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Aktenzeichen / Case Number / N<sup>o</sup> du recours : T 417/87 - 3.2.1

Anmeldenummer / Filing No / N<sup>o</sup> de la demande : 82 104 825.3

Veröffentlichungs-Nr. / Publication No / N<sup>o</sup> de la publication : 0 066 838

Bezeichnung der Erfindung: Extractor ventilator for industrial buildings  
Title of invention:  
Titre de l'invention :

Klassifikation / Classification / Classement : F24F 7/02, A01K 1/00

### ENTSCHEIDUNG / DECISION

vom / of / du 17 August 1989

Anmelder / Applicant / Demandeur : Fioratti, Paolo

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Extractor/Fioratti

EPÜ/EPC/CBE Article 123(2), Rule 88 EPC

Schlagwort / Keyword / Mot clé : Correction of errors in the description

Leitsatz / Headnote / Sommaire

Case Number : T 417/87 - 3.2.1



**D E C I S I O N**  
of the Technical Board of Appeal 3.2.1  
of 17 August 1989

**Appellant :** Fioratti, Paolo,  
Via P. Castaldi, 23  
I-20124 Milano (IT)

**Representative :** Faggioni, Marco, Dr. Ing. et al,  
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**Decision under appeal :** Decision of Examining Division 073  
of the European Patent Office  
dated 25 May 1987 refusing European  
patent application No. 82 104 825.3  
pursuant to Article 97(1) EPC

**Composition of the Board :**

**Chairman :** F. Gumbel

**Members :** C.T. Wilson  
J.-C. Saisset

## Summary of Facts and Submissions

- I. European patent application No. 82 104 825.3 filed on 2 June 1982 and published on 15 December 1982 under publication No. 0 066 838 was refused by a decision of the Examining Division dated 25 May 1987. The decision was based on Claims 1 to 8 received on 27 November 1986.
  
- II. The impugned decision comes to the conclusion that the patent application has been amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. In particular, the features of Claim 1, (which is essentially a combination of the original Claims 1 and 2), relating to the construction of a static extractor were not originally disclosed. Reference was made originally, in the description and in Claim 2, to a "Mueller" static extractor as described in Italian patent No. 833 144. However, this cited document relates to measuring and regulating the tension of filaments and the number is clearly incorrectly cited. Moreover, the term "Mueller" extractor has no well known meaning in the art. The Examining Division went further to assert in the Decision that:

"a correction of the wrongly cited document into IT-A-883 144, which is apparently the right document, according to Rule 88 of the EPC, cannot lead to admissible features of the "Mueller" extractor deriving from this document, since these features only came to notice with the request of the applicant for correcting the number of the document dated 9.10.85, i.e. after the filing date. At the filing date, merely by contesting that a wrongly cited Italian patent should relate to a "Mueller" extractor, it was not immediately evident that nothing else would have been intended than the IT-A-883 144."

III. A notice of appeal was filed on 13 July 1987, the appeal fee having been paid on 9 July 1987. The Statement of Grounds was filed on 2 October 1987 (in Italian) and on 17 October 1987 (in English). The Appellant argues essentially as follows:

- (i) Particularly in the light of the search carried out at the Italian Patent Office, the results of which were filed on 27 November 1986, and which shows that there are no other Italian patents in the name Mueller having a number similar to the wrong number 833 144, except for the correct number, it was obvious which number was intended. Since also the cited number was obviously wrong, a correction under Rule 88 EPC should have been allowed.
- (ii) The failure of the Examining Division to discuss in its decision the above referred to search carried out at the Italian Patent Office, constitutes a prejudice to the Appellant's rights.
- (iii) The term "Mueller" extractor is anyway well known in the art.
- (iv) Furthermore, the Appellant was surprised by the fact that the Examining Division rejected the present application as not complying with Article 123(2), before clarifying the situation with respect to the request for correction under Rule 88.
- (v) Further errors are to be seen in the assertions in the Decision that a correction according to Rule 88 cannot have a retrospective effect, and that for the correction to be allowed it must be immediately evident that nothing else would have been intended

than the IT-A-883 144 "at the filing date". In this respect reference was made to the decision J 04/85, OJ 7/1986, 205.

- (vi) Since the addition of the characteristics of the "Mueller extractor" was only filed by the Applicant on 27 November 1986 after the claims had already been once amended with the letter of 30 October 1984, said addition could have been made only with the approval of the Examining Division in accordance with Rule 86(3). It is procedurally clearly wrong for the Examining Division to then reject the application because of this addition.

IV. The Appellant requests that the impugned decision be set aside, and that the Board of Appeal:

- A - Declare allowable the correction requested according to Rule 88, to correct the number of the Italian patent indicated on page 5, line 14 of the description, by replacing the No. 833 144 with the No. 883.144;
- grant a patent on the basis of Claim 1 now on file, or return the patent application to the Examining Division with this indication.

As a subsidiary request, and in the event that the Board of Appeal should consider the request of correction according to Rule 88 not to be allowable, it is requested that the Board of Appeal:

- B - Recognise the term "MUELLER static extractor" and the characteristics thereof to be well known to the technicians of the field;

- grant a patent on the basis of Claim 1 now on file, or return the patent application to the Examining Division with this indication.

