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**Datasheet for the decision
of 17 June 2022**

Case Number: T 0806/21 - 3.3.04

Application Number: 11192705.9

Publication Number: 2468770

IPC: C07K16/18, A61P25/28

Language of the proceedings: EN

Title of invention:

Humanized antibody against amyloid beta.

Applicant:

AC Immune S.A.
Genentech, Inc.

Headword:

Humanized antibody/IMMUNE and GENENTECH

Relevant legal provisions:

EPC R. 140

Keyword:

Correction of errors in decisions - grant decision

Decisions cited:

G 0001/10, T 2081/16, T 1003/19

Catchword:

As ruled in decision G 1/10, Rule 140 EPC is not available to correct patents. G 1/10 does not restrict the scope of the exclusion of the applicability of the rule in any way.



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Case Number: T 0806/21 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 17 June 2022

Appellant: AC Immune S.A.
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Appellant: Genentech, Inc.
(Patent Proprietor 2) One DNA Way
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 14 October 2020
refusing correction under Rule 140 EPC of the
decision to grant the European Patent No. 2 468
770

Composition of the Board:

Chair M. Pregetter
Members: O. Lechner
P. de Heij

Summary of Facts and Submissions

- I. The appeal of the patent proprietors is against the decision of the examining division dated 14 October 2020 to refuse correction of the decision to grant European patent No. 2 468 770, ensuing from application No. 11 192 705.9.
- II. The patent application as filed contained 131 pages, including pages 106 to 131, which describe several embodiments of the claimed invention. During the examination proceedings, the examining division opined that these pages contravened Article 84 EPC and should therefore be deleted.
- III. With a letter dated 5 April 2017, the appellants filed new pages 1 to 84 of the description, which were to replace pages 1 to 84 then on file. Pages 106 to 131 of the description were cancelled. With a further letter dated 27 April 2017, new pages 8a to 8f were filed, to replace pages 8a to 8e.
- IV. The examining division's communication pursuant to Rule 71(3) EPC dated 17 May 2017 included a description spanning pages 1 to 84. No reference was made to pages 85 to 105. The appellants subsequently filed some amendments to the text on the basis of which the examining division intended to grant the patent, which included amended pages of the description. However, the appellants did not comment on the omission of pages 85 to 105. Furthermore, the appellants waived the right to receive a further communication under Rule 71(3) EPC.
- V. The examining division's communication pursuant to Rule 71(3) EPC dated 13 November 2017 again referred only to

pages 1 to 84 of the description. In the communication it is noted that there is agreement as to the text to be granted, that the required fees have been paid and that the translation of the claims has been filed, and it is announced that the decision to grant will be issued. The subsequent decision to grant dated 23 November 2017 is based on the documents indicated in the communication dated 13 November 2017. This decision was not appealed.

- VI. With a letter dated 20 January 2020, the appellants requested correction of the decision to grant under Rule 140 EPC, so as to incorporate pages 85 to 105 of the description into the text of the granted patent, stating that the omission of these pages was an obvious error.
- VII. The decision under appeal acknowledges that the omission of pages 85 to 105 was an error of the examining division. However, according to decision G 1/10, Rule 140 EPC was not available for correcting patent documents. The two cases that the appellants had relied on, T 1003/19 and T 2081/16, differed from the case at hand in that in those cases the decision to grant had not been final and had been appealed within the time limit for appeals.
- VIII. In their notice of appeal and statement of grounds of appeal, the appellants requested that the decision be set aside and that the request for correction of the decision under Rule 140 EPC, filed on 20 January 2020, be allowed. Oral proceedings were requested in the event the board did not intend to allow the request for correction or intended to reject the appeal as inadmissible.

IX. The board issued a communication pursuant to Article 15(1) RPBA and arranged for oral proceedings to be held. In its communication, the board informed the appellants that it was inclined to agree with the decision under appeal.

X. With a letter dated 13 June 2022, the appellants additionally requested the referral of questions to the Enlarged Board of Appeal (EBA). The questions to be referred were as follows:

Question 1: Is a request to correct a decision to grant under Rule 140 EPC admissible in circumstances where pages of the application were accidentally omitted by the Examining Division when assembling the text for grant? In particular, is a request to correct a decision to grant under Rule 140 EPC admissible in circumstances where the text omits pages of the application and this omission was i) not introduced by the applicant; and ii) not indicated as an intentional deletion in the communication under Rule 71(3) EPC?

Question 2: If the answer to question 1 is yes, can the request for correction be allowed, provided that the error is obvious in the sense that it is clear not only that the deciding body did not intend to decide as appears from the decision, but also in what form it did intend to decide?

XI. During the oral proceedings the appellants maintained their requests as stated in the written proceedings. At the end of the oral proceedings, the Chair announced the board's decision.

XII. The appellants' arguments, as far as they are relevant to the decision, can be summarised as follows:

There was a fundamental difference between the case underlying the G 1/10 decision and the case at hand. The former concerned a situation in which the examining division had intended the patent to include amendments, but an error had occurred in the intended amendments. In the case at hand, no amendment had been intended; there had simply been a formatting error. Such a formatting error could be corrected under Rule 140 EPC. Decision G 1/10 did not apply to this kind of error. Correction of the error would not be to the detriment of legal certainty, as the error and its correction were obvious. This was explained in decision G 1/10, section 8 of the Reasons.

The appellants' view was supported by section III.L.2 of the Case Law of the Boards of Appeal, 9th edition, 2019 and by the Guidelines for Examination in the EPO, sections H.VI.3.1 (paragraph 1) and H.VI.3.4 (paragraph 5). Decisions T 2081/16 and T 1003/19, although different from the case at hand in that they concerned appeals against the decision to grant, were relevant because it was reasoned that in a situation like the present one, the applicant had to be deemed not to have been informed of the text on the basis of which the examining division intended to grant the patent.

