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Datasheet for the decision of 20 June 2018

Case Number: T 0506/16 - 3.3.05

Application Number: 10705476.9

Publication Number: 2396848

IPC: H01M10/0565, H01M10/052, C08G81/02

Language of the proceedings: EN

Title of invention:
HIGHLY CONDUCTIVE POLYMER ELECTROLYTES AND SECONDARY BATTERIES INCLUDING THE SAME

Patent Proprietor:
Dow Global Technologies LLC

Headword:
Correction of patent/DOW GLOBAL

Relevant legal provisions:
EPC R. 71(3), 139, 140
EPC Art. 97(1), 112(1)(a)
Guidelines for examination Part H - Chapter VI, Sections 3.3 and 4

Keyword:
Correction of error - grant decision - request (rejected)
Referral to the Enlarged Board of Appeal - (no)

This datasheet is not part of the Decision.
It can be changed at any time and without notice.

Decisions cited:
G 0001/10, G 0008/95, G 0005/88, J 0015/92, J 0042/92, J 0017/04, T 0850/95, T 0450/97, T 1242/04, T 1869/12, T 1785/15, T 0055/00

Catchword:

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Case Number: T 0506/16 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 20 June 2018

Appellant: (Patent Proprietor)	Dow Global Technologies LLC 2040 Dow Center Midland, MI 48674 (US)
Representative:	Beck Greener Fulwood House 12 Fulwood Place London WC1V 6HR (GB)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 4 December 2015 rejecting the request for correction under Rule 139 EPC as inadmissible, refusing the request for correction of the printing errors, refusing the request for correction under Rule 140 EPC and rejecting as inadmissible the request to consider the decision to grant null and void and to issue a further communication under Rule 71(3) EPC**

Composition of the Board:

Chairman	E. Bendl
Members:	A. Haderlein
	P. Guntz
	G. Glod
	O. Loizou

Summary of Facts and Submissions

I. The appeal of the patent proprietor (appellant) lies from the decision of the examining division in the matter of European patent No. 2 396 848 to
- reject as inadmissible the request for correction of the granted patent under Rule 139 EPC,
- refuse the request for correction of printing errors in the patent specification,
- refuse the request for correction of the granted patent under Rule 140 EPC, and
- reject as inadmissible the request to consider the decision to grant null and void and to issue a further communication under Rule 71(3) EPC.

II. With a letter dated 8 November 2013, the appellant (the then applicant) filed *inter alia* a main request comprising 15 claims on a total of four pages and a first auxiliary request comprising 14 claims on a total of four pages.

III. On 14 and 15 November 2013 telephone consultations took place between the applicant's representative and the first examiner of the examining division.

IV. A first communication under Rule 71(3) EPC dated 17 December 2013 was issued. On its cover page the text forming the basis for the intention to grant was said to be claims 1 to 14 as submitted with the letter dated 8 November 2013, with claim 1 being amended "according to [the applicant's] request dated 15-11-2013" and description pages 1, 3 and 4 comprising amendments "proposed by the division". The documents intended for grant attached to the communication contained 14 claims on four pages, with a handwritten amendment in claim 1 on claims page 1. Claims 1 to 12 were directed to a

composition, claim 13 to a secondary battery and claim 14 to a process for preparing a block copolymer.

V. By letter dated 17 April 2014, the applicant submitted new pages 3 and 4 of the description.

VI. A second communication under Rule 71(3) EPC was issued on 13 May 2014. On its cover page the text forming the basis for the intention to grant was again said to be claims 1 to 14 as submitted with the letter dated 8 November 2013, with claim 1 being amended "according to [the applicant's] request dated 15-11-2013". The documents attached to this communication contained 14 claims identical to those attached to the first communication under Rule 71(3) EPC.

