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**Datasheet for the interlocutory decision  
of 17 June 2010**

**Case Number:** T 1145/09 - 3.5.03

**Application Number:** 99115002.0

**Publication Number:** 0961184

**IPC:** G05B 19/418

**Language of the proceedings:** EN

**Title of invention:**

System for use in a field device management

**Patentee:**

Fisher-Rosemount Systems, Inc.

**Opponent:**

Endress+Hauser (Deutschland) AG+Co. KG

**Headword:**

Stay of proceedings/FISHER-ROSEMOUNT

**Relevant legal provisions:**

EPC Art. 100(c), 106(2), 112(1)(a), 123(2)(3)  
EPC R. 140

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

EPC R. 89

**Keyword:**

"Request for correction of grant decision filed after  
initiation of opposition proceedings - admissibility -  
competence - referral of questions to the Enlarged Board of  
Appeal"

**Decisions cited:**

G 0008/95, G 0001/97, G 0002/04, T 0850/95, T 0226/02,  
T 0268/02, T 0079/07

**Catchword:**

The following questions are referred to the Enlarged Board of Appeal for decision:

1. Is a patent proprietor's request for correction of the grant decision under Rule 140 EPC which was filed after the initiation of opposition proceedings admissible? In particular, should the absence of a time limit in Rule 140 EPC be interpreted such that a correction under Rule 140 EPC of errors in decisions can be made at any time?

2. If such a request is considered to be admissible, does the examining division have to decide on this request in ex parte proceedings in a binding manner so that the opposition division is precluded from examining whether the correction decision amounts to an unallowable amendment of the granted patent?



Case Number: T 1145/09 - 3.5.03

**INTERLOCUTORY DECISION**  
of the Technical Board of Appeal 3.5.03  
of 17 June 2010

**Appellant:** Endress+Hauser (Deutschland) AG+Co. KG  
(Opponent) Colmarer Strasse 6  
D-79576 Weil am Rhein (DE)

**Representative:** -

**Respondent:** Fisher-Rosemount Systems, Inc.  
(Patent Proprietor) 8301 Cameron Road  
Austin, Texas 78754 (US)

**Representative:** Bohnenberger, Johannes  
Meissner, Bolte & Partner GbR  
Widenmayerstrasse 48  
D-80538 München (DE)

**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
12 March 2009 staying opposition proceedings  
concerning European patent No. 0961184.

**Composition of the Board:**

**Chairman:** A. S. Clelland  
**Members:** R. Moufang  
F. van der Voort

## **Summary of Facts and Submissions**

- I. These are the second appeal proceedings concerning procedural issues arising from an opposition against European patent 0 961 184.
  
- II. The opposition was based on the ground of added subject-matter (Article 100(c) EPC). The opponent argued that a feature contained in claim 1 of the opposed patent ("means for initiating (56) a command related to a position of the device data") was not originally disclosed so that the patent included subject-matter extending beyond the content of the application as filed.
  
- III. The proprietor submitted in its reply to the opposition that a typographical error had occurred when claim 1 had been amended in the course of the pre-grant procedure and that the feature should read "means for initiating (56) a command related to a portion of the device data" (i.e. "portion" instead of "position"). It requested inter alia that the opposition proceedings be stayed and that the case be remanded to the examination division for re-issuance of the granted patent after correction under Rule 89 EPC 1973.
  
- IV. On 2 November 2006 a formalities officer acting for the opposition division sent out a communication to the parties stating inter alia that the case was referred to the examining division and that the examination of the opposition was adjourned pending the final decision of the examining division.

