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**Intermediate
D E C I S I O N
of 21 November 1995**

Case Number: T 0850/95 - 3.3.2

Application Number: 89311913.1

Publication Number: 0370703

IPC: C04B 11/024

Language of the proceedings: EN

Title of invention:

Composite material and method of producing

Applicant:

UNITED STATES GYPSUM COMPANY

Opponent:

-

Headword:

Correction of decision to grant/US GYPSUM

Relevant legal provisions:

EPC Art. 21(3), 112(1)(a)
EPC R. 89

Keyword:

"Competence of the Boards of Appeal"
"Refusal of a correction of the decision to grant"

Decisions cited:

G 0001/94; J 0012/85; J 0027/86; J 0030/94; T 0546/90;
T 0946/91

Headnote follows.



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Case Number: T 0850/95 - 3.3.2

**Intermediate
D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 21 November 1995**

Appellant: UNITED STATES GYPSUM COMPANY
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Chicago
Illinois 60606 (US)

Representative: Cline, Roger Ledlie
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Decision under appeal: Decision of the Examining Division of the European Patent Office dated 8 May 1995 refusing a request for correction of the description of the patent granted on European patent application No. 89 311 913.1.

Composition of the Board:

Chairman: P. A. M. Lançon
Members: R. E. Teschemacher
G. J. Wassenaar

Summary of Facts and Submissions

- I. European patent application No. 89 311 913.1 designating Spain and Greece was filed on 16 November 1989, claiming priority from an earlier application in the United States of America. The Examining Division informed the Applicant in a communication of 30 May 1994 of the version in which the patent was intended to be granted. By letter of 7 September 1994, the Applicant approved the text intended for grant. After the formal requirements according to Rule 51(6) EPC had been fulfilled, the decision to grant was dispatched on 23 February 1995.

- II. By fax of 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 before publication. By communication of 17 March 1995, the Applicant was informed that the technical preparations for the publication of the patent specification had been completed before receipt of the fax of 10 March 1995 and that a request to amend the decision to grant could be filed upon receipt of the printed specification. By fax of 18 April 1995, the Applicant requested that the patent be re-published with the missing pages enclosed.

- III. The Examining Division issued a decision pre-printed on form 2053, dated 8 May 1995, "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. A notice of appeal was filed on 14 June 1995 and the appropriate fee was paid on 22 June 1995. In the Statement of Grounds of Appeal, filed with a letter dated 8 September 1995, the Appellant submitted that pages 4a and 4b had been omitted due to a clerical error when a full replacement specification had been 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 declared expressly when filing the amended specification. 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.

Reasons for the Decision

1. The admissible appeal lies from the decision of the Examining Division refusing a request under Rule 89 EPC for correction of the decision to grant the patent.
2. This Board is competent to decide on this appeal only if the requirements of Article 21(3)(a) EPC are fulfilled, i.e. if the decision under appeal concerns the grant of the patent.
 - 2.1 In respect of this question, the Legal Board of Appeal has decided in J 30/94, dated 9 October 1995, that a decision refusing a request for correction under Rule 89 EPC does not concern the grant of the patent and that the Legal Board is responsible for examining the appeal under Article 21(3)(c) EPC. The fact that the request for correction relates to a decision to grant a patent does not, according to that decision, alter the competence because what is under appeal is the decision

to refuse a request for correction and not the decision to grant the patent.

2.2 In two earlier decisions the Legal Board was concerned with a request under Rule 89 EPC. In the first decision (J 12/85, OJ EPO 1986, 155), the appeal was rejected as inadmissible since the Examining Division had not yet rendered a decision on the request. In the second decision (J 27/86 of 3 October 1987) concerning the same application, the decision refusing the addition of a claim by way of correction was set aside for lack of reasons (Rule 68(2) EPC). These decisions did not specifically address the question of competence.

2.3 In contrast thereto, at least two Technical Boards have accepted their competence under Article 21(3)(a) EPC to decide on appeals against decisions refusing a request for correction under Rule 89 EPC in decisions T 546/90, dated 12 September 1991, and T 946/91, dated 17 August 1993. In T 546/90 the Applicant had requested that drawings be replaced and in T 946/91 he had requested mistakes in the definition of certain compounds be corrected. In T 546/90 the Examining Division used the pre-printed form 2053 for the refusal of the request which was also used in the present case. In T 946/91 the following addition was made to the pre-printed reasons on form 2053: "All required corrections relate to errors which were in the text specified at grant. Correction under Rule 89 is not possible and Rule 88 is not relevant." In T 546/90 the correction was allowed by the Board for the reason that the approval of the Applicant under Rule 51(4) EPC was not interpreted correctly (see pt. 4 of the reasons), without mentioning Rule 89 EPC, and in T 946/91 it was allowed on the basis of Rule 88, second sentence, EPC.

