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**Datasheet for the decision
of 11 July 2023**

Case Number: T 1877/21 - 3.3.05

Application Number: 17196706.0

Publication Number: 3395779

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H01M10/054

Language of the proceedings: EN

Title of invention:

ALKALI METAL SUPER IONIC CONDUCTING CERAMIC

Applicant:

Enlighten Innovations Inc.

Headword:

Super Ionic Conducting Ceramic/Enlighten

Relevant legal provisions:

EPC R. 139

EPC Art. 123(2)

RPBA 2020 Art. 13(2)

Keyword:

Correction of error - immediately evident that nothing else could have been intended (no)

Amendments - allowable (no)

Amendment after summons - exceptional circumstances (no)

Decisions cited:

G 0003/89, G 0011/91, T 0737/90, T 0341/04, T 1931/13

Catchword:



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Case Number: T 1877/21 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 11 July 2023

Appellant: Enlighten Innovations Inc.
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Calgary, Alberta T2G 1B1 (CA)

Representative: HGF
HGF Limited
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 17 May 2021
refusing European patent application No.
17196706.0 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman E. Bendl
Members: G. Glod
S. Fernández de Córdoba

Summary of Facts and Submissions

I. The appellant's (applicant's) appeal lies from the examining division's decision refusing European patent application No. 17 196 706.0 for non-compliance with Article 123(2) EPC. The examining division found that the introduction into the application as filed of page 7 of the parent application could not be considered a correction within the meaning of Rule 139 EPC and therefore infringed Article 123(2) EPC.

II. The appellant argued that in view of the page numbering of the application as filed, it was immediately evident that a page was missing between pages 6 and 8. The introduction of page 7 of the parent application should be allowed since it was the evident correction of an obvious error. Paragraphs [49] to [69] of page 7 showed numerous chemical formulae that did not provide any flexibility for change. This situation was different to in case T 1931/13, where the then missing page 5 provided many possibilities of amendment. The currently missing page 7 could have been easily retrieved by a search. T 341/04 and T 737/90 were relevant.

The auxiliary request presented during oral proceedings before the board contained only the paragraphs of page 7 of the parent application for which it was immediately evident that no change was intended.

III. At the end of the oral proceedings of 11 July 2023, the appellant's requests were as follows.

The appellant requested that the impugned decision be set aside and that a patent be granted on the basis of the main request underlying the impugned decision.

Auxiliary it was requested to include into the description as filed page 7 of the parent application without paragraph [0070].

Reasons for the Decision

Main request

1. Rule 139 EPC
 - 1.1 Under Rule 139 EPC, "[l]inguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request. However, if the request for such correction concerns the description, claims or drawings, the correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction".
 - 1.2 For a correction to the description, the claims or the drawings to be allowable under Rule 139 EPC, second sentence, EPC, the boards apply a two-step approach. It must be established (i) that it is obvious that an error is in fact present in the document filed with the EPO and (ii) that the correction of the error is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction (Case Law of the Boards of Appeal of the EPO, 10th edn., 2022, II.E.4.2).
 - 1.3 In the case at hand, the board accepts, in line with decision T 1931/13 (Reasons 1) cited by the appellant, that the gap between pages 6 and 8 shows that an error occurred in the filing of the application.

- 1.4 The board is, however, not convinced that what had been intended by the applicant is immediately evident. The scope of protection envisaged by the appellant - and a possibly adapted description - cannot be derived from the claims since no claims were filed with the application. The skilled person reading the application as filed would notice that some materials in Tables 2, 3 and 4 are not further specified in the application. However, the skilled person would not know whether these materials are relevant for the invention meaning that their specification was forgotten or whether they are not relevant for the invention meaning that their specification might not be needed.
- 1.5 The appellant's argument is based on the skilled person immediately realising that information was missing in the description to these tables. Even if the board accepted this argument, which it does not, what the exact missing part was would still be questionable. Since it is accepted that page 7 is missing, the skilled person would probably recognise that Table 1 is incomplete. It may be true that the skilled person would also accept that within each of paragraphs [0049] to [0069] of the parent application there is no reason for change. However, it is not immediately evident that the appellant did not intend to delete one (or more) of these paragraphs. Furthermore, changes in paragraph [0070] would also not be excluded by the skilled person, including, for example, the deletion of the last sentence of that paragraph. Therefore, it cannot be accepted that it would be immediately evident that the whole of page 7 of the parent application was omitted by error. If there is any doubt that nothing else would have been intended than what is offered as the correction, a correction cannot be made (G 03/89, Reasons 6).

