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**Datasheet for the decision
of 26 October 2020**

Case Number: T 0265/20 - 3.5.05

Application Number: 11820257.1

Publication Number: 2609534

IPC: G16H40/00, G16H40/40,
G16H40/60, G16H40/67

Language of the proceedings: EN

Title of invention:

SYSTEM FOR ENABLING TEST DATA FROM A CLINICAL ANALYTIC DEVICE
TO BE COMMUNICATED TO AN ELECTRONIC PATIENT INFORMATION
MANAGEMENT SYSTEM

Applicant:

Zafena AB

Headword:

Deemed approval to the text intended for grant

Relevant legal provisions:

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

Keyword:

Admissibility of appeal - appellant adversely affected despite
decision to grant a patent
Approval by paying fee for grant and publishing and filing
translations - binding effect

Decisions cited:

T 1003/19, T 2081/16, T 2277/19, T 2864/18, G 0001/10,
T 0850/95, J 0009/10

Catchword:

1. The appellant is adversely affected by the decision to grant a patent in the present case, as all of the drawing sheets as requested are missing from the text of the granted patent (point 1).

2. It is not the content of the text intended for grant which triggers the deemed approval under Rule 71(5) EPC, but rather the applicant paying the fee for grant and publishing and filing the translations according to Rule 71(5) EPC. Thus the "true will" of the members of the examining division when editing the communication pursuant to Rule 71(3) EPC is of no relevance (point 2).



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 0265/20 - 3.5.05

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 26 October 2020

Appellant: Zafena AB
(Patent Proprietor) Sjöbacka Fallhagen 1
590 76 Vreta Kloster (SE)

Representative: AWA Sweden AB
Östra Storgatan 7
553 21 Jönköping (SE)

Decision under appeal: **Decision of the Examining Division to grant a patent dated 26 September 2019**

Composition of the Board:

Chair A. Ritzka
Members: D. Prietzel-Funk
E. Konak

Summary of Facts and Submissions

I. The appeal lies from the decision of the examining division to grant a European patent on the basis of the application documents indicated in the communication pursuant to Rule 71(3) EPC following examination of European patent application No. 11 820 257.1, which was filed on 25 August 2011 as an international application with publication No. WO 2012/026872.

II. The original application documents contained description pages 1 to 22, claims 1 to 31 and drawing sheets 1/4 to 4/4. During the examination procedure, the applicant filed new claims 1 to 12 in electronic form on 26 February 2019 and new description pages 1 to 23 in electronic form on 11 March 2019. The drawing sheets were neither discussed nor amended.

III. The examining division issued a communication under Rule 71(3) EPC on 29 May 2019 on Form 2004. The list of documents on the basis of which the patent was intended to be granted was indicated as follows:

- description, pages 1 to 23 filed in electronic form on 11 March 2019,
- claims, numbers 1 to 12 filed in electronic form on 26 February 2019,

with some minor amendments to the above-mentioned documents proposed by the division regarding claims 4 and 11.

None of drawing sheets 1/4 to 4/4 as originally filed was mentioned in the list. Also the Druckexemplar sent

as an annex to the appellant did not contain drawing sheets.

- IV. The appellant subsequently filed a translation of the claims in the two other official languages and paid the fee for grant and publishing within the period indicated in the communication dated 29 May 2019.
- V. On 26 September 2019 the examining division issued the decision to grant a European patent pursuant to Article 97(1) EPC in the form as indicated in the communication under Rule 71(3) EPC.
- VI. After having discovered that the drawings were missing from the B1 publication, the appellant filed a request for correction pursuant to Rule 140 EPC.
- VII. The appellant also filed an appeal against the grant of the patent. It requested in the oral proceedings before the board

that the decision under appeal be set aside and that a patent be granted on the basis of the following documents:

- claims 1 to 12 as filed in electronic form on 26 February 2019,
- description pages 1 to 23 as filed in electronic form on 11 March 2019, and
- drawing sheets 1/4 to 4/4 as published.