3. Considering this divergency in the case law, the Board has to examine whether an answer to the question of competence can be derived from the EPC which gives an appropriate basis to follow the one or the other group of decisions.
 - 3.1 The only decision dealing expressly with the question of competence is J 30/94. The reasons given there appear, however, not to be the only possible interpretation of the law. In J 30/94 the phrase in Article 21(3)(a) EPC "the decision concerns...the grant of a European patent" has been given the same meaning as "the decision under appeal orders the grant of the European patent", with the consequence that the requirements of Article 21(3)(a) EPC were not regarded as being fulfilled and competence was based on Article 21(3)(c) EPC.
 - 3.2 The wording of the phrase may, however, also be understood in a broader sense as meaning "the decision under appeal is related to the grant of the European patent." Starting from such an interpretation, the correction of the decision to grant can be regarded as being related to or concerned with the grant of the patent. The decision to grant is composed of several elements, e.g. the fact that the patent is granted, that it is granted to a certain person, that it is granted for specific designated states and that it is granted on the basis of the final version of the application (cf. Article 97(2) EPC). The description, claims and any drawings are not contained in the decision to grant (form 2006); they are, however, essential elements of this decision and identified in it by reference. Otherwise, they could not be corrected by correction of the decision to grant. Any change of an essential element of the decision to grant changes the effects of the decision to grant and is therefore related to the

grant. A request for correction has as its goal the amendment of the decision to grant in the same way as an appeal against the decision itself. It was, therefore, no coincidence that in case J 12/85 the amendment of the documents and the setting aside of the decision to grant were requested by the Appellant on an alternative basis.

3.3 If a provision can be interpreted on the basis of its wording in different ways, i.a. the object and purpose of the provision have to be taken into consideration (G 1-6/83, OJ EPO 1985, 60, pt. 5 of the reasons; G 1/94, OJ EPO 1994, 787, pt. 7 of the reasons). In this respect, one criterion for defining the appropriate composition of the Board might be whether the type of cases in question is more concerned with legal or with technical questions, since the distinction made in Article 21(3)(a) and (c) EPC shows that the legislator intended cases in which the emphasis is typically on legal questions to be dealt with by the Legal Board and cases in which the emphasis is on technical problems by the Technical Boards (Gori/Löden, Münchner Gemeinschaftskommentar zum EPÜ, Lfg. 18 (1995), Article 21 EPC, pt. 63). In this respect different aspects may be emphasised.

3.3.1 On the one hand, the application of Rule 89 EPC raises **legal** questions. It may be doubtful in which cases Rule 89 EPC and in which cases Rule 88 EPC is to be applied (see e.g. T 946/91, pt. 1.3 above). Furthermore, it has to be decided on which basis a correction should be allowed. In particular, it has to be defined which documents are relevant and from whose perspective an alleged mistake has to be considered (cf. in this respect the interpretation proposed in the Guidelines for Examination in the EPO, E-X, 10, cited in the decision under appeal).

- 3.3.2 On the other hand, a decision on a request for correction of a decision of an Examining Division may require that the Board reconstructs the considerations of the Examining Division when taking the decision to grant. These considerations are mainly **technical** considerations concerning the substance of the invention. An example of such a situation may be case T 946/91.
4. Since the purpose and object of Article 21(3)(a) and (c) EPC do not give a clear answer to the question of competence, it is appropriate to have recourse to the travaux préparatoires to the EPC for further clarification (G 1-6/83, loc. cit.; G 1/94, loc. cit., pt. 8 of the reasons). From the preparatory work, it appears that the Haertel draft for Implementing Regulations to the EPC defined the competence of the Technical Boards more narrowly (Doc., dated 9 April 1963, p. 9, no. 1 relating to Article 58, in: Historical Documentation relating to the EPC, Munich 1981, no English texts in the EEC phase of the preparatory work).

The wording was restricted to the final decision to refuse or to grant. It is not apparent from the travaux préparatoires why later the broader drafting "concerns the refusalor the grant" (in German ("betrifft die Zurückweisung ... oder die Erteilung") was chosen. Though there was a list of situations in which the Legal Board should be competent to decide (Doc., dated 9 April 1963, loc. cit., p. 9 seq.), it seems that the particular competence for appeals from a decision refusing a request for correction was never discussed. Nor is there any apparent indication that the competence of the Legal Board should be expanded or restricted in general.

5. In short, the Board cannot come to an unequivocal conclusion on the interpretation of Article 21(3)(a) EPC removing the doubts raised by the relevant cited decisions. For reasons of legal security, doubts in questions of competence should be avoided. In particular, the composition of a particular Board to decide on an appeal should not be influenced by the first instance's choice of to whom the file is addressed. In the Board's view, it seems appropriate that a uniform application of this important point of law be ensured by a decision of the Enlarged Board of Appeal.

Order

For these reasons it is decided that:

The following question of law shall be referred to the Enlarged Board of Appeal under Article 112(1)(a) EPC:

Are appeals from a decision of an Examining Division refusing a request under Rule 89 EPC for correction of the decision to grant to be decided upon by a Technical Board of Appeal (Article 21(3)(a)(b) EPC) or by the Legal Board of Appeal (Article 21(3)(c) EPC)?

If the answer is depending on the circumstances of the case, who shall decide on the competence?

The Registrar:



P. Martorana

The Chairman:



P. Lançon