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**Datasheet for the decision
of 16 March 2010**

Case Number: T 1349/08 - 3.3.10

Application Number: 99201230.2

Publication Number: 0952132

IPC: C07C 1/06

Language of the proceedings: EN

Title of invention:

Process for the preparation of hydrocarbons from synthesis gas

Patentee:

AGIP PETROLI S.p.A., et al

Appellant:

ExxonMobil Research and Engineering Company

Headword:

Hydrocarbon preparation/AGIP PETROLI

Relevant legal provisions:

EPC Art. 60(3), 64(1), 94(3), 97(4), 99(1), 100(1), 112(1)(a),
115, 125

EPC R. 139, 140

Relevant legal provisions (EPC 1973):

EPC R. 88, 89

Keyword:

"Third party, even when opponent indirectly affected in
opposition proceedings, has no party status in examination
proceedings"

"Correction of decision to grant"

Decisions cited:

G 0001/97, G 0003/98, J 0042/92, J 0027/96, T 0198/88,
T 0850/95, T 0777/97, T 0713/02, T 1093/05, T 0079/07

Catchword:

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Case Number: T 1349/08 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 16 March 2010

Appellant: ExxonMobil Research and Engineering Company
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 20 May 2008.

Composition of the Board:

Chairman: R. Freimuth
Members: J. Mercey
J.-P. Seitz
C. Komenda
F. Blumer

Summary of Facts and Submissions

- I. The Appellant, ExxonMobil Research and Engineering Company, lodged an appeal on 9 June 2008 against the decision of the Examining Division dated 20 May 2008 refusing to withdraw its decision to correct the decision to grant European patent No. 952 132 and to reinstate the original decision to grant. The Appellant is the Opponent in opposition proceedings pending on this patent and the Respondent is the Patent proprietor.
- II. The decision to grant European patent No. 952 132 was issued on 7 February 2002 and was published on 20 March 2002 in the Bulletin 2002/12. Following the filing of a "petition to amend" by the Respondent dated 17 May 2002, a decision to correct the decision to grant under Rule 89 EPC 1973 was taken on 5 July 2002. This decision to correct was not published in the Register of European Patents. Notice of Opposition was filed by the Appellant on 20 December 2002 requesting revocation of the patent under Articles 100(a) and (b) EPC. In a letter to the Examining Division dated 12 July 2004, the Appellant requested that the original decision of 7 February 2002 to grant the patent be reinstated, either by withdrawal of the correction of 5 July 2002 or by a further correction under Rule 89 EPC 1973. As an auxiliary request, the Appellant requested an appealable decision by the Examining Division setting out the basis for maintaining the changes made on 5 July 2002. By a communication dated 17 September 2004, the Opposition Division indicated that in view of the Opponent's request for an appealable decision by the Examining Division regarding the decision to correct the decision to grant dated 5 July 2002, the date

already fixed for oral proceedings before the Opposition Division was cancelled and a new date would be fixed after the requested decision of the Examining Division, namely the decision now under appeal, had become final.

III. In the contested decision dated 20 May 2008, the Examining Division held that the present Appellant, not being a party to the examination proceedings, was thus not entitled to request reinstatement of the decision to grant European patent No. 952 132 dated 7 February 2002, such that its requests to this effect filed with the letters dated 12 July 2004 and 23 January 2007 were rejected as inadmissible. It further indicated that the decision to correct the decision to grant taken on 5 July 2002 under Rule 89 EPC 1973 corresponded to the real intention of the Examining Division and thus could not be further amended, said decision having become final and the Examining Division being now bound by it.

IV. The Appellant argued that it was a party to the examination proceedings on the patent in suit, since it was at least a party to the opposition proceedings concerning the patent in suit and these opposition proceedings were affected by the decision of the Examining Division dated 20 May 2008 not to reinstate the decision to grant dated 7 February 2002, since the wording of claim 1 of the opposed patent, which formed the basis of the opposition proceedings, could thereby have been changed. The Appellant further argued that it had acquired party status in the examination proceedings by virtue of the Opposition Division's decision of 17 September 2004 referring the case back to the Examining Division for a decision on the

Appellant's request for reinstatement of the original decision to grant. In any case, according to the decision J 27/96 (see point 3.2 of the Reasons, not published in OJ EPO), correction of a mistake was an isolated procedural measure and not a case of reestablishment into a defined procedural phase as a whole. Thus a correction under Rule 140 EPC 2000 (Rule 89 EPC 1973) was not part of the examination proceedings and the Appellant was entitled to become a party to a legal dispute relating to an isolated procedural measure when this impacted the opposition proceedings. It was adversely affected by the contested decision, since said decision prevented the Appellant from challenging the post-grant amendment, which amendment contravened Article 123(3) EPC, the post-grant amendment not being an allowable correction, under either Rule 139 or 140 EPC 2000. As such, the Appellant argued that its legitimate expectations had not been protected, and further relied on the provisions of Article 125 EPC, stating that the EPO should take into account the principles of procedural law generally recognised in the Contracting States.