As a first auxiliary request, the appellant requested that the decision under appeal be set aside and that the case be remitted to the examining division with the order to grant a patent based on the same documents as for the main request.

As a second auxiliary request, the appellant requested that the case be referred to the Enlarged Board of Appeal with the questions set out on page 6 of the letter dated 16 October 2020.

VIII. The appellant's submissions may be summarised as follows.

The appellant argued that the text intended for grant enclosed with the communication pursuant to Rule 71(3) EPC was not the text on the basis of which the examining division was intending to grant a patent. Given that the documents forming part of the original application as filed contained drawing sheets 1/4 to 4/4, that the file history did not indicate the removal of any drawings and that the references to the drawings still formed part of the description of the granted patent, it was clear that the drawings were intended to be part of the granted patent. The granted version therefore did not correspond to any text submitted by the appellant, nor did it correspond to any text agreed to by it.

The appellant claimed that it was adversely affected by the impugned decision. In case the board was minded to follow case T 2277/19 and hold the appeal inadmissible on the grounds that the appellant was not adversely affected, there would arise a clear divergence in the case law, also with regard to decisions T 1003/19 and T 2081/16, in which the appeals were found to be admissible in practically identical cases. In such a case, the appellant requested that the questions set out on page 6 of its letter dated 16 October 2020 be referred to the Enlarged Board of Appeal as follows:

Where a substantial mistake in the Druckexemplar is introduced through the actions of the EPO, can the applicant be adversely affected in the sense of Article 107 EPC, in spite of the provisions relating to the deemed approval of the text pursuant to Rule 71(5) EPC?

If the answer to the question is yes, under what circumstances can the appellant be deemed to be adversely affected?

The appellant further stated that neither the examining division nor the appellant realised that the documents in the communication under Rule 71(3) EPC did not correspond to the appellant's latest request. The communication was clearly erroneous, and the error was introduced by the examining division, which thus was the very cause of the problem. As was decided in decisions T 1003/19 and T 2081/16, the stipulation of Rule 71(5) EPC that the applicant shall be deemed to have approved the text communicated to it by filing the fee for grant only applied where the applicant/appellant had been informed of the text with which the examining division in fact intended to grant the patent.

The present appeal also corresponded to the practice set out in decision G 1/10 by the Enlarged Board of Appeal. Unlike the case in which correction of obvious mistakes in the text of a granted patent according to Rule 140 EPC was denied, this appeal aimed to grant a patent on the basis of the documents including the drawing sheets as requested by the appellant before the examining division.

Reasons for the Decision

1. The appeal is admissible.
- 1.1 According to Article 107 EPC, first sentence, any party to the proceedings adversely affected by a decision may appeal.
- 1.2 The board acknowledges that the appellant is adversely affected in the case at hand by the discrepancy between the appellant's explicit request in the examination proceedings for the grant of a patent and the content of the B1 publication. The impugned decision did not include drawing sheets 1/4 to 4/4, and thus the B1 publication lacks these drawing sheets, which is clearly less than what was requested by the appellant. The fact that all of the drawing sheets were missing is sufficient in the present case to assume that the appellant was adversely affected by the impugned decision, irrespective of why they are missing and how the legal framework of Rule 71 EPC has to be interpreted.
- 1.3 The board sees no reason to refer the case to the Enlarged Board of Appeal under Article 112 EPC in this regard. It does not consider that the case requires a decision by the Enlarged Board to ensure uniform application of the law with respect to the admissibility of the appeal regarding the question of being adversely affected.
 - 1.3.1 Firstly, with respect to the admissibility of the appeal, the board decided in favour of the appellant. Thus, the outcome of this case does not depend on the question of admissibility. The appellant also acknowledged that in this case the questions

intended to be referred to the Enlarged Board of Appeal were of no relevance.

1.3.2 Secondly, the board also does not consider decision T 2277/19 to amount to diverging case law with the need to refer questions regarding the admissibility of the appeal to the Enlarged Board of Appeal on its own motion.

