPC entered into force (see also J 10/07, to be published in the OJ EPO, Reasons, point 1). Thus the appeal is admissible.

*Competence of the board to verify whether the correction decision of the examining division complies with Rule 89 EPC 1973*

3. In the present case, in accordance with Rule 89 EPC 1973, the examining division corrected errors in its decision to grant after the opposition division had decided that the European patent in suit was revoked and after an appeal was filed against the decision of the opposition division. The respondents assert that it lies within the - at least inherent - competence of the board to verify in the present opposition appeal proceedings whether the decision of the examining division to correct its decision to grant complies with Rule 89 EPC 1973. However, the present board agrees with the appellant and believes that it is not

competent to review this decision of the examining division.

4. The examining division had the authority to correct its own decision to grant under Rule 89 EPC 1973 since the competence to correct errors in a decision lies with the body which has given the original decision (see decision G 8/95, OJ EPO 1996, 481, and for example decisions T 226/02, not published in the OJ EPO; J 16/99, not published in the OJ EPO).

In its decision G 8/95 (loc. cit., Reasons, points 3.3 and 3.4) the Enlarged Board of Appeal concluded that a request for correction of the decision to grant concerns the grant of the patent and that therefore the decision on the correction must also concern the grant of the patent within the meaning of Article 21(3)(a) EPC 1973, since it is the request of the party which defines the subject of the dispute. With regard to the subject of the dispute in the second instance, the Enlarged Board of Appeal ruled that the decisive criterion in Article 21(3)(a) EPC 1973 is not that the decision under appeal is the decision to grant itself, but that it is sufficient for the decision to "concern" the grant and that 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 (Reasons, point 4). The Enlarged Board of Appeal concluded that the technical boards of appeal as defined in Article 21(3)(a) and (b) EPC 1973 have to decide on appeals from a decision of an examining division refusing a request under Rule 89

- EPC 1973 for correction of the decision to grant (Reasons, point 6).
5. From this reasoning of the Enlarged Board of Appeal the board draws the conclusion that a decision of an examining division allowing the request under Rule 89 EPC 1973 for correction of the decision to grant concerns the grant of the patent in *ex parte* examination proceedings and that such a decision can in principle be contested by means of an appeal (see also T 1063/02, not published in the OJ EPO, Reasons, point 1). An administrative act of the EPO which settles a given case finally and in a legally binding way is an appealable decision within the meaning of Article 106(1), first sentence, EPC (see decision T 263/00, not published in the OJ EPO). The board considers that the present correction of the decision to grant amounted to an appealable decision of the examining division because, with regard to the request for correction, it terminated proceedings vis-à-vis the patent proprietor who was the only party in *ex parte* examination proceedings. It is established board of appeal and Enlarged Board of Appeal case law that an examining division is bound by its final decision, which can be set aside only following an admissible, allowable appeal (see G 12/91, OJ EPO 1994, 285, Reasons, point 2; G 4/91, OJ EPO 1993, 707, Reasons, point 7; T 371/92, OJ EPO 1995, 324, Reasons, points 1.4 and 1.5; T 1093/05, OJ EPO 2008, 430, Reasons, point 6).
6. In the present case, however, the appellant contests the decision of the opposition division to revoke its European patent. Thus the present board is acting in

*inter partes* opposition appeal proceedings as a technical board of appeal as defined in Article 21(4)(a) EPC 1973. It has the power to amend the decision of the opposition division within the legal framework determined by the appellant's request, since in appeal proceedings the appellant's request that instituted the proceedings defines the subject of the appeal proceedings and, accordingly, the extent of the power of the board of appeal to decide (G 9/92 and G 4/93, OJ EPO 1994, 875). The board, however, has no appellate competence to review the decision on correction of the grant decision taken in *ex parte* examination proceedings, since that decision does not form the subject of the present appeal proceedings.

