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**Datasheet for the decision  
of 19 December 2024**

**Case Number:** T 0423/21 - 3.3.08

**Application Number:** 13800852.9

**Publication Number:** 2859350

**IPC:** G01N33/574, G01N21/64,  
A61K31/24, A61K31/197, C12Q1/48

**Language of the proceedings:** EN

**Title of invention:**  
5-ALA FOR DETECTION OF BRAIN TUMORS

**Applicant:**  
Pioma Inc.

**Headword:**

**Relevant legal provisions:**  
EPC Art. 97, 113  
EPC R. 71(3), 139, 140  
RPBA 2020 Art. 15(1)

**Keyword:**  
Correction of errors in decisions - grant decision

**Decisions cited:**

G 0001/10, J 0042/92, T 0506/16, T 2081/16, T 1003/19,  
T 2277/19, T 0806/21

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

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Case Number: T 0423/21 - 3.3.08

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.08**  
**of 19 December 2024**

**Appellant:** Pioma Inc.  
(Patent Proprietor) 1827 South Bayshore Lane  
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**Representative:** Rystedt, Hampus  
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**Decision under appeal:** **Decision of the Examining Division posted on  
29 October 2020 refusing the request for  
correction of the patent publication**

**Composition of the Board:**

**Chairman** D. Pilat  
**Members:** M. Montrone  
A. Bacchin

## Summary of Facts and Submissions

- I. The appeal of the patent proprietor (appellant) lies from the decision of an examining division dated 29 October 2020 to refuse correction of the publication of European patent No. EP 2 859 350.
- II. The patent is based on European patent application No. 13 800 852.9 which was filed as international application PCT/US2013/044351 on 5 June 2013 and published as WO 2013/184830. The international application as filed contained *inter alia* 1-18 drawing sheets, with 15 drawings. During the proceedings before the examining division, the drawing sheets were not amended by the then applicant, either at its request or in response to a communication from the examining divisions.
- III. With a communication pursuant to Rule 71(3) EPC dated 5 December 2018 (EPO Form 2004C), the examining division indicated the intention to grant a patent including the following documents:
- (a) Description, pages 1-27 filed in electronic form on 8-12-2017
  - (b) Claims, numbers 1-11 filed in electronic form on 8-12-2017, with the relevant amendments to the description and the claims, as proposed by the division.
- Drawings were neither mentioned in this communication nor in the attached "Druckexemplar".
- IV. The appellant did not file any amendment to the documents on the basis of which the examining division intended to grant the patent. Instead they filed a

translation of the claims and paid the relevant grant and printing fees on 26 March 2019.

- V. On 11 April 2019, the decision to grant the patent (Form 2006A) was issued on the basis of the patent documents indicated in the examining division's communication under Rule 71(3) EPC. The decision took effect on the date of publication of the mention of the grant on 8 May 2019. This decision was not appealed.
- VI. With two letters, respectively dated 23 July 2019 and 6 August 2019 the appellant requested correction of the published European patent in order to include the 18 sheets of drawings indicated in the application as filed.
- VII. The requests were refused by communications of 5 August 2019 and 26 September 2019 substantially on the ground that correction of errors concerning the text of the patent, which are not publication errors or formatting/editing errors, cannot be corrected. Reference was made to decision G 1/10 according to which Rule 140 EPC was not available to correct the text of a patent.
- VIII. With further letter dated 6 November 2019 the appellant requested a decision on the allowability of the request for correction of the B1 publication of the patent.
- IX. In the appealed decision, issued on 29 October 2020 following a communication under Article 113(1) EPC, the examining division rejected the appellant's requests.
- X. In the statement of grounds of appeal, the appellant made in essence the following submissions:

- (a) The appellant has never actively withdrawn the drawings from the application.
- (b) The examining division in its communication under Rule 71(3) EPC did not indicate that it intentionally proposed to remove the drawings from the application.
- (c) Thus the omission of the drawings was an inadvertent error of the examining division, as confirmed in its reply to the appellant's request for correction ("This text proposed for grant erroneously omits drawing sheets 1-18", communication by the examining division dated 26 September 2019).
- (d) For this reason the text present in the communication under Rule 71(3) EPC was not the text on which the examining division actually intended to grant a patent.
- (e) Cases T 2081/16 and T 1003/19 support the fact that this discrepancy is fundamental. In those decisions the board held that an applicant, in application of Rule 71(5) EPC, cannot be considered to have approved the text of a patent communicated to it, if that text is not the text intended for grant in the sense of Rule 71(3) EPC. Thus the appellant's response with the filing of the translated claims and the payment of the relevant fees cannot be understood as an implicit approval of the present text of the patent.
- (f) The appellant's legitimate expectations that the patent be granted with the drawings had therefore been violated. If the omission of the drawings were easily identifiable, then it would have been also the EPO's obligation to warn the appellant about the missing drawings before issuing the decision to grant.