(a) In T 2277/19, the facts were different from the outset. In that case, the original application contained the description pages, the claims and in particular drawing sheets 1/18 to 18/18. During the examination proceedings, the applicant filed amended drawing sheets 1/7 to 7/7 in order to replace drawing sheets 1/18 to 18/18 of the application as filed. The drawing sheets 1/7 to 7/7 as explicitly requested by the applicant were included in the text communicated to the appellant under Rule 71(3) EPC, but drawing sheets 8/18 to 18/18, which had in fact been withdrawn by the applicant before, were also included. The applicant then approved the text intended for grant subject to minor amendments. The board held the appeal inadmissible on the ground that the appellant was not adversely affected.

(b) The facts of the case at hand differ in that no drawings at all, neither the requested ones nor any others, were included in the text communicated to the appellant under Rule 71(3) EPC and the Druckexemplar, and in that no explicit approval was given, but the approval was rather deemed to have been given. Thus, there is no diverging case law and consequently no need to refer the case to the Enlarged Board of Appeal.

1.4 Since all other requirements regarding the admissibility of the appeal pursuant to Article 108 EPC and Rule 99 EPC are fulfilled, the appeal is admissible.

2. Allowability of the appeal

2.1 A decision on a European patent application pursuant to Article 97(1) EPC complies with Article 113(2) EPC when it is based on a text submitted to the EPO or agreed by the applicant. Before the examining division decides to grant the patent, it shall inform the applicant of the text in which it intends to grant it (Rule 71(3) EPC). According to Rule 71(5) EPC, if the applicant pays the fee for grant and publishing and files the translations of the claims in the two other official languages within a period of 4 months, it shall be deemed to have approved the text communicated to it under Rule 71(3) EPC.

2.2 It follows that the concluding step in establishing the final text for grant is the approval of the text by the applicant. Without the applicant's approval of the text intended for grant, there is no grant of the patent.

2.3 In the case at hand, it is undisputed that the applicant/appellant, upon receiving the communication pursuant to Rule 71(3) EPC with the text intended for grant, in which drawing sheets 1/4 to 4/4 were missing from the list of documents, made no comments. Instead, it paid the fee for grant and publishing and filed the translations of the claims in the other official languages within the period of 4 months.

- 2.4 Thus, the prerequisites for the legal consequence foreseen in Rule 71(5) EPC were fulfilled. Taking into account its wording, the provision does not require more than that. The legal consequence is that the applicant is deemed to have given approval to the text communicated to it under Rule 71(3) EPC. This effect takes place by operation of law, no matter whether the text intended for grant is correct or whether the applicant is aware of any mistakes or of the fact that paying the fee for grant and publishing and filing translations would have such a consequence. It takes place even if the applicant does not consider the text communicated to it at all. The deemed approval takes effect by way of a legal fiction, a well-recognised legal tool to assume a fact, used in the provision by saying that the applicant "shall be deemed" to have approved the text communicated to it under Rule 71(3) EPC, under the specified circumstances. Whether or not the text is really approved does not matter in a legal sense.
- 2.5 The appellant argued that the stipulation of Rule 71(5) EPC only applied when the applicant was in fact informed of the text which reflected the true will of the examining division. Only the text really intended for grant was decisive, not the one communicated under Rule 71(3) EPC. The appellant referred to decisions T 1003/19 and T 2081/16, in which it was found that the list of documents intended for grant neither corresponded to any request by the applicant nor to any amendment explicitly suggested by the examining division. This was regarded as being sufficient to indicate that the communication under Rule 71(3) EPC did not contain the text intended for grant. Thus, Rule 71(5) EPC did not apply (see T 1003/19, catchwords 1 and 2, and also T 2081/16, catchword), and no approval

was given. The appellant argued that these findings also applied in the case at hand, since in the examination proceedings neither the applicant nor the examining division ever suggested deleting or removing the drawing sheets. Since the text was not the really intended text, the filing of the translation and the payment of fees by the appellant in response to the communication was not an approval of the text, and thus Rule 71(5) EPC did not apply.

