

Decision of Technical Board of Appeal 3.3.2 dated 12 July 1996

T 850/95 - 3.3.2

(Language of the proceedings)

Composition of the board:

Chairman: P. A. M. Lançon

Members: R. E. Teschemacher

G. J. Wassenaar

Applicant: UNITED STATES GYPSUM COMPANY

Headword: Correction of decision to grant/US GYPSUM III

Rule: 67, 68(2), 89 EPC

Keyword: "Correction of decision to grant - yes" - "Reimbursement of the appeal fee - yes" - "Reasons for a decision - insufficient"

Headnote

I. In a decision to grant, if the text given for grant is not and obviously cannot be the text corresponding to the real intention of the Examining Division, there is an obvious mistake within the meaning of Rule 89 EPC and the text erroneously indicated can be replaced by the text on which the Division actually wanted to base its decision.

II. The filing of replacement pages for the whole specification should be avoided unless the extent of amendments makes it absolutely necessary.

Summary of Facts and Submissions

I. European patent application No. 89 311 913.1 designating Spain and Greece was filed on 16 November 1989. The Examining Division informed the Applicant in a communication of 30 May 1994 of the version in which it intended to grant the patent. In a letter dated 7 September 1994, the Applicant approved the text intended for grant. Once the formal requirements under Rule 51(6) EPC had been fulfilled, the decision to grant was dispatched on 23 February 1995.

II. In a fax dated 10 March 1995, the Applicant filed two additional pages 4a and 4b of the description and requested that they be included in the patent specification prior to publication. In a communication dated 17 March 1995, the Applicant was informed that the technical preparations for the publication of the patent specification had been completed before the fax dated 10 March 1995 had been received and that a request to amend the decision to grant could be filed upon receipt of the printed specification. In a fax dated 18 April 1995, the Applicant requested that the patent be re-published incorporating the missing pages.

III. The Examining Division issued a decision dated 8 May 1995, pre-printed with reasons on form 2053, "refusing a request for correction of errors in decision (Rule 89 EPC)" on the ground that "the corrections specified did not relate to passages in the patent specification where the Division wished to base its decision on a different text (Guidelines, Part E-X, 10)".

IV. The Patentee filed a notice of appeal on 14 June 1995 and paid the appropriate fee on 22 June 1995. Pursuing the request for correction, the Appellant submitted in his statement of grounds of appeal, received on 8 September 1995, that pages 4a and 4b had been omitted due to a clerical error when a full replacement specification was filed on 25 March 1994. The text was intended to be identical to the text previously submitted in the corresponding Euro-PCT application 90 901 172.8 in which, at the time, it was not possible to designate Spain and Greece. This intention had been expressly declared when the amended specification was filed. The additional pages contained text providing support for, and corresponding to, Claims 6, 9, 10, 12 and 17 as agreed and accepted by the examiner.

V. The Examining Division remitted the file to the Board of Appeal, addressing it to this Board on the basis of the business distribution scheme for the Technical Boards of Appeal.

VI. Considering a divergency in the previous case law, this Board referred to the Enlarged Board of Appeal the question of law whether appeals from a decision of an Examining Division refusing a request under Rule 89 EPC for correction of the decision to grant are to be decided upon by a Technical Board of Appeal or by the Legal Board of Appeal. In decision G 8/95, dated 16 April 1996 (OJ EPO 1996, 481), the Enlarged Board of Appeal decided that such appeals are to be decided by the Technical Boards of Appeal.

Reasons for the Decision

1. The appeal is admissible.

2. The requested correction is allowable under Rule 89 EPC only if it removes a linguistic error, error of transcription or obvious mistake in the decision. According to the practice of the EPO, the decision to grant is a form generated by Electronic Data Processing. In respect of the specification, the form refers to the documents indicated in the communication pursuant to Rule 51(4) EPC. By this reference the documents approved by the applicant become an integral part of the decision to grant in the same way as if the documents were repeated in the decision itself. It follows from this that errors in the specification may be corrected under Rule 89 EPC.

3. In a decision to grant, if the text given for grant is not and obviously cannot be the text corresponding to the real intention of the deciding instance, there is an obvious mistake within the meaning of Rule 89 EPC and the text erroneously indicated can be replaced by the text on which the Examining Division actually wanted to base its decision.

4. In the present case, the Applicant filed on 25 March 1994 a complete set of replacement pages for the text of the application containing inter alia amendments to pages 4 and 5 of the original description. In reply, the Examining Division issued the communication under Rule 51(4) EPC on the basis of these documents.

4.1 The amendment at the bottom of page 4 consists of the repetition of independent Claims 1 and 2 as a "first" and "second aspect of the invention". This text replaces the earlier text dealing with a "principal", a "related" and "a more specific objective of the invention". The first part of page 5 is not amended.

4.2 Pages 4 and 5 as amended on 25 March 1994 do not fit together in several respects. Formally, page 4 ends with a full stop, whereas page 5 starts in the midst of a sentence no meaning being derivable from it, and there being no connection to the last sentence on the previous page. As to the substance, the first complete sentence on page 5 speaks of "a further specific objective" which implies that there should be at least a first specific objective and at least one general objective of the invention which have already been dealt with, but these are no longer mentioned in the description as amended. This makes it apparent that some text is missing between pages 4 and 5. There is another indication in this respect because the "aspects of the invention" introduced by the amendment on page 4 cover only independent Claims 1 and 2, whereas the other independent Claims 6, 9, 10, 12 and 17 are not dealt with for reasons which are not apparent. Taking the amendments on pages 4 and 5 as a whole, there was a clear inconsistency in the documents filed which could be recognized even by a cursory check of the documents intended for grant.