VII. With a letter dated 12 August 2014, the applicant requested amendments in claims 1, 8, 10 and 11 in order to remedy typographical errors which were said to have been noted during preparation of claims translations. Claims pages 1 and 3 containing part of claim 1 and claims 7 to 13 were attached to the letter. In this letter the applicant requested that these two pages be substituted for those pages then on file.

VIII. A third communication under Rule 71(3) EPC was issued on 25 September 2014. On its cover page the text forming the basis for the intention to grant was said to be claims "1-13 received on 12-08-2014 with letter of 12-08-2014". The text attached to this communication contained only two pages with claims, i.e. a first page ("page 1") containing part of claim 1 and a second page ("page 3") containing claims 7 to 13. The claim set no longer contained claims pages 2 and 4, i.e. no longer contained the final 15 lines of claim 1, claims 2 to 6

and claim 14.

IX. With a letter dated 9 October 2014, the applicant filed French and German translations of the claims. Both translations comprised four pages containing claims 1 to 14, wherein claim 1 was complete and claim 14 was directed to a process.

X. The decision to grant a European patent pursuant to Article 97(1) EPC was issued and was dated 23 October 2014. According to this decision "a European patent with the title and the supporting documents indicated in the communication pursuant to Rule 71(3) EPC dated 25.09.14 is hereby granted".

XI. With a letter dated 9 January 2015, the applicant requested "correction of the B1 publication [in] accordance with Rule 139 EPC" and that the complete set of claims attached to the letter be substituted in their entirety for the claims currently on file.

XII. Furthermore, with a letter dated 19 January 2015 and subsequent submissions, the applicant requested correction of a printing error and, in the alternative, correction of the decision to grant under Rule 140 EPC.

XIII. The decision under appeal (see point I above) dated 4 December 2015 was issued. According to the examining division the request under Rule 139 EPC was inadmissible because this provision was only available for documents submitted to the EPO by any party to the proceedings, and not to documents issued by the EPO departments themselves. Moreover, a request under Rule 139 EPC could only be filed as long as proceedings were pending before the EPO. In the case at hand, this was no longer the case. The request for correction of

printing errors was refused because the alleged errors in question did not originate from the process of printing the granted patent. The request pursuant to Rule 140 EPC was also refused, in particular because according to G 1/10 this provision was not available to correct patents. The request to issue a new communication under Rule 71(3) EPC was rejected because the decision to grant had become binding on the examining division and could only have been amended upon the patent proprietor filing an admissible and well-founded appeal.

XIV. Notice of appeal including grounds of appeal was filed in due time. A set of 14 claims on a total of four pages was attached thereto. At the same time the appeal fee was validly paid.

XV. The appellant's arguments may be summarised as follows:

The rationale of G 1/10 did not apply in the present case because the present case in particular related neither to pending opposition proceedings nor to an error introduced by the applicant. Moreover, it had not been the true intention of the examining division to grant a patent based on only pages 1 and 3 of a total of four claims pages, i.e. based on only a part of claim 1 and claims 7 to 13. The error should also be corrected under Rule 139 EPC or at least be treated as a printing error. Moreover, the examination proceedings leading to the decision to grant had suffered from a substantial procedural violation. Also, the examining division had breached the principle of protection of legitimate expectations. If the board did not grant the correction of the error by including the set of 14 claims as submitted with the notice of appeal and the grounds of appeal, it was requested to correct the

patent by including the complete set of 13 claims as indicated in the third communication under Rule 71(3) EPC. The questions to be referred to the Enlarged Board concerned several important points of law.

XVI. Requests

The appellant requested as its main request that the specification of the granted patent be corrected to include claims 1 to 14 as attached to the notice and grounds of appeal.

In the alternative, it requested that the patent specification be reprinted "with claims 1 to 13 complete". It also requested that the following questions be referred to the Enlarged Board of Appeal:

"1. To what extent should the broad statement in **G 1/10** that a proprietor's request to correct the text of a patent (i.e., an integral part of the Decision to Grant) is inadmissible whenever made, be applicable to cases that deviate significantly from the facts of **G 1/10**?