- 2.6 The board does not share this view. The unambiguous wording of Rule 71(5) EPC does not allow for an interpretation other than the foreseen legal consequence as set out above under point 2.2.

Firstly, there is no legal basis in the EPC for a distinction between the text referred to in a communication under Rule 71(3) EPC and the text really intended by the examining division (see also T 2277/19, point 1.3 of the Reasons).

Secondly, it is not the content of the text which triggers the deemed approval under Rule 71(5) EPC, but the applicant paying the fee and filing the translations according to Rule 71(5) EPC. It follows that it is pointless to explore the "true will" of the members of the examining division when editing the communication pursuant to Rule 71(3) EPC. In fact, it is the applicant itself with whom the final responsibility for the text remains, not the examining division.

- 2.7 The appellant argued against such an interpretation by relying on the legitimate expectation that the text communicated to it under Rule 71(3) EPC would correctly reflect what the final text for grant should be and

that, in particular, none of the application documents would be removed without any reason. While this legitimate expectation cannot be denied, it is not relevant for deciding the case at hand, taking into account the legal mechanisms foreseen in Rule 71 EPC. It is rather the applicant's responsibility to check whether the text communicated to it corresponds to what it has requested. Rule 71(6) EPC namely addresses the possibility that the text communicated under Rule 71(3) EPC does not reflect the appellant's requests and gives the applicant the right to request amendments. As already indicated in decision T 2277/19, point 1.3 of the Reasons, and also in the board's view, Article 71(3) EPC imposes on the applicant a duty to check and verify this text. The fact that an applicant does not exercise its right to request amendments under Rule 71(6) EPC can therefore only be interpreted as consent to the communicated text, i.e. the text intended for grant. Whether or not the applicant notices a possible error in the text has no effect on the fact that its approval, whether given explicitly or deemed to have been given under Rule 71(5) EPC, is binding.

2.8 This binding effect does not appear unjust or unbalanced. It may reasonably be expected that the applicant reads the communicated text thoroughly and verifies that the text is the one it expects it to be before approving it by paying the fee and filing translations. Moreover, the fact that paying the fee and filing translations means approval of the communicated text is indicated in EPO Form 2004 used for the communication under Rule 71(3) EPC.

2.9 The appellant also pointed to decision T 850/95, in which the board found that there were obvious mistakes in the text and corrected the decision to grant. Not

only did that case deal with the correction of an obvious mistake which is different from what the appellant requested here, but decision G 1/10 also expressly disagreed with the board's approach according to point 5 of the Reasons. The cited case thus cannot be seen as a valid precedent for the case at hand. The same is true for decision J 9/10, point 2.8 of the Reasons, cited by the appellant. Since it is based on totally different facts, the decision does not appear to have any relevance for the case at hand.

2.10 Taking into consideration decision G 1/10, this decision, in the board's view, does not prejudice the interpretation of Rule 71 EPC since it deals with the correction of errors pursuant to Rule 140 EPC, which is quite different from what is requested here. This was not contested by the appellant either.

2.11 Taking into consideration decisions T 1003/19 and T 2081/16 too, the board finds that they do not amount to diverging case law which requires a decision of the Enlarged Board of Appeal pursuant to Art. 112(1) EPC to ensure the uniform application of the law. In decisions T 1003/19 and T 2081/16, the board held that the appellant cannot be deemed to have given its approval by paying the fee for grant and publishing because the text communicated to it under Rule 71(3) EPC did not reflect the true will of the examining division and what it intended to grant. In the case at hand, the board has no doubt that the wording of Rule 71 EPC does not allow it to be concluded that the "true will" of the examining division is something that has to be taken into consideration when making a judgement regarding the deemed approval and its binding effect. Moreover, no convincing reasons can be identified in this respect in the cited decisions. The board thus

refrained from a referral to the Enlarged Board of Appeal.

3. From these considerations it follows that the appeal is not allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



A. Chavinier-Tomsic

A. Ritzka

Decision electronically authenticated