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D E C I S I O N
of 21 June 2001

Case Number: T 0367/96 - 3.4.2

Application Number: 87402408.6

Publication Number: 0266271

IPC: B01D 53/22

Language of the proceedings: EN

Title of invention:

Process for membrane separation of gas mixtures

Patentee:

L'AIR LIQUIDE, SOCIETE ANONYME POUR L'ETUDE ET L'EXPLOITATION
DES PROCEDES GEORGES CLAUDE

Opponent:

THE DOW CHEMICAL COMPANY

Headword:

Request of correction/L'AIR LIQUIDE

Relevant legal provisions:

EPC R. 89

Keyword:

"Request of correction of a decision by the board"
"Request admissible; jurisdictional measures"
"Request not allowable under Rule 89 EPC"

Decisions cited:

G 0008/95, G 0001/97, T 0867/96



Case Number: T 0367/96 - 3.4.2

Decision of the Technical Board of Appeal 3.4.2
of 21 June 2001 on the request for correction
of the decision of 3 December 1997

Appellant:
(Proprietor of the patent)

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Respondent:
(Opponent)

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Composition of the Board:

Chairman: A. Klein
Members: M. Rayner
B. Schachenmann

Summary of Facts and Submissions

- I. European patent 0 266 271 (application No. 87 402 408.6) was revoked a first time by the opposition division.

The opposition division's decision was set aside by the board of appeal 3.4.2 in its decision T 1027/93 of 11 November 1994 and the case remitted to the opposition division for further prosecution.

- II. The patent was revoked again by the opposition division.

Following a further appeal filed by the appellant (patentee), the second revocation of the patent by the opposition division was set aside by the board of appeal 3.4.2 in its decision T 367/96 of 3 December 1997. Having, inter alia, rejected a patentee's request that the patent be maintained as granted on the ground that the claimed subject-matter lacked an inventive step in view of citation US-A-4 591 365 (D1), the board decided that the case be remitted to the first instance with the order to maintain the patent as amended on the basis of the claims filed as the appellant's fourth auxiliary request, with the description and drawings to be adapted where necessary.

- III. In its letter dated 10 April 1998 to the opposition division, which had invited it to file an adapted version of the description, the appellant submitted that it was on the basis of an erroneous interpretation of D1 that the board of appeal had erroneously concluded that the invention set out in the claims as granted was obvious. It requested that the opposition division reexamine the question of obviousness of the invention over D1, and reissue a decision of non-

obviousness. It also requested that the opposition division correct the obvious mistake in the board's decision under Article 89 EPC, and that oral proceedings be appointed if the opposition division envisioned rejection of the case.

The opposition division then revoked the patent for a third time, stating that it was bound by the *ratio decidendi* of the board's decision, and that it could neither reexamine the obviousness objection, nor consider it as an obvious mistake and correct it under Rule 89 EPC. It stated that it had no alternative but to revoke the patent because there was no text of the European Patent submitted by the proprietor as stipulated in Article 113(2) EPC in which the European patent may be maintained within the meaning of Article 102(3) EPC. The requested oral proceedings were refused under Article 116 EPC on the grounds that the parties and the subject of the proceedings were the same. Further reexamination could not be the subject of oral proceedings, neither was adaptation of the description a ground for oral proceedings.

Following a change of the business distribution scheme of the technical boards of appeal, the third appeal as filed by the appellant was allocated to technical board 3.3.5, before which it is still pending under case number T 555/98. Oral proceedings held on 26 January 2001 before board 3.3.5 were terminated with the decision to continue the procedure in writing to give the appellant, in accordance with its request, the opportunity to submit the case to the board of appeal 3.4.2 which has given decision T 367/96, in order to request its correction under Rule 89 EPC (see the communication of the technical board of appeal 3.3.5 dated 6 March 2001).

IV. In its letter dated 27 February 2001 the appellant, referring to its letter of 10 April 1998, requested the present board 3.4.2 to correct the alleged obvious mistake in decision 367/96 consisting in justifying obviousness over D1 by a pressure difference there (as derived from the indications in the document) of only 1.25 bar between nitrogen pressure on the feed side and nitrogen pressure on the permeate side. The appellant submitted that it had duly pointed at the board's misconstruction of document D1 during the oral proceedings held before it, and that it had believed that this point had been accepted.

In a communication dated 23 March 2001 the board informed the parties of its provisional view that an allegedly incorrect understanding by the deciding body of the true content of a prior art citation, and the consequential refusal of a corresponding request, would not constitute a linguistic error, an error of transcription or an obvious mistake within the meaning of Rule 89 EPC.