1.6 The appellant also argued that the skilled person would consider the compound with the designation "E-04", cited on the page to be inserted, to be a kind of reference and that they would use this reference in a specific search with quotes, i.e. "E-04 membrane electrolytic cell". This would inevitably lead them to the parent application, in which they would identify page 7 and add it to the application as filed. The board does not concur with the appellant that the material indicated in the application could be used as a reference as in G 11/91 (Reasons 7), in which the reference was a reference to a document; not to one material among others.

Furthermore, even if the skilled person did a search for E-04, there is no reason why they would specifically use the term "E-04 membrane electrolytic cell" in quotes as a search term in Google. Using an equally likely "E-04 NaSICON material" as the search term without quotes gives a very high number of hits, while the same expression with quotes gives no hits. So there is no one-way street to the result.

But even if it was again accepted that the skilled person would perform such a search, there is no reason to assume that the missing page would be introduced in the description without any change. As indicated above under point 1.5, it would be just as reasonable to assume that the intention was to amend page 7 and that the amended page was simply forgotten.

To conclude, the appellant's arguments are completely based on hindsight; starting from the result and trying to justify why it would have been evident to arrive at that result.

1.7 The arguments based on T 341/04 and T 737/90 are irrelevant for the current case since neither case dealt with a correction under Rule 139 EPC and the "immediately evident" requirement. Instead, they concerned the retrieval of a document based on the information available in the description. This means that it was known what was missing, unlike in the case at hand.

In case T 341/04, the question was whether a referenced document which could be unambiguously identified at the date of filing of the document containing the reference by its document number but which was "missing", in that it was not available at the date of filing, can be "taken into account" for the purpose of Article 83 EPC by relying on information in a family member of the referenced document (Reasons 1.3). In T 341/04, the board was of the opinion that the skilled person would have retrieved the document and used the information it contained.

In case T 737/90, the question was whether the cross-reference to a co-pending application in the description was sufficient to allow an unambiguous identification and an easy retrieval of the document referred to (Reasons 2). The board was satisfied that the skilled person would have been able to retrieve the document and use it for the purpose of sufficiency.

In the current case, however, the question was not whether a certain defined content could be retrieved but rather what the content was meant to be.

1.8 The appellant's argument that their evidence should be judged on the basis of the balance of probabilities

cannot be accepted since the wording of Rule 139 EPC requires the correction to be "immediately evident", pointing to a high degree of certainty. This is also in line with the established case law (Case Law of the Boards of Appeal of the EPO, 10th edn., 2022, II.E.5). As indicated above (points 1.4 and 1.5), several corrections could be argued as probable. However, Rule 139 EPC requires that it is immediately evident that there is only one option for correcting the error. This degree of certainty does not lead to a rule without purpose since numerous cases exist where a correction was accepted. Some examples can be found in Case Law of the Boards of Appeal of the EPO, 10th edn., 2022, II.E.4.2.3.

1.9 To conclude, the board is not convinced that the inclusion of page 7 is an immediately evident correction of an error. The requirements of Rule 139 EPC are not fulfilled.

2. Article 123(2) EPC

Since page 7 does not find a basis in the application as filed, the requirements of Article 123(2) EPC are not fulfilled, and the main request is not allowable.

Auxiliary request

3. Article 13(2) RPBA 2020

This request was first submitted during the oral proceedings before the board. Article 13(2) RPBA 2020 applies. For the following reasons, the board cannot

recognise any exceptional circumstances that justified that the request be taken into account.

The communication pursuant to Article 15(1) RPBA 2020 was issued on 3 March 2023. It dealt with all points and arguments brought forward in the grounds of appeal. It was indicated under point 1 that the communication was not an invitation to make further submissions. This is also in line with the case law (Case Law of the Boards of Appeal of the EPO, 10th edn., 2022, III.C. 6.4.2).

During the oral proceedings before the board, part of the discussion dealt with whether the skilled person would consider amending page 7 of the parent application possible and reasonable. This question was dealt with in the impugned decision (point 14.4, last sentence) and generally under point 5.6 of the communication pursuant to Article 15(1) RPBA 2020. Thus, the discussion during oral proceedings did not raise any new objections or questions of law which were not present at the start of the appeal proceedings and which would possibly have triggered the submission of a new request (Case Law of the Boards of Appeal of the EPO, 10th edn., 2022, V.A.4.5.6 c)).

In addition, this new request leads for the first time to the question of whether complementing Table 1 only (without paragraph [0070]) could be considered an immediately evident correction of the accepted error. This represents a shift in the appellant's argument. Under the circumstances of the current case, there is no reason to accept such a shift at this late stage of the proceedings.

4. Since the request is not taken into account, there is no allowable request on file.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Vodz

E. Bendl

Decision electronically authenticated