As a further subsidiary request, and in the event that the Board of Appeal should consider the term "Mueller static extractor" and its characteristics not to be well known to a technician expert in the field, it is requested that the Board of Appeal:

- C - Grant a patent on the basis of a new Claim 1, filed with the Statement of Grounds, or return it to the Examining Division with this indication.

The Applicant also requests to attend a hearing, in the event that the Board of Appeal should deem not to grant the request expressed in A hereabove.

It is finally requested to refund the appeal fee according to Rule 67 and, in the event that such a request should not be accepted, to partially refund said fee according to Rule 6(3).

#### Reasons for the Decision

1. The appeal is admissible.
2. In the original application documents reference was made in Claim 2 to a "Mueller" static extractor and on page 5, lines 11 to 14 to "This extractor is commonly known as the "Mueller" or "Modified Mueller" extractor and it consists of a double layer of suitably shaped and spaced blades, as described in the Italian patent No. 833 144". Since this cited patent relates to measuring and regulating the tension of filaments, it is clear that a mistake is

present. Moreover, the Appellant has filed evidence (see the result of the search made in the Italian Patent Office) to show that only two patents were recorded in the name of Mueller, (Mueller Heinrich), up to 31 October 1984, namely Nos. 883 144 and 820 719. In the light of the similarity between the incorrectly cited number and patent No. 883 144, which does indeed relate to an extractor, it is immediately evident that nothing else was intended than this patent. The request for correction of this number should therefore have been allowed under Rule 88 EPC.

3. Had this correction been allowed, then the objection under Article 123(2) EPC would not have arisen. The Examining Division is incorrect when it asserts that "a correction of the wrongly cited document into IT-A-883 144, which is apparently the right document, according to Rule 88 of the EPC, cannot lead to admissible features of the "Mueller" extractor deriving from this document, since these features only came to notice with the request of the applicant for correcting the number of the document dated 9.10.85, i.e. after the filing date. At the filing date, merely by contesting that a wrongly cited Italian patent should relate to a "Mueller" extractor, it was not immediately evident that nothing else would have been intended than the IT-A-883 144."

It has already been established in the earlier decision (J 04/85, OJ 7/1986, 205, paragraph 3) that "The correction of an error restores the application to the form in which it has been established that the applicant intended to file it, the correction thus taking effect "retroactively" on the date on which the application was filed."

4. In accordance with Rule 67 EPC, reimbursement of an appeal fee shall be ordered when a Board of Appeal deems an appeal to be allowable "if such reimbursement is equitable by

reason of a substantial procedural violation." In the present case, the Appellant appears to assert that there was such a violation in that no reference was made to the result of the search carried out in the Italian Patent Office in the written reasons for the decision. However, in the Board's opinion, failure to discuss this document does not necessarily mean that the Examining Division had not considered this argument at all.

The fact that the Examining Division did not follow the legal position taken in the above-mentioned decision J 04/85 concerning the retroactive effect of a correction under Rule 88 EPC cannot be considered as a "substantial procedural violation" either since, at the time when the impugned decision was issued, it was supported by the then valid version of the Guidelines (see C-VI, 5.9 of the version dated March 1985). Moreover, there was no reference to the Board's decision J 04/85 from the Applicant's side previous to the date of issue of the impugned decision.

Consequently, the Board does not see a substantial procedural violation within the meaning of Rule 67 EPC and therefore rejects the Appellant's request for reimbursement of the appeal fee.

Of course, the Appellant is entitled to have the reduction of appeal fee in accordance with Rule 6(3) EPC.

5. The remarks of the Appellant in respect of the application of Rule 86(3) EPC appear to be based on a misunderstanding. Consent of the Examining Division for further amendments does not imply that these amendments are acceptable. Indeed, it is only after consent to amend has been given that these amendments can be examined as to their allowability.



6. Since the requested correction under Rule 88 EPC has been allowed, it is not necessary to consider the subsidiary requests B and C and particularly to consider whether the term "Mueller" extractor is well known in the art.
7. The Examiner, during an informal interview with the Applicant, expressed the opinion that a new Claim 1 corresponding essentially to the Claim 1 now on file could form the base for an allowable claim if the IT-A-883 144 could be recognised as disclosed in the application as filed. Since the Board has now found that such is the case, it considers it proper to return this case to the first instance for completion of the examination on the basis of this present Claim 1.

#### Order

For these reasons, it is decided that:

1. The contested decision is set aside.
2. The correction requested according to Rule 88 EPC, namely to replace the reference on page 5, line 14 to No. 833 144 with the No. 883 144, is allowed.
3. Reduction of the appeal fee under Rule 6(3) EPC is ordered.

4. The case is remitted to the first instance for completion of substantive examination on the basis of Claim 1 received on 27 November 1986.

The Registrar:

*S. Fabiani*

S. Fabiani

The Chairman:

*F. Gumbel*

F. Gumbel

*A.B. Jones*