7. In support of the asserted appellate competence of the board, the respondents referred to provisions of national law which in their view were applicable to the present case pursuant to Article 125 EPC 1973. In the absence of procedural provisions in the EPC the principles of procedural law generally recognised in the contracting states shall be taken into account pursuant to Article 125 EPC 1973. As is apparent from the preceding reasons the EPC provisions and the EPO jurisprudence are clear on the procedural matter at issue. Therefore, the board does not agree with the respondents that the cited national provisions have to be taken into account in the present case. However, the board notes that the view it takes on its appellate competence is also in accord with the national provisions cited by the respondents.

Article 4, first paragraph of the French New Code of Civil Procedure (NCPC) reads:

*"Les erreurs et omissions matérielles qui affectent un jugement, même passé en force de chose jugée, peuvent toujours être réparées par la juridiction qui l'a rendu ou par celle à laquelle il est déféré, selon ce que le dossier révèle ou, à défaut, ce que la raison commande."*

This provision concerns the competence **for correcting** errors in court decisions. This competence lies either with the court which issued the decision comprising an error or with the court to which said decision was referred. However, its wording does not indicate that an appellate instance could review a correction decision if neither the decision with the error nor the correction decision itself was the subject of the dispute in appellate instance proceedings.

§ 319 (3) of the German Code of Civil Procedure (ZPO) reads:

*"Gegen den Beschluss, durch den der Antrag auf Berichtigung zurückgewiesen wird, findet kein Rechtsmittel, gegen den Beschluss, der die Berichtigung ausspricht, findet sofortige Beschwerde statt."*

From the wording of this provision it is evident that an appeal has to be filed **directly** against the correction decision if a review of said decision is striven for.

8. The respondents argue that, even if the board had no appellate jurisdiction with regard to the decision on correction of the grant decision, it has at least an

inherent competence to verify the validity of the examining division's correction decision within the framework of an opposition procedure. In support of their argumentation they refer to decision T 268/02 (not published in the OJ EPO) where it is stated with no further amplification:

"La division d'opposition a examiné le brevet dans la version corrigée par la division d'examen le 19 décembre 2000 à juste titre. La division d'examen avait bien la compétence pour cette correction car c'est elle qui a rendu la décision de délivrance (G 8/95, JO OEB 1996, 481, motifs 3.4). Par la correction au titre de la règle 89 CBE, une décision n'est pas changée sur le fond mais elle n'est que rétablie dans la forme manifestement envisagée par ses auteurs. Dans ses circonstances, la division d'opposition qui n'a pas apporté la correction, a cependant la compétence incidente de vérifier si la division d'examen a bien pris en compte les dispositions de la règle 89 CBE. Cette dernière compétence revient aussi à la Chambre de recours." (Reasons, point 2)

The respondents' core arguments are that, taking into account the stage at which the request for correction was made by the patent proprietor and the correction took place, the opposition division and the board in opposition appeal proceedings should not be bound by that correction decision if it was made in violation of the provisions of Rule 89 EPC 1973 and in particular contrary to Article 123(3) EPC. The fact that a correction decision was taken under Rule 89 EPC 1973 did not necessarily mean that the correction fulfilled

the provisions of Article 123(3) EPC, since not the form of such decision is decisive, but its content.

9. For the reasons which follow, it is the board's view that neither the opposition division nor the board of appeal in ensuing appeal proceedings has such inherent competence. Thus in this respect the board does not concur with the view taken in decision T 268/02.
10. According to Article 19(1) EPC 1973 the opposition divisions are responsible for the examination of oppositions against any European patent. The substantive examination of the opposition is prescribed in Article 101 EPC. If the opposition is admissible, the opposition division examines whether at least one ground for opposition laid down in Article 100 EPC 1973 prejudices the maintenance of the European patent (Article 101(1) EPC).
11. Article 100 EPC 1973 lays down the exclusive grounds for opposition being limited to and essentially the same as some grounds for revocation under national law (Article 138(1)(a)-(c) EPC 1973). The function of this provision is to provide, within the framework of the EPC, a limited number of legal bases, i.e. a limited number of objections on which an opposition can be based (G 1/95, OJ EPO 1996, 615, Reasons, point 4.1). The non-conformity with the provision of Rule 89 EPC 1973 of an examining division's decision correcting the decision for grant is not one of the grounds of opposition under Article 100 EPC 1973. This has also not been disputed by the respondents. It is established board of appeal case law that further grounds which would lead to a refusal of a European patent