- (g) The examining division misunderstood the appellant's request as an appeal under Rule 140 EPC against the decision to grant. The appeal is rather directed to a correction of the patent publication. For this reason the reference by the examining division to decision T 2277/19 is not pertinent.
- (h) There was at least an implicit consensus between the examining division and the appellant that the drawings should be included in the granted patent. The applicant's right to be heard under Article 113(1) EPC had been violated.
- (i) It would be immediately evident for third parties by reading the description in the Druckexemplar that drawings were part of the patent. Moreover there was only one set of drawings available on file.
- (j) The teaching of G 1/10 that Rule 140 EPC is not available to correct the text of the patent is not applicable to a request for correction of the drawings. In addition G 1/10 did not consider the situation in which the appellant's rights under Article 113(1) EPC have been violated.
- (k) Rule 139 EPC is available also when proceedings are no longer pending before the EPO. With the introduction of administrative reviews under Articles 105(a), (b) and (c) with the EPC 2000, the EPO has now jurisdiction over a granted European patent. For this reason the EPO is in a position to correct obvious mistakes under Rule 139 EPC also in granted patents.

XI. With a communication under Article 15(1) RPBA the board provided its provisional opinion that the board tended to agree with the decision under appeal for essentially the same reasons as adopted by the examining division. Oral proceedings were scheduled on 12 December 2023.

- XII. In reaction to the board's communication, the appellant informed the board that it was not going to be represented at the oral proceedings and requested a decision on the record.
- XIII. As a consequence, oral proceedings were cancelled.
- XIV. The appellant requests:
- that the decision under appeal be set aside and the case be remitted to the examining division with an order to correct the patent publication so as to include drawing sheets 1-18 as originally filed (main request),
  - or in the alternative that the case be remitted to the examining division with an order to correct the decision to grant under Rule 140 EPC so as to include drawing sheets 1-18 as originally filed (first auxiliary request).
  - The appellant further requests that the case be remitted to the examining division with an order to reintroduce the missing drawing sheets 1-18 as a correction under Rule 139 EPC (second auxiliary request).

## **Reasons for the Decision**

### *Main request*

1. The appellant's main request is directed to the correction of the publication of the patent at stake.
2. As explained below, no errors in publication occurred in the present case since the publication relies



exclusively on the grant decision (see section V above) and exactly corresponds to it.

3. Errors in publication occur where the content of the printed specification differs from the documents (Druckexemplar) transmitted to the applicant with the communication under Rule 71(3) EPC (Form 2004), if these documents form the basis of the decision to grant.
4. Such errors in publication can be corrected at any time.
5. However, in the present case the printed specification is identical to the Druckexemplar transmitted to the applicant with the communication under Rule 71(3) EPC (see section III above). In both cases the drawings sheets 1-18 are missing. Therefore no errors in publication occurred in the current case. The appellant's main request cannot be granted.
6. In the board's view the appellant's main request actually aims at correcting the patent publication by introduction of the drawing sheets, on the basis of a decision to grant which does not provide for drawing sheets. Therefore - under the present circumstances - this request does not differ from the first auxiliary request, which is directed to remit the case to the examining division with an order to correct the decision to grant under Rule 140 EPC so as to include the drawing sheets as originally filed. For this reason, the argument that the examining division misunderstood this request cannot be followed.
7. In view of this state of requests, the board deals with the further submissions by the appellant in the

framework of the main request, although they properly belong to the request to correct the decision to grant, i.e. the first auxiliary request.

8. The appellant invoked decisions T 1003/19 and T 2081/16 to further support their requests (see section X, e) above).
9. In those cases the board reasoned that the applicant cannot be deemed to have approved the text in which the examining division intended to grant the patent because the text communicated to him did not express the true intention of the examining division. The decision to grant therefore did not comply with Article 113(2) EPC.
10. As correctly observed in the decision under appeal, cases T 1003/19 and T 2081/16 concern appeals from the decision to grant under Article 97(1) EPC, not a correction of that decision already in effect in accordance with Article 97(3) EPC (T 2081/16, Reasons 3.2; T 1003/19, Reasons 4.2). The decisions to grant in those cases were thus not yet final, so that legal certainty was not prejudiced. In the current case, in contrast, no appeal was filed against the decision to grant, therefore the latter became final (Article 97(1) and (3) EPC) and the granted patent ceased to be within the jurisdiction of the EPO (G 1/10, OJ EPO 2013, 194, Reasons 6). Already for this reason, none of these decisions is of relevance to the present legal assessment.
11. Further the board is currently not convinced by the appellant's interpretation of decisions T 1003/19 and T 2081/16, that, even without having appealed the decision to grant, a patent can be corrected if a communication under Rule 71(3) EPC does not reflect the

true intention of the examining division. To support this interpretation, the appellant argues that the right to be heard and the principle of legitimate expectations have been violated.

