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**Datasheet for the decision
of 30 August 2019**

Case Number: T 1003/19 - 3.3.05

Application Number: 11846831.3

Publication Number: 2649211

IPC: C22B11/00, C22B3/12, C22B3/22,
C22B3/24, C22B3/42, B01D11/00

Language of the proceedings: EN

Title of invention:

CO-CURRENT AND COUNTER CURRENT RESIN-IN-LEACH IN GOLD LEACHING
PROCESSES

Applicant:

Barrick Gold Corporation

Headword:

Failure to communicate the text intended for grant - missing
drawing sheets

Relevant legal provisions:

EPC Art. 97(1), 108, 113(2)
EPC R. 71(3), 71(5), 73(1)

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, J 0004/09, T 0850/95, T 0854/12, T 1869/12,
T 2081/16

Catchword:

1. 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 2.4).
2. The fact that the list of documents intended for grant neither corresponds to any request of the applicant nor to any amendment explicitly suggested by the examining division is sufficient to indicate that the communication under Rule 71(3) EPC does not contain the text intended for grant; the existence of discrepancies between the text of the communication and the "Druckexemplar" may be another indication (see Reasons 2.4.4).
3. Differentiation from G 1/10 (see Reasons 4).
4. Where the applicant could have noticed an apparent discrepancy between the text of the communication under Rule 71(3) EPC and the "Druckexemplar", the reimbursement of the appeal fee is not equitable by reason of a substantial procedural violation (see Reasons 5).



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Case Number: T 1003/19 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 30 August 2019

Appellant:

(Patent Proprietor)

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Decision under appeal:

**Decision of the Examining Division of the
European Patent Office posted 7 January 2019
granting European patent 2 649 211 pursuant to
Article 97(1) EPC.**

Composition of the Board:

Chairman E. Bendl
Members: P. Guntz
A. Haderlein

Summary of Facts and Submissions

- I. This appeal of the applicant (appellant) lies from the decision of the examining division dated 7 January 2019 to grant a patent on the basis of application documents as indicated in a communication under Rule 71(3) EPC dated 13 August 2018 following examination of European patent application No. 11846831.3, which was filed on 7 December 2011 as an international application with publication No. WO 2012/076981 A1.
- II. The original application contained description pages 1 to 15, claims 1 to 30 and drawing sheets **1/7** to **7/7**. Following several communications of the examining division, the applicant electronically filed new claims 1 to 13 on 30 August 2016 and new description pages 1 to 16 on 7 June 2018. Throughout the proceedings before the examining division, an amendment of the drawing sheets was never suggested by the examining division nor requested by the appellant.
- III. On 13 August 2018 a communication under Rule 71(3) EPC was sent to the appellant informing it of the examining division's intention to grant a European patent on the basis of its application, however listing the following text and drawings:
- description, pages 1 to 16 filed in electronic form on 7 June 2018;
 - claims, numbers 1 to 13 filed in electronic form on 30 August 2016;
 - drawings, sheets **1/1** as published.
- IV. The appellant subsequently filed a translation of the claims in the two other official languages and paid the

fee for grant and publishing on 6 December 2018.

- V. In its statement of grounds of appeal, the appellant argued that the communication dated 13 August 2018 which did not contain any reference to an amendment - within the set of drawing sheets - listed the drawings **as published** and a description that, in paragraph [0039], referred to all the figures 1 to 7 as originally published. Thus, there were clear indications that it was not the intention of the examining division to grant a patent containing only a single sheet of drawings showing, of all things, just figure 1 that is explicitly marked "PRIOR ART". Against the backdrop that amendments to the figures had never been requested by the applicant nor suggested by the examining division it thus seemed that the real intention of the examining division was to grant a patent including all 7 drawing sheets and that the indication "1/1" was an obvious mistake.
- VI. It was furthermore pointed out with reference to T 850/95 that, as the patent had not been granted based on documents approved by the appellant, a substantial procedural violation had occurred which justified the filing of the present appeal and the request for the reimbursement of the appeal fee.
- VII. The appellant requested to correct the decision under appeal and the publication to include the complete set of figures 1 to 7. The appellant further requested a reimbursement of the appeal fee.
- VIII. In parallel with the present appeal the appellant submitted a request for correction of the patent under Rule 140 EPC on 6 March 2019. In a communication dated 28 March 2019 and following the decision G 1/10 the

examining division has assessed the request as being inadmissible.

