

Veröffentlichung im Amtsblatt	Ja/Nein
Publication in the Official Journal	Yes/No
Publication au Journal Officiel	Oui/Non

Aktenzeichen / Case Number / N° du recours : T 200/89 - 3.3.1

Anmeldenummer / Filing No / N° de la demande : 80 201 130.4

Veröffentlichungs-Nr. / Publication No / N° de la publication : 0 031 605

Bezeichnung der Erfindung:  
Title of invention: Method of manufacturing products from a copper  
Titre de l'invention : containing aluminium alloy

Klassifikation / Classification / Classement : C22C 21/16, C22F 1/04

### ENTSCHEIDUNG / DECISION

vom / of / du 7 December 1989

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet :

The Boeing Company

Einsprechender / Opponent / Opposant :

- 1) Schweizerische Aluminium A.G.
- 2) Pechiney S.A.

Stichwort / Headword / Référence : Obvious error/BOEING

EPÜ / EPC / CBE Article 123(2)(3), Rules 88 second sentence, Rule 51(4)

Schlagwort / Keyword / Mot clé : <sup>old version</sup>  
"Errors in claims" - "established by file history" - "Correction obvious in part to skilled reader of patent in isolation"

#### Leitsatz / Headnote / Sommaire

I. An allowable correction under Rule 88 EPC has a retrospective effect (Decisions J 4/85 - 3.1.1 dated 28 February 1986 "Correction of drawings/ETAT FRANCAIS", OJ EPO 1986, 205 and T 219/86 - 3.2.2 dated 3 July 1987 "Naming of opponent/ZOKOR", OJ EPO 1988, 254 followed), in contrast to an amendment under Article 123 EPC, which is not retrospective.

II. Article 123(3) EPC and Rule 88 EPC contain different requirements which are both intended to ensure legal certainty in the sense that after amendment or correction, to a skilled person the protection conferred by the patent should not be greater than was apparent before the amendment or correction.

.../...

III. If, following approval of the text of a patent, the proprietor discovers an error in the text, he is not estopped from correcting the error under Rule 88 EPC.

IV. For the purpose of Rule 88 EPC, whether an error is present in a document filed at the EPO is a subjective matter which may be established by reference to any relevant evidence (including here, the file history).

V. Whether correction of such an error in a patent is obvious in the sense of Rule 88 EPC is an objective matter which must be established by reference to the patent text in its entirety, but in isolation, and without reference to the file history.



Case Number : T 200/89

DECISION  
of the Technical Board of Appeal  
of 7 December 1989

Appellant : The Boeing Company  
(Proprietor of the patent) P.O. Box 3707  
Seattle, Washington 98124 (USA)

Representative : Octrooibureau Arnold & Siedsma  
P.O. Box 18558  
NL-2502 EN The Hague

Respondent : 01 Schweizerische Aluminium A.G  
(Opponent) CH-8212 Neuhausen am Rheinfall

02 Pechiney S.A.  
28, rue de Bonnel  
F-69433 Lyon Cedex 3

Representative :

Decision under appeal : Decision of the Opposition Division of the European  
Patent Office dated 8 November 1988 revoking  
European patent No. 0 031 605 pursuant to  
Article 102(1) EPC.

Composition of the Board :

Chairman : K. Jahn  
Members : F. Antony  
G.D. Paterson

Summary of Facts and Submissions

I. European patent application No. 80 201 130.4, which had been filed on 27 November 1980, claiming USA-priority of 28 December 1979, was granted as European patent No. 31 605 on 3 October 1984 with five claims, the only independent one, Claim 1, reading as follows:

"1. A method of manufacturing a product from an aluminium alloy of the 2000 series, said alloy having copper, magnesium and manganese as main alloying elements, characterised by providing an alloy of the following composition:

<u>Weight percent</u>	<u>Element</u>
4.2 to 4.7	Cu
1.3 to 1.8	Mg
0.8 to 1.3	Mn
0.08 to 0.15	Zr
a maximum of 0.25	Zn
a maximum of 0.15	Ti
a maximum of 0.10	Fe
a maximum of 0.12	Si
a maximum of 0.05	Each other trace element
a maximum of 0.15	Total of said other trace elements
the balance being	Al,

and by subjecting a body formed from said alloy to a treatment comprising the following steps:

homogenizing said body  
to provide a substantially uniform distribution of alloying elements,

hot working said body to form a wrought product, said hot working being conducted at temperatures effective to yield a product having a highly elongated and substantially unrecrystallized grain microstructure after solution treating and quenching said body."