5. At the time of the communication of 30 May 1994 informing the Applicant of the intention to grant a patent, the Examining Division had available all the information necessary for detecting the inconsistency and taking all the steps required to remove the inconsistency in the amended specification.

5.1 In his letter dated 19 November 1993, the Applicant had already drawn the Examining Division's attention to the fact that there were two parallel applications, this European application, and a Euro-PCT application directed to the same invention. He expressly mentioned that it was thought that both specifications, including claims and drawings, corresponded, and requested that both applications

be consolidated. In the subsequent letter submitting the amended pages 4 and 5, the Applicant wrote once more that the present application was identical to the Euro-PCT application, on which the communication under Rule 51(4) EPC had been issued. He added that he filed replacement pages in order to expedite the present application. These declarations made it evident that the text submitted for this application should correspond to the text for the Euro-PCT application.

5.2 In the Euro-PCT application the corresponding amendment to page 4 was submitted with a letter received on 13 March 1994 in reply to the communication under Rule 51(4) EPC, i.e. less than two weeks before the amendment in the present application. The page is identical to page 4 as amended in the present application as far as wording and layout are concerned. With the same letter new pages 4a and 4b were submitted in the Euro-PCT application, starting with the repetition of the remaining independent Claims 6, 9, 10, 12 and 17 as further aspects of the invention and concluding with the fields of use of the invention which were indicated in the original page 4 as the principal, related and more specific objectives of the invention. From this it becomes clear that the amendments made in the Euro-PCT application were also appropriate amendments for the present application and removed all the inconsistencies outlined above (pt. 4.2).

6. On the basis of these facts, the question to be answered is whether the Examining Division intended to grant the patent with the description in the inconsistent version as described above.

6.1 The only source of information in this respect is the reasons of the decision under appeal. There it is only stated that the corrections "do not relate to passages

in the patent specification where the Examining Division wished to base its decision on a different text". The decision gives no indication whether the inconsistency had been recognized or not, or whether it was intended to grant the patent on the basis of the Applicant's request notwithstanding the inconsistency.

6.2 The preprinted reasons of the decision under appeal fail to deal with the specific facts of the case. When assessing what the intention of the Examining Division was, the Board cannot start from the assumption that the Examining Division, when checking the documents intended for grant, wanted to make a full examination of the documents in order to remove any errors in the full text of the application. Rather, it was the task of the Examining Division at this stage of the proceedings to check whether all objections made had been removed. In addition, it had to be expected that the Examining Division wanted to put together in the communication under Rule 51(4) EPC a set of documents for grant which reflected the result of the previous examination in a complete and consistent way. Therefore, the Board can assume that the Division did not intend to accept gaps or formal inconsistencies in the amendments contained in the replacement pages submitted to put the application in order for grant. Since such gaps and inconsistencies were actually present, the Board assumes that the Examining Division intended to grant the patent on the basis of the available text removing the gaps and inconsistencies and already examined and agreed in the parallel Euro-PCT application. Whereas procedural acts have to be effected, as a general principle, in the relevant file, there was a special connection between the co-pending applications in this case. Although the Applicant's request for consolidation of the applications could not be allowed for formal reasons by the Examining Division dealing with both files in the same composition, it was clear on the basis of the content of both applications and their

closely related procedural history that they could not be seen isolated from each other. Therefore, the Board considers that, despite of the pre-printed reasons in the contested decision which would suggest otherwise, the real intention of the Examining Division was to grant a patent including the subject-matter of pages 4a and 4b in agreement with the parallel Euro-PCT application. The absence of these pages constitutes an obvious mistake which could and should have been corrected under Rule 89 EPC.

7. The Appellant requested reimbursement of the appeal fee referring to decision T 546/90, dated 4 August 1992, [1993] EPOR 214, and alleging that this was an extremely similar case in which the correction was allowed and the appeal fee reimbursed.

For the application of Rule 67 EPC, the Board regards it as sufficient to base the decision on the omission to deal with the facts of the case in the reasons of the decision under appeal. It is true that the source of the error in the decision to grant was the Applicant's mistake in submitting an incomplete set of documents and, furthermore, his conduct of the proceedings. He submitted a complete set of replacement pages for the whole text of the specification without any apparent need, although applicants are advised by the Office to avoid this unless the extent of the amendments makes it absolutely necessary (Notice of the Vice-President of the EPO Directorate General 2 concerning amendments, OJ EPO 1985, 172). He also failed to identify the amendments made and to explain their purpose. Such indications would have helped the Examining Division to concentrate on the amendments instead of having to bear the burden of identifying the differences between the previous text and the complete set of replacement pages (cf. T 113/92, dated

17 December 1992, not published in OJ EPO, Reasons, 3). Nevertheless, it was the Examining Division's obligation to give substantive reasons for the decision on the request for correction, dealing with the specific facts of the case. A correctly reasoned decision would have given a more detailed factual basis to these appeal proceedings and assisted the Appellant as well as the Board.

In this context the Board observes that the form (2053) used to refuse the correction of errors contains pre-printed reasons which are of a very general character. Moreover, the form does not seem to foresee any possibility of adding more specific reasons taking into account of the special circumstances of the case, which gives the Examining Division easily the impression that further, more detailed reasons are not necessary. Nor do the Guidelines (E-X, 10) to which reference is made present any lead that a detailed reasoning is required.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The decision to grant is correct by including pages 4a and 4b, submitted on 10 March 1995, into the description.
3. The appeal fee shall be reimbursed.