Reasons for the Decision

The appeal is admissible (point 2) and allowable (point 3). The board in arriving at this conclusion does not deviate from G 1/10 (see point 4).

1. *Interpretation of the request on the merits*

The board understands the appellant to request on the merits that the decision under appeal be set aside and that a patent be granted based on the following documents:

- claims 1 to 13 as filed in electronic form on 30 August 2016;
- description pages 1 to 16 as filed in electronic form on 7 June 2018;
- drawing sheets 1/7 to 7/7 as published.

2. *Admissibility of the appeal*

2.1 The appeal is admissible. The appellant is adversely affected. The granted version of the patent corresponds neither to a text submitted by the appellant (see below, point 2.2) nor to a text agreed by it (point 2.3), nor to a text deemed to have been approved by it (point 2.4). There is, therefore, a discrepancy between the appellant's request and the decision of the examining division.

- 2.2 Whereas the appellant neither by its letter dated 7 June 2018 nor by any prior letter requested the grant of a patent with any other than the 7 drawing sheets as initially submitted and published, the communication under Rule 71(3) EPC dated 13 August 2018 refers only to "drawings, sheets 1/1 as published".
- 2.3 The said communication did not indicate that the drawing sheets intended for grant differed from the appellant's request due to further deletions proposed by the examining division. In any case, the appellant did not *expressis verbis* approve the amended application documents as referred to in the communication dated 13 August 2018.
- 2.4 The appellant also cannot be deemed to have approved the list of documents communicated to it in this communication according to Rule 71(5) EPC:
- 2.4.1 Apparently neither the members of the examining division nor the appellant realised that the documents referred to in the communication dated 13 August 2018 did not correspond to the documents according to the appellant's latest request, i.e. corresponding to the application documents as last amended by its letter dated 7 June 2018.
- 2.4.2 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. The meaning of the word "text" (in German: "Fassung") is not limited to written information but may contain visual information as can be deduced from Rule 73(1)

EPC: "The specification of the European patent shall include the description, the claims and any drawings."

- 2.4.3 Under normal circumstances, it is to 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.
- 2.4.4 In the present case, however, there is sufficient evidence to conclude that this was not the case in respect of the communication dated 13 August 2018:
- The European Patent Office is held to decide upon a European patent application only on the text submitted [or agreed, see point 2.4.5 below] by the applicant (Article 113(2) EPC). However, the drawing sheet referred to in the communication does not correspond to the drawing sheets 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. Removing all drawing sheets showing embodiments of the invention, as is the case here, cannot be expected to be accepted by an applicant: the description, in paragraph [0039] et seq. still referring to the missing figures, 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 the removal of all drawing sheets except one that relates to the prior art.

- 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 was used by the examining division but only to indicate an amendment on page 1 of the description and to refer to Rule 48(1)(c) EPC and the Guidelines. In contrast, no deletion of any drawing sheets is mentioned. Hence, there is no indication that the examining division intended to include such amendments to the application documents submitted by the appellant.
- Finally, at the time of issuing the communication, the whole file did not contain any drawing sheet marked "1/1". While the sheet annexed to the communication dated 13 August 2018 bears a "1/1" in small letters at the top, seemingly printed over the original page, it is marked "1/7" in bold at the bottom. Thus, there is an obvious discrepancy between the text of the communication and the proposed "Druckexemplar".

The board concludes from all these indications that in the present case neither the documents referred to in Form 2004C nor the documents making up the "Druckexemplar" corresponded to the text, i.e. the description, claims and drawing sheets, in which the examining division intended to grant the European patent.

The case is not to be confused with the one where the communication refers to the correct documents as submitted by an applicant and these documents contain mis-spellings or other inaccuracies; in such a case it must be assumed that the examining division actually intended to grant a patent based on these documents even if it may have overlooked any inaccuracies contained therein (see sections 4.4 and 4.6 below).

- 2.4.5 The board *mutatis mutandis* follows the logic of T 2081/16 (cf. section 1.4 of the Reasons). There it is clarified that in cases where the text intended for grant is *not* communicated to the applicant under Rule 71(3) EPC, the fact that the applicant 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. Following this reasoning, Rule 71(5) EPC correspondingly does not apply in the present case, as the applicant was also not informed of the text in which the examining division intended to grant the patent.