12. First, the appellant's interpretation of decisions T 1003/19 and T 2081/16 is not in line with the ruling of G 1/10 that "Rule 140 EPC is not available for correcting patents". This ruling is clearly not confined in its scope in any way and equally applies to all requests under Rule 140 EPC filed after grant of the patent and even to situations where the error was made or introduced by the examining division (see G 1/10, Reasons 11 and also T 806/21, Reasons 3). Thus the appellant's argument that G 1/10 did not consider the situation in which the appellant's rights under Article 113 EPC have been violated does not stand.
13. Second, as further explained below in the context of the first auxiliary request, Rule 71(3) EPC imposes on applicants a duty to check and verify the documents communicated to them as intended for grant. If, following this obligation, an applicant does not draw the examining division's attention to any errors, then the applicant alone bears the responsibility for any errors remaining in the documents, regardless of who is responsible for the error, i.e. even when the error is introduced by the examining division and is unconditionally approved by the applicant (see G 1/10, Reasons 11 and see also T 506/16, Reasons 3).
14. In the present case the appellant was given the possibility to verify the documents proposed by the examining division both in the EPO Form 2004C and in the attached "Druckexemplar" under Rule 71(3) EPC. Upon receiving this communication, the appellant should have

noted that the documents intended for grant did not contain any drawings and should have requested their inclusion in order to safeguard their interests. Instead, the appellant failed to do so and expressly approved the documents communicated in accordance with Rule 71(3) EPC in their letter of 26 March 2019.

Therefore the board is unable to see how the provision of Article 113(2) EPC, which requires the EPO to decide upon a European patent application only in the text submitted or agreed by the applicant, has been infringed, as well as how the appellant's right to be heard had been violated.

15. Finally, the board fails to see how the communication under Rule 71(3) EPC was misleading or otherwise violated the principle of protection of legitimate expectations, since both the documents indicated in Form 2004C and in the attached Druckexemplar were identical (unlike in case T 1003/19). Thus the appellant could not reasonably expect, on the basis of that communication, that the documents intended for grant contained any drawings.

*First auxiliary request*

16. The appellant's request to correct the decision to grant under Rule 140 EPC cannot be allowed either.
17. The examining division correctly referred to the principle established by the Enlarged Board of Appeal in G 1/10 that Rule 140 EPC is not available for correcting patents and that such a correction is inadmissible whenever made.

18. As it is the applicant's duty to properly check all the documents making up the communication under Rule 71(3) EPC (i.e. Form 2004 and the Druckexemplar), the responsibility for any errors remaining after grant are his alone, whether the error was made (or introduced) by him or by the examining division.
19. In this context, point 2 of the communication under Rule 71(3) EPC expressly invites the applicant to either approve the documents communicated therein and verify the bibliographic data or, in case of disapproval, to request reasoned amendments or corrections to the documents communicated.
20. Since the appellant neither requested reasoned amendments nor corrections to the documents communicated to them, the completion of the required acts, namely the filing of a translation of the claims and paying the relevant fees, implied an unconditional approval of the text proposed by the examining division within the meaning of Rule 71(5) EPC.
21. The appellant's argument that the *rationale* of G 1/10 does not apply to the present case since it is requested to correct the drawings, rather than the *text* of the patent has no basis. The questions referred to the Enlarged Board in that case concern the correction of the grant decision under Rule 140 EPC. Accordingly, the Enlarged Board clarified the scope of decision G 1/10, as being "*...confined to corrections of patents themselves - to the description, claims and drawings (often called the "patent documents")... The Enlarged Board's decision is therefore limited to corrections within grant decisions of the description, claims and drawings and references in these reasons to "patent*

*corrections" or "correcting patents" are also so limited.*" (see G 1/10, Reasons 3.)

22. It is therefore undisputed that the *rationale* of G 1/10 is fully applicable to the present request for correction of the (missing) drawings in the grant decision. The board further notes that a decision to grant under Article 97(1) EPC can only be based on the patent documents, i.e. claims, description and drawings, which have been communicated to the applicant under Rule 71(3) EPC and have been approved by the applicant under Rule 71(5) EPC. Therefore the present request for correction of the drawings cannot be distinguished from the request to correct the decision to grant.
23. Under the present circumstances, the first auxiliary request is not allowable in view of the principle established by G 1/10 that Rule 140 EPC is not available in order to correct patents.

*Second auxiliary request*

24. The appellant also relies on Rule 139 EPC in order to reintroduce the missing drawing sheets 1-18 as a correction.
25. As correctly held by the examining division, this provision is only available as long as proceedings are pending before the Office (see also G 1/10, Reasons 9).
26. A request under Rule 139 EPC may indeed only be filed during the pendency of an application or of opposition proceedings (see J 42/92, Reasons 6).

27. Therefore, since in the current case the decision to grant has become final, the EPO has no jurisdiction to change the text of the granted patent or deal with the request for correction (see also G 1/10, Reasons 6). In contrast to the appellant's argument, opposition and limitation proceedings are the only exception to this rule. The request for correction under Rule 139 EPC is therefore also not allowable in the present case.

*Conclusion*

28. In view of the above considerations, the board decides that none of the appellant's requests can be granted.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

D. Pilat

Decision electronically authenticated