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**Datasheet for the decision
of 15 November 2018**

Case Number: T 2081/16 - 3.5.03

Application Number: 08767833.0

Publication Number: 2158711

IPC: H04B7/155, H04K3/00

Language of the proceedings: EN

Title of invention:

ON FREQUENCY REPEATER WITH AGC STABILITY DETERMINATION

Applicant:

Intel Corporation

Headword:

Failure to communicate the text intended for grant

Relevant legal provisions:

EPC Art. 97(1), 108, 113(2)

EPC R. 71(3), 71(5)

Keyword:

Admissibility of appeal - appellant adversely affected despite decision to grant a patent

Fundamental procedural defect - patent granted without agreement on the text for grant

Decisions cited:

G 0001/10, T 0854/12, T 1869/12

Catchword:

Rule 71(5) EPC only applies where the text intended for grant has been communicated to the applicant according to Rule 71(3) EPC (see Reasons 1.4).

Differentiation from G 0001/10 (see Reasons 3).



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Case Number: T 2081/16 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 15 November 2018

Appellant: Intel Corporation
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Representative: Goddar, Heinz J.
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Decision under appeal: Decision of the Examining Division dated
18 February 2016 to grant a European patent
according to Article 97 (1) EPC

Composition of the Board:

Chairman F. van der Voort
Members: P. Guntz
A. Madenach

Summary of Facts and Submissions

- I. This appeal lies from the decision of the examining division dated 18 February 2016 to grant a patent on the basis of application documents as indicated in a second communication under Rule 71(3) EPC dated 16 September 2015 following examination of European patent application No. 08767833.0, which was filed as an international application with publication No. WO 2008/147506 A1.
- II. By letter dated 4 December 2014, the applicant filed amended description pages 1 to 22 and amended claims 1 to 15. Based on these documents, including minor amendments to description pages 21 and 22 proposed by the examining division, together with drawing sheets 1/9 to 9/9 as published, a first communication under Rule 71(3) EPC was sent on 25 March 2015.
- III. In its letter of reply dated 29 July 2015, the applicant stated that it did not agree to the text intended for grant and requested that the patent be granted on the basis of the following documents: new claims 1 to 16 and new description pages 1, 4, 4a, 5, 13 and 23, as annexed to the letter; description pages 2, 3, 6 to 12, 14 to 22 and 24 as originally filed; and drawing sheets 1 to 9 as originally filed.
- IV. An internal Form 2092C, dated 8 September 2015, was signed by the first examiner and the chairman of the examining division. It informed the formalities officer that consent was given to the amendments/corrections requested by the applicant.
- V. On 16 September 2015, a "communication under Rule 71(3) EPC" (Form 2004C) was sent by the formalities officer,

informing the applicant about the intention of the examining division to grant the patent on the basis of the following documents: claims 1 to 16 as filed with the letter dated 29 July 2015; description pages 1, 4, 4a, 5, 13 and 23 as filed with the letter dated 29 July 2015; description pages 2, 3, 6 to 12, 14 to 22 and 24 as filed with the letter dated 4 December 2014; and drawing sheets 1/9 to 9/9 as published.

- VI. The applicant subsequently filed a translation of the claims in the two other official languages and paid the fee for grant and publishing on 16 January 2016.
- VII. In its statement of grounds of appeal, the applicant (appellant) argued that the documents referred to in the communication dated 16 September 2015 neither corresponded to its request nor constituted the documents on the basis of which the examining division intended to grant the patent, as followed from, *inter alia*, internal Form 2092C dated 8 September 2015.

Furthermore, given that in the communication dated 16 September 2015 no further amendments were indicated by the examining division other than those which had already been proposed by the examining division in its first communication under Rule 71(3) EPC dated 25 March 2015, and that description pages 2, 3, 6 to 12, 14 to 22 and 24 as filed with the letter dated 4 December 2014 clearly did not fit together with pages 1, 4, 4a, 5, 13 and 23 filed with the letter dated 29 July 2015, which could easily be recognised from, for instance, the mismatches between the texts bridging pages 3 and 4 and pages 22 and 23, it also followed that the documents cited in the communication of the formalities officer did not correspond to those on the basis of

which the examining division intended to grant the patent.