II. Two notices of opposition were filed against the patent in suit, by

(1) Schweizerische Aluminium AG (hereinafter "Respondent 1") and

(2) Pechiney S.A. (hereinafter "Respondent 2"),

on 14 and 21 June 1985 respectively, requesting complete revocation of the patent, for lack of inventive step and, in the case of Respondent 2, also for lack of novelty.

III. Following issue of a summons to oral proceedings the Opposition Division became aware of a difference between, on the one hand, the granted version of Claim 1 as well as the corresponding part of the description (column 2, lines 8 to 51) and, on the other hand, the text of the application as originally filed (Claims 1 and 5), as follows:

As can be seen from the granted version of Claim 1 set out in I above, the named constituents of the alloy include iron with a maximum of 0.10% and do not include chromium (Cr) at all, whereas in the originally filed text, the iron content was given as up to 0.15%, and the chromium content as up to 0.10%. On the other hand, the text of the description in the patent as granted, apart from the passage at column 2, lines 8 to 51, corresponds to the text of the application as originally filed, and includes references to a maximum amount of iron of 0.15%

and to a maximum amount of chromium of 0.10% (see e.g. column 3, lines 26 to 29, and column 4, line 59 and following).

In a communication from the Opposition Division, it was suggested that the amendment during prosecution had violated Article 123(2) EPC. In response, the patent proprietor applied to correct Claim 1 as granted and the corresponding passage at column 2 so that they corresponded with the text of the application as originally filed, on the basis that a typing error had occurred and that correction of such an obvious transcription error was allowable in accordance with Rule 88 EPC.

- IV. In a decision orally announced at the end of the oral proceedings on 8 November 1988 and posted on 11 January 1989, the Opposition Division revoked the patent because Claim 1 as proposed to be corrected did not comply with the requirements of Art. 123(3) EPC. The proposed correction was not in respect of an obvious inconsistency; rather, the granted version had made sense as a restriction. A correction under Rule 88 EPC was thus not possible. It was expressly stated that the opposition grounds raised by the Opponents remained undiscussed.
- V. The patent proprietor (Appellant) filed a Notice of Appeal on 10 March 1989, paying the appeal fee at the same time, and submitted a Statement of Grounds on 9 May 1989. In this Statement he contended that the amended Claim 1 resulted from the correction of a transcription error, which was permissible following Decision T 113/86 dated 28 October 1987 (unpublished), because the inconsistency in the granted claim version was so obvious to a skilled person in the light of the description that the protection conferred by the amended claim could be anticipated by a

third party. In this connection, reference was made to column 3, lines 26-29; to column 4, line 64, to column 5, line 1; and to Example I mentioning 0.11% iron; as well as to the file history, which the Appellant contended should also be taken into consideration.

- VI. Respondent 1 made no observations. Respondent 2, in a written response, contested the existence of a transcription error and emphasised that the Appellant, following the communication pursuant to Rule 51(4) and (5) EPC, gave his agreement to the text of the patent to be granted (including the alleged error). The amendment during the examination stage was therefore an intentional restriction, which could not be reversed after grant.
- VII. All parties to the proceedings were duly summoned to an oral hearing which took place on 7 December 1989. Only the Appellant and Respondent 2 appeared at such proceedings.
- VIII. The Appellant emphasised that both prerequisites for the permissibility of a correction to the claim under Rule 88 EPC were met, viz. there had to be an error, and the corrected version of the claim (and the corresponding passage in column 2) was immediately evident to the careful reader of the specification; furthermore, any doubt as to the correct interpretation would be removed upon reading the file history.

The Appellant also submitted that the proposed amendments were allowable under Article 123 EPC, having regard to the text of the description of the patent as granted.

He requested that the Decision under appeal be set aside and that the patent be maintained - as Main Request - with specification as considered by the Opposition Division

(i.e. with Claim 1 and column 2 as submitted on 16 July 1987); as First Auxiliary Request - on the basis of the claims as filed during the oral hearing (i.e. granted Claim 1 with the sole difference of a maximum of 0.15% rather than 0.10% Fe); and as Second Auxiliary Request - with text as granted.

- IX. Respondent 2 argued that even if the evidence of an error was accepted, it was not evident from the granted specification what was the correct text. In particular, Example I mentioned 0.11% Fe, but was silent on the chromium content; besides, it was not unusual that after a restriction to claims there remained examples no longer covered by the claims. He requested that the appeal be dismissed.
  