- 2.4.6 As the text on the basis of which the patent was granted was not in accordance with the request of the appellant, the appellant was adversely affected by the decision under Article 97(1) EPC.
- 2.5 Filing an admissible 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 not in danger because the appealed decision has not yet become binding (see section 4.5 below).
- 2.6 All other requirements pursuant to Rule 101(1) EPC being met, the board concludes that the appeal is admissible.
- 3. *Allowability of the appeal*
 - 3.1 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 appellant, as is the case here (see points 2.2 to 2.4 above), does not comply with Article 113(2) EPC.
 - 3.2 The decision under appeal is therefore to be set aside.
- 4. *G 1/10*
 - 4.1 In arriving at this decision, the board does not deviate from G 1/10. Article 21 RPBA does not therefore apply. With regard to decision T 850/95 Article 20(1) sentence 1, second alternative RPBA applies.
 - 4.2 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.

4.3 The Enlarged Board expressly considers that the absence of a possibility to request patent corrections under Rule 140 EPC should not prejudice the patent proprietor (Reasons Nr. 8 to 12) and 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 "the responsibility for 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.

4.4 Furthermore, in G 1/10, the Enlarged Board, in the context of the above cited passages, 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 generally mean that the text intended for grant is deemed approved pursuant to Rule 71(5) EPC.

4.5 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 applicant. The

present case is an example of this. Since there is a limited period of only 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) and no danger exists that the text of a granted patent may be challenged years later: once the granting decision has become binding, any deficiencies during the granting process are remedied (see T 1869/12, Reasons 4.6; T 854/12, Reasons 7).

- 4.6 G 1/10 bases its consideration on the requirement according to Rule 71(3) EPC that the applicant must be informed of the text in which the examining division intends to grant a patent (see Reasons 10) and deals with the applicant's possible reactions thereto, like the implicit approval of this text. In contrast thereto the present decision is based on the fact that the text intended for grant by the examining division had, based on verifiable facts, not been communicated to the appellant and, therefore, Rule 71(5) EPC did not (yet) apply. As a result, no text had been approved by the appellant.

This is fundamentally different from attempts to impute to the examining division mistakes in amended claims which were introduced by an applicant "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).

5. Rule 103(1)a) EPC provides for a refund of the appeal fee where an appeal is allowable and the reimbursement is equitable by reason of a substantial procedural violation.
 - 5.1 As the decision under appeal does not comply with Article 113(2) EPC (see 3.1 above), the examining division committed a substantial procedural violation.
 - 5.2 The reimbursement of the appeal fee is not equitable if an applicant made no use of opportunities to participate in the initial proceedings (J 4/09, Reasons 4).
 - 5.3 In the case at hand, while the first communication of the examining division dated 12 May 2016 contained the statement that "examination is being carried out on the following application documents [...] Drawing, Sheets 1/7-7/7 as published", in all subsequent communications starting with the one dated 22 December 2016 this passage reads "examination is being carried out on the following application documents [...] Drawing, Sheets **1/1** as published" (emphasis added by the board). It appears therefore that the error was introduced by the examining division as early as in December 2016 and found its way into the communication under Rule 71(3) EPC.
 - 5.4 Normally, non-observation of the requirements of Article 113(2) EPC by the examining division justifies reimbursement of the appeal fee, as is also mentioned in G 1/10, paragraph 12 of the Reasons. In the present case, however, while the error was committed by the examining division, the appellant had several instances to spot this error and, at the latest, could and should have noticed it when comparing the text of the communication under Rule 71(3) EPC and the

"Druckexemplar". In particular, the fact that no published drawing sheet "1/1" existed but only one marked "1/7" should have alerted the appellant and should have prompted a double check.

5.5 The fact that a narrow interpretation of Rule 71(3) and (5) EPC as proposed by this board and by the board in decision T 2081/16 (see section 2.4. above) allows for an appeal to be treated as admissible should not be misinterpreted as an invitation to neglect the applicant's duty to carefully check both the communication and the "Druckexemplar" sent to it under Rule 71(3) EPC.

5.6 The request for reimbursement of the appeal fee is therefore rejected.

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 13 as filed in electronic form on 30 August 2016;
 - description pages 1 to 16 as filed in electronic form on 7 June 2018;
 - drawing sheets 1/7 to 7/7 as published.
3. Appellant's request for refund of the appeal fee is rejected.

The Registrar:

The Chairman:



C. Vodz

E. Bendl

Decision electronically authenticated