- V. The Respondent argued that the appeal was not allowable, since the Appellant was not a party to the examination proceedings which led to the original decision to grant, the decision of correction of the Examining Division dated 5 July 2002 also being within the scope of these examination proceedings. Any submissions made by the Appellant before the Examining Division could thus only be considered to be third party observations in the meaning of Article 115 EPC; it could not thereby fictitiously become a party to these examination proceedings. The decision J 27/96 cited by the

Appellant did not state that a request for correction instituted new independent proceedings which were not part of the examination proceedings, but merely that such a correction did not reinstate the terms to take specific procedural steps within the examination proceedings.

- VI. The Appellant requested as main request that the decision under appeal be set aside, and that the genuine decision to grant dated 7 February 2002 be reinstated. As a first auxiliary request, it requested that the decision under appeal be set aside and that the matter be referred back to the Examining Division with an order that it refuse the correction under Rule 140 EPC 2000 in relation to the "petition to amend" filed by the Patentee dated 17 May 2002. As a second auxiliary request, it requested that the decision under appeal be set aside and that the matter be referred back to the Examining Division with an order that it make a further correction under Rule 140 EPC 2000 to reinstate the original decision to grant. The Appellant further requested that a question be referred to the Enlarged Board of Appeal under Article 112 EPC, namely whether an opponent can be an adversely affected party to proceedings relating to correction of a decision to grant under Rule 140 EPC 2000 (or Rule 89 EPC 1973).

The Respondent requested that the appeal be dismissed.

- VII. Oral proceedings were held on 16 March 2010 in the absence of the Respondent, who, after having been duly summoned, informed the Board by a letter dated 15 January 2010 that it would not attend. At the end of

the oral proceedings, the decision of the Board was announced.

Reasons for the Decision

1. The question of whether the present appeal is admissible and whether the decision of the Examining Division dated 20 May 2008, hereinafter referred to as the "decision", was a genuine decision in the sense of Article 106(1) EPC need not be decided upon in the present case, as the appeal is in any case not allowable.

2. *Party status of Appellant*
 - 2.1 The Examining Division, in a decision dated 5 July 2002, corrected the decision to grant a European patent issued on 7 February 2002 pursuant to Rule 89 EPC 1973.

On a request of the Appellant, the Examining Division, in a "decision" dated 20 May 2008, decided that the Appellant was not a party to examination proceedings and was thus not entitled to request reinstatement of the original decision to grant and all its requests were thus rejected as inadmissible.

 - 2.2 The object underlying this dispute is the request of the Appellant to the Examining Division to cancel its decision to correct the decision to grant and to reinstate its original decision to grant.

Thus the present dispute lies within the framework of examination proceedings, the Appellant's request being

directed to the Examining Division and the "decision" under appeal dated 20 May 2008 being issued by the Examination Division.

The question arises, whether the Appellant, being neither the applicant nor the patentee, could nevertheless become a party to the examination proceedings.

- 2.3 The correction of the decision to grant a European patent as well as the decision refusing the Appellant's request to withdraw said decision to correct and to reinstate the original decision to grant underlying the present dispute belongs to the examination proceedings pertaining to said European patent and have been taken by the competent Examining Division. Examination proceedings are *ex parte* proceedings between the European Patent Office and the applicant/patentee (see Articles 60(3) and 94(3) EPC). Analogous to Article 115 EPC, which stipulates that a person submitting observations concerning the patentability of an invention shall not be party to the proceedings before the EPO, a person contesting the allowability of a correction of a decision to grant a European patent under Rule 140 EPC 2000 and requesting reinstatement of the original decision to grant, cannot thereby become a party to the proceedings. The Appellant, being neither the applicant nor the patentee, thus cannot be party to the examination proceedings.

Therefore the Appellant, not being party to the examination proceedings, has no party status in the present examination proceedings.

This was the conclusion of the Examining Division in its "decision" of 20 May 2008 and the Board shares this view. Consequently, irrespective of whether or not the Appellant is adversely affected by said "decision", it cannot acquire the quality of party status to the examination proceedings.

- 2.4 Therefore, the appeal is to be dismissed.

- 2.5 For the following reasons, the Board is not convinced by the Appellant's submissions as to why it should indeed be regarded as a party to the examination proceedings.
 - 2.5.1 The Appellant submitted that it was at least a party to the opposition proceedings concerning the patent in suit, that these opposition proceedings were affected by the "decision" of the Examining Division dated 20 May 2008 not to reinstate the decision to grant dated 7 February 2002, and the Appellant was adversely affected thereby in these opposition proceedings.