2. In particular, to what extent should **G 1/10** be applied to situations where the Applicant has not had ample opportunity to check the patent specification, or indeed to situations where errors were unintentionally introduced by the Examining Division and not the Applicant, and where these errors were not identified by the Examining Division in the 'Communication under Rule 71(3) EPC'?

3. Since Rule 140 EPC explicitly allows the correction of obvious mistakes in decisions of the European Patent Office, and the printed patent specification is

considered to be an integral part of the Decision to Grant, are there any circumstances in which an obvious error in the patent specification may be corrected under Rule 140 EPC?" (emphasis in the original)

Reasons for the Decision

1. The appeal is admissible.

Main request

2. The appellant requests that the specification of the granted patent be corrected to include claims 1 to 14 as attached to the submissions containing the notice and grounds of appeal. Put differently, it requests that the second part of claim 1, claims 2 to 6 and claim 14, which were missing from the patent specification, be included therein.

The appellant thus requests a "patent correction" in the sense of G 1/10 (see Reasons 3, last sentence). According to G 1/10 (see Order), however, such a request is inadmissible whenever made.

3. The appellant essentially argues that the rationale of G 1/10 does not apply in the present case because the factual circumstances underlying the case to be decided by the then referring board in G 1/10 were different from those underlying the present case.

It is true that the facts of the case at hand differ from those of the above case leading to the referral in G 1/10, in that it concerns neither an error in a document introduced by an applicant nor a situation where correction of the patent under Rule 140 EPC is requested while opposition proceedings are pending

(cf. G 1/10 *supra*, point II of Summary of Facts and Submissions). Rather, in the case at hand it was the examining division that committed an error by not including pages 2 and 4 of the claim set dated 8 November 2013 in the text intended for grant and by indicating on the cover sheet that the relevant claims were "claims 1-13 received on 12-08-2014 with letter of 12-08-2014".

The board however sees no convincing reason why the conclusions drawn in G 1/10 are not applicable in the present case. Firstly, the Enlarged Board's decision is clearly not confined to situations where a request under Rule 140 EPC is filed during pending opposition proceedings, but extends to all such requests submitted after the decision to grant (cf. G 1/10, *supra*, Reasons 3: "Rule 140 EPC is not available for correcting patents, including during opposition or limitation proceedings"; and point 1 of the Order: "such a correction is inadmissible whenever made"). Secondly, the findings in the Enlarged Board's decision also mention situations where the error was made or introduced by the examining division (see G 1/10 *supra*, Reasons 11) and thus also to cases where the applicant, as contended by the appellant, has "only one opportunity at which it might have noticed the examining division's error" (i.e. when receiving the communication under Rule 71(3) EPC prior to the decision to grant).

4. The appellant further submits that, according to G 8/95, Rule 140 EPC was available in the present case because it had not been the true intention of the examining division to grant a patent with only pages 1 and 3 of the claim set submitted with the letter dated 12 August 2014, i.e. not including pages 2 and 4 of the

claims.

The board does not concur with the appellant. Firstly, G 8/95 dealt with a different question, i.e. that of whether a technical board of appeal or the Legal Board was competent to hear appeals from decisions by the examining division refusing a request under what is now Rule 140 EPC (G 8/95, *supra*, point VI of Summary of Facts and Submissions and Order). Put differently, in this decision the Enlarged Board of Appeal did not rule on the admissibility or allowability of a request under Rule 140 EPC but only on the competent body to deal with such a request. Secondly, at least for the reason that G 8/95 predates G 1/10, the former decision must be read in the light of the latter, leading to the conclusion that, as stated above, a request for correction of a patent is inadmissible whenever made.