application in the examination proceedings cannot be successfully presented in opposition proceedings (see for example G 1/91, OJ EPO 1992, 253; J 22/86, OJ EPO 1987, 280, Reasons, point 18; T 99/85, OJ EPO 1987, 413, Reasons, point 4; T 127/85, OJ EPO 1989, 271; T 301/87, OJ EPO 1990, 335, Reasons, point 3.3 and 3.4; T 550/88, OJ EPO 1992, 117, Reasons, point 4; T 428/95, not published in the OJ EPO, Reasons, point 4.2). As to this, it is important to bear in mind that opposition is an independent procedure following the grant procedure and is not to be seen as a continuation or extension of the examination procedure (see decisions G 1/84, OJ EPO 1985, 299, Reasons, point 9; G 9/91 and G 10/91, OJ EPO 1993, 408 and 420; and for example decision T 198/88, OJ EPO 1991, 254).

12. If the patent proprietor has made an amendment occasioned by the grounds for opposition, the opposition division must examine whether this amendment to the European patent and the invention to which it relates meets the requirements of the EPC (Article 101(3) EPC). In this context, in particular Article 123(3) EPC has to be taken into consideration which prescribes that the European patent may not be amended in such a way as to extend the protection it confers.
  
13. In the present case, however, it is apparent that the correction of granted claim 1 by the decision of the examining division in accordance with Rule 89 EPC 1973 does not constitute an amendment of the European patent within the meaning of Articles 101(3) and 123(3) EPC. The correction of the grant decision under Rule 89 EPC 1973 concerns only the form in which the decision for



grant was expressed, but not the substance of the decision to grant (see decision G 8/95, *loc. cit.*, Reasons, point 3.3 and T 1093/05, *loc. cit.*, Reasons, point 10). A correction under Rule 89 EPC 1973 has a retrospective effect (T 212/88, OJ EPO 1992, 28) and the incorrect grant decision has been replaced retrospectively by the corrected version. However a change in a granted claim which arises by way of a correction decision issued by the examining division does not amount to an amendment of the claims **after** the grant of the European patent. Where, as in the present case, the decision of the opposition division taken on the basis of the European patent according to the uncorrected grant decision has not become final at the date of the correction due to the suspensive effect of the appeal pending at that time, the corrected version of the patent has to be considered as the granted European patent in opposition appeal proceedings.

Consequently, only a ground for opposition laid down in Article 100 EPC 1973 could prejudice the maintenance of the European patent in its corrected form. It is only amendments which might be made subsequently in the course of the opposition proceedings to the corrected version of the patent which are subject to the requirements of Article 123(3) EPC.

14. The respondents argue that it has to be verified within the framework of opposition proceedings whether the requirements of Rule 89 EPC 1973 were fulfilled since the correction decision of the examining division should not have any effect on opposition proceedings or ensuing appeal proceedings if it were made in violation

of said provision. The board, however, does not agree with the respondents.

15. First of all, it is important to consider the purpose and the legal nature of opposition proceedings. The purpose of opposition is to give opponents the opportunity to challenge the validity of the granted European patent (see G 9/93, OJ EPO 1994, 891, Reasons point 3), whereby the opposition can only be based on a limited number of grounds for opposition under Article 100 EPC 1973 (see point 11 above). As already stated (see point 11 above) opposition is an independent procedure and is not to be seen as a continuation or extension of the *ex parte* examination procedure. Post-grant opposition proceedings under the EPC are in principle to be considered as contentious proceedings between parties normally representing opposite interests (see decisions G 9/91 and G 10/91, loc. cit., Reasons, point 2). Moreover the *inter partes* opposition procedure is a purely administrative procedure and must not be considered as a judicial procedure as is the case for the appeal procedure (see G 7/91 and G 8/91, OJ EPO 1993, 356 and 346, Reasons, point 7; G 9/91 and G 10/91, loc. cit., Reasons, point 18). Opposition is not a legal remedy in the classical sense and it therefore has neither suspensive effect nor the effect of transmitting the case to a superior tribunal (T 695/89, OJ EPO 1993, 152). Under the EPC the opposition division has the competence to decide that the opposition is rejected as inadmissible (Rule 77 EPC), the opposition is rejected (Article 101(2), second sentence EPC), the patent is revoked (Article 101(2), first sentence, or (3)(b) EPC), or the patent is maintained in amended form

