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**Datasheet for the decision
of 9 May 2016**

Case Number: T 1785/15 - 3.2.04

Application Number: 09756869.5

Publication Number: 2501267

IPC: A47K10/34, B65H26/08, A47K10/36

Language of the proceedings: EN

Title of invention:
DISPENSER WITH LOW-MATERIAL SENSING SYSTEM

Applicant:
Alwin Manufacturing Co., Inc.

Headword:

Relevant legal provisions:
EPC Art. 107
EPC R. 140, 71(5), 103(1)(a)

Keyword:
Admissibility of appeal - party adversely affected by decision
(no)
Correction of error - grant decision
Reimbursement of appeal fee - (yes) - legitimate expectation

Decisions cited:

G 0001/10, T 0308/05, J 0042/92, G 0001/09

Catchword:

see reasons 1.2, 1.5, 2.3, 2.4



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Case Number: T 1785/15 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 9 May 2016

Appellant: Alwin Manufacturing Co., Inc.
(Patent Proprietor) 2954 Holmgren Way
Green Bay, Wisconsin 54304 (US)

Representative: Caspary, Karsten
Kroher-Strobel
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80336 München (DE)

Decision under appeal:

Composition of the Board:

Chairman A. de Vries
Members: J. Wright
C. Heath

Summary of Facts and Submissions

- I. This is a case where the patent proprietor has filed an appeal against the decision dated 2 July 2015 to grant a patent based on EP application no. 09756869.5 pursuant to Art.97(1) EPC.

- II. The present application was filed as a PCT application which entered into the regional phase on 23 March 2012. In response to the communication pursuant to Rule 161(1) and 162 EPC, referring to an international preliminary written opinion of the ISA the then applicant on 2 January 2013 submitted amendments to the claims and description. Subsequently, the examining division issued a communication under Rule 71(3) EPC dated 20 February 2015 stating its intention to grant a patent indicating the description, claims and figures on which grant was to be based as well as identifying proposed amendments to the description and claims together with detailed explanations. The complete text for grant (the "Druckexemplar") was enclosed in versions with and without markup. When compared to the version of the claims previously on file, it turns out that the examining division had suggested numerous amendments particularly to claim 1.

On 17 June 2015, the applicant, in reference to the Rule 71(3) communication payed the fee for grant and publishing and filed translations of the accepted claims into German and French pursuant to Rule 71(5) EPC.

Thereupon, a decision to grant a European patent pursuant to Article 97(1) EPC was issued on 2 July 2015. The publication of the mention of the grant in the European Patent Bulletin was envisaged for 29 July 2015.

- III. With letter of 21 July 2015 and in reference to a telephone conversation and e-mail correspondence of July 2016 with the first examiner the former applicant (now patent proprietor) requested not to publish the mention of grant as "the claims currently on file contain obvious errors". Amended claims and an adapted description in clean copy and with markup were annexed. It was further requested that the Examining Division "consent to acceptance of the amendments given by [the primary examiner] with e-mail of July 2015".
- IV. In a consultation by telephone dated 24 July 2015 the formalities officer on 24 July 2015 informed the patent proprietor that there had "been a misunderstanding ... regarding the stage the application was in the procedure, [that] the binding Decision to Grant a European Patent was already dispatched on 2 July 2015 [and that] therefore it is no longer possible to amend the description and claims as requested (**G1/10**)". Furthermore, "the option of filing an Appeal against the Decision to Grant, within 2 Months form the issuance of the Decision on 2 July 2015" was pointed out.
- V. In response the patent proprietor filed a notice of appeal received 27 July 2015, paid the appeal fee and filed the grounds of appeal on the same day. The appellant-patent proprietor requested that the obvious error be removed the and the application documents be corrected according to what was filed with the grounds, that a new decision to grant a European patent based on the amended claims and description be issued, and that the appeal fee be reimbursed.
- VI. In a communication dated 15 January 2016, the Board pointed out that in light of the decision **G 1/10**, the appeal appeared inadmissible, yet that the Board for

reasons of equity would be prepared to order a reimbursement of the appeal fee. In its response dated 16 March 2016, the appellant welcomed the Board's intention to reimburse the appeal fee and requested "the Examining Division to issue a new decision to grant based on the application documents currently on file (Druckexemplar) so that the grant can be published." At no stage did the appellant request oral proceedings.