In the event the board doubted decision G 1/10 to be applicable to the case at hand, the appellants' questions were to be referred to the EBA to clarify this issue. Decision G 1/10 was not unambiguous. In particular, it was not clear to what situations section 12 of the Reasons referred. In addition, section 8 of the Reasons seemed to contradict the subsequent order.

In the case at hand, the error and the correction were obvious. From the file history it was clear that the examining division had accidentally omitted pages 85 to 105 from the communication under Rule 71(3) EPC. There could be no doubt that it had been the intention of the examining division to include those pages in the text of the patent.

XIII. The appellants' final requests were:

- that the decision under appeal be set aside and that the request for correction of the decision under Rule 140 EPC, filed on 20 January 2020, be allowed;
- that the questions as formulated in their letter dated 13 June 2022 be referred to the EBA in the event the board was minded not to allow the requested correction without referral.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 99 EPC and is admissible.
2. The arguments advanced by the appellants have not convinced the board for the following reasons:
3. Decision G 1/10 clearly expresses that, for reasons of legal certainty, Rule 140 EPC is not available for correcting patents (see section 5 of the Reasons). This exclusion of the applicability of the rule is not restricted in scope in any way. The board therefore cannot accept an interpretation of decision G 1/10 according to which, as argued by the appellants, Rule 140 EPC can be applied to correct a patent if the communication under Rule 71(3) EPC does not reflect the true intention of the examining division because it

includes an unintentional amendment to the application as filed. There is nothing in the decision even hinting at such an approach. On the contrary, the arguments for the exclusion of the applicability of the rule, in particular legal certainty, equally apply to this particular situation.

4. In addition, decision G 1/10 (see section 11 of the Reasons) appears to eliminate any possible doubt by stating: *"If, given the opportunity to check the patent text before approving it, an applicant does not draw any errors to the attention of the examining division and thus ensure his approval is limited to the correct text, then the responsibility for any errors remaining in that text after grant should be his alone, whether the error was made (or introduced) by him or by the examining division"*. The decision further illustrates this with two examples.
5. The first example concerns a situation in which the applicant approved the text of the patent that contained an error that had been introduced by the applicant itself or by the examining division. Correction under Rule 140 EPC is not possible, even if it is contended that the examining division did not intend to make a decision which included the text approved by the applicant.
6. The second example (see section 12 of the Reasons) concerns a situation in which the decision to grant concerns a text of the patent that has not been approved by the applicant because it contains an error which was introduced by the examining division subsequent to the approval of the applicant of the text of the patent. Such a decision is open to appeal (but cannot be corrected under Rule 140 EPC).

7. Particularly in the second example it can be assumed that the decision of the examining division did not correspond with its intentions, but these circumstances did not lead the EBA to a different conclusion regarding the applicability of the rule. Moreover, the board cannot see the slightest indication that it makes a difference whether the true intention of the examining division was that the patent would include amendments (as compared to the application as filed) or not. The gist of these examples is that the interests of the applicant/patent proprietor are sufficiently safeguarded by the required approval of the text and the opportunity to appeal the decision to grant.

8. Cases T 1003/19 and T 2081/16 do not support the appellants' interpretation of decision G 1/10. These decisions reason that, in a situation like the present one, the applicant cannot be deemed to have approved the text on the basis of which the examining division intended to grant the patent because the text communicated to it did not express the true intention of the examining division. The decision to grant therefore did not comply with Article 113(2) EPC. As correctly observed in the decision under appeal, cases T 1003/19 and T 2081/16 concern appeals based on decisions to grant, not the correction of those decisions (see T 2081/16, sections 3.2 and 3.5 of the Reasons; and T 1003/19, sections 4.2 and 4.5 of the Reasons). These cases are therefore of no relevance to the present legal assessment.

9. The reference to parts H.VI.3.1 and H.VI.4 of the Guidelines for Examination (the board assumes the appellants intended to refer to H.VI.4 as H.VI.3.4 does not exist) is not convincing either. H.VI.3.1,

paragraph 1, states, *inter alia*, that after the decision to grant formatting and editing errors may be corrected. H.VI.4 concerns a more detailed correction of such formatting and editing errors, the latter being defined as "*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*". Since in the case at hand Form 2004 dated 13 November 2017 clearly indicated a description containing pages 1 to 84 only, the error does not qualify as a formatting or editing error within the meaning of part H.VI.4 of the Guidelines but instead constitutes an error for which "*the patent proprietor has to file an appeal to seek remedy*" (part H.VI.4, last sentence). Therefore, quite apart from the fact that the board is not in any way bound by the Guidelines, applying them would not benefit the appellants here in any case.

10. In the same vein as the Guidelines, section III.L.2 of the Case Law of the Boards of Appeal, 9th edition, states that formatting/editing errors fall under Rule 140 EPC. The appellants cannot find any support for their view here for the same reasons as set out above with respect to their references to the Guidelines.
11. The board does not see the need to refer questions to the EBA, as requested by the appellants, in order to receive guidance on a point of law of fundamental importance. That guidance has already been given in decision G 1/10. The board fails to see the supposed contradiction in section 8 with the order, in which the former states in essence that the patent proprietor has no legitimate need for the opportunity of correction, and the latter denies that opportunity. Furthermore,

section 12 of the Reasons unmistakably deals with errors of the examining division that are made after the approval of the patent proprietor of the text of the patent, as indicated in the first sentence of that paragraph. Neither of the issues raised by the appellants cast doubt on the clear guidance of the decision. The board sees no basis for referring questions to the EBA in the present case. Therefore, the request is rejected.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



I. Aperribay

M. Pregetter

Decision electronically authenticated