- V. An appeal filed by the opponent against this communication was rejected as inadmissible by the present board in a different composition. In its decision T 165/07 of 23 November 2007, the board considered that the appealed communication did not constitute a decision within the meaning of Article 106(1) EPC 1973 and that the opposition division had not yet taken a decision on the proprietor's request to stay the opposition proceedings and to remit the case to the examination division for a decision on the request for correction under Rule 89 EPC 1973.
- VI. On 12 March 2009 the opposition division took the interlocutory decision to stay opposition proceedings and to remit the case to the examining division for a decision on the request for correction under Rule 140 EPC (which corresponds to Rule 89 EPC 1973). It allowed a separate appeal against this decision.
- VII. The opponent (appellant) appealed the interlocutory decision and submitted its grounds of appeal.
- VIII. In order to expedite the appeal proceedings, the board sent out an early communication in which it expressed its preliminary view that the appeal raised an important point of law which might justify a referral to the Enlarged Board of Appeal. The parties were invited to inform the board whether they agreed that, after submission of the proprietor's (respondent's) reply to the grounds of appeal, a referral decision might be taken without prior oral proceedings. The parties were also invited to propose possible questions to be considered by the board for a referral.

IX. In their replies the parties agreed that, if an interlocutory decision referring questions of law to the Enlarged Board of Appeal were to be taken, this decision could be taken without prior oral proceedings.

X. The opponent (appellant) requests that the interlocutory decision of the opposition division be set aside, that it be ordered that the opposition division decide on the proprietor's request for correction and that the appeal fee be reimbursed in view of a substantial procedural violation.

XI. The appellant furthermore proposes two questions for a referral to the Enlarged Board which when translated into the language of the proceedings read as follows:

"1. In pending (inter partes) opposition proceedings, is a remittal to the examining division (ex parte proceedings) for correction of an error pursuant to Rule 140 EPC in an independent patent claim permitted if the correction of the error has a direct influence on the sole ground for opposition raised by the opponent, 'added subject matter', and if the correction of the error would have the consequence that an opposition which was admissible when the opposition period expired became inadmissible a posteriori?

2. In (inter partes) opposition proceedings, is a remittal to the examining division (ex parte proceedings) for correction of an error pursuant to Rule 140 EPC in an independent patent claim permitted if the correction of the error would have the consequence that an opposition which, on the basis of

issues under Article 123(2) EPC/Article 123(3) EPC, was admissible and well founded when the opposition period expired became inadmissible and unfounded a posteriori since the sole ground for opposition, 'added subject-matter', in combination with 'extension of scope of protection' became baseless due to the correction?"

XII. The arguments submitted by the appellant can be summarized as follows:

- The remittal of the case to the examining division violated the principle of equal treatment of the parties to the opposition proceedings. If the examining division allowed the requested correction, the opponent would a posteriori lose the sole ground on which its opposition was based.
- The opponent would have no legal remedy against the correction decision since it had no party status in proceedings before the examining division and could not therefore appeal the decision. On the other hand, the proprietor could appeal the examining division's decision if the request for correction were not allowed.
- The decision G 8/95 of the Enlarged Board of Appeal concerned an ex parte case and could not be applied to the present situation where a correction decision by the examining division could lead to an obvious discrimination of one of the parties to pending opposition proceedings.

XIII. The proprietor (respondent) argues that the appealed decision is correct, thereby implicitly requesting that the appeal be dismissed.

XIV. Further, the respondent proposes the following questions for a referral to the Enlarged Board:

"1. If a Request for Correction under old Rule 89 EPC / current Rule 140 EPC is filed during opposition proceedings regarding a Decision by the Examining Division, is the Examining Division or the Opposition Division to be considered competent to decide on the Request for Correction?

2. If a Request for Correction under old Rule 88 EPC / current Rule 139 EPC is filed during opposition proceedings regarding description pages, claims or drawings filed after filing of the European patent application pursuant to Art. 75 EPC / filing of the divisional application pursuant to Art. 76 EPC / entry into the European regional phase [sic] pursuant to Art. 153 EPC in conjunction with old Rule 107(1)(b) / current Rule 159(1)(b) EPC yet prior to the Decision to Grant for the version of the European patent under opposition, is the Examining Division or the Opposition Division to be considered competent to decide on the Request for Correction?

3. If the Examining Division is competent to decide on a Request for Correction under any of old Rule 89 EPC / current Rule 140 EPC and old Rule 88 EPC / current Rule 139 EPC during the pendency of opposition proceedings, may an Opponent (including an alleged



infringer pursuant to G 3/04) appeal the Examining Division's Decision on the Request for Correction?