Reasons for the Decision

1. Admissibility of the Appeal
 - 1.1 The appeal is directed against the written decision of the examining division dated 2 July 2015 to grant a European patent pursuant to Art.97(1) EPC.
 - 1.2 According to Art. 106 EPC, appeals can be filed against decisions. According to Art. 107 EPC anyone who is "adversely affected" by the decision is entitled to file an appeal. By filing the translations of the claims in German and French, and paying the fees for grant and publication (see the applicant's communication of 17 June 2015), the applicant however signalled its approval to the version of the application upon which the examining division based its communication of intention to grant a patent. An unreserved approval of the version intended for grant leaves no room for the notion that the applicant was "adversely affected" by the decision to grant.
 - 1.3 Patents are public titles to exclude all others from working within the scope of the patented teaching. In order to protect the interests of third parties and the public in general, the possibility of correcting such

titles is rather limited, regardless of the reasons why errors have occurred. Rule 139 EPC offers the possibility of correcting linguistic errors and mistakes in documents filed with the European Patent Office. Where corrections concern the description or claims this is only possible during the pendency of an application or pending subsequent opposition proceedings, see decision **J 42/92** of 28 February 1997. In the case of grant an application ceases to be pending on the day before the mention of its grant is published, **G 1/09** (OJ EPO 2011, 336), reasons 4.3.2.

- 1.4 Rule 140 EPC on the other hand offers the possibility of correcting obvious mistakes in decisions of the European Patent Office. However, as held in **G 1/10** (OJ 2013, 194), see headnote I, Rule 140 EPC is not available to correct the text of a patent, and a proprietor's request to that effect is inadmissible whenever made. Thus this rule does not apply to cases where the approved text of a European Patent and the text subject to the decision to grant are identical, as the decision is not erroneous in such case. Decision **G 1/10** in paragraphs 9 - 11 of the reasons has further elaborated on the relationship between the intention to grant a European Patent (Rule 71(3) EPC), the decision to grant a European Patent (Article 97(1) EPC), and the possibilities of correcting errors:

"9. In the Enlarged Board's judgment a patent applicant (or, subsequently, a patent proprietor) has adequate means at his disposal to ensure his patent as granted is in the exact form he wants it to be without any need to invoke Rule 140 EPC. Should an applicant, at any stage up to and including the final approval by him of the text of his patent, make a mistake (or overlook a mistake he has previously made) in a document he has

filed - for example, he misspells a word or uses an incorrect word in an amended claim which he files in the course of examination proceedings - then before grant that mistake can be corrected under Rule 139 EPC on request.

10. Further, a patent applicant is obliged to approve the text in which his patent is to be granted (see Article 97(1) and Rule 71(3)(4) and (5) EPC). He must be informed of the text in which the examining division intends to grant a patent and is deemed to approve that text if he proceeds to pay the requisite fees and file translated claims within a period of four months (see Rule 71(3) EPC). Otherwise he must within that four month period request amendments or corrections (see Rule 71(4) EPC, which specifically mentions "correction of errors under Rule 139"); and there is also a procedure for further amendment and approval in the event those first amendments or corrections are not consented to by the examining division (see Rule 71(5) EPC).