Also, decision T 450/97 (see Reasons 5.2) cited by the appellant fails to support the appellant's request to correct the patent specification. It deals with a request to correct the reasons of a decision of a board of appeal, a request which was rejected (T 450/97, *supra*, Reasons 5 and 5.2). Also, the conclusions drawn in T 850/95 of 12 July 1996 (Reasons 2) referred to by the appellant, i.e. that errors in the patent documents referred to in a grant decision may subsequently be corrected under what is now Rule 140 EPC, is explicitly not agreed with by the Enlarged Board (G 1/10, *supra*, Reasons 5).

5. The appellant also relies on Rule 139 EPC. As correctly held by the examining division, this provision is only available in the proceedings leading up to the grant of the patent (see also G 1/10, *supra*, Reasons 9). A request under Rule 139 EPC may indeed only be filed

during the pendency of application or opposition proceedings (J 42/92, Reasons 6). It is therefore not sufficient to argue, as submitted by the appellant, that in the present case there are pending appeal proceedings. The present appeal proceedings are directed neither to application proceedings nor to opposition proceedings, but to the examining division's rejection of the very request for correction of the granted patent.

The board also agrees with the examining division in that Rule 139 EPC is only applicable to documents filed with the EPO and does not extend to documents issued by it, e.g. the decision to grant. This is clear from the wording of Rule 139 EPC (English: "filed with"; French: "produit[-] auprès"; German "bei[-]... eingereicht").

6. The appellant further argues that the requested correction is allowable because it is directed to a printing error or formatting/editing errors.

This argument is not persuasive. As correctly ruled by the examining division, in the present case there is no printing error or error in publication, because the English text of the printed patent specification uncontestedly corresponds to the documents attached to the third (and last) communication under Rule 71(3) EPC, i.e. they correspond to the so-called "Druckexemplar" (cf. the Guidelines for Examination in the EPO of November 2017, in the following "Guidelines", Part H - Chapter VI, section 4). The board also does not agree that the error in question is merely a formatting or editing error as contended by the appellant, since the reintroduction of claims pages 2 and 4 clearly would go beyond an alteration in format or in editing. The passage in the *Guidelines* (*supra*,

Part H - Chapter VI, section 3.3) according to which "Formatting/editing errors are alterations in the patent documents which occur during the preparation of the Druckexemplar and which are indicated neither by standard marks nor in Form 2004" must not be read in isolation and in particular cannot be construed as referring to any error that would not be indicated in Form 2004, e.g. omission of entire pages containing claims as in the present case.

According to G 1/10 (*supra*, Reasons 10 and 11), the obligation to check the text in which the patent is to be granted lies with the applicant, and if it does not draw the examining division's attention to any errors, then the appellant alone bears the responsibility for any errors remaining in the text, regardless of who is responsible for the error.

7. The appellant also submits that the examination proceedings leading to the decision to grant the patent suffered from a substantial procedural violation because the decision is impossible to implement and was not based on an approved text and because of the examining division's failure to implement the text of the decision to grant. Therefore, the decision to grant was null and void.

The board observes that in order to have a decision to grant a patent that adversely affects the patent proprietor declared null and void, i.e. in order to have such a decision set aside, an appeal must be filed against that decision (cf. G 1/10, *supra*, Reasons 12; see also T 1869/12, Reasons 4.5). The decisions cited by the appellant in this respect (J 15/92 and J 17/04) do not concern decisions to grant a patent. But there, too, the Legal Board set the impugned decisions aside

following the filing of an admissible and allowable appeal.

In the case at hand, the patent proprietor did not file an appeal against the decision to grant, but relied solely on filing a request for correction of the granted patent. The present appeal proceedings are directed to the proceedings before the examining division with respect only to this request for correction. Whether a substantial procedural violation occurred during the proceedings leading up to the grant of the patent, i.e. during the proceedings leading to a decision against which no appeal was filed, is therefore irrelevant in the present proceedings.