The appellant in its response of 10 April 2001 to the board's communication stressed that, whilst an incorrect understanding by the board of the content of citation D1 would not be correctable under Rule 89 EPC, the mistake at issue here was that the board had agreed on the appellant's explanation of partial pressure difference during the oral proceedings, but found differently in its decision.

The respondent (opponent) did not file any comments on the question of the allowability of the requested correction.

Reasons for the Decision

1. *Procedural matters*

1.1 Competence

Although in a different composition due to the fact that the chairman and the members involved in decision T 367/96 have left the board 3.4.2 in the meantime, it is this board which has taken the decision of which correction is sought. This board is thus the competent body for dealing with this matter (see decisions of the Enlarged Board of Appeal G 8/95, OJ EPO 1996, 481, point 3.4 of the Reasons and G 1/97, OJ EPO 2000, 322, point 6 of the Reasons).

Incidentally the board notices that the appellant with its letter of 10 April 1998 actually presented its request for correction under Rule 89 EPC to the opposition division instead of presenting it to this board. Had the opposition division however immediately referred the case to the board, the issue might have been resolved in a more expedient manner.

1.2 Jurisdictional measures and admissibility

According to decision G 1/97, if it is clear that an appellant's request was based on an alleged violation of a fundamental procedural principle and aimed at the revision of a final decision taken by a board of appeal having the force of res judicata, it should be refused immediately as inadmissible, without any further procedural formalities. This jurisdictional measure applies only to requests directed against a decision of a board of appeal bearing a date after that of decision G 1/97, which is 10 December 1999 (see points 1 to 3 of the Order).

Similar requests concerning earlier decisions should be subject to administrative measures (see point 7 of the Reasons).

The decision of which correction is requested here bears the date of 11 December 1998, which is prior to the date of decision G 1/97. Thus, the appellant's request would be subject to purely administrative measures, if it were to fall under the kind of requests to which decision G 1/97 refers, namely those "based on an alleged violation of a fundamental procedural principle and aimed at the revision of a final decision taken by a board of appeal having the force of res judicata".

In the present instance, however, the appellant submits that it only seeks correction under Rule 89 EPC of an obvious mistake in the decision. Such correction, if justified in substance, would not in principle result in a revision of the decision based on a violation of a fundamental procedural principle, within the meaning of decision G 1/97.

The board therefore considers that it must evaluate the merits of the submission requesting a correction, taking proper account of the facts of the case and of the other party's submissions if any, i.e. within the framework of *inter partes* proceedings and on this basis decide whether or not it could actually proceed to the correction under Rule 89 EPC (in analogy to the decision of 30 November 2000 taken by technical board of appeal 3.3.2 on a request for correction of its decision T 867/96, not published in the OJ EPO).

Accordingly, the request for correction is admissible.

2. *Allowability of the request for correction*

Rule 89 EPC states that: "In decisions of the European Patent Office, only linguistic errors, errors of transcription and obvious mistakes may be corrected". According to decision G 1/97, point 3(c) of the Reasons, Rule 89 EPC should be limited to its narrow wording.

Thus, like Rule 88 EPC which explicitly refers to "linguistic errors, errors of transcription and mistakes in any **document** ..." (emphasis added) Rule 89 EPC only allows for correction of formal errors in the **written text** of the decision notified to the parties in accordance with Rule 68 EPC. Rule 89 EPC does not however pave the way to reexamination of the factual or legal issues on which a decision was based, nor to reversal of any conclusion derived by the deciding body from a consideration of these issues.

Therefore neither an alleged incorrect understanding by the board of appeal of the content of a prior art citation nor the contention that the decision was based on an interpretation which in the course of oral proceedings was shown to be wrong by the appellant and which was admitted to be so by the board - as was submitted by the appellant in its letter 10 April 2001 - nor the consequential refusal of the appellant's corresponding request can provide a basis for a correction of the decision under Rule 89 EPC, as they do not constitute linguistic errors, errors of transcription or obvious mistakes which are open for such a correction.

The appellant's request cannot therefore be allowed, and there is no need to investigate the merits of the appellant's submissions as to board's understanding of citation D1 in its earlier decision.

Order

For these reasons it is decided that:

The appellant's request for correction of the decision under Rule 89 EPC is refused.

The Registrar:

The Chairman:

P. Martorana

A. Klein