(Article 101(3)(a) EPC). In the context of the EPC, however, the opposition division has no appellate jurisdiction to set aside a decision of the examining division.

16. What the respondents are essentially aiming at is a review of a correction decision taken by the examining division after the grant of the patent, justified by an inherent competence of the opposition division.

The fallacy of inherent competence of the opposition division to examine conformity of the correction decision with Rule 89 EPC 1973 can be illustrated by considering the potential outcome. If the opposition division were to find a violation of Rule 89 EPC 1973 it would have to deny the legal effect of the correction (point 13 above) and consider it as an amendment subsequent to the grant of the patent, and therefore subject to the restrictions imposed by Article 123(3) EPC, thereby indirectly reversing the correction decision. A decision can be reversed, however, only as the consequence of an appeal filed against it (see point 5 above), not of an opposition. If, on the other hand, the opposition division were to find no violation of Rule 89 EPC 1973 the correction decision still would not take effect as regards the EPO opposition proceedings until the decision of the opposition division including its finding to that effect becomes final.

17. To recognise an inherent competence of an opposition division to examine and decide on the compliance of the examining division's correction decision with the requirements of Rule 89 EPC 1973 would, moreover,

effectively give opponents the opportunity to act in *inter partes* proceedings on an issue which, in accordance with the EPC provisions and EPO jurisprudence, has to be dealt with in *ex parte* proceedings to which only the patent proprietor can be party (see point 5 above). This, however, is not the purpose for which the opposition proceedings were designed. Therefore, the board cannot accept the respondents' argument that, although there should be no general possibility for third parties to interfere in proceedings with regard to the correction of the grant decision, the situation was different in opposition proceedings where the opponent is confronted with a correction of the grant decision during pending opposition proceedings.

18. The board also does not agree with the respondents' argument that, due to the principle of equal treatment of all parties to opposition proceedings, the opponent should not be forced to accept a correction decision which results in an extension of scope of protection conferred by a patent whereas the patent proprietor could appeal if the examining division were to refuse the request for a correction. The principle of equal treatment of all parties being a procedural principle generally recognised in the contracting states is applicable to opposition proceedings pursuant to Article 125 EPC 1973 and means that all parties must be accorded the same procedural rights (see also G 1/86, OJ EPO 1987, 447, Reasons, points 13 to 15; G 1/97, OJ EPO 2000, 322, Reasons, point 3(a)). If a procedural right is granted to one party in *inter partes* proceedings, the equal procedural right must be given to the other party or parties. For example the parties

must be given an equal right to be heard within the meaning of Article 113 EPC 1973 (see for example T 402/01 of 21 February 2005, not published in the OJ EPO, Reasons, point 11) and, therefore, an equal number of opportunities to comment. However, the principle of equal treatment does not mean that procedural rights given to the applicant or patent proprietor in examination proceedings (or examination appeal proceedings) have to be equally provided for the opponent in opposition proceedings (or opposition appeal proceedings), since both proceedings are independent from each other (see point 11 above).