8. Likewise, the appellant's argument, with reference to G 5/88, that the decision to grant infringed the principle of good faith and the protection of the legitimate expectations of the users of the EPO must also fail. Such an alleged breach of the principle of good faith and protection of legitimate expectations in the proceedings leading to a decision by the EPO's departments of first instance can only be objected to if the party is adversely affected by that decision and files an appeal against it, as mentioned above (cf. also J 42/92, *supra*, Reasons 9).

9. For these reasons, the appellant's main request is rejected as inadmissible.

Auxiliary request

10. As an auxiliary request, the appellant requests that the patent specification be reprinted "with claims 1 to 13 complete". In the context of this request, the appellant refers to the third communication under

Rule 71(3) EPC, wherein "Claims 1-13 received on 12-08-2014 with letter of 12-08-2014" are mentioned.

As the claims received on that date contain neither the last 15 lines of claim 1 nor claims 2 to 6, the board understands the appellant's auxiliary request to entail having the patent specification reprinted with claims pages 1 (containing the first part of claim 1) and 3 (containing claims 7 to 13) as of 12 August 2014 and claims page 2 (containing the second part of claim 1 and claims 2 to 6) of the auxiliary request dated and received on 8 November 2013 (cf. the text attached to the first and second communications under Rule 71(3) EPC).

11. In the decision to grant dated 23 October 2014, reference is made to "the supporting documents indicated in the communication pursuant to Rule 71(3) EPC dated 25.09.14" (cf. point X above). The cover page of this (third) communication under Rule 71(3) EPC contains the following passage:

"You are informed that the Examining Division intends to grant a European patent on the basis of the above application with the text and drawings... as indicated below.

A copy of the relevant documents is enclosed.

...

Claims, Numbers
1-13 received on 12-08-2014 with letter of 12-08-2014".

In the text attached to this communication, as mentioned before, the final part of claim 1 and claims

2 to 6 were omitted.

While there is an apparent contradiction between the passage cited above and the documents attached to the communication, neither the cover page of the third communication under Rule 71(3) EPC nor the text attached to this communication comprises any reference to documents received on 8 November 2013.

12. The error in question can therefore not be regarded as a mere printing error for the same reasons as set out for the main request. Thus, the reasons for rejecting the main request apply *mutatis mutandis* to the auxiliary request. This request is therefore rejected as inadmissible.

Request to refer questions to the Enlarged Board of Appeal

13. In order to ensure uniform application of the law, or if a point of law of fundamental importance arises, a board of appeal shall refer any question to the Enlarged Board of Appeal if it considers that a decision is required for the above purposes (Article 112(1)(a) EPC). If the question to be referred can be answered beyond all doubt by the board itself, the board does not need to refer it to the Enlarged Board (T 1242/04, Reasons 10.3).

According to the appellant, the questions to be referred (see point XVI above) are aimed at several important points of law "that may be worthy of referral".

Questions 1 and 2 start from the premise that the facts underlying the present case are significantly different

from those addressed in G 1/10. As stated in particular in point 3 above, the facts underlying the present case do not significantly differ from those addressed in G 1/10. Moreover, question 2 presupposes that the appellant did not have "ample opportunity" to check the documents intended for grant. This is clearly not the case here, because in the (third) communication under Rule 71(3) EPC in question the time limit for (dis)approving the text was set at four months from notification thereof as required by that provision. During this period the appellant (the then applicant) had the opportunity not only to check the text written on Form 2004 but also to check the enclosed documents (the "Druckexemplar") (cf. T 55/00, Reasons 5, and T 1785/15, Reasons 1.4).

Question 3 relates very generally to "any circumstances" in which an obvious error in the patent specification may or may not be corrected. As far as the circumstances underlying the present case are concerned, the board is able to answer the question beyond all doubt (see points 2 to 12 above). As far as circumstances are concerned that would differ from those of the case at hand, a decision is obviously not required for the purposes set out in Article 112(1) EPC.

For these reasons, the request for referral is refused.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

M. Schalow E. Bendl

Decision electronically authenticated