As the patent had not been granted based on documents approved by the applicant, a substantial procedural violation had occurred, which justified the filing of the present appeal (see T 1869/12).

- VIII. The board summoned the appellant to oral proceedings. In a communication annexed to the summons, the board gave its preliminary opinion that the appeal appeared to be inadmissible. The fact that according to internal Form 2092C consent had been given to the amendments/ corrections requested by the applicant with its letter dated 29 July 2015 appeared to be irrelevant since the text which was deemed to have been approved by the applicant by paying the relevant fees and filing the translation had become the relevant last request. The decision under appeal corresponds to this request and, hence, the applicant did not appear to have been adversely affected.
- IX. Oral proceedings were held on 15 November 2018.

The appellant's arguments may be summarised as follows:

- The text of the application on the basis of which the grant of the patent was decided did not correspond to the real intention of the examining division, namely, the grant of a patent according to the applicant's request dated 29 July 2015.
- The applicant's implicit approval by filing the translation and paying the relevant fees could only be understood such that it kept to the latest text submitted by it (Rule 71(6) EPC).

- Since the text referred to by the formalities officer in the communication dated 16 September 2015 did not correspond to the true intention of the examining division, the formalities officer acted *ultra vires*, and the communication could not have triggered the consequences as laid down in Rule 71(3) and (5) EPC.
- Having regard to Rule 71(5) EPC, holding the applicant bound by a mistake made by the European Patent Office would be contrary to the principle of legitimate expectations. Nor did G 1/10 require such binding effect.

The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of:

- claims 1 to 16 as filed with the letter of 29 July 2015;
- description pages 1, 4, 4a, 5, 13 and 23 as filed with the letter dated 29 July 2015;
- description pages 2, 3, 6 to 12, 14 to 22 and 24 as originally filed; and
- drawing sheets 1/9 to 9/9 as published.

By way of an auxiliary request, the appellant requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution on the basis of the above-mentioned application documents.

Furthermore, the appellant conditionally requested that questions be referred to the Enlarged Board of Appeal.

Reasons for the Decision

The appeal is admissible (point 1) and allowable (point 2). The board in arriving at this conclusion does not deviate from G 1/10 (see point 3).

1. *Admissibility of the appeal*

1.1 The appeal is admissible. The appellant is adversely affected. The granted version of the patent corresponds neither to a text submitted by the applicant (see below, point 1.2) nor to a text agreed by it (point 1.3), nor to a text deemed to have been approved by it (point 1.4). There is, therefore, a discrepancy between the applicant's request and the decision of the examining division.

1.2 Whereas the applicant, with its letter dated 29 July 2015, requested the grant of a patent on the basis of "original description pages 2, 3, 6 to 12, 14 to 22 and 24 ...", the communication dated 16 September 2015 sent by the formalities officer refers to "description pages 2, 3, 6 to 12, 14 to 22 and 24 filed in electronic form on 4 December 2014 ...".

1.3 The communication dated 16 September 2015 did not indicate that the text intended for grant differed from the applicant's request due to further amendments proposed by the examining division. In any case, the applicant did not *expressis verbis* approve the amended application documents as referred to in the communication dated 16 September 2015.

1.4 The applicant cannot be deemed to have approved the text communicated to it in this communication according to Rule 71(5) EPC:

1.4.1 Apparently neither the members of the examining division nor the appellant realised that the documents referred to in the communication dated 16 September 2015 did not correspond to the documents according to the applicant's request dated 29 July 2015.

1.4.2 The consequence as stipulated in Rule 71(5) EPC, i.e. "the applicant ... shall be deemed to have approved the text communicated to him under paragraph 3", only applies where the applicant, according to Rule 71(3) EPC, has been informed "of the text in which it [i.e. the examining division] intends to grant" the patent.

1.4.3 Under normal circumstances, it may be assumed that the text referred to in a communication under Rule 71(3) EPC reflects the true will of the examining division and is therefore identical to the text on the basis of which the grant of the patent is intended.