19. The board has some sympathy for the respondents' argument as to the effect a correction of the grant decision under Rule 89 EPC 1973 might have for third parties. There is indeed an unavoidable risk that a third party relying on the granted patent in the original version may have started to use the invention and that the use would not constitute infringement of the patent in the original version, but of the patent as corrected. The respondents are right in pointing out that the EPC contains no express provisions for protection of third parties in such circumstances analogous to those in Article 122(5) or Article 70(4)(b) EPC. However, in the absence of specific provisions in the European Patent Convention, the solution of any problem of third party rights must be left to the national courts of competent jurisdiction (see also J 12/80, OJ EPO 1981,143, Reasons, point 9; J 10/87, OJ EPO 1989, 323, Reasons, point 11). In any case the possible problem of third party rights does not justify recognising an inherent competence of the opposition division to verify the validity of the examining

division's correction decision since, as stated in point 15 above, such competence would amount to an appellate jurisdiction of the opposition division which is not provided for under the EPC.

20. Also the respondents' reference to national revocation proceedings and their allegation that, where an erroneous correction decision is taken which extends the scope of protection third parties are deprived of their right to invoke national revocation proceedings does not convince the board. Even if, in such circumstances, the European patent only in its corrected version were subject to national revocation proceedings and, therefore, it were no longer possible for third parties to seek revocation on the ground that the protection conferred by the European patent had been extended (Article 138(1)(d) EPC 1973), it indicates that in national revocation proceedings the national court would not review the correction decision of the EPO examining division. Since the concept of post-grant opposition under the EPC has in fact several important features in common with the concept of traditional revocation procedure (G 9/91 and G 10/91, loc. cit., Reasons, point 2), the alleged legal situation in national revocation proceedings supports the board's position that there is no inherent competence of the opposition division to review the correction of the grant decision.

21. Lastly, the board turns to the respondents' argument that even if the provision of Article 4, first paragraph French NCPC did not apply directly in the present case, it should be taken into consideration in accordance with Article 125 EPC 1973 with regard to an

inherent competence of the board in opposition appeal proceedings. As the board explained above (point 7), this provision of French Law concerns the competence **for correcting** errors in court decisions and does not imply an appellate competence of the present board for reviewing an examining division's correction decision in opposition appeal proceedings. This is all the more so as regards inherent competence of the opposition division which has no appellate competence at all (see point 15 above).

The board is also of the view that § 319 (3) of the German ZPO does not provide a basis for an inherent competence of the opposition division. This national provision rules that an appeal has to be filed **directly** against the correction decision if a review of said decision is striven for (see point 7 above) which means that an appellate competence of the deciding body is necessary for a review. However, as stated above an opposition division does not have such competence.

22. In view of the above considerations the board concludes that the opposition division in opposition proceedings has no inherent competence to review the correction decision taken by the examining division. Thus the opposition division would act *ultra vires* if it were to verify whether the correction of the grant decision of the examining division fulfilled the requirements of Rule 89 EPC 1973. The same applies to the board of appeal in opposition appeal proceedings (Article 111(1), second sentence EPC 1973).
23. Since the board comes to the conclusion that there is no competence of the board to verify whether the

examining division's correction decision complies with the requirements of Rule 89 EPC 1973, it has no power to deal with any issue raised by the respondents with regard to the requirements of said rule, in particular whether a grant decision can be corrected under Rule 89 EPC 1973 during opposition or ensuing appeal proceedings.

*Referral to the Enlarged Board of Appeal*

24. The respondents requested that questions be referred to the Enlarged Board of Appeal. The respondents based their request for referral on the argument that a negation of the board's competence for verifying whether the correction complied with Rule 89 EPC 1973 would be prejudicial to ensuring uniform application of the law in view of decision T 268/02 (see point 8 above). Furthermore, an important point of law was concerned since the matter touches on the rights of third parties and in particular of opponents.
  
25. According to Article 112(1)(a) EPC 1973, a board of appeal shall, either of its own motion or upon request from a party, refer any question of law to the Enlarged Board of Appeal in order to ensure uniform application of the law, or if an important point of law arises, if it considers that a decision is required for the above purposes.