4. If a Request for Correction with regard to a Decision to Grant is granted under old Rule 89 EPC / current Rule 140 EPC during opposition proceedings, how do the Proceedings continue and to what respect does it depend on the particular circumstances of the granted correction?

5. If a Request for Correction with regard to the description, claims and/or drawings of a granted patent is granted under old Rule 88 EPC / current Rule 139 EPC during opposition proceedings, how do the Proceedings continue and to what respect does it depend on the particular circumstances of the granted correction?

6. In considering a Request for Correction under old Rule 89 EPC / current Rule 140 EPC, what criteria are to be applied and what documents / evidence form the basis for determining whether a purported error is a "transcription error" / "Schreibfehler" / "faute de transcription"? Similarly, what criteria are to be applied and what documents / evidence form the basis for determining whether a mistake is "obvious" / "offenbar" / "manifeste"?

7. In considering a Request for Correction under old Rule 88 EPC / current Rule 139 EPC, what criteria are to be applied and what documents / evidence form the basis for determining whether it is "immediately evident" / "sofort erkennbar" / "apparaît immédiatement" that nothing else would have been intended than what is offered as the correction?"

XV. The arguments submitted by the respondent, as far as they are relevant for the present decision, can be summarized as follows:

- Granting of the requested correction by the examining division would not be any less fair than a refusal of the proprietor's request for correction.
- There was no guarantee in the EPC that a seemingly fruitful ground for opposition would, in the end, be successful.
- It was not correct to state that the remittal of the proprietor's requests for correction to the examining division would convert inter partes proceedings into ex parte proceedings and degrade the opponent's role to that of a bystander. The legal framework provided by the EPC and the corresponding departments of the EPO could be trusted to provide fair and equal treatment.

### **Reasons for the decision**

1. The appeal is admissible since it complies with the requirements of Articles 106 to 108 and Rule 99 EPC. In particular it is noted that pursuant to Article 106(2) EPC the opposition division has allowed a separate appeal against the interlocutory decision.
2. In the present case the opposition division has decided to stay the opposition proceedings in order to allow the examining division to decide on the proprietor's

request for correction under Rule 140 EPC. There is no explicit provision in the EPC specifying the circumstances under which an organ of the European Patent Office may stay pending proceedings in order to wait for the decision of another organ of the Office. Rules 14 and 78 EPC only concern the situation where the entitlement of the applicant or the proprietor is challenged before a national court.

3. Nevertheless the case law of the boards of appeal recognizes that a stay of proceedings may also be contemplated in other situations. In particular, it is the boards' common practice to stay appeal proceedings if their outcome depends on the answers the Enlarged Board of Appeal will give to questions of law referred to it. Also the departments of first instance frequently stay pre-grant or opposition proceedings in order to be able to take into account forthcoming decisions or opinions of the Enlarged Board of Appeal (see e.g. Notice from the EPO dated 1 September 2006 concerning staying of proceedings, OJ EPO 2006, 538, superseding the Notice from the EPO dated 2 November 2005 concerning divisional applications, OJ EPO 2005, 606, and Guidelines for Examination in the EPO, E-VII, 3).
  
4. The board is aware that the stay of opposition proceedings in a case such as the present one may lead to a considerable delay in the conclusion of the proceedings, in particular if the possibility that the decision of the examining division could be appealed by the proprietor is taken into account. As emphasised by the Enlarged Board of Appeal, opposition proceedings are conceived as a simple, speedily conducted procedure.

That a decision should be reached as quickly as possible serves not only the interests of both parties but also the interest of the public at large in having clarified as soon as possible the question as to whether an exclusive right has to be respected (see decision G 2/04, OJ EPO 2005, 549, point 2.1.4 of the reasons).

5. In the light of the above considerations, the board takes the view that the stay of the opposition proceedings can only be justified in the present case if the respondent's request for correction under Rule 140 EPC, which was filed after the initiation of opposition proceedings, constitutes an admissible remedy on which only the examining division has the power to take a binding decision **and** if the outcome of the opposition proceedings decisively depends on that decision.
  