- X. At the end of the oral proceedings the Chairman announced the decision of the Board that the Decision under appeal was set aside and the case was remitted to the Opposition Division to continue prosecution on the basis of the specification in accordance with the First Auxiliary Request.

#### Reasons for the Decision

- 1. The appeal complies with Arts. 106 to 108 and Rule 64 EPC; it is therefore admissible.
  
- 2. This appeal raises the question of the proper interpretation of the EPC as regards the relationship between Article 123 EPC and Rule 88 EPC. As set out above, the main contention of the Appellant was that the proposed correction of Claim 1 of the patent as granted (in accordance with his main request), so as to correspond



essentially to the text of Claim 5 of the application as originally filed, was allowable under Rule 88 EPC. He also contended that the proposed amended text did not offend Article 123 EPC. On the other hand, the Opposition Division held that the correction was not obvious within the meaning of Rule 88 EPC, in particular because, having regard to Decision T 113/86, dated 28 October 1987, a skilled person could not have anticipated the extent of protection conferred by the amended claim. Furthermore, Claim 1 as granted contravened Article 100(c) EPC (i.e. Article 123(2) EPC), and the proposed amendment to granted Claim 1 contravened Article 123(3) EPC.

- 2.1 In the Board's view, Rule 88 EPC is concerned with situations where an applicant or patent proprietor alleges that an error occurred in a document filed at the EPO, so that its contents at the time of filing did not in fact conform to what was intended. He therefore seeks to correct the error, in order that the corrected text should conform to what was originally intended.

In order for correction under Rule 88 EPC to be allowable, two matters must be established:

- (i) that an error is present in the document as filed at the EPO;
- (ii) that the correction of the error is obvious in the sense set out (i.e. "in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction").

If allowable, a correction under Rule 88 EPC has a retrospective effect (see Decisions J 4/85 (OJ EPO 1986, 205) and T 219/86 (OJ EPO 1988, 254)). In other words, it

must be assumed (as a legal fiction) that the corrected text was in fact the text as originally filed. On that basis, in the Board's view the question whether a correction which is allowable under Rule 88 EPC is also allowable under the provisions of Article 123 EPC does not ever require to be considered, because Article 123 EPC is concerned only with amendments and not with corrections, and an amendment is concerned with changing the text from what it was previously (and normally from what it was previously intended to be), and is not retrospective in its effect.

In any event, as is recognised in Decision T 401/88 dated 28 February 1989, headnote published in OJ 9/1989, both Article 123 EPC and Rule 88 EPC contain similar requirements which are clearly intended to ensure legal certainty as to the scope of protection conferred by the patent. Thus, as far as amendments proposed during opposition proceedings are concerned, under Article 123(3) EPC the proposed amendment must not extend the protection conferred. Under Rule 88 EPC, the proposed correction must be obvious in the sense defined. Both these requirements provide legal certainty in the sense that after the amendment or correction, to a skilled person the protection conferred by the patent should not be greater than was apparent before the amendment or correction. Nevertheless, these two requirements are in terms different and it follows that the Appellant's request for correction (under Rule 88 EPC) must be considered separately from his request for amendment (under Article 123 EPC). An unallowable request for correction under Rule 88 EPC does not in principle preclude an allowable amendment under Article 123 EPC, and vice-versa.

2.2 Furthermore, contrary to the submissions of the Respondent, in the Board's view the fact that the text of the patent as intended to be granted was approved by the Appellant following issue of a communication under Rule 51(4) EPC does not constitute an agreement to which the Appellant is bound, so that he is estopped from correcting an error in such text under Rule 88 EPC. The purpose underlying Rule 88 EPC is to enable an error in a document to be corrected when it is appropriate so to do, so that it is in the form which was originally intended. The retrospective nature of the correction means that the text which was approved by the Appellant must be assumed to have been in the form in which it was intended.

3. **Rule 88**

3.1 As to the request under Rule 88 EPC, it follows from the above that for a request for correction of an error in a description (or claims or drawings) of a patent to be allowable, during opposition proceedings or otherwise, the two conditions set out in paragraph 2.1 above must be satisfied. Beyond this, correction is always a matter of discretion.

3.2 In order to establish condition (i), which is a subjective matter, reference may be made to any relevant documents or other evidence, including in appropriate cases the file history (see in this connection Decision J 4/85, paragraph 7, third sub-paragraph).