However, the party status of an opponent in opposition proceedings cannot be transferred to examination proceedings, opposition proceedings and examination proceedings being separate proceedings (see T 198/88, OJ EPO, 1991, 254, point 2.1 of the Reasons). Whether the opposition proceedings are affected or not by a decision issued in the course of examination proceedings is irrelevant to the matter of whether the Appellant, who is opponent in opposition proceedings, may acquire party status in the examination proceedings in view of the separate nature of these proceedings. The submission that the Appellant might be adversely

affected by the "decision" of the Examining Division dated 20 May 2008 may give the Appellant an interest to act, but is irrelevant to the legal question of party status, an interest to act not in itself conferring party status in proceedings to which the Appellant was not a party.

- 2.5.2 The Appellant further argued that in the particular circumstances of this case it was indeed party to the examination proceedings because the Opposition Division, by virtue of its decision of 17 September 2004 cancelling the date for oral proceedings already fixed and indicating that a new date would be fixed after the requested decision of the Examining Division had become final, had thereby recognised that the Examining Division should address the Appellant's request for an appealable decision by the Examining Division regarding the decision to correct the decision to grant dated 5 July 2002, the Appellant hereby acquiring party status.

However, irrespective of whether or not the communication of the Opposition Division dated 17 September 2004 bore all the characteristics necessary for qualifying as a decision and, thus, could in fact constitute a decision, and whether or not the Opposition Division indeed had the power to refer the case back to the Examining Division, examination proceedings are *ex parte* proceedings (see point 2.3 above) which are separate from opposition proceedings (see point 2.5.1 above) which by nature are *inter partes* proceedings. As such, no action of the Opposition Division could confer party status to an opponent in examination proceedings on the same case,

it indeed being questionable whether or not opposition and examination proceedings may coexist for the same application/patent.

- 2.5.3 The Appellant further submitted that correction of a decision to grant a European patent did not form part of the examination proceedings but was an isolated procedural measure, citing J 27/96 (*loc. cit.*) in this respect, thus the Appellant was entitled to be party to this isolated procedural measure.

However, decision J 27/96 is concerned with Rule 88 EPC 1973 (Rule 139 EPC 2000), which applies to corrections of errors in documents filed before the European Patent Office, whereas the Appellant is objecting to a decision concerning a correction under Rule 140 EPC 2000 (Rule 89 EPC 1973), which applies to decisions of deciding bodies of the EPO. In any case, the Appellant cannot be party to an isolated procedural measure, but only to proceedings as a whole, the decision J 27/96 merely stating that the applicant which requested a correction of a mistake in documents was not thereby reinstated in a particular procedural phase which would thereby have made said whole procedural phase available to him again. Thus, the decision J 27/96 is not relevant to the present case, the correction of a decision to grant a European patent being within the scope of examination proceedings.

- 2.5.4 The Appellant cited Article 125 EPC, stating that if the European Patent Office were to take into account the principles of procedural law generally recognised in the Contracting States, the Appellant would become a party to the examination proceedings.

However, the Board notes that Article 125 EPC provides for taking such principles into account only in the absence of procedural provisions in the EPC. This Article thus does not refer to the absence of a procedure but only to the absence of procedural provisions. Since there is no procedure in the EPC for creating party status for a third party in examination proceedings, indeed on the contrary, it is specifically provided for in Article 115 EPC that a third party shall not be party to the proceedings before the EPO (see point 2.3 above), there can be no absence of procedural provisions. In any case, the Appellant did not substantiate its argument and did not provide corroborating evidence that in the majority of, or in any particular Contracting States, there existed some modus for creating party status for a third party in examination proceedings on patent applications. Thus regardless of whether procedural provisions are absent in the EPC, the absence of such provisions being a prerequisite for the application of Article 125 EPC, the Board concludes that in the absence of any evidence of relevant procedural principles from the Contracting States, said Article cannot serve as a basis for creating a special legal remedy making it possible for a third party to attain party status in examination proceedings (see G 1/97, OJ EPO 2000, 322, point 3 of the Reasons).

2.5.5 The Appellant submitted that its legitimate expectations had not been protected, the published text of the patent it had opposed, namely European patent No. 952 132, having been amended post-grant in an unallowable manner, the Appellant being adversely

affected thereby as it was now prevented from challenging the post-grant amendment in opposition proceedings under Article 123(3) EPC.