The requirement "to ensure uniform application of the law" is fulfilled if the board deems it necessary to deviate from the interpretation or explanation of the EPC contained in another decision of a board of appeal, or if there are diverging decisions of two boards



(Moser, "Münchener Gemeinschaftskommentar zum EPÜ", 1997, Artikel 112, Note 19; Benkard, "Europäisches Patentübereinkommen", München 2002, Artikel 112, Note 5). However, in accordance with Article 112(1)(a) EPC 1973, a referral is only made when the board considers that a decision of the Enlarged Board of Appeal is required. In this context also Articles 20 and 21 RPBA have to be taken into consideration. According to these provisions, the referral of questions to the Enlarged Board of Appeal must be made in cases where the board considers it necessary to deviate from an interpretation or explanation of the EPC contained in an earlier opinion or decision of the Enlarged Board of Appeal (Article 21 RPBA). However, whenever the board wishes to deviate from an earlier decision of a board of appeal, the referral is not compulsory, but the grounds for the deviation have to be given unless such grounds are in accordance with an earlier opinion or decision of the Enlarged Board of Appeal (Article 20(1), first sentence, RPBA). The present board avails itself of this discretion and does not refer questions to the Enlarged Board of Appeal. The board has explained in detail (see points 8 to 23 above) why, contrary to the board in decision T 268/02, it does not consider that the opposition division or the board of appeal in ensuing appeal proceedings has an inherent competence to verify whether the correction decision taken by the examining division fulfils the requirements of Rule 89 EPC 1973.

26. "An important point of law" within the meaning of Article 112(1)(a) EPC 1973 arises if that point is of fundamental importance in that it is relevant to a substantial number of similar cases and is therefore of

great interest not only to the parties in the present appeal but also to the public at large (see for example T 271/85, OJ EPO 1988, 341). A question regarded as an important point of law does not need to be referred to the Enlarged Board of Appeal if the question can be answered beyond all doubt by the board itself (see for example J 5/81, OJ EPO 1982, 155 and T 198/88, loc. cit.; J 22/95, OJ EPO 1998, 569; Case Law of the Boards of Appeal, 5th edition 2006, VII.D.13.2 with further references).

27. The present board considers that cases in which a correction of a grant decision is an issue in opposition or opposition appeal proceedings will occur only extremely infrequently, so that the number of those who might be negatively affected provides no reason for a referral. Indeed, to the board's knowledge no previous case other than that of T 268/02 has occurred. Even if this were not the case, as set out above (points 8 to 23), the board does not have any doubts that there is no basis for any inherent competence of the opposition division or the board of appeal in ensuing appeal proceedings to verify whether a correction of a grant decision complies with the requirements of Rule 89 EPC 1973. Hence no important point of law arises or needs to be clarified by the Enlarged Board of Appeal. Finally, the first of the questions prepared by the respondents concerns the conditions under which a correction under Rule 89 EPC 1973 may be made. This question, however, is not decisive in the present case, since the board has come to the conclusion that there is no inherent competence of the board to review the examining division's correction decision.

28. For these reasons the board does not see a necessity to refer the respondents' questions to the Enlarged Board of Appeal.

*Remittal to the first instance*

29. Due to the effect of the correction decision under Rule 89 EPC 1973 of the examining division (see in particular point 13 above), the basis for the present opposition appeal proceedings is the corrected granted patent. Claim 1 of the corrected patent no longer includes the subject-matter found by the opposition division to extend beyond the content of the application as originally filed. Consequently, the only reason given in the contested decision which prejudiced the maintenance of the granted patent no longer exists and the decision of the first instance must be set aside. However, the grounds for opposition have not been examined by the opposition division on the basis of the corrected granted patent. In order to give the parties the opportunity to prosecute their rights at two instances of jurisdiction, the board considers that the department of first instance should examine whether a ground for opposition prejudices the maintenance of the corrected granted patent. The board thus makes use of its power under Article 111(1) EPC 1973 to remit the case to the first instance for further prosecution.

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The request for referral to the Enlarged Board of Appeal is rejected.
3. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

A. Vottner

S. Crane