1.4.4 In the present case, however, there is sufficient evidence to conclude that this was not the case in respect of the communication dated 16 September 2015:

- The European Patent Office is held to decide upon a European patent application only in the text submitted [or agreed, see point 1.4.5 below] by the applicant (Article 113(2) EPC). However, the text referred to in the communication does not correspond to the text submitted by the applicant.
- The European Patent Office may on its own initiative suggest minor amendments. In accordance with Article 113(2) EPC, the Office's practice is

to only suggest amendments which the examining division can reasonably expect the applicant to accept, e.g. bringing a statement of invention in the description into conformity with the claims or correcting any linguistic or other minor errors. Composing non-fitting pages of a description in a way that distorts its meaning and leaves out entire passages randomly, as is the case here, cannot be expected to be accepted by an applicant: The description serves, *inter alia*, the important purpose of interpreting the claims in the context of Article 69 EPC (extent of protection) and of describing in detail at least one way of carrying out the invention claimed (Rule 42(1)(e) EPC). Therefore, it cannot be assumed that the Office, aiming at complying with the European Patent Convention, would intentionally propose such amendments.

- Furthermore, it is good standard practice at the Office to include every amendment suggested by the examining division not only in the text on the basis of which the patent is to be granted, i.e. in the "Druckexemplar" annexed to the communication under Rule 71(3) EPC (Form 2004C), but also to indicate them in the communication. A special field is provided at the bottom of page 1 of Form 2004C, in which amendments proposed by the examining division are to be indicated. In the present case, this field remained unaltered in comparison with the previous communication under Rule 71(3) EPC dated 25 March 2015. Hence, there is no indication that the examining division intended to include any further amendments to the latest application documents submitted by the appellant.

- With its statement of grounds of appeal, the appellant filed a copy of an internal document, Form 2092C, which had apparently been submitted on 3 August 2015 by the formalities officer to the examining division, together with the applicant's request for amendments dated 29 July 2015. It contains the finding that "The request was received within the IGRA period" and the request "Please decide below whether the requested amendments/corrections are allowable". This Form 2092C was then apparently returned to the formalities officer with box 3.1 ticked: "Consent is given to the amendments/corrections requested".

The form was signed only by the chairman and the primary examiner, which suggests that the members of the examining division did not want to deviate far from their first communication under Rule 71(3) EPC and wanted to comply with the applicant's request filed with the letter dated 29 July 2015 in response to the first communication. Had there been the intention to grant a patent only after proposing substantive amendments, all three members of the examining division would have had to make a decision (see Article 18(2) EPC, first sentence).

The board concludes that the members of the examining division were of the view that the applicant's request did not imply major amendments compared to the first communication under Rule 71(3) EPC and that they intended to issue a second such communication indicating their intention to grant the patent as requested without proposing any additional amendments on their own initiative.

The board concludes, especially given that the examining division did not indicate any new amendments in the corresponding field on page 1 of Form 2004C, that in the present case neither the documents referred to in Form 2004C nor the "Druckexemplar" reflected the text in which it intended to grant the European patent.

- 1.4.5 Where the text intended for grant is *not* communicated to the applicant under Rule 71(3) EPC, the fact that the appellant subsequently files a translation and pays the fees for grant and publishing is not decisive. The provisions of Rule 71(5) EPC, in this regard, refer to Rule 71(3) EPC and therefore presuppose that the applicant has not only been notified of *any* text but of the text *intended for grant*. Only in this case would Rule 71(5) EPC apply and would the filing of a translation and the payment of the relevant fees imply the approval of the text communicated to it.
- 1.4.6 The appellant's further argument (see point IX above), according to which the payment of the relevant fees and the filing of the translation had to be construed with regard to its apparent intent as a declaration under Rule 71(6) EPC that it kept to the latest text submitted by it, does not need to be further considered here. The same holds true for the appellant's further argument regarding the protection of legitimate expectations.
- 1.4.7 As the text on the basis of which the patent was granted was not in accordance with the request of the applicant, the applicant was adversely affected by the decision under Article 97(1) EPC.
- 1.5 Filing an appeal against the decision to grant was an adequate remedy (see T 1869/12, Reasons 4.5). At the same time, legal certainty for third parties is

provided by the fact that where the decision becomes binding, deficiencies can no longer be challenged (see T 1869/12, Reasons Nr 4.6; T 854/12, Reasons 7).