In the present case, as submitted by the Appellant, in the Board's view, having regard to the file history, there is no doubt that the granted version of Claim 1 indeed resulted from an unintentional transcription error. Reference is made in particular to original Claims 1 and 5 as originally filed ("... a maximum of 0.10(%) Cr, a

maximum of 0.15(%) Fe ..."); the Appellant's submission of 17 December 1981 expressing willingness to adapt the claims to European practice, along with an essentially unchanged product Claim 1 (up to 0.10% Cr, up to 0.15% Fe), but - without conceivable explanation for an intentional difference - a method Claim 5 mentioning only up to 0.10% Fe, without mentioning Cr at all; and the fresh set of claims submitted on 8 September 1983, omitting the product claims and maintaining only the method claims, former Claim 5 (with amended percentages) thus becoming new Claim 1, and with page 2 of the description containing an appropriate consistory clause.

On the basis of this file history, it seems very clear that a line was unintentionally missed out when Claim 5 was retyped for the submission of 17 December 1981, and the resulting error was carried over unnoticed into Claim 1 of 8 September 1983 and from there into the granted version.

3.3 As a result of this error, the description of the patent as granted contains inconsistencies in relation to the amount of chromium and iron which may be present in the alloy which is the subject of the invention. In particular, the composition set out in Claim 1 as granted (and the corresponding description in column 2) requires a maximum of 0.05% chromium (being within the term "trace element") and of 0.10% iron, whereas the passages beginning at column 3, line 26 and column 4, line 59 refer specifically to maximum amounts of 0.10% chromium and 0.15% iron.

3.4 In order to establish condition (ii) set out in paragraph 2.1 above, the Appellant must establish that the correction of this inconsistency (as proposed by the Appellant) is obvious in the sense set out in the Rule. In

contrast to the situation in relation to condition (i) as discussed above, in the Board's view it is clear that condition (ii) must be established on an objective basis: that is, it must have been "immediately evident" to a skilled reader that the patent should be corrected in the way proposed by the Appellant. Such a skilled reader must be assumed to have read the entire contents of the patent carefully. However, the proposed correction must be obvious to such a skilled reader on reading the patent text in its entirety but in isolation, and without reference to any other documents (such as the file history). In this connection see Decision T 401/88 dated 28 February 1989, paragraph 2.2.

In the Board's view, this approach to the establishment of condition (ii) follows directly from the use of the words "immediately evident" in Rule 88 EPC. Once it is envisaged that a skilled reader would need to go beyond the text of the patent itself, and would need to consider for example the file history of the patent (including for example priority documents and earlier filed versions of the patent application), it can hardly be "immediately" evident what the correction should be. Furthermore, the published text of a patent is supposed to inform the public of the scope of protection conferred by it.

In deciding whether condition (ii) has been established, in the Board's view the fact that interested parties such as the Opponents in the present case did not notice the error in the granted patent until it was pointed out by the Opposition Division (this fact having been relied upon in the Decision of the Opposition Division as corroboration of the non-obviousness of the error) is of little relevance. An error such as occurred in the present case can easily remain unnoticed by skilled persons who may read only a part of the patent, or who may even read

the whole of the patent but with insufficient care to such details. As stated above, when deciding the question objectively it must be assumed that every word of the patent is read and considered carefully by the skilled person.

3.5 In the present case, in the Board's view a skilled reader of the patent specification would immediately recognise the existence of the inconsistency discussed in paragraph 3.3 above and would therefore conclude that an error had occurred. The question whether the Appellant's proposed corrections of such error, as set out in his requests, would have also been "immediately evident" to such skilled reader must now be considered.

3.6 **Main request.**

As mentioned in paragraph VIII above, the text of Claim 1 (and the corresponding passage in column 2) in accordance with the main request includes the addition of a specific reference to "a maximum of 0.10%" for chromium as compared to the text of Claim 1 as granted, which makes no specific reference to the weight per cent of chromium. Such specific reference corresponds to the references to the weight per cent of chromium at column 3, lines 26 and following, and column 4, lines 59 and following. The text of the patent as granted contains only one other reference to the weight per cent of chromium in an alloy in accordance with the invention, namely in Example 1 at column 11, line 7, where a weight per cent of 0.01% chromium is specified. However, since this is well below the maximum amount envisaged in Claim 1 both as granted and as proposed to be corrected, it is consistent with both such texts of Claim 1.