However, any legitimate expectations the Appellant may have resulting from the publication of the decision to grant of European patent No. 952 132 may be relevant only to the opposition proceedings pending on this case (see point 5.3 below) to which the Appellant would appear to be a party, namely in its quality as opponent. Regardless of whether or not the Appellant has any legitimate expectations in the examination proceedings, legitimate expectations are not in themselves a ground for generating party status to the present examination proceedings, just as they would not be for any other member of the public, which may also have legitimate expectations in examination proceedings.

3. Since the Appellant has no party status in these examination proceedings, the appeal is not allowable, party status being a prerequisite for the Board to allow any of the Appellant's main, first and second auxiliary requests.
4. *Referral to the Enlarged Board of Appeal*
 - 4.1 According to Article 112(1)(a) EPC, a referral to the Enlarged Board of Appeal is only admissible if a decision is required in order to ensure uniform application of the law or if an important point of law arises. The answer to the referred question should not be merely of theoretical or general interest, but has to be decisive, i.e. essential, to reach a decision on

- the appeal in question (see, for example, G 3/98, OJ EPO 2001, 62, point 1.2.3 of the Reasons).
- 4.2 The question put forward by the Appellant (see point VI above) concerns the issue of whether an opponent could be an adversely affected party to proceedings relating to correction of a decision to grant under Rule 140 EPC 2000 (or Rule 89 EPC 1973). Since, however, the decision for correction itself dated 5 July 2002 is not the decision under appeal in the present proceedings, but rather the "decision" of 20 May 2008 concerning the reinstatement of the original decision to grant, the answer to the proposed question cannot be decisive in the present case.
- 4.3 The issue addressed in the proposed question thus being merely of theoretical nature, any answer of the Enlarged Board of Appeal to that question is irrelevant for deciding on the present appeal, and hence the request for referral of the question must be refused.
5. The following comments of the Board do not form part of the *ratio decidendi* of this decision. However, in view of the unusual nature of this case, *inter alia* the following points may need attention when the opposition proceedings pending on this case resume.
- 5.1 Under Articles 99(1) and 101(1) EPC, the Opposition Division shall examine whether or not at least one ground for opposition prejudices the maintenance of the European patent. Thus the Opposition Division should identify the subject-matter of the patent which forms the basis of the opposition proceedings in order to

determine the object of the legal dispute, this being the competence and duty of every deciding body.

5.2 Thus it appears that the subject-matter of the opposed patent should be determined. This is usually the subject-matter as defined in the published granted patent. If, as in the present case, an amendment has been carried out after mention of grant of the European patent in the Bulletin, then the deciding body, in this case the Opposition Division, may need to decide whether or not this amendment may further define the subject-matter of the opposed patent to be decided upon in opposition proceedings under Article 101 EPC.

5.3 When deciding on whether the amendment should be taken into account, the Opposition Division may need to consider whether or not the amendment carried out after publication of the decision to grant in the Bulletin (see Article 97(4) EPC) has any effect, particularly in view of any "cut-off" effect of said publication (see T 777/97, point 3, last paragraph of the Reasons and J 42/92, points 5 and 6 of the Reasons) due to the jurisdiction passing to the Contracting States from this date (see Article 64(1) EPC). The question thus may arise whether or not the Examining Division had the competence to act after this date due to an exhaustion of its competence *ratione materiae* as well as *ratione legis*. Furthermore, the interests of the public in respect of legal certainty may also have to be taken into account (see G 1/97, *loc. cit.*, point 3(c) of the Reasons and T 713/02, OJ EPO 2006, 267, point 2.2.6 of the Reasons), the date of publication of the decision to grant in the Bulletin being the starting date for

the nine month period in which opposition may be filed (Article 99(1) EPC).

- 5.4 If an amendment has been allegedly carried out under Rule 140 EPC 2000, the Opposition Division may need to determine whether or not said amendment was in fact a genuine correction under Rule 140 EPC 2000 (see T 1093/05, OJ EPO 2008, 430, point 7 of the Reasons and T 850/95, 1997, 152, Headnote I). The Opposition Division may indeed not have the right to verify the substance of a correction under Rule 140 EPC 2000 (see T 79/07, points 3 to 23 of the Reasons, not published in OJ EPO), but, in view of the discretionary nature of the decision to correct, it may have the competence and duty to verify whether the proper criteria were applied in determining whether the correction made did indeed qualify as a correction pursuant to Rule 140 EPC 2000, or whether the use of Rule 140 EPC 2000 as a legal basis was unjustified, e.g. the Examining Division, under Rule 140 EPC 2000, had in fact reopened examination proceedings.

Order

For these reasons it is decided that:

1. The request for referral of a question to the Enlarged Board of Appeal is rejected.
2. The appeal is dismissed.

The Registrar:

The Chairman:

C. Rodríguez Rodríguez

R. Freimuth