6. In its decision G 8/95 (OJ EPO 1996, 481) the Enlarged Board held that a technical board of appeal - and not the legal board of appeal - is competent to deal with an appeal from a decision of an examining division refusing a request under Rule 89 EPC 1973 for correction of a decision to grant. The reasons of the decision include the following passage (at point 3.4):

"The competence to correct errors in a decision under Rule 89 EPC [1973] lies with the body which has given the decision. Hence, in the examination procedure the Examining Division has to decide on a request to correct errors in the decision to grant."

The decision of referral, i.e. T 850/95 (OJ EPO 1996, 455), concerned a case where the request for correction was submitted prior to the publication of the mention of the grant of the patent, i.e. prior to the date on which the decision to grant took effect according to Article 97(4) EPC 1973. No opposition was filed within the period specified in Article 99(1) EPC 1973.

7. Appeal decisions have acknowledged the examining division's competence to decide on a request for correction of the grant decision also in situations where this request was submitted after the initiation of opposition proceedings (see T 226/02 of 13 July 2004, point 5.1; T 268/02 of 31 January 2003, point 2) and even after the opposition division had already revoked the patent by a decision later appealed by the proprietor (see T 79/07 of 24 June 2008, sections III to VI and point 4).
  
8. The board notes that Rule 140 EPC is silent on the question of whether any time limit applies in connection with the correction of decisions and that - unlike in the situation of limitation proceedings (see Rule 93 EPC) - there is no specific rule on which the precedence or otherwise of opposition proceedings may be based. However, if it is accepted that requests for corrections under Rule 140 EPC submitted only after the initiation of opposition proceedings are admissible at all and are to be dealt with by the examining division, certain issues are bound to arise due to the existence of "parallel" proceedings relating to the same patent before different departments of the EPO. This is demonstrated by the present case where the requested correction concerns an alleged error regarding the very

feature on which the ground for opposition raised by the appellant, i.e. the objection of added subject-matter, is based.

9. According to the established principles laid down by the case law of the Enlarged Board of Appeal, a request for correction under Rule 140 EPC is directed against the form in which the decision was expressed, not against the substance of the decision (see G 8/95, point 3.3). In this context, decision G 1/97 (OJ EPO 2000, 322, point 3(c)) stated the following:

"The 'travaux préparatoires' concerning Rule 89 EPC [1973] also show that the legislator was particularly concerned with the protection of third parties. This is evident from the history of Rule 89 ... . Finally, it was decided that Rule 89 EPC [1973] should be limited to its present, narrow wording, which rules out any possibility of such adverse effect."

10. It thus appears that any correction decision of the examining division which respects the inherent limits of the remedy under Rule 140 EPC cannot alter the content of the patent grant decision. Since the granted patent will then necessarily remain the same in substance, it may be argued that it does not matter for the outcome of ongoing opposition proceedings whether the examination of the opposition grounds is made on the basis of the original version of the granted patent or on the basis of its corrected version.
11. However, the possibility that the examining division might exceed the limits of the remedy under Rule 140

EPC cannot be excluded. If the opposition division were not bound by the examining division's correction decision, i.e. if it could, or even had to, examine whether or not the corrections accepted by the examining division constitute unallowable amendments of the patent as originally granted, the outcome of the opposition proceedings need not be influenced by the examining division's decision. If, however, the opposition division were bound by such a decision in the sense that the examination of the opposition must be based on the corrected version of the patent, the examining division's decision would have a decisive impact on the opposition proceedings since, without it, the opposition division might reach a different result.

12. The case law of the boards of appeal does not reveal a unanimous view on the question of whether the opposition division is indeed bound in the above sense by an examining division's correction decision. On the one hand, in decision T 268/02 of 31 January 2003, point 2, without giving further explanations, board 3.3.02 came to the conclusion that the opposition division - and the board of appeal in opposition appeal proceedings - had the inherent power to verify whether the examining division had correctly applied the provisions of Rule 89 EPC 1973.
13. On the other hand, board 3.2.01 in its decision T 79/07 of 24 June 2008 did not concur with this conclusion and reached the opposite result. Emphasis was placed on the established principle 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. Since a change in a granted

claim which arises by way of a correction decision issued by the examining division did not amount to an amendment of the claims after the grant of the patent, the corrected version of the patent had to be considered as the granted patent. In inter partes opposition appeal proceedings the board of appeal had no appellate competence to review the decision on correction of the grant decision taken in ex parte examination proceedings, since that decision did not form the subject of the appeal proceedings.