As mentioned in paragraph 3.4, a skilled reader of the granted patent would immediately recognise the inconsistency between Claim 1 and the passage at column 2, on the one hand, and the passages in columns 3 and 4 on the other hand. However, in the Board's judgement it would not be immediately evident to him how such inconsistency should be resolved; i.e. whether correction should be made to Claim 1 and column 2 so as to make them correspond to the passages at columns 3 and 4, or vice-versa. Both of such possible corrections would remove the inconsistency in the text of the patent as granted, and both would be equally plausible to the skilled reader as possibly corresponding to the original intention of the patentee.

In this circumstance, the Board rejects the proposed correction in accordance with the main request, because it would not be "immediately evident that nothing else would have been intended than what is offered as the correction".

### 3.7 First Auxiliary Request

As mentioned in paragraph VIII above, the only proposed correction is that the maximum amount of iron in Claim 1 and column 2 becomes 0.15%, instead of 0.10% in Claim 1 as granted.

In this context, the fact that each of the Examples in the patent as granted directly or implicitly contains references to amounts of iron must also be taken into account, in addition to the references at column 3, line 29 and column 4, line 65 and following to a maximum of 0.15% iron.

Specifically, Example I gives an Fe content of 0.11% (column 11, line 7); Example II refers to "the compositional limitations ... outlined in Example I" (column 13, lines 29-31), thus to the same Fe content; Example III refers to Table 1B (bottom of columns 13 and 14), which in turn indicates 0.11% Fe (fifth vertical column); and Example IV again refers to an "alloy ... prepared in accordance with ... Example I" (column 16, lines 8-10. In effect, thus, all the working Examples of the patent as granted require an iron content which is higher than 0.10%. In the Board's judgement, this disclosure, in combination with the passages at columns 3 and 4, would remove all doubts which the skilled person might have had concerning the intended extent of protection of the patent, in the sense that he would conclude that 0.10% could not have been the intended upper limit for the iron content. It would thus be immediately evident to him that the said upper limit had to be 0.15% as specified in column 3, line 29, and column 4, line 65 and following. With reference to the argument of Respondent 2, mentioned in above section IX, second sentence, while after amendments during prosecution a single Example no longer covered by the claims might by oversight remain in a specification, the skilled person would rule out a combination of oversights by which each of four Examples as well as two passages in the general description would continue to stand after a deliberate restriction of Claim 1 requiring their deletion.

- 3.8 The Board has considered whether the passages at column 3, lines 28-29 and column 4, lines 63-64 which indicate a chromium content inconsistent with Claim 1 should remain in the specification. In the Board's view, since such inconsistencies do not constitute a ground of opposition, they should remain in the specification.



3.9 For the above reasons, the request for correction in accordance with the First Auxiliary Request is allowable. In this circumstance, the allowability of the Second Auxiliary Request need not be considered.

4. **Article 123 EPC**

The Board has also considered whether an amendment (as opposed to a correction) of the patent in accordance with the main request would be allowable having regard to Article 123 EPC. Insofar as such amendments to the granted patent would result in a text essentially corresponding to the application as filed, there would be no violation of Article 123(2) EPC. In connection with Article 123(3) EPC, however, the question to be considered is whether the amendment is such as to extend the protection conferred. Following Decision G 2/88 dated 11 December 1989 (to be published), paragraph 4, when considering this question the first step must be to determine the extent of protection which is conferred by the patent before the amendment, i.e. as granted.

Having regard to the inconsistencies in the granted patent as set out in paragraph 3.2 above, the Board is not satisfied that the protection conferred by the patent as granted is the same as the protection that would be conferred by the patent after amendment in accordance with the main request. In this circumstance, in the Board's judgement the proposed amendment must be refused under Article 123(3) EPC.

5. As stated in paragraph IV above, having regard to the error in the text, the Opposition Division did not deal in its Decision with the grounds of opposition which had been specifically alleged by the Respondents. The grounds of opposition must accordingly be examined in relation to the

corrected text in accordance with the First Auxiliary Request as decided above. The case is, therefore, remitted to the Opposition Division for this to be carried out as soon as possible having regard to the delay in substantive examination of the grounds of opposition which has occurred.

Order

For these reasons, it is decided that:


1. The Decision of the Opposition Division is set aside.
2. The case is remitted to the Opposition Division to continue prosecution on the basis of Claim 1 in accordance with the First Auxiliary Request.

The Registrar:

  
M. Beer

The Chairman:

  
K. Jahn

 01654

2.5.90