1.6 All other requirements pursuant to Rule 101(1) EPC being met, the board concludes that the appeal is admissible.

2. *Allowability of the appeal*

2.1 A decision to grant pursuant to Article 97(1) EPC which is based on an application in a text which was neither submitted nor agreed to by the applicant, as is the case here (see points 1.2 to 1.4 above), does not comply with Article 113(2) EPC.

2.2 The decision under appeal is therefore to be set aside.

3. *G 1/10*

3.1 In arriving at this decision, the board does not deviate from G 1/10. Article 21 RPBA does not therefore apply.

3.2 In G 1/10, the Enlarged Board of Appeal found that Rule 140 EPC is not available to correct the text of a patent. This question is not at stake in the present case.

3.3 It is only in the context of the consideration that the absence of a correction possibility under Rule 140 EPC should not prejudice the patent proprietor (Reasons Nr. 8 to 12) that the Enlarged Board refers to the availability of other means to ensure the correctness of the text in a granted patent and to the opportunity

and responsibility to check the text of the supporting documents before approving it (Reasons 11). Therefore, the general statement that "any errors remaining in the text after grant should be his [*the proprietor's*] alone, whether the error was made (or introduced) by him or by the examining division" cannot prejudice the question of how Rule 71(5) EPC is to be construed.

- 3.4 Furthermore, in G 1/10, the Enlarged Board, in the context of the above cited passage, refers to amendments made by either the applicant or the examining division that might contain inaccuracies like a mis-spelt or incorrect word that should be brought to the attention of the examining division by the applicant before giving its approval.

In such a case, there normally exists an intention to grant a patent based on amended documents and the amendments - if not introduced by the applicant itself - are at least indicated in the communication under Rule 71(3) EPC. Thus, unlike in the present case, the filing of the translation and the payment of the relevant fees would normally mean that the text intended for grant is deemed approved pursuant to Rule 71(5) EPC.

- 3.5 Furthermore, the Enlarged Board (see Reasons 12) mentions the right to appeal a decision to grant when the granted text was not approved by the proprietor. The present case is an example of this. Since there is a limited period of two months for filing an appeal in accordance with Article 108 EPC, the need for legal certainty is fulfilled (see G 1/10, Reasons 5).
- 3.6 The present decision is based on the fact that the text intended for grant had not been communicated to the

applicant and, therefore, Rule 71(5) EPC did not yet apply. As a result, no text had been approved by the applicant. This is fundamentally different from attempts to impute mistakes in amended claims which were introduced by an applicant 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" as referred to by the Enlarged Board in G 1/10 (see Reasons 11).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance with the order to grant a patent on the basis of the following documents:
 - claims 1 to 16 as filed with the letter dated 29 July 2015;
 - description pages 1, 4, 4a, 5, 13 and 23 as filed with the letter dated 29 July 2019;
 - description pages 2, 3, 6 to 12, 14 to 22 and 24 as originally filed; and
 - drawing sheets 1/9 to 9/9 as published.

The Registrar:

The Chairman:



G. Rauh

F. van der Voort

Decision electronically authenticated



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Case Number: T 2081/16 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 23 July 2019
correcting an error in the decision
of 15 November 2018

Appellant: Intel Corporation
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Representative: Goddar, Heinz J.
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Decision under appeal: **Decision of the Examining Division dated
18 February 2016 to grant a European patent
according to Article 97 (1) EPC**

Composition of the Board:

Chairman: F. van der Voort
Members: P. Guntz
T. Snell

The typographical error "2019" in the order of the decision is corrected such that it reads "2015" (Rule 140 EPC).

The Registrar:

The Chairman:



G. Rauh

F. van der Voort

Decision electronically authenticated