14. As already indicated above (see point 5), the procedural issue in the present case, namely whether the opposition division should stay the pending opposition proceedings in view of the respondent's request for correction under Rule 140 EPC, decisively depends on the question of whether such a request filed after the initiation of opposition proceedings is an admissible remedy on which only the examining division has the power to take a binding decision. If the board were to come to the conclusion that this question has to be answered in the affirmative, a stay of the opposition proceedings would have to be considered as justified and the appeal would have to be dismissed.
  
15. The appellant has, however, argued (see section XII above) that, in the light of the particular circumstances of the present case, remittal to the examining division and in consequence a stay of the opposition proceedings would be procedurally unfair and violate the principle of equal treatment of the parties to the opposition proceedings: it is common ground between the parties that if the examining division were to allow the requested correction, the sole ground on



which the opposition was based would be deprived of its basis so that the opposition would be likely to be rejected as unfounded or - in view of the retroactive effect of the correction decision - even as inadmissible. Furthermore, the opponent would have no legal remedy against the correction decision since it has no party status in proceedings before the examining division and could therefore not appeal the decision. On the other hand, the proprietor could appeal the examining division's decision if the request for correction were not allowed.

16. These arguments cause the present board to doubt whether the EPC should be interpreted as meaning that a request by the proprietor under Rule 140 EPC which is only submitted after the initiation of opposition proceedings can still be admissible. Although Rule 140 EPC does not specify a time limit, this does not necessarily imply that a request for correction can be validly filed at any time and decided by the examining division in ex parte proceedings in a binding manner. Such a request, if admitted, might de facto allow the patent proprietor to transform what started out as an inter partes procedure into an ex parte procedure on the very point which gave rise to the opposition. It is of particular concern to the board that the opponent could be left without legal remedy in a situation where the examining division exceeds the inherent limits of Rule 140 EPC and amends the patent grant decision in substance by its "correction" decision.

17. The board considers that the decisive issue in the present case constitutes a point of law of fundamental importance on which a decision of the Enlarged Board of

Appeal is required in accordance with Article 112(1)(a) EPC. It concerns the interpretation of Rule 140 EPC, the delimitation of the respective competences of the examining and opposition divisions as well as the possible intercalation of ex parte proceedings and inter partes proceedings. The procedural provisions of the EPC are silent on these issues and the case law of the boards of appeal is at least partly divergent. Thus a referral of relevant questions of law to the Enlarged Board also serves the purpose of ensuring uniform application of the law.

18. When formulating the questions to be referred, the board has taken into account the respective proposals made by the parties (see above sections XI and XIV). The referred questions reflect both questions proposed by the appellant as well as questions 1 and 4 proposed by the respondent. The respondent's further proposed questions are not considered to be relevant for reaching a decision in the present case, since they either concern requests for correction under Rule 88 EPC 1973, Rule 139 EPC rather than under Rule 89 EPC 1973, Rule 140 EPC (see questions 2, 5 and 7), relate to the substantive criteria to be applied for determining whether a correction under Rule 140 EPC is allowable (see question 6), or relate to the possibility of appeal by the opponent against a correction decision taken by the examining division (see question 3).

**Order**

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

The following questions are referred to the Enlarged Board of Appeal for decision:

1. Is a patent proprietor's request for correction of the grant decision under Rule 140 EPC which was filed after the initiation of opposition proceedings admissible? In particular, should the absence of a time limit in Rule 140 EPC be interpreted such that a correction under Rule 140 EPC of errors in decisions can be made at any time?
2. If such a request is considered to be admissible, does the examining division have to decide on this request in ex parte proceedings in a binding manner so that the opposition division is precluded from examining whether the correction decision amounts to an unallowable amendment of the granted patent?

The Registrar:

The Chairman:

D. Magliano

A. S. Clelland