11. If, given the opportunity to check the patent text before approving it, an applicant does not draw any errors to the attention of the examining division and thus ensure his approval is limited to the correct text, then the responsibility for any errors remaining in that text after grant should be his alone, whether the error was made (or introduced) by him or by the examining division. Thus, for example, the responsibility for a mis-spelt or incorrect word in an amended claim in the approved text is from this point in time entirely that of the patent applicant and it would be illogical thereafter to impute that mistake to the examining division - by suggesting the examining division did not intend to make a decision which in fact included the

very text approved by the applicant himself - in order to bring the applicant's own error within the ambit of Rule 140 EPC. The President's comments (see section VII. 2 above) referred to the practice of some applicants who turn to Rule 140 EPC to request the correction of obvious errors when this is no longer possible under Rule 139 EPC. That practice suggests some patent applicants seek to rely on Rule 140 EPC to "tidy up" their own errors by the fiction of ascribing them to the examining division. As epi correctly observed (see section VIII.1 above), Rule 140 EPC is intended for correcting errors in decisions of the EPO and not errors in documents filed by a patent applicant or proprietor. It would follow from the non-availability of Rule 140 EPC to correct patents that this practice should cease."

1.5 The above findings of the Enlarged Board read directly on the case at issue. Consequently, the appellant's request for correction is inadmissible, as the appellant, having approved the granted text, is not adversely affected by the decision to grant on the basis of that text. As he has approved the text, the responsibility of any errors left in the text are his own. **G 1/10** does not foresee the possibility of appeal for an proprietor in a case where despite having consented to the version of the patent to be granted, amendments to this text are subsequently sought. After the decision to grant, the claims can only be amended in procedures where this possibility is specifically mentioned, namely in limitation or opposition proceedings, see **G 1/10** reasons 13.

1.6 The appellant has submitted no cogent reason why the Board should deviate from the Enlarged Board's interpretation to the convention in **G 1/10**, nor are such reasons apparent to the Board. In the light of the above

the Board concludes that the current appeal is inadmissible.

2. Reimbursement of the Appeal Fee

2.1 According to Rule 103(1)(a) EPC, the appeal fee shall be reimbursed in the event of interlocutory revision or where the Board deems an appeal allowable, if such reimbursement is equitable by reason of a substantial procedural violation.

2.2 In the case at issue, the appeal is not allowable. It is not even admissible. Reimbursement could therefore only be requested if foreseen in circumstances other than those stipulated in Rule 103 EPC. This was so held in decision **T 308/05** of 27 February 2006 where the applicant had relied on misleading information provided by the Office (par. 6 of the reasons).

2.3 In the case at issue, the appellant upon a first enquiry with the examiner received erroneous information regarding the possibility of correction. Though this error was subsequently corrected by the formalities officer, in the telephone conversation of 24 July 2015, the appellant was then led to believe that an appeal against the decision to grant would be possible: "[he] pointed out the option of filing an Appeal against the decision to grant". The Board does not interpret this as a suggestion to file an appeal, but as an information that it is possible to file an appeal, not unlike the notice contained in most formal decisions of the EPO that are open to appeal. The applicant filed its appeal only three days later.

2.4 Objectively speaking, the telephone advice given by the registrar was to say the least, inaccurate. In fact, the

decision **G 1/10** (as above) makes clear that there are in effect no remedies against errors in the approved text of a patent application once the decision to grant has been issued. Suggesting a legal remedy where there is none is at best misleading, and the small interval between the advice and the filing of an appeal suggests that the applicant may very well have relied upon such advice when filing the appeal. The Board therefore likens the current case to the above-mentioned decision **T 308/05** and finds it equitable to order a reimbursement of the appeal fee as it cannot be ruled out, and is in fact likely, that the applicant filed the appeal based on incorrect advice from the Office. The applicant thereby had at least a legitimate expectation that the appeal would be found admissible and examined as to its substance.

3. Other issues

With its last submission dated 16 March 2016, the appellant requested that the Examining Division be ordered to issue a new decision to grant based on the application documents currently on file (Druckexemplar) so that the grant can be published. As the appeal is inadmissible, the Board can make no such order. Nor can the examining division issue a new decision, as the previous one has not been set aside.

Order

For these reasons it is decided that:

1. The appeal is rejected as inadmissible.
2. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:



G. Magouliotis

A. de Vries

Decision electronically authenticated