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File Number: T 184/91 - 3.3.2

Application No.: 85 304 848.6

Publication No.: 0 169 016

Title of invention: Polypeptide cartilage-inducing factors found in bone

Classification: C07K 13/00

**I N T E R L O C U T O R Y  
D E C I S I O N  
of 25 October 1991**

Applicant: CELTRIX LABORATORIES, INC.

Headword: Glu-Gln/CELTRIX

**EPC** Article 123(2); Rule 88, second sentence

Keyword: Referral of questions to the Enlarged Board of Appeal

**Headnote**



Case Number : T 184/91 - 3.3.2

**I N T E R L O C U T O R Y   D E C I S I O N**  
of the Technical Board of Appeal 3.3.2  
of 25 October 1991

**Appellant :** CELTRIX LABORATORIES, INC.  
2500 Faber Place  
Palo Alto  
CA 94303 (US)

**Representative :** Harrison, David Christopher  
MEWBURN ELLIS & CO  
2/3 Cursitor Street  
London EC4A 1BQ (GB)

**Decision under appeal :** Decision of Examining Division of the European  
Patent Office dated 24 September 1990 refusing  
European patent application No. 85 304 848.6  
pursuant to Article 97(1) EPC.

**Composition of the Board :**

**Chairman :** P.A.M. Lançon  
**Members :** E.M.C. Holtz  
A.J. Nuss

**Summary of Facts and Submissions**

- I. This interlocutory decision concerns a request to refer the case in connection with two questions already pending before the Enlarged Board of Appeal.
- II. In its decision of 24 September 1990 to refuse European patent application No. 85 304 848.6 the Examining Division of the European Patent Office i.a. refused a request by the Appellants to correct in the patent application the amino acid residue in position 12 of the N-terminal sequence of CIF-B, originally given as Glu, to read Gln. The main reason for refusing this correction was that it did not satisfy Rule 88 EPC, in that it was not immediately evident neither that an error had occurred nor that the correct amino acid should be Gln. In arriving at the second conclusion, the Examining Division noted that Gln could neither be derived from the documents as originally filed taken by themselves, nor from the priority document. The fact that the information was available to the inventors had no significance. The filed European patent application did not include this information. The Examining Division therefore held that the error in the amino acid residue in position 12 of the CIF-B could not be corrected under Rule 88, but that it required an amendment under Article 123(2) EPC. Four different proposals for amendments submitted by the Appellants were all refused as contravening Article 123(2) EPC.
- III. In their appeal against the above decision the Appellants requested that the claims annexed to the decision under appeal be allowed on the basis i.a. of the offered correction under Rule 88 EPC. It was pointed out that only

dependent claims were affected by the refusal to allow the offered correction and that no other issue was at stake with regard to the granting of a patent.

The Appellants argued that the offered correction at the date of application was (a) known and (b) before the applicant. This knowledge was objective, having been derived from a third party (an analytical laboratory) and reduced to writing before the date of preparation of the specification. The Appellants had submitted evidence from third parties to this effect. The error was purely clerical, the "n" in Gln having been mistyped as "u".

The Appellants further argued that the Examining Division had introduced a new, unreasonable requirement in holding that for an error to be correctible under Rule 88 EPC it must have been immediately evident that an error had occurred. Having regard to J 04/85 and the constant case-law according to which external evidence of the fact that a mistake had been made is admissible, the Appellants concluded that in order for a correction to be allowable under Rule 88 it must only satisfy the requirement that the correction, once offered, is immediately evident. "The test about what is 'immediately evident...' should therefore be that the person reading the specification and having appropriate knowledge should (i) say when he notices the thing in question 'that is wrong' and (ii) immediately know what is right."

In the opinion of the Appellants, the approach taken by the Examining Division would mean that no difference existed between Rule 88 corrections and amendments under Article 123(2) EPC. However, there must be a difference between a "correction" and an "amendment", otherwise there would be no reason to have both Rule 88 and Article 123 EPC. "The difference is that Rule 88 does not debar any change, even addition of content, provided always that its own tests are satisfied."

IV. The Appellants subsequently requested that the case be referred to the Enlarged Board of Appeal for a decision on two questions pending in G 3/89 (OJ EPO 1991, 20). In so doing, the Appellants drew attention to an apparent illogicality in the second question referred in that case, in so far as it related to a correction being capable of extending the subject-matter. A correction by definition was not an amendment and therefore could not extend any such matter.

V. In response to a communication of 11 July 1991 from the Board of Appeal to suspend proceedings until the decision of the Enlarged Board of Appeal had been issued, the Appellants submitted that the present case was absolutely relevant to the reference in G 3/89 and that it must be helpful to the Enlarged Board of Appeal to have an actual case in front of it illustrating the sort of situation which could arise. Finally, if it were possible that the decision of the Enlarged Board of Appeal would in effect resolve the outcome of the appeal of the present case, it would only be equitable to give the Appellants an opportunity to make observations to the Enlarged Board of Appeal.

## Reasons for the Decision

1. The appeal is admissible.
2. The questions pending before the Enlarged Board in G 3/89 were referred by the President of the EPO in order to ensure uniform application of the law. These questions read:
  - (1) Where a correction is requested in accordance with Rule 88, sentence 2, EPC, are documents submitted after the date of filing admissible as evidence that nothing else would have been intended than what is offered as the correction?
  - (2) Is such a correction allowable even where the amendment requested would (inadmissibly) extend the subject-matter disclosed in the documents as they stood on the date of filing within the meaning of Article 123(2) EPC?

In the letter of referral the President referred to i.a. decisions J 04/85 (OJ EPO 1986, 205) and T 401/88 (OJ EPO 1990, 297).

3. The Board of Appeal has concluded that both questions are relevant for the consideration of the present case. As to the first question, in the present case the evidence concerning the correct amino acid was filed only on 28 August 1989, i.e. more than four years after the date of filing of the patent application. This evidence had been available to the applicant at the time of filing. Contrary to J 04/85, the evidence did not concern any priority documents, but consisted of letters from a third party (a laboratory having made certain analyses for the applicant).

The second question is relevant with regard to the linkage made by the Examining Division in the present case between Rule 88 and Article 123(2) EPC.

4. In decision T 401/88, the relationship between corrections under Rule 88, second sentence, and amendments under Article 123 (2) EPC was analysed. This case concerned a requested correction in the form of a deletion of a feature indicating the physical condition of a test piece (a direct-current source). The deletion was not allowed, with reference i.a. to the requirements under Article 123(2) EPC.

Implicit in the reasoning in T 401/88 seems to lie the conclusion that by the word "correction" of Rule 88 EPC actually is meant the same as "amendment" in Article 123(2) EPC, at least as far as corrections provided for in the second sentence of Rule 88 are concerned (relating to description, claims or drawings). The question then arises whether an offered correction in the form of a replacement of one feature with another would constitute a different category of correction, which would not have to pass the test under Article 123(2) EPC. However, T 401/88 does not analyse the probable consequences of a generally applicable linkage between Rule 88 and Article 123(2) EPC covering different categories of corrections. In other words, the question whether there might exist any circumstances under which Rule 88 corrections would not have to meet Article 123(2) requirements has not yet found a definite answer.

Decision J 04/85, on the other hand, held that it is not possible for a correction under Rule 88 EPC to be at variance with Article 123(2) EPC. This seems to indicate the opposite extreme from T 401/88, viz. that Article 123(2) EPC could never apply to corrections under

Rule 88 EPC, at least once it is established that an error did occur and the offered correction satisfies Rule 88, second sentence EPC.

5. As already indicated by the President of the European Patent Office in his referral of the questions pending in G 3/89, there thus seems to be an inconsistency between the interpretation as laid down in T 401/88 and the one in J 04/85. To these examples can be added i.a. decisions T 417/87 of 17 August 1989 (not published in OJ EPO), Lin T 3/88 of 6 May 1988 (not published in OJ EPO) and T 200/89 of 7 December 1989 (to be published in OJ EPO - headnote in OJ EPO 1990/10). All these cases are relevant in the present appeal. T 417/87 and T 3/88 are particularly relevant since they relate to transcription errors (in the former case a correction of the Figure 8 into 3 in a patent number, and in the latter a correction of the Figure 163 in a temperature range to read 136 were both allowed).

6. In view of the impact of the coming decision of the Enlarged Board of Appeal on the outcome of the present appeal, and in order to safeguard the Appellants' right to a fair hearing, the Board finds a referral justified.

7. Article 112(1) EPC enables a Board of Appeal to refer questions, not cases. The reason for this distinction is evidently that a case pending before a Board of Appeal cannot be decided on by any other body. The jurisdiction lies with the Board so seized, cf. Article 21 EPC on the competence of Boards of Appeal, as distinct from the competence of the Enlarged Board of Appeal under Article 22 EPC. A Board of Appeal wishing to have an Enlarged Board of Appeal opinion in a matter must therefore refer a question. There is nothing in the EPC, however, to prevent the Board from reiterating questions



that are pending, in order that the parties to an appeal case may enjoy the position under Article 112(2) EPC of being party to the proceedings before the Enlarged Board of Appeal.

**Order**

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

The questions quoted in point 2, pending before the Enlarged Board of Appeal in G 3/89, are put anew in respect of the present appeal.

**The Registrar:**

**The Chairman:**

P. Martorana